
COPYRIGHT ENFORCEMENT: TIME TO ABOLISH THE PRE-LITIGATION REGISTRATION REQUIREMENT

Tom James*

No formalities are required to establish a copyright.¹ It arises automatically upon fixing a creative work in a tangible medium of expression.² Registration is not a condition of copyright protection.³ Nevertheless, the Copyright Act prohibits claims of infringement of the copyright in a United States work from being filed in court unless “registration has been made.”⁴

Courts have not agreed about what “making registration” means. The Eleventh Circuit Court of Appeals thought it meant the Copyright Office’s approval of registration of a copyright.⁵ This is known as the “registration approach.”⁶ The Ninth Circuit, by contrast, thought it meant that an infringement lawsuit could be commenced as soon as the copyright claimant filed all necessary elements of the application, without having to wait for the Copyright Office to act on it.⁷ This is the “application approach.”⁸ The U.S. Supreme Court granted certiorari in *Fourth Estate Public Benefits Corp. v. Wall-Street.com, LLC* to resolve the conflict in the circuits.⁹

Applying ordinary principles of statutory interpretation, the Court unanimously rejected the application approach, holding that the registration requirement set out in 17 U.S.C. § 411(a) means that an infringement suit may not be filed unless the Copyright Office has either approved or denied the application for registration.¹⁰

* J.D., Southwestern University School of Law; B.A., University of California at Berkeley. Admitted to practice in the United States Court of Appeals for the Federal and Eighth Circuits, the Trademark Trials and Appeals Board, and Minnesota state and federal courts.

1. 17 U.S.C. § 408(a) (2018).
2. 17 U.S.C. § 102(a) (2018).
3. 17 U.S.C. § 408(a) (2018).
4. 17 U.S.C. § 411(a) (2018).
5. *Fourth Estate Pub. Benefits Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338 (11th Cir. 2017).
6. *Id.* at 1340.
7. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 621 (9th Cir. 2010).
8. *Id.* at 619.
9. *Fourth Estate Pub. Benefits Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881, 887 (2019).
10. *Id.* at 889.

As a matter of statutory interpretation, the Court's decision seems reasonable enough. Section 411(a) states, in pertinent part:

[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....¹¹

As the Court observed, both sentences focus on Copyright Office action on an application; specifically, the Office's registration or refusal to register a work. If filing an application sufficed to "make registration," then the second sentence would either be superfluous or denote a different meaning of *registration* than the one used in the first sentence.¹² Courts generally do not read the same words in consecutive sentences to refer to something different.¹³

Other provisions of the Copyright Act support this interpretation. For example, 17 U.S.C. § 408(f) allows a copyright owner who is concerned that a copyright may be infringed before it is registered to apply for preregistration of the work. There would be no need for this provision if merely applying for a copyright were all that was necessary to "make registration."

The Court's adoption of the registration approach may have been mandated by the language of the statute and rules of statutory interpretation, but that does not mean that it is superior to the application approach. There are important reasons why Congress should amend the Copyright Act to adopt the application approach. Chief among these is the basic truism that justice delayed is justice denied. Having to wait until registration is issued leaves a copyright owner powerless to prevent continuing infringement. Some claims may become unenforceable while the copyright owner is waiting for the Copyright Office to act on an application.

I. THE LIMITATIONS PERIOD

The Copyright Act imposes a three-year limitations period for civil claims of copyright infringement.¹⁴ This means that a civil lawsuit to enforce a claim of copyright infringement must be commenced no later than three years after the claim accrued. If it isn't, then the claim is forever barred.¹⁵

Of course, where the infringement is ongoing, as it often is, the consequences of the Copyright Office's delay might not be quite as severe. The general rule is that the statute of limitations runs from the date of the last infringing act,

11. 17 U.S.C. § 411(a) (2018).

12. *Fourth Estate Pub. Benefit Corp.*, 139 S. Ct. at 888–89.

13. *Mid-Con Freight Sys., Inc. v. Michigan Pub. Serv. Comm'n*, 545 U.S. 440, 448 (2005).

14. 17 U.S.C. § 507(b) (2018). The limitations period for criminal prosecutions is five years. 17 U.S.C. § 507(a) (2018).

15. *See, e.g., Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 612, 620 (9th Cir. 2010).

not the first.¹⁶ Damages, however, may be recovered only for infringing acts that occurred during the three-year period immediately prior to the filing of suit.¹⁷ This is important because the initial acts of infringement often cause much more harm than ongoing acts of infringement occurring three or more years later do. In the music industry, for example, a recording artist might make the most sales of a new song in the first few weeks after it is first released. If the recording artist infringed a songwriter's copyright but the songwriter is not able to commence suit until more than three years have gone by, the songwriter will have no remedy for the loss of those initial profits.

An award of damages is just one of several remedies that are available for the redress of copyright infringement. The Copyright Act also provides for injunctive relief, which may be temporary, permanent, or both.¹⁸ Temporary injunctions are important because they enable a copyright claimant to stop infringement from continuing while an infringement lawsuit is pending.¹⁹ The remedy is worthless if a copyright claimant cannot get into court to ask for one. The registration approach requires copyright owners to endure the ongoing theft of their intellectual property rights while they wait for the Copyright Office to act on their applications.

These are not merely abstract issues. According to the Copyright Office, applications typically take four to seven months to process, but the process can sometimes take as long as 28 months from application to registration.²⁰ To be clear, a copyright registration application can sometimes take 2.33 years to process. A lot of infringing activity can occur in that time, and a lot of infringement claims can be lost.

A. Preregistration

One way a copyright claimant can secure a right to enforce the copyright before the Copyright Office acts on a registration application is to preregister the work.²¹ Preregistration does not obviate the need to register a work, but it does enable a copyright owner to begin enforcing a copyright without having to wait for the Copyright Office to either grant or deny a regular application for registration.

16. *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 671 (2014).

17. *Id.*

18. 17 U.S.C. § 502 (2018).

19. The Copyright Office has recognized the danger that delay poses to copyright owners' rights. *See, e.g.*, REGISTER OF COPYRIGHTS, REPORT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 75 (Comm. Print 1961) ("If the infringement continues, the delay involved . . . may aggravate the injury.")

20. *Registration Processing Times*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/registration/docs/processing-times-faqs.pdf> (last visited Oct. 22, 2019).

21. *See* 17 U.S.C. § 408(f) (2018).

Preregistration requires the payment of a nonrefundable fee. This fee is considerably higher than the regular application fee. It is additional to, not credited toward, the regular registration fee. Fees are currently \$140 for preregistration; \$55 for registration.²²

The preregistration procedure is only available for a very narrow range of works.²³ The work must fall into one of the following categories:

- (a) Motion picture
- (b) Sound recording
- (c) Musical composition
- (d) Literary work being prepared for publication in book form
- (e) Computer program (including videogames)
- (f) Advertising or marketing photograph.²⁴

Artwork, articles, blog posts, letters, short stories, plays, screenplays, choreography, architecture, and sculpture do not qualify for preregistration. Nor do photographs and graphics that are not created with the intention of being used in advertising or marketing campaigns. Further, only unpublished works may be preregistered. Preregistration is not available for published works.²⁵ That means it is not available for the protection of blog posts, articles, artwork, photographs or any other works that have been published online. Next, preregistration is limited to unfinished works. Already completed songs, book manuscripts, photographs, etc., do not qualify.²⁶ Finally, the work must be in the process of being prepared for commercial exploitation.²⁷ Overall, very few works meet all these criteria.

B. *Special Handling*

A copyright registration applicant may request special handling; that is to say, an applicant may ask the Copyright Office to try to expedite processing of the application.²⁸ Expedited processing is entirely discretionary with the Copyright Office. The Office may deny a request simply because it is busy and does not want to be bothered.²⁹

Cost is an even bigger problem. Currently, an applicant requesting special handling must pay, in addition to the regular filing fee, \$800 per work.³⁰ A request for special handling of applications to register a dozen published photo-

22. 37 C.F.R. §§ 201.3(c)(10), 202.16(c)(1) (2019).

23. *Preregister Your Work*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/prereg/> (last visited Oct. 12, 2019) (“For the vast majority of works, preregistration is not useful.”).

24. 37 C.F.R. § 202.16 (2019).

25. *Id.*

26. *Id.*

27. *Id.*

28. *Special Handling*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/help/faq/faq-special.html> (last visited Oct. 12, 2019).

29. *Id.*

30. 37 C.F.R. § 201.3(d)(7) (2019).

graphs, then, would cost \$9,600 plus the regular filing fees. A major movie production studio or music recording label might be able to afford exorbitant fees like this, but most content creators cannot.

II. THE BERNE CONVENTION

The Berne Convention for the Protection of Literary and Artistic Works (“Berne Convention”) is an international agreement that is intended to free content creators from copyright formalities.³¹ It expressly declares that “[t]he enjoyment and the exercise of [copyright] rights shall not be subject to any formality....”³² For more than a century, the United States refused to accede to it. The country had a complex array of copyright formalities in place, from mandatory copyright notices and registration renewals to regulations of where copies could be manufactured. The requirement of registration as a prerequisite to filing an infringement suit is another example.

The United States finally acceded to the Berne Convention in 1988.³³ Congress thereafter amended the Copyright Act to bring the United States into compliance with the anti-formalities directive.³⁴ To harmonize the Copyright Act with the Berne Convention, it was amended to expressly provide, among other things, that enforceable copyrights do not require any kind of formality to come into existence. Instead, “[c]opyright in a work . . . subsists from its creation.”³⁵ More to the point, “registration is not a condition of copyright protection.”³⁶

Congress’s retention of the registration formality exclusively for United States works is at odds with the purpose and intent of the Berne Convention. It is a formality with which a copyright owner must comply in order to possess a copyright that is enforceable in court. Congress was faithful to the intent of the Berne Convention only with respect to foreign works. The Section 411(a) requirement of registration as a prerequisite to filing a lawsuit was made applicable only to United States works; it does not apply to foreign works.³⁷

The retention of the registration formality for domestic works but not for authors of foreign works has resulted in the anomaly that owners of copyrights in foreign works have less difficulty enforcing their copyrights in American courts than American copyright owners do. If a person is infringing the copyrights in both a foreign and a United States work, the owner of the copyright in the foreign work may immediately petition a United States court for temporary

31. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, *revised* at Paris, July 24, 1971, *amended* Sept. 28, 1979, 25 U.S.T. 1341, 828 U.N.T.S. 221, https://www.wipo.int/treaties/en/text.jsp?file_id=283698#P127_22000 [hereinafter Berne Convention].

32. *Id.* art. 5(2).

33. World Intellectual Prop. Org., *Berne Notification No. 121* (November 1988), https://www.wipo.int/treaties/en/notifications/berne/treaty_berne_121.html.

34. Berne Convention Implementation Act of 1988, Pub. L. 100-568, 102 Stat. 2853 (1988) (amending scattered sections of 17 U.S.C. (2018)).

35. 17 U.S.C. § 302(a) (2018).

36. *Id.* § 408(a).

37. *Id.* § 411(a).

and permanent injunctions to stop the infringement.³⁸ The owner of the copyright in the United States work, on the other hand, will have to tolerate the continued infringement of his or her copyright for months—in some cases, up to 2.33 years—before filing suit.³⁹ No rational policy objective is served by affording greater protection to foreign works than to United States works.

Declaring that copyrights arise upon the creation of a work without the need to comply with formalities was a step in the right direction toward compliance with the Berne Convention, but “[w]ithout right of vindication a copyright is valueless.”⁴⁰ Consistent with the accession to the Berne Convention, Congress should strive to eliminate formalities like registration in order to achieve effective copyright laws that are harmonious with the laws of most of the rest of the world.⁴¹

III. THE PUTATIVE RATIONALES FOR THE REGISTRATION APPROACH

It might be thought that requiring registration as a precondition to filing an infringement claim gives copyright owners an incentive to register their copyrights and helps prevent invalid copyright claims from being asserted in court. The question that needs to be asked, though, is whether these benefits, to the extent they exist, outweigh the costs the requirement imposes on copyright owners.

A. *Incentives to Register*

Conditioning copyright enforcement on registration certainly incentivizes copyright claimants to apply to register their copyrights. Whether conditioning enforceability on Copyright Office action adds any additional value to this incentive is not as certain. The speed and efficiency of the Copyright Office are out of an applicant’s hands.

Moreover, it is doubtful that any such incentive is needed anyway. The Copyright Act already incentivizes copyright owners to apply for registration promptly.⁴² Statutory damages and attorney fee awards are denied to those who fail to apply within three months of publication.⁴³

B. *Claim Screening*

Requiring a claimant to wait until the Copyright Office completes its review of an application for registration might seem, at first blush, to serve the salient function of preventing unfounded copyright claims from being filed in

38. Fourth Estate Pub. Benefits Corp. v. Wall-Street.com, LLC, 139 S. Ct. 881, 891 (2019).

39. *Id.* at 892.

40. Washingtonian Publ’g Co. v. Pearson, 306 U.S. 30, 40 (1939).

41. *cf.* Golan v. Holder, 565 U.S. 302, 335 (2012); Subafilms, Ltd. v. MGM Pathe Commc’ns Co., 24 F.3d 1088, 1097 (9th Cir. 1994) (en banc).

42. 17 U.S.C. § 412 (2018).

43. *Id.*

court. The Copyright Office's approval of registration, however, is not a prerequisite to filing an infringement claim. A claim may be filed even if the Copyright Office denies registration.⁴⁴ The registration requirement, then, does not actually serve the function of screening out invalid claims.

Being denied registration arguably might have the psychological effect of discouraging an individual from pursuing an infringement claim in court. Reliance on the copyright registration process to weed out meritless claims, however, is misplaced. The Copyright Office generally takes the allegations in a copyright application at face value. It does not investigate claims to determine if they are valid, nor does it make findings of facts.⁴⁵ The Copyright Office generally does not examine deposit copies to determine if they are original, on one hand, or substantially similar to other works, on the other. Nor does it conduct searches to determine if a work has been previously published or registered.⁴⁶

The Copyright Office approves applications 97% of the time.⁴⁷ Denials may be due to the applicant's failure to comply with some formality having nothing to do with the substantive validity of the copyright claim. The applicant may have neglected to submit the requisite deposit copies or to pay a required filing fee, or may have made other kinds of errors having nothing to do with the validity of the copyright.⁴⁸

If copyright applications were examined the way patent and trademark applications are, then the requirement of Copyright Office review prior to instituting a civil lawsuit might be a valid screening process. As the situation now stands, though, the requirement is an administrative obstacle that imposes significant burdens on copyright owners with very little, if any, offsetting benefit. As one court put it, "the Copyright Office's practice of summarily issuing registrations ... counsel against placing too much weight on registrations as proof of a valid copyright."⁴⁹

Moreover, if a court really believes that the Copyright Office's registration decision would be necessary or helpful, it has the option of setting the trial date far enough out to give the Office time to make a decision on registrability.

IV. CONCLUSION

Delaying a copyright owner's right to enforce the copyright until the Copyright Office's issuance or refusal of registration impairs the right. In some cases, it effectively bars claims. It may also destroy or impair remedies for infringement. This is contrary to the intent of the Berne Convention, and there is no justification for it. Congress should exercise its constitutional authority to promote

44. *Id.* § 411(a).

45. U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 602.4(B)-(C) (3d ed. 2017).

46. *Id.* § 602.4(D).

47. MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 7.16[B][3][b][ii] (citing Brief for the United States as Amicus Curiae Supporting Vacatur and Remand, *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 4 n.2 (2010)).

48. COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES, *supra* note 45, § 1702.

49. *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 428 (4th Cir. 2010).

the progress of science and useful arts⁵⁰ by securing to authors the exclusive right to their creations without unnecessary bureaucratic delay. It can do this by amending the Copyright Act to replace the registration approach with the application approach to the pre-litigation registration requirement.

50. U.S. CONST. art. I, § 8.