No. 17-571

IN THE
# Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
*Petitioner*,

v.

WALL-STREET.COM, LLC AND JERROLD D. BURDEN,
*Respondents*.

**On Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit**

## BRIEF FOR PETITIONER


JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN INTELLECTUAL PROPERTY LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

AARON M. PANNER
*Counsel of Record*
GREGORY G. RAPAWY
GRACE W. KNOFCZYNSKI
KELLOGG, HANSEN, TODD, FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)


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## QUESTION PRESENTED

Section 411(a) of the Copyright Act provides (with qualifications) that "no civil action for infringement of [a] 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." 17 U.S.C. § 411(a). The question presented is:

Whether "registration of [a] copyright claim has been made" within the meaning of § 411(a) when the copyright holder delivers the required application, deposit, and fee to the Copyright Office, as the Fifth and Ninth Circuits have held, or only once the Copyright Office acts on that application, as the Tenth Circuit and, in the decision below, the Eleventh Circuit have held.

## PARTIES TO THE PROCEEDINGS

Petitioner Fourth Estate Public Benefit Corporation was the plaintiff and the appellant in the proceedings below.

Respondents Wall-Street.com, LLC and Jerrold D. Burden were the defendants and the appellees in the proceedings below.

## RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, petitioner Fourth Estate Public Benefit Corporation states that it is a public benefit corporation that has not issued any stock.

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## INTRODUCTION

The Copyright Act requires, before a civil action for infringement is brought, that "registration of the copyright claim . . . be[] made in accordance with this title." 17 U.S.C. § 411(a). Read together with the statute as a whole, that language is best understood to mean that, before bringing suit, the copyright owner must comply with the statutory formalities required for registration – that is, the owner must "deliver[] to the Copyright Office the deposit [of copies of the work] specified" in § 408, "together with the application and fee specified by sections 409 and 708." *Id.* § 408(a). It does not require the completion of the potentially far longer process – frequently taking months or years – through which the Register of Copyrights, "after examination, . . . 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," and thus "register[s] the claim." *Id.* § 410(a).

The Copyright Act, including in the provisions most directly addressing the significance of registration in litigation, consistently employs the phrase "make registration" and its passive-voice counterparts such as "registration has been made" to refer to *the copyright owner's* compliance with the statutory registration requirement, not the determination by the Copyright Office that all formalities have been satisfied. That is true of other subsections of § 411 itself, and of a related provision – § 412 – that requires copyright owners to make registration within three months of first publication of a work as a condition of obtaining statutory damages and attorney's fees.

Just as important, petitioner's construction comports with the statute's rejection of formalities – which all prior federal statutes had required to some degree – as a condition of statutory copyright protection. The Act grants a copyright owner exclusive rights in a work as soon as it is fixed in a tangible medium of expression, *see id.* § 102(a), and "registration is not a condition of copyright protection," *id.* § 408(a). To be sure, before a copyright owner can sue to enforce those rights, the copyright owner must register the claim with the Copyright Office. But once the copyright owner has submitted the required application, deposit, and fee, that requirement is vindicated. That is confirmed by the fact that, in cases where the Register refuses to register the claim, the copyright owner may sue nevertheless; it is likewise confirmed by the fact that the statute, in § 410(d), gives courts the power to determine, in the first instance, whether the copyright owner complied with the statutory prerequisites for registration.

A contrary reading of § 411(a) would make the Register a gatekeeper to the courthouse, allowing bureaucratic delays concerning such matters as classification to prevent a copyright owner from promptly enjoining infringement that may significantly undermine the value of its property. As this Court has noted, "[w]ithout right of vindication a copyright is valueless." *Washingtonian Publ'g Co. v. Pearson*, 306 U.S. 30, 40 (1939). There is nothing in the structure or history of the Copyright Act to suggest that the Register's determination – or, in this case, the 16-month-long absence of any such determination – should be given such out-sized importance in the statutory scheme.

## OPINIONS BELOW

The opinion of the court of appeals (App. 1a-10a) is reported at 856 F.3d 1338. The order of the district court granting respondents' motion to dismiss (App. 11a-14a) is not reported (but is available at 2016 WL 9045625).

## JURISDICTION

The court of appeals entered its judgment on May 18, 2017. On August 7, 2017, Justice Thomas extended the time for filing a certiorari petition to and including October 13, 2017, App. 36a; the petition was filed on that date and granted on June 28, 2018, 138 S. Ct. 2707. The jurisdiction of this Court rests on 28 U.S.C. § 1254(1).

## STATUTORY PROVISIONS INVOLVED

Relevant provisions of the Copyright Act (17 U.S.C.) are reproduced at App. 23a-35a.

## STATEMENT

### A. Statutory Background

The Copyright Act protects "original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated." 17 U.S.C. § 102(a). As soon as a work is created, the copyright owner holds exclusive rights "to do and to authorize" others to do certain things with the work. *Id.* § 106; *see Harper & Row, Publ'ers, Inc. v. Nation Enters.*, 471 U.S. 539, 546-47 (1985). Accordingly, unlike useful inventions – which are protected by exclusive rights only after a patent application has been approved by the Patent and Trademark Office and a patent issued – original works of authorship are protected by virtue of their creation, not by an administrative agency's affirmative grant.

**1.** The Copyright Act also contains provisions for registration of copyrights. The statutory registration requirement dates to the original copyright statute, but its nature has changed substantially over time. *See generally* Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (Aug. 1958) ("Kaplan, *Registration*") (reviewing history).[1] The first copyright statute, adopted by the First Congress in 1790, made registration a prerequisite for any statutory right. *See Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 662 (1834). Copyright protection extended to domestic "map[s], chart[s], [and] book[s]"; and "no person" would be entitled to the protection "unless he shall before publication deposit a printed copy of the title . . . in the clerk's office of the district court." Act of May 31, 1790, ch. 15, § 3, 1 Stat. 124, 125. The clerk was "directed and required to record the same forthwith." *Id.* The "author or proprietor" was also required to publish a copy of the district court record in a newspaper "for the space of four weeks." *Id.* After publication, it was required that a copy of the work be delivered to the Secretary of State, "to be preserved." *Id.* § 4. In 1802, Congress added a provision requiring publication of copyright notice in the work itself. Act of Apr. 29, 1802, ch. 36, § 1, 2 Stat. 171, 171.

Although the details changed, these basic requirements – publications with notice, registration, and deposit – remained in place for more than a century. *See* Kaplan, *Registration* at 15 ("[T]he old pattern

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[1] *Reprinted in Copyright Law Revision: Studies Prepared for the Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary*, 86th Cong. (Comm. Print 1960), *available at* https://www.copyright.gov/history/studies/.

was unbroken: securing copyright depended on compliance, and exact compliance, with formalities – notice, registration, and deposit."); *Washingtonian Publ'g*, 306 U.S. at 37.

**2.** The Copyright Act of 1909 ("1909 Act") – which remained in force (with amendments) until the current Copyright Act of 1976 ("1976 Act") came into effect – abolished the requirement of registration as a condition of copyright. Instead, the statute (1) provided that, in the case of unpublished works, the author could enforce common-law rights (under state, not federal, law), *see* 17 U.S.C. § 2 (1970); (2) established that statutory copyright in published works could be secured "by publication thereof with the notice of copyright required by this title," *id.* § 10; and (3) allowed statutory copyright to be obtained for works, "of which copies are not reproduced for sale," by deposit of the work, *id.* § 12. Registration could still be obtained for published works, by "complying with the provisions" of the statute, including the requirement for "deposit of copies" as set forth in § 13. *Id.* § 11. In the case of works published with notice of copyright, furthermore, the statute required that two copies of the work be "promptly deposited" in the Copyright Office. *Id.* § 13. Although the 1909 Act (unlike prior legislation) did not require registration as a condition of copyright, it did provide that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with." *Id.*

Two interpretative issues arose concerning the deposit and registration requirements contained in § 13. The first was whether a copyright owner's

failure to deposit copies *promptly* could bar an action for infringement. In *Washingtonian Publishing*, this Court answered that question in the negative. In that case, the petitioner had published an issue of a monthly magazine with the required copyright notice; 14 months later, copies were first deposited and a certificate of registration issued. 306 U.S. at 33-34. The defendant argued that failure to make prompt deposit defeated the copyright owner's right to bring an action "because of infringement prior in date to a tardy deposit." *Id.* at 35-36.

This Court disagreed. It noted that the 1909 Act "was intended definitely to grant valuable, enforceable rights to authors, publishers, etc., without burdensome requirements." *Id.* at 36. Although "[u]nder the old Act deposit of the work was essential to the existence of copyright," that "requirement caused serious difficulties and unfortunate losses." *Id.* at 37. The new statute therefore made publication with notice all that was necessary to secure a copyright in a published work. Although the statute also required prompt deposit, allowing failure to comply with that requirement to defeat the copyright owner's cause of action "would not square with the words actually used in the statute, would cause conflict with its general purpose, and in practice produce unfortunate consequences." *Id.* at 39. "Petitioner's claim of copyright came to fruition immediately upon publication. Without further notice it was good against all the world. Its value depended upon the possibility of enforcement." *Id.*[2]

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[2] The Court noted if the Register "finds undue delay" he could "require deposit of copies"; failure to comply would subject the copyright owner to a fine, a penalty "adequate . . . to enforce

A second question arose as to whether a copyright owner could bring suit if the copyright owner had complied with the requirements of § 13 but the Register had not granted registration. The first court to address this issue said yes: in *White-Smith Music Publishing Co. v. Goff*, 187 F. 247 (1st Cir. 1911), the plaintiff (a music publisher) claimed a statutory extension of copyright, applied for registration, and was refused. The court, while ruling against the plaintiff on the merits, held that it could sue because "it fully complied with the requirements of law, and is entitled to maintain this suit if it had any statutory right to the extension." *Id.* at 247.

A subsequent decision of the Second Circuit, however, suggested a different view. In that case, the plaintiff published photographs and obtained certificates of registration, but "[t]he trouble [wa]s that the certificates of registration [we]re for photographs not to be reproduced for sale, no date of publication being stated." *Lumiere v. Pathe Exch., Inc.*, 275 F. 428, 430 (2d Cir. 1921). The court held that, because "[d]eposit of copies and registration is each a condition precedent of the right to maintain an action for infringement," the suit had to be dismissed without prejudice. *Id.*

These conflicting views persisted until the 1976 Act was adopted. In *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958), the question was whether the plaintiff, which had sought copyright registration for a watch-

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contributions of desirable books to the Library [of Congress]." *Washingtonian Publ'g*, 306 U.S. at 40-41; *cf.* 17 U.S.C. § 407(d) (maintaining fines for failure to comply with current deposit requirements); *infra* note 4.

face design, could sue despite the refusal of registration by the Register. A divided Second Circuit, in an opinion by Judge Learned Hand (who had been the district judge in *Lumiere*), said no: the court held that the 1909 Copyright Act "forbade any action for infringement of the copyright when the Register of Copyrights had refused" registration. *Id.* at 639. Instead, the copyright owner would first have to seek mandamus to correct the allegedly unlawful refusal to grant registration. *Id.* at 640.[3] By contrast, in *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970), the court reached the opposite conclusion, finding that, when "plaintiff placed the revised applications in the mail on July 27, 1966, it had done everything required of it under the copyright law with respect to the deposit of copies and registration and could therefore, on that day 'maintain' that action." *Id.* at 1108-09.

**3.** In the 1976 Act, Congress retained provisions for registration, while making clear that the copyright owner's compliance with the registration requirement – not the grant of registration by the Register – is what is required to initiate a suit for infringement.

The copyright owner "may obtain registration of the copyright claim" by depositing a copy (or, in the

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[3] Judge Clark dissented. He found that § 13 "[q]uite obviously . . . puts the condition of complying with the law, including the deposit of copies, upon the copyright owner before he sues." *Vacheron*, 260 F.2d at 645 (Clark, C.J., dissenting). He rejected the proposition that the plaintiff would have to wait until the Register "performed his statutory duties" to sue, noting that to "read this serious prohibition into the single word 'registration'" was "belied by both the immediate context and the general statutory scheme of copyright." *Id.*

case of published works, two copies) of the work, along with "the prescribed application and fee" with the Copyright Office. 17 U.S.C. § 408(a), (b); *see also id.* § 409 (describing required elements of the application).[4]

The Register of Copyrights is required to conduct an examination, and, if the Register determines that "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 a "certificate of registration." *Id.* § 410(a). The "effective date of a copyright registration" is not the date of issuance of the certificate but is instead "the day on which an application, deposit, and fee, which are later determined . . . to be acceptable for registration, have all been received in the Copyright Office." *Id.* § 410(d).

If, on the other hand, the Register determines that "the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason," the Register "shall refuse registration" and notify the applicant of the reasons for refusal. *Id.* § 410(b).[5]

The new statute also maintains the requirement that a copyright owner seek registration before filing suit for infringement. Section 411(a) provides that

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[4] The statute also retained a requirement for the deposit of published works for the Library of Congress. *See* 17 U.S.C. § 407. The copies so deposited "may be used to satisfy the deposit provisions" of § 408. *Id.* § 408(b).

[5] Copyright Office regulations provide for internal administrative review of an examiner's decision to refuse registration – a procedure referred to as "reconsideration." *See* 37 C.F.R. § 202.5.

"no 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." *Id.* § 411(a).[6] The statute makes clear, however, that, whether registration is granted or refused, the copyright owner may initiate suit as long as "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form." *Id.* In any case where "registration has been refused," the plaintiff is required to serve a notice of the suit, "with a copy of the complaint," on the Register of Copyrights. *Id.* Once the Register is served, she has 60 days to intervene "with respect to the issue of registrability of the copyright claim." *Id.* The litigation may proceed irrespective of the Register's participation. *See id.*

A certificate of registration obtained before or promptly after publication confers certain litigation

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[6] As adopted in 1976, this provision read "no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title." Pub. L. No. 94-553, § 101, 90 Stat. 2541, 2583. The limitation to United States works was added as part of the Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 9(b)(1), 102 Stat. 2853, 2859. *See also* Digital Millennium Copyright Act, Pub. L. No. 105-304, § 102(d), 112 Stat. 2860, 2863 (1998) (modifying language); *see generally Golan v. Holder*, 565 U.S. 302, 306-14 (2012). The statutory provisions governing preregistration, and the reference to preregistration in § 411(a), were added in 2005. *See* Artists' Rights and Theft Prevention Act of 2005, Pub. L. No. 109-9, tit. I, § 104(b), 119 Stat. 218, 222. The limitation to "civil" actions was added in 2008. *See* Prioritizing Resources and Organization for Intellectual Property Act of 2008, Pub. L. No. 110-403, § 101(a), 122 Stat. 4256, 4257.

advantages. In particular, if a plaintiff has a certificate of a registration "made before or within five years after first publication of the work," the certificate "shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate"; the "evidentiary weight to be accorded" a certificate granted thereafter is left to the court's discretion. *Id.* § 410(c).

The requirement that a copyright owner comply with the prerequisites for registration before bringing suit is not the only statutory inducement to registration. *See Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 158 n.1 (2010) (noting that the Act "establish[es] remedial incentives to encourage copyright holders to register their works"). Section 412 provides (with enumerated exceptions) that "no award of statutory damages or of attorney's fees, as provided by sections 504 and 505, shall be made for" any infringement of a work "commenced . . . before the effective date of its registration." 17 U.S.C. § 412. In the case of published works, however, the statute provides a grace period, allowing such damages if "registration is made within three months after the first publication of the work." *Id.* § 412(2).

**4.** Commentators and the Copyright Office itself have recognized that the Office "has been experiencing an upward trend in the backlog of claims and average processing time for applications [for registration]."[7] In its 2009 annual report, the Office reported

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[7] Statement of Maria A. Pallante, U.S. Register of Copyrights, Before the Subcommittee on Legislative Branch Appropriations, U.S. Senate, Fiscal 2016 Budget Request at 4 (Mar. 17, 2015) ("Pallante Statement"), *available at* https://www.appropriations.senate.gov/imo/media/doc/hearings/031715%20LOC%20Register%

that its average processing time for claims had increased from 82 days in 2005 to 309 days in 2009.[8] In its most recent annual report, the Office reported that it had received nearly 540,000 claims for registration in fiscal year 2017 and ended the year with "more than 335,000 claims on hand in the system," including "more than 55,000" that "required more information from applicants."[9] Those who deal with the Office regularly report that long delays both in registration and in responding to correspondence are common.[10] The Office refused registration on "nearly

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20of%20Copyrights%20Testimony%20-%20LegBranch.pdf; *see also* U.S. Copyright Office, "Registration Processing Times" (reporting average processing times of 7-16 months for registration applications), https://www.copyright.gov/registration/docs/processing-times-faqs.pdf.

[8] U.S. Copyright Office, *Annual Report of the Register of Copyrights* 47 (2009), *available at* https://www.copyright.gov/reports/annual/2009/ar2009.pdf. In its 2011 annual report, the Office reported that processing times had gotten shorter while noting that, as a result of the need for paper submissions and "because some claims require the Office to further correspond with the applicant, the Office always has categories of work that take longer to process," something that it considers a "routine part of the Office's business operations." U.S. Copyright Office, *Annual Report of the Register of Copyrights* 21-22 & n.2 (2011), *available at* https://www.copyright.gov/reports/annual/2011/ar2011.pdf.

[9] U.S. Copyright Office, *Fiscal 2017 Annual Report* 4 (2017) ("*2017 Annual Report*"), *available at* https://www.copyright.gov/reports/annual/2017/ar2017.pdf.

[10] *See* Comments of Science Fiction and Fantasy Writers of America, Inc., et al., at 3, *Group Registration of Unpublished Works*, Copyright Office Docket No. 2017-15 (filed Nov. 13, 2017) (noting "mean delay of well over a year between application and issuance of a certificate"), *available at* https://www.regulations.gov/document?D=COLC-2017-0009-0076; Comments

18,000 claims," about 3% of claims processed.[11] It is not clear what percentage of those rejections involved questions of copyrightable subject matter, but the very small number of requests for administrative review following a rejection – in Fiscal 2017, only 361 such requests involving 429 claims were made – may indicate that many rejections are for "legal or procedural" reasons other than copyrightability.[12]

The backlog in applications is due in no small part to the fact that, "[b]ecause the Office depends on Congress to appropriate taxpayer dollars to fund over a third of its budget, and depends on its parent agency, the Library of Congress, to request those appropriations, it is chronically short of funds."[13]

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of the National Press Photographers Ass'n at 12, *Copyright Office Fees*, Copyright Office Docket No. 2012-1 (filed May 14, 2012) ("The current registration process takes too long and creates a burden for registrants."), *available at* https://www.copyright.gov/docs/newfees/comments/05142012/; Joint Comments of American Society of Media Photographers and Professional Photographers of America at 9, *Copyright Office Fees*, Copyright Office Docket No. 2012-1 (filed May 14, 2012) (reporting batch registration held "for almost a year without notifying [the registrant]"), *available at* https://www.copyright.gov/docs/newfees/comments/05142012/.

[11] *2017 Annual Report* at 4.

[12] *Id.*

[13] Robert Brauneis, *Properly Funding the Copyright Office: The Case for Significantly Differentiated Fees*, GW Law School Public Law and Legal Theory Paper No. 2017-58, at 1-2 (2017) ("Brauneis, *Properly Funding the Copyright Office*") (footnote omitted), *available at* https://ssrn.com/abstract=2997192; *see also* Copyright Alliance, "Copyright Registration" (explanation for increased processing times by U.S. Copyright Office official), https://copyrightalliance.org/ca_faq_post/can-you-please-explain-why-the-timeline-for-receiving-a-certificate-of-registration-has-

Not only has this resulted in serious delays in registration, but it has also led the Office to adopt a practice of "accepting some registration applications with radically incomplete authorship information"; more generally, because of the reduction in information recorded by the Office, "a large number of records in the electronic catalog" of registrations "have very thin information, . . . in some cases mak[ing] it more difficult to identify the work that has been registered."[14]

To "reduce the length of time required to process an application for registration of a claim to copyright," the Copyright Office established, several decades ago, a procedure known as "special handling," which is "granted at the discretion of the Register of Copyrights in a limited number of cases as a service to copyright registrants who have compelling reasons for the expedited issuance of a certificate of registration." Policy Decision Announcing Fee for Special Handling of Applications for Copyright Registration, 47 Fed. Reg. 19,254, 19,254 (May 4, 1982). In 1982, for the first time, the Register established a fee for this service while retaining the discretion to reject requests to provide it, *see id.* at 19,254-55, a discretion it retains today, *see* Policy Decision: Revised Special Handling Procedures, 56 Fed. Reg. 37,528, 37,529 (Aug. 7, 1991); U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 623.2 (3d ed. 2017), *available at* https://www.copyright.gov/comp3/docs/compendium.pdf. In those cases where the Register decides to provide special handling, the additional

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gone-from-three-months-to-eight-months/ (last visited Aug. 21, 2018).

[14] Brauneis, *Properly Funding the Copyright Office* at 7-8.

charge for each application is $800, a fee that the Register has proposed to increase to $1,000. *See* Copyright Office Fees, 83 Fed. Reg. 24,054, 24,060 (May 24, 2018).

**B. Factual Background**

**1.** Fourth Estate "is an independent news organization" whose journalists produce "high quality, timely, accurate and compelling journalism." App. 15a-16a (Compl. ¶¶ 1-2). Fourth Estate owns the copyrights in those journalists' works and licenses them to a cloud-based news organization called AHN Feed Syndicate; AHN Feed Syndicate, in turn, licenses them to others. App. 16a, 18a (*id.* ¶¶ 2, 4, 14-15). Fourth Estate retains the right to sue for copyright infringement. App. 16a (*id.* ¶ 2).

This case concerns one of AHN Feed Syndicate's former licensees, Wall-Street.com, LLC ("Wall-Street"). Wall-Street secured a license to put some of Fourth Estate's works on the Internet. App. 18a (*id.* ¶ 17). Under that license, if Wall-Street canceled its account with AHN Feed Syndicate, Wall-Street was to "stop display of all Feed Syndicate provided content and permanently take down, remove and/or delete all cached, saved, archived, stored or data-based content or data." *Id.* (*id.* ¶ 18). Wall-Street canceled its account but continued to copy and distribute 244 of Fourth Estate's works. App. 18a-19a (*id.* ¶¶ 15, 19); *see* Compl. Ex. 1, ECF 1-2.

**2.** In March 2016, Fourth Estate sued Wall-Street, seeking an injunction and damages. App. 21a-22a (Compl. at 7). Before it did so, it filed its application for registration with the Copyright Office; it did not wait for the Office to act on that application. App. 18a (*id.* ¶ 14).

In its brief on the petition in this case, the government represented to the Court that it sent a letter rejecting petitioner's group application on August 4, 2017, approximately 16 months after the application was complete. *See* U.S. Inv. Br. App. 3a-4a.[15] The rejection letter (which is not in the record) casts no doubt on the copyrightability or registrability of the works at issue in the underlying suit. Instead, the letter faults petitioner for submitting several news articles for group registration as a database; "[i]n order to register the articles contained within this claim, separate applications for each article must be submitted to the Copyright Office." *Id.* at 9a. Petitioner had not previously had any reason to think the Office would take that position: AHN Media Corp., predecessor to AHN Feed Syndicate, had previously and successfully made group registration for databases containing the same type of material at issue here.[16]

**C. Proceedings Below**

Wall-Street moved to dismiss the complaint, arguing that § 411(a) bars Fourth Estate from suing until after the Register of Copyrights acts on its application. The district court granted the motion. App. 13a.

Recognizing that this case "require[d] [it] to decide an issue that has divided the circuits," App. 1a, the

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[15] Such a delay is not unusual: in 2015, the Register informed Congress that the "average processing time" for paper applications (like petitioner's) was 13.5 months. Pallante Statement at 4.

[16] *See*, *e.g.*, Registration Nos. TX0006595981 (Apr. 30, 2007), TX0006595982 (Apr. 30, 2007), TX0006596887 (June 25, 2007) (searchable at https://cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?DB=local&PAGE=First).

Eleventh Circuit held that the text of the Copyright Act required dismissal – aligning itself with the Tenth Circuit and expressly rejecting the contrary view of the Fifth Circuit and the Ninth Circuit. App. 4a-6a. The court stated that the Act "defines registration as a process that requires action by both the copyright owner and the Copyright Office." App. 6a. The court held that the use of the phrase "after examination" in § 410(a) – which describes the procedure that the Register must follow in registering a claim – "makes explicit that an application alone is insufficient for registration." *Id.* Furthermore, § 410(b) authorizes the Register to "refuse registration"; the court believed that, if "registration occurred as soon as an application was filed, then the Register of Copyrights would have no power to 'refuse registration.'" App. 7a (quoting 17 U.S.C. § 410(b)).

The court rejected Fourth Estate's contrary arguments based on other provisions of the statute. The court read § 408(a) – which states that a copyright owner "may obtain registration of the copyright claim by delivering" the required materials to the Register, 17 U.S.C. § 408(a) – to say nothing about when registration occurs, but only about "the conditions a copyright owner must satisfy to obtain registration." App. 7a. It likewise found it insignificant that § 410(d) provides that the effective date of registration is the date the application is complete, rather than the date the Copyright Office acts on an application. In the court's view, that section supports its rule because "registration occurs only after the Register of Copyrights deems an application 'to be acceptable.'" App. 8a (quoting 17 U.S.C. § 410(d)).

The court also acknowledged the harsh result that its rule, together with the statute of limitations,

can bring about: "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." *Id.* "But," in the court's view, "this potential loss encourages an owner to register his copyright soon after he obtains the copyright and before infringement occurs." *Id.* The court also refused to consider the Copyright Act's legislative history and animating policy, instead finding the language that other courts of appeals had interpreted differently to be "unambiguous." App. 9a.

## SUMMARY OF ARGUMENT

The text of the Copyright Act, particularly when read in light of its history, makes clear that the registration requirement in § 411(a) imposes an obligation on the copyright owner to file for registration before initiating suit; it does not require any particular action by the Register. That interpretation, moreover, comports with the overall statutory structure and purpose and avoids the serious disadvantages of the rule adopted by the court below.

**I.A.** The phrase "registration has been made" and related constructions are used consistently in the 1976 Copyright Act to connote the action of a copyright owner in submitting the required deposit, fee, and application to obtain registration. *See Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 536 (2013) (noting that "we normally presume" that a statutory phrase "carr[ies] the same meaning when [it] appear[s] in different but related sections"). Section 411(c) – which was originally codified as § 411(b) – permits an action for infringement of the copyright in "a work consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission," to be initiated if, among other require-

ments, "*the copyright owner . . . makes registration* for the work . . . within three months after its first transmission." 17 U.S.C. § 411(c)(2) (emphasis added). The construction "copyright owner . . . makes registration" parallels the passive-voice construction "registration . . . has been made," confirming that, while the Copyright Office "register[s] [a] claim," *id.* § 410(a), the copyright owner "makes registration."

Section 412 likewise supports petitioner's reading. That provision precludes the "award of statutory damages or of attorney's fees" for any "infringement . . . commenced . . . before the effective date of its registration unless" – in the case of published works – "such *registration is made* within three months after the first publication." *Id.* § 412(2) (emphasis added). The evident purpose of this provision – to provide a safe-harbor for a copyright owner who complies with the registration requirement promptly after publication – makes it implausible to suggest that it puts the diligent copyright owner at the mercy of bureaucratic delay by the Copyright Office. *Cf. Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 346 (1998) (construing statutory term in light of context of related provisions). Additional provisions of the statute likewise use the phrase in a context that clearly refers to the action of the copyright owner, not the Copyright Office. *See* 17 U.S.C. § 408(c), (e).

**B.** The second sentence of § 411(a) – which applies "[i]n any case . . . where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused" – demonstrates only that the single word "registration" can *also*, in context, refer to the action of the Register in refusing (or granting) registration. That is not surprising: the statute provides no special definition of "registration"

and the ordinary meaning of "registration" has this flexibility built in. On a correct reading, this provision reinforces the conclusion that the phrase "registration . . . has been made" means that registration has been made by the copyright owner.

**II.** The history of § 411(a) reinforces this textual analysis. When the 1976 Act was adopted, courts were divided with respect to whether the Register's failure to grant registration could block a copyright owner from suing for infringement; the statute now makes clear that it cannot. Given that Congress wanted to avoid that result, it makes little sense to claim that Congress intended to give the Copyright Office the power to block suit through bureaucratic delay. *Cf. American Broad. Co. v. Aereo, Inc.*, 134 S. Ct. 2498, 2507 (2014) (refusing to credit construction that would permit result that Congress legislated to avoid). Moreover, the statute not only provides that a copyright owner may sue in "any case" where the Register refuses registration but also alters the language of the prior statute – its reference to "deposit of copies *and* registration of such work," 17 U.S.C. § 13 (1970) (emphasis added) – that had been cited in support of the conclusion that action by the Register was required before a suit could be filed.

**III.** Granting the Register the power to delay a copyright owner from suing to prevent ongoing infringement also would be inconsistent with the scheme of rights and remedies that the Copyright Act creates. The statute expressly states that "registration is not a condition of copyright protection." 17 U.S.C. § 408(a). Yet as this Court recognized in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939), without a right of enforcement, a copyright provides hardly any protection at all. *See id.* at 39 (the value of a copyright "depend[s] upon the possi-

bility of enforcement"). Any claim that a decision by the Register should always be obtained before litigation is allowed to proceed founders on the express statutory recognition that courts, not just the Register, have the authority to determine that the requirements for registration have been complied with. *See* 17 U.S.C. § 410(d).

## ARGUMENT

### I. THE STATUTORY TEXT MAKES CLEAR THAT THE COPYRIGHT OWNER MAKES REGISTRATION FOR PURPOSES OF § 411(a) BY COMPLYING WITH THE STATUTE'S REQUIREMENTS

The text of § 411 and surrounding provisions make clear that the phrase "registration . . . has been made" in § 411(a) refers to the actions of the copyright owner in submitting the deposit, application, and fee required for registration, not to a later determination by the Register.

#### A. The Statute Employs the Phrase "Make Registration" and Its Variants To Refer to the Actions of the Copyright Owner

Careful attention to the statutory text demonstrates that the phrase "make registration" and its passive-voice counterpart "registration has been made" is used in the Copyright Act to refer to the action of the copyright owner and not to the action of the Copyright Office. *See Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) ("[I]nterpretation of a phrase of uncertain reach is not confined to a single sentence when the text of the whole statute gives instruction as to its meaning.") (alteration in original). It is a "standard principle of statutory construction . . . that identical words and phrases within the same statute should normally be

given the same meaning." *Powerex Corp. v. Reliant Energy Servs., Inc.*, 551 U.S. 224, 232 (2007). That principle supports petitioner here.

**1.** *First*, within § 411(a) itself, the phrase "registration of the copyright claim has been made *in accordance with this title*" (emphasis added) more naturally refers to the owner's actions, because the owner's right to sue turns on whether the owner's actions (not the Copyright Office's) "complied with the relevant statutory . . . registration procedures." *Harper & Row, Publ'ers, Inc. v. Nation Enters.*, 471 U.S. 539, 547-48 (1985) (citing § 408, which addresses procedures that copyright owners must follow to "obtain registration"); *see also Golan v. Holder*, 565 U.S. 302, 314 n.11 (2012) ("The Copyright Act retains . . . incentives for *authors to register* their works") (emphasis added); *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 171 (2010) (Ginsburg, J., concurring in part and concurring in the judgment) (describing § 411(a) as "instruct[ing] *authors to register* their copyrights before commencing suit for infringement") (emphasis added).

*Second*, § 411(c), which applies to works consisting of "sounds, images, or both, the first fixation of which is made simultaneously with transmission," allows a copyright owner to institute an action for infringement if (among other requirements) "*the copyright owner . . . makes registration* for the work, if required by subsection (a), within three months after its first transmission." 17 U.S.C. § 411(c)(2) (emphasis added). This active-voice construction, with "the copyright owner" as the subject, implies that the passive-voice construction "registration . . . has been made" likewise refers to the action of the copyright owner. That inference is particularly strong because § 411(c)

was originally codified as § 411(b), in immediate juxtaposition to § 411(a). *See* 90 Stat. 2583. In such circumstances, the "maxim" favoring consistent construction "is doubly appropriate." *Powerex*, 551 U.S. at 232.[17]

*Third*, in § 412, the statute uses the phrase "registration is made" in a context that makes clear that it refers to the action of the copyright holder. 17 U.S.C. § 412(2); *cf. Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 346 (1998) (interpreting statutory term in light of its use in context of related provisions). Section 412 specifies (with certain statutory exceptions) that "no award of statutory damages or of attorney's fees . . . shall be made for . . . any infringement of copyright commenced after first

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[17] The explanation of § 411(a) in the House Report accompanying the 1976 Act likewise indicates that the language of § 411(a) refers to the action of the copyright owner, not the Register:

> 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*.

H.R. Rep. No. 94-1476, at 157 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5773 (Comm. on the Judiciary) (emphases added). *See also Copyright Law Revision – Part 6: Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill* 124 (Comm. Print 1965) ("*1965 Supplementary Report*") ("[T]he owner of an unregistered copyright . . . *must register* his claim before he can enforce his rights in the courts.") (emphasis added), *available at* https://babel.hathitrust.org/cgi/pt?id=mdp.39015030337722;view=1up;seq=151.

publication of the work and before the effective date of its registration, *unless such registration is made* within three months after the first publication of the work." 17 U.S.C. § 412(2) (emphasis added). This provision creates a grace period within which a copyright owner may register a claim in a published work without losing the valuable remedies provided in § 504 and § 505.[18] It would make no sense for the three-month deadline to apply to action by the Copyright Office (which may be delayed due to no fault of the copyright owner); rather, as with § 411(c), this provision requires *copyright owners* to make registration within three months (even though the Copyright Office may – and usually does – act later).

*Fourth*, other provisions of the Act use variants of the phrase "make registration" in the same way. Thus, § 408(c)(3) notes that, "[a]s an alternative to separate renewal registrations under [§ 304(a)], a single renewal registration *may be made* for a group of works by the same individual author, all first published as contributions to periodicals, . . . *upon the filing* of a single application and fee" under certain conditions. 17 U.S.C. § 408(c)(3) (emphases

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[18] *See* H.R. Rep. No. 94-1476, at 158, *reprinted in* 1976 U.S.C.C.A.N. 5774:

> As an exception, however, the clause provides a grace period of three months after publication during which registration can be made without loss of remedies; full remedies could be recovered for any infringement begun during the three months after publication if registration is made before that period has ended. This exception is needed to take care of newsworthy or suddenly popular works which may be infringed almost as soon as they are published, before the copyright owner has had a reasonable opportunity to register his claim.

added). Thus, registration is again "made . . . by the . . . author"; and it is also "made . . . upon . . . filing," not upon approval by the Register. Likewise, § 405(b) protects certain innocent infringers for acts of infringement committed "before receiving actual notice that registration for the work has been made *under section 408*." 17 U.S.C. § 405(b) (emphasis added). Section 408 describes how the *copyright owner* "may obtain registration" – namely, "by delivering to the Copyright Office the deposit specified by [§ 408], together with the application and fee specified by sections 409 and 708." 17 U.S.C. § 408(a). It does not describe the Register's decision to register a claim, which is addressed in § 410.[19]

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[19] The use of the phrase in § 406(a)(1) and § 409 does not shed light on its meaning. The former provision – which addresses the consequences of an error in a copyright notice on copies distributed before March 1, 1989 – states that an error in a copyright notice (1) does not affect "validity and ownership of the copyright" but (2) does provide a "complete defense" to "any person who innocently begins an undertaking that infringes the copyright" if the person "proves that he or she was misled by the notice and began the undertaking in good faith under a purported transfer or license from the person named" in the copyright notice. 17 U.S.C. § 406(a). That defense is unavailable, however, if "registration for the work had been made in the name of the owner of copyright" or a document showing transfer of ownership has been recorded. *Id.*; *see infra* pp. 26-27 (discussing § 205(c)). The government has argued that, because this is a "constructive notice" provision, U.S. Inv. Br. 21, it would make no sense to deprive an infringer of the defense before registration is granted and recorded. But because the "effective date of a copyright registration," 17 U.S.C. § 410(d), is the date that the copyright owner files the application and required copies and fees, it is possible under either competing reading of the statute that the infringer would lose the defense as of that date. That result is not surprising: the statute similarly limits awards "of statutory damages or of attorney's fees"

*Fifth*, § 110 of the 1976 Act – which preserves the penalties established by § 13 of the 1909 Act for failure to make required deposit of works published with notice before the effective date of the 1976 Act, *see* 35 Stat. 1078, codified as amended at 17 U.S.C. § 14 (1970) – provides that "any deposit and registration made after that [effective] date in response to a demand under that section shall be made in accordance with" the provisions of the new Act. 90 Stat. 2600, *reprinted in* 17 U.S.C. § 407 note. It is the copyright owner, not the Copyright Office, who makes a deposit and who responds to "a demand" by the Register. Accordingly, it is also the copyright owner who makes registration under § 110.

*Sixth*, § 205(c) provides that recordation "gives all persons constructive notice of the facts stated in the recorded document" "only if" "(1) the document, or material attached to it, specifically identifies the work to which it pertains so that, after the document is indexed by the Register of Copyrights, it would be revealed by a reasonable search under the title or registration number of the work"; and "(2) registration has been made for the work." 17 U.S.C. § 205(c). In light of its purposes, this provision likewise suggests that the phrase "registration has been made" refers to the action of the copyright owner rather than to the action of the Copyright Office.

Suppose that (1) an author took out a loan against the value of the author's copyright in a work; (2) the

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for infringement of unregistered works but expressly authorizes them for infringement after the "effective date" of registration. *Id.* § 412.

Section 409 refers to a situation where registration has *not* been made – which could refer equally to registration by the copyright owner or the Copyright Office.

lender had a security interest in the copyright; (3) the author had applied for registration; but (4) the Copyright Office had not yet issued a registration certificate. Under petitioner's reading of the phrase "registration has been made," the lender gains protection against a subsequent transferee of the copyright by recording the lien in the manner prescribed in § 205(a) as long as the author has made registration of the work by sending the required application, copies, and fee – whether or not the Copyright Office has yet issued a certificate of registration. Under respondents' reading, the lender remains at risk until the Copyright Office acts, even though the lien documents were on file with the Office and could have been found by searching "under the title . . . of the work." That odd and counterintuitive result is another reason to understand the "making" of registration, here and elsewhere in the statute, as the action of the copyright owner.

*Finally*, it is true that § 708(a) refers to fees that may be charged "on filing each application under section 408 for registration . . . , including the issuance of a certificate of registration if registration is made." *Id.* § 708(a)(1); *see also id.* § 708(a)(2). In this single provision, "registration is made" is used to mean "registration is granted by the Copyright Office." But, as enacted, the 1976 Act did not include this phrase: it simply provided that the fee for registration would "includ[e] the issuance of a certificate of registration." 90 Stat. 2593. The phrase "if registration is made" was added only in 1982 and thus sheds little light on the proper construction of the related phrase in § 411(a). *See Almendarez-Torres v. United States*, 523 U.S. 224, 237 (1998) (finding the use of a disputed statutory term in "later enacted laws" to be

"beside the point" because, among other things, those laws "d[id] not reflect any direct focus by Congress upon the meaning of the earlier enacted provisions"). And that is particularly so because § 708 appears in a separate chapter addressing fees and not in a closely related provision addressing the procedural or litigation consequences of registration.

**2.** The premise of the Eleventh Circuit's decision – that "registration" in the statute uniformly refers to the action of the Register when she registers a copyright claim – is thus incorrect. To be sure, the word "registration" is sometimes used in the statute to refer to the action of the Copyright Office – for example, § 410(a) directs the Register to "register" a claim when legal and formal requirements have been met, and § 410(b) directs the Register to "refuse registration" when such requirements are not met. But the observation that registration *can* be used in a context that refers to the action of the Copyright Office does not mean that it *cannot* refer, in appropriate context, to the action of the copyright holder in applying for registration. *See Barber v. Thomas*, 560 U.S. 474, 484 (2010) (noting that some statutory terms "can [be] easily use[d] in different ways without risk of confusion"); *cf. Feltner*, 523 U.S. at 356 (Scalia, J., concurring in the judgment) (noting that the word "court" can mean either the judge alone or both the judge and the jury).

As a matter of ordinary language, there is nothing paradoxical about this, because the word "registration" has substantial flexibility built in. A college student may register for classes (and thus complete registration) yet not get into a particular course (and thus be denied registration). Indeed, this Court has repeatedly referred to a copyright owner "regis-

tering" a claim. *See, e.g.*, *Golan*, 565 U.S. at 314 n.11; *Reed Elsevier*, 559 U.S. at 157. Furthermore, the statute contains no definition that would cut back on the ordinary meaning of "registration."[20]

To determine how the statute uses the word "registration" in a particular provision of the Copyright Act, it is thus necessary to look to the specific context of the use. Here, the most important textual evidence is its use in the phrase "registration has been made," which, as shown above, the statute consistently employs to refer to the action of the copyright owner, not the Register.

### B. The Portion of § 411(a) Addressing the Consequences of Refusal of Registration Further Supports the Conclusion That "Registration . . . Has Been Made" Refers to the Action of the Copyright Owner

The second sentence of § 411(a) clarifies that the Register's refusal to register a claim does not bar an action for infringement: so long as "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form . . . , the applicant is entitled to institute a civil action for infringement." 17 U.S.C. § 411(a). This provision reversed the result the Second Circuit reached in *Vacheron & Constantin-Le Coultre Watch-*

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[20] Although the statute now contains a definition of the word, it was not included in the 1976 Act, offers no elaboration on the meaning of the term, and was added only in 1992 to clarify that registration referred to both "the original" and "the renewed and extended term of copyright" provided for in that Act. Copyright Renewal Act of 1992, Pub. L. No. 102-307, tit. I, § 102(b)(2), 106 Stat. 264, 266; *cf. Taniguchi v. Kan Pac. Saipan, Ltd.*, 566 U.S. 560, 566 (2012) ("When a term goes undefined in a statute, we give the term its ordinary meaning.").

*es, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958) – as discussed further below – by making clear that the Register's determination that a claim is not registrable does not preclude an action to enforce it.

The specific wording of this provision, moreover, is consistent with the conclusion that "registration has been made" refers to the copyright owner's compliance with statutory requirements, not the decision to register the claim. Otherwise, the two sentences would contradict each other – that is, the second sentence would mean that a suit for infringement may be instituted even though registration had *not* been made. Statutes should be read to avoid, not create, such contradictions. *See Liteky v. United States*, 510 U.S. 540, 552 (1994) (rejecting reading that would cause statute "to contradict itself").

The use of the word "however" in the second sentence does not show that an internal contradiction was intended. *Cf. Dollar Sav. Bank v. United States*, 86 U.S. (19 Wall.) 227, 236 (1874) (rejecting as "inadmissible" a "broad construction of [a] proviso" that would "make[] it plainly repugnant to the body of the act"). The "however" clause can and should be read as a signal that, if the Copyright Office refuses registration, an additional requirement is imposed – notice to the Office. It need not (and therefore should not) be read to state that a civil action may be instituted even though registration has never been "made" at all. Put another way, cases where "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused" constitute a subset of those cases where "registration . . . has been made" that are subject to an additional procedural requirement.

Respondent argues that the use of the word "institute" in the second sentence of § 411(a) implies that the refusal to register must take place before the suit is filed; if refusal must come before a suit is filed, so too must approval. But it is no stretch to read the second sentence of § 411(a) to say that if the copyright owner has complied with the registration requirement a suit may be instituted, and that if a refusal comes (before or after the suit is initiated) notice must be served on the Register.[21] In particular, the statute does not say that notice must be served on the Register before the suit begins: on the contrary, there is no time limit on service, and the fact that a copy of the complaint (not the prospective complaint) must be served indicates that the suit will have begun when the Copyright Office is notified.

In any event, even if the second sentence is read to address how to initiate a suit *after* refusal, and not what to do in a suit already initiated when a refusal comes, it still does not preclude a suit when the copyright owner has complied with the registration requirement but the Register has not acted one way or another. It makes sense to clarify the point that even affirmative rejection of an application does not

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[21] That this is a reasonable reading of the provision is supported by the language of the House Report accompanying the legislation, which states that, "[u]nder section [4]11, a rejected claimant who has properly applied for registration may *maintain* an infringement suit if notice of it is served on the Register." H.R. Rep. No. 94-1476, at 157, *reprinted in* 1976 U.S.C.C.A.N. 5773 (emphasis added). *See also* H.R. Rep. No. 90-83, at 125 (1967) ("[A] rejected claimant who has properly applied for registration may *maintain* an infringement suit if he serves notice of it on the Register of Copyrights.") (emphasis added).

preclude a copyright owner from alleging that "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form," despite the Register's determination to the contrary. That such an action may proceed supports the conclusion that the Register's failure to act cannot bar a suit either.

## II. THE HISTORY OF § 411(a) FURTHER DEMONSTRATES THAT A COPYRIGHT OWNER MAY INSTITUTE A CIVIL ACTION FOR INFRINGEMENT ONCE STATUTORY REQUIREMENTS ARE COMPLIED WITH

At the time of the adoption of the 1976 Act, the courts of appeals had articulated two interpretations of the registration requirement contained in the 1909 Act. One interpretation held that, so long as the copyright owner had complied with statutory formalities, a suit could proceed; the other, that approval by the Register was required. In expressly rejecting the latter view, the statute is most reasonably read to adopt the former. That is particularly clear because the reading adopted by the court below perpetuates the practical defects of the interpretation that the statute rejects. *See American Broad. Co. v. Aereo, Inc.*, 134 S. Ct. 2498, 2505-06 (2014).

**1.** The first sentence of § 411(a) corresponds to the last sentence of § 13 of the previous statute, which provided that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with." 17 U.S.C. § 13

(1970).[22] Like the current statute, this requirement was phrased in the passive voice, and, like the present statute, it gave rise to conflicting interpretations with respect to whether compliance with the requirements of the statute referred to the actions of the copyright owner or required action by the Register as well.

On the one hand, the First and Ninth Circuits understood that the registration requirement was satisfied so long as the copyright owner had "complied with the requirements of law." *White-Smith Music Publ'g Co. v. Goff*, 187 F. 247, 247 (1st Cir. 1911). As the Ninth Circuit explained, once "plaintiff placed the revised applications in the mail . . . , it had done everything required of it under the copyright law with respect to the deposit of copies and registration and could therefore, *on that day* 'maintain' that action." *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1108-09 (9th Cir. 1970) (emphasis added). The same view was also expressed in a dissenting opinion by Judge Clark, who insisted that § 13 "[q]uite obviously . . . puts the condition of complying with the law . . . upon the copyright owner before he sues." *Vacheron*, 260 F.2d at 645 (Clark, C.J., dissenting).

On the other hand, the Second Circuit had held that it was not enough for the copyright owner to comply with statutory requirements; registration by the Register was required. Thus the court of appeals read § 13 to "forb[id] any action . . . when the

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[22] *See* H.R. Rep. No. 94-1476, at 157, *reprinted in* 1976 U.S.C.C.A.N. 5773 ("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.").

Register of Copyrights had refused" the registration. *Id.* at 639 (majority).

The statute rejects the result reached by the Second Circuit, which indicates approval of the understanding of the First and Ninth Circuits (and Judge Clark) that the registration requirement is satisfied once the *copyright owner* has complied with the statute. *See Reed Elsevier*, 559 U.S. at 163-65 (recounting history); *Aereo*, 134 S. Ct. at 2504-05 (relying on intent to overrule result of prior cases to construe scope of provision); *cf. CBOCS W., Inc. v. Humphries*, 553 U.S. 442, 454 (2008) ("After all, the 1991 amendments themselves make clear that Congress intended to supersede the result in *Patterson* [*v. McLean Credit Union*, 491 U.S. 164 (1989)] and embrace pre-*Patterson* law.").

Moreover, the statute eliminates the language in § 13 that the Second Circuit had relied on in reaching its conclusion. The court reasoned that because § 13 barred an action "until the provisions of this [Act] with respect to the deposit of copies *and* registration of such work shall have been complied with" – and because the copyright owner had to deposit copies as part of obtaining registration – the separate statutory reference to registration must refer to the action of the Register. *See Vacheron*, 260 F.2d at 640-41. The 1976 Act avoids any such (mistaken) inference by limiting the requirement to making "registration" – and eliminating the separate reference to "deposit." *Cf. Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 356 (1991) (change in language of successor provision provided clarification of existing law). This provides further evidence that the statute does not require action by the Register before a suit can proceed.

**2.** This conclusion is reinforced because the interpretation adopted by the court of appeals recreates the very problem to which critics of the *Vacheron* rule objected. *See Aereo*, 134 S. Ct. at 2505-07. By requiring a copyright owner to obtain a certificate of registration before bringing suit, the *Vacheron* rule led to potentially lengthy delays while a copyright owner pursued mandamus to compel the Register to register a claim. *See* 260 F.2d at 640; *id.* at 644-45 (Clark, C.J., dissenting). Statements in the many studies and reports prepared in the course of the revision of the copyright laws repeatedly reflect dissatisfaction with this state of affairs. For example, a report of the Register called the result in *Vacheron* "unfortunate." *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law* 75 (Comm. Print 1961), *available at* https://www.copyright.gov/history/other_reports.html. "If the infringement continues, the delay involved in proceeding first against the Register may aggravate the injury. And two successive actions – usually in different jurisdictions – may be an expensive burden." *Id.*; *see also id.* at vi-vii ("[F]ailure to register should not forfeit the copyright. However, *application* for registration would still be a prerequisite to bringing an infringement suit.") (emphasis added).[23]

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[23] *1965 Supplementary Report* at 124 ("The bill also follows the *Report*'s recommendation that the law as interpreted in *Vacheron & Constantin-Le Coultre Watches, Inc.* v. *Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958), be changed to permit a claimant whose application has been refused to maintain a suit against an infringer 'if the Register is notified and permitted to become a party to the suit.'").

The rule adopted by the court below risks "aggravat[ing] the injury" of the copyright holder in the same way. In a case where the copyright owner filed for registration and the Register fails to register it – either without explanation or following the copyright holder's response to correspondence from the Office – the copyright holder will be unable to bring suit without first (in an extreme case) seeking judicial relief to compel action. It makes no sense to adopt a reading of the registration requirement that recreates the very defect the statute was modified to avoid. *Cf. Exxon Mobil Corp. v. Allapattah Servs., Inc.*, 545 U.S. 546, 565 (2005) (rejecting an interpretation of 28 U.S.C. § 1367 that "would mean that § 1367 left the *Finley* [*v. United States*, 490 U.S. 545 (1989)] result undisturbed" because "all concede that one purpose of § 1367 was to change the result reached in *Finley*").

## III. THE STATUTORY SCHEME OF RIGHTS AND REMEDIES FAVORS ALLOWING SUITS TO PROCEED ONCE THE COPYRIGHT OWNER HAS COMPLIED WITH REQUIRED FORMALITIES

The Copyright Act's scheme of rights and remedies further supports the conclusion that § 411(a) does not permit the Register to prevent an infringement suit by failing to act on an application for registration submitted in accordance with the Act's requirements. *See FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 133 (2000) (noting that "[a] court must . . . interpret [a] statute as a symmetrical and coherent regulatory scheme and fit, if possible, all parts into an harmonious whole") (citation omitted); *see also* 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 7.16[B][3][b][ii] (2013) ("Indeed, some

courts that follow the [Eleventh Circuit's] approach concede that it yields an inefficient and peculiar result.").

*First*, making the Copyright Office the gatekeeper to enforcement of copyrights is inconsistent with the rest of the Copyright Act, which makes clear that a copyright owner's statutory rights do not depend on administrative action. The Act grants a copyright owner exclusive rights in a work as soon as it is fixed in a tangible medium of expression. *See* 17 U.S.C. § 102(a); *Harper & Row*, 471 U.S. at 546-47. Those rights are not granted by the Copyright Office (or even by virtue of compliance with formalities like publication with notice); they, instead, come about by virtue of the creation and fixation of the work.

Moreover, the statute expressly provides that the "registration" that a copyright owner "may obtain" is "not a condition of copyright protection." 17 U.S.C. § 408(a). Yet, as this Court pointed out in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939), in the absence of any possible enforcement action, a copyright hardly provides any protection at all: "[w]ithout right of vindication a copyright is valueless." *Id.* at 40; *see also Dowling v. United States*, 473 U.S. 207, 221 (1985) ("Congress [has] chiefly relied on an array of civil remedies to provide copyright holders protection against infringement"). It would be paradoxical to say that a requirement that can render a patent "valueless" – even temporarily – is "not a condition of copyright protection."

On a proper reading of § 411(a), there is no tension between the registration requirement and the permissive nature of registration: the copyright owner is always protected because it can always satisfy the purely procedural requirement of making registration

before suing. *Cf. Harper & Row*, 471 U.S. at 547-48 (explaining that copyright holders protected themselves by "compl[ying] with the relevant statutory notice and registration procedures"). Indeed, as Judge Clark argued in dissent in *Vacheron*, though *Washingtonian Publishing* "is not explicit on our present issue, its holding and discussion certainly tend in the same direction." 260 F.2d at 646 (Clark, C.J., dissenting).

*Second*, although the Copyright Act strongly encourages registration by limiting statutory remedies for infringement commenced before the effective date of registration, *see* 17 U.S.C. § 412; *Golan*, 565 U.S. at 314 n.11, what matters is the date when the copyright owner complies with the statutory requirements, not the date when the Register acts. Thus, § 410(d) defines the "effective date of a copyright registration" as "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." 17 U.S.C. § 410(d). It would be strange to conclude that "registration . . . has been made" for purposes of beginning a suit only months or years *after* the "effective date of . . . registration" for purposes of determining the remedies available in that same suit. Consistent with all this, the statute makes clear that whether the copyright owner has complied with the requirements for registration may be determined in litigation by the court. *See* *Reed Elsevier*, 559 U.S. at 163-64. Not only will that ensure that a copyright owner whose application for registration has been refused may still obtain relief, but it will also ensure that any

issue of registrability can be litigated, if necessary, while an application is pending.

*Third*, it is not the case, as the court below thought, that allowing litigation to be instituted after the copyright holder has registered the claim (but before the Copyright Office has acted) would deprive the Register of "power to 'refuse registration.'" App. 7a. Whatever the status of any litigation commenced in federal court, the Register will be able to act in due course on the application submitted to the Copyright Office. Nor is it correct that "an applicant could obtain the advantage" of a presumption of validity "upon application" only to lose it if the Register denied the application. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1205 (10th Cir. 2005). The presumption of validity depends on a "*certificate* of a registration," not registration. 17 U.S.C. § 410(c) (emphasis added). Accordingly, if the Copyright Office has not registered the claim and issued a certificate of registration, the copyright holder gains no evidentiary advantage from having made registration.

It is likewise not the case (as the government has asserted in the past) that allowing litigation to proceed while registration is pending will deprive the Copyright Office of its right to intervene in litigation in cases where registration is refused: if an application is refused, notice would be required, and the government could choose to intervene at that point.[24]

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[24] Furthermore, the Register will have prompt notice of pending copyright litigation, allowing it to expedite review of any claims at issue in a civil action. *See* 17 U.S.C. § 508(a) ("Within one month after the filing of any action under this title, the clerks of the courts of the United States shall send

Absent unreasonable delay in examination, there is no risk that the government will lose its chance to participate at a meaningful time – and the possibility of such unreasonable delay is an argument in favor of petitioner's reading of the statute.

As noted, litigation may proceed irrespective of the view of the Copyright Office, and the determination of the Copyright Office constitutes "prima facie" evidence only in cases where it *grants* a certification of registration, 17 U.S.C. § 410(c).[25] As the leading treatise has pointed out, in most cases, even if litigation begins before the Copyright Office has granted or refused registration, such action can be expected during the course of litigation, giving the court the benefit of the Register's views. *See* 2 *Nimmer on Copyright* § 7.16[B][3][b][ii]. Just as important, in any case where a claim's eligibility for copyright protection presents a substantial issue, a court can use the ordinary tools of litigation management – including the doctrine of primary jurisdiction – to give the Copyright Office the first crack at determining whether the subject matter of the work is

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written notification to the Register of Copyrights setting forth, as far as is shown by the papers filed in the court, the names and addresses of the parties and the title, author, and registration number of each work involved in the action."). (The reference to "registration number" does not assist respondents: the provision requires information only "as far as is shown by the papers," and there is no dispute that, in cases anticipated under § 411(a) where registration has been refused, no registration number will be available.)

[25] By contrast, after the Patent and Trademark Office has issued a patent, a litigant must present "clear and convincing" evidence to overcome the presumption that the patent is valid. *See generally Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91 (2011).

copyrightable. *Cf. Syntek Semiconductor Co. v. Microchip Tech. Inc.*, 307 F.3d 775, 781 (9th Cir. 2002) (similar). Given the breadth of copyright law's protections, *see* 17 U.S.C. § 102(a), the Office typically grants the overwhelming majority of applications. *See* 2 *Nimmer on Copyright* § 7.16[B][3][b][ii]. There is no reason to believe that substantial issues of copyrightability will arise often – and no such defense has been asserted in this case.[26]

*Fourth*, requiring action by the Copyright Office before a suit can be filed creates significant practical problems. For one thing, by barring a copyright owner from seeking the injunctive relief to which the Copyright Act entitles the copyright owner until the Copyright Office acts, the rule requires the copyright owner to endure the ongoing theft of intellectual property rights the copyright owner already possesses – to the benefit of the infringer. *See Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 620 (9th Cir. 2010). As noted, this is the very problem that § 411(a) was drafted to avoid. *See supra* pp. 32-36. For another thing, if the Act's statute of limitations elapses before the Office acts on the application, the copyright owner may forever lose any ability to enforce the very rights the Act grants. *See Cosmetic Ideas*, 606 F.3d at 620.

*Fifth*, it is no answer to these objections to point out that the Copyright Office has instituted

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[26] The government's invitation brief suggests that there may be a dispute about the classification of the works for which registration was sought as well as about the timing of payment. A copyright owner that intends to sue has every incentive to avoid such disputes by taking care to submit a deposit, application, and fee that meets requirements for registration.

a procedure that allows copyright owners to obtain faster processing of registrations.[27] The cost of special handling is, at present, $800 per work; for a copyright holder pursuing relief for infringement of multiple works, those fees can rapidly amount to tens if not hundreds of thousands of dollars. Furthermore, special handling is discretionary and provides no guarantee that a particular registration will be resolved by any deadline. And there is no reason to suppose that Congress maintained the registration requirement for the purpose of increasing the fees the Copyright Office might impose.

If the Copyright Office were better funded and more efficient and routinely provided service within days of filing – as was once the case[28] – it is true

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[27] Preregistration under § 408(e) – a procedure that came into existence only in 2005 – does not address this problem either. As the Copyright Office warns, "[f]or the vast majority of works, preregistration is not useful." U.S. Copyright Office, "Preregister Your Work," https://www.copyright.gov/prereg/ (last visited Aug. 23, 2018). The procedure is available only for a subset of unpublished works and would not have been available for the news articles at issue here. *See* 37 C.F.R. § 202.16(b). Moreover, preregistration does not eliminate the need for registration; it simply permits a copyright owner to sue before registration, conditional on making registration within the required time. *See* U.S. Copyright Office, "Preregister Your Work" ("A person who has preregistered a work is required, in order to preserve the legal benefits of preregistration, to register such work within one month after the copyright owner becomes aware of infringement and no later than three months after first publication. If full registration is not made within the prescribed time period, a court must dismiss an action for copyright infringement that occurred before or within the first two months after first publication.").

[28] *See* Arthur Fisher, U.S. Register of Copyrights, "The Copyright Office and the Examination of Claims to Copyright,"

that the question presented would be of lesser importance. But the answer to that question would remain the same.

## CONCLUSION

The judgment of the court of appeals should be reversed.

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*in 1953 Copyright Problems Analyzed* 11, 15 (Theodore R. Kupferman ed.):

> In recent years, the Copyright Office has emphasized currency of operation. We like the pleasant reaction we get when claimants receive certificates of registration very soon after their applications are submitted. Sometimes we feel that we would like to operate the way a bank does and balance our books at the end of each day's business, or as some modern merchandising houses do and dispose of all our mail within 24 hours of its receipt.

Respectfully submitted,

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN
INTELLECTUAL PROPERTY
LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

AARON M. PANNER
*Counsel of Record*
GREGORY G. RAPAWY
GRACE W. KNOFCZYNSKI
KELLOGG, HANSEN, TODD,
FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

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