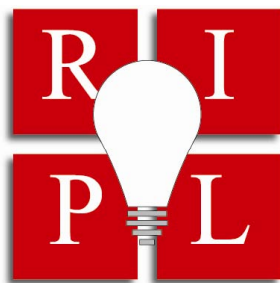


THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



THERE HAS BEEN AN INFRINGEMENT OF MY WORK AND MY CIRCUIT DOES NOT ALLOW
ME TO SUE! THE TIME HAS COME TO HASH-OUT THE FEDERAL CIRCUIT COURT
DISCREPANCY ON COPYRIGHT REGISTRATION

THOMAS PLACZEK

ABSTRACT

The time has come to relieve the ambiguity created by the continued lack of consensus regarding the proper interpretation of 17 U.S.C. § 411(a). The persistent split amongst the various Federal Courts regarding the meaning of § 411(a)'s registration requirement allows some fortunate artists to immediately enforce their rights in a number of jurisdictions, while artists from other jurisdictions are prohibited from immediately enforcing the same rights. Several circuit and district courts subscribe to the “application approach,” while others employ the “registration approach.” This comment delves into the rationale behind the respective approaches, and discusses the arguments made for and against each one. In the end, this comment will ultimately highlight and advocate in favor of the seemingly superior features of the “application approach.” Additionally, this Comment also addresses the importance of adopting an efficient, uniform interpretation of § 411(a) that alleviates the uncertainty that plagues this portion of the Copyright Act. This comment suggests that the proper cure for this ambiguity lies in an enhanced application approach, coupled with a claimant's obligation to amend her complaint at bar following the Copyright Office's decision regarding a pending application for registration.

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Cite as Thomas Placzek, *There Has Been an Infringement of My Work and My Circuit Does Not Allow Me to Sue! The Time Has Come to Hash-Out the Federal Circuit Court Discrepancy on Copyright Registration*, 18 J. MARSHALL REV. INTELL. PROP. L. 344 (2019).

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THOMAS PLACZEK

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THOMAS PLACZEK*

I. INTRODUCTION

Imagine the following situation: you create a copyrightable work, then submit an application to the Copyright Office thinking the copyright will be granted as soon as an agent reviews the application. In the meantime, you helplessly watch as others infringe upon your work. You must wait, cross your fingers, and hope the agents at the Copyright Office make a final decision within three years of submitting your application.¹ If your copyright is not granted within the three years, you may never be able to recover damages from the infringement.² The damages resulting from a person who willfully infringes upon your creations will be gone forever. Unfortunately, the current split among the federal circuits creates just this situation in over half the United States circuit courts.

Courts have adopted two differing interpretations of 17 U.S.C. § 411. The two approaches, which lead to vastly different conclusions, disagree on the appropriate timing at which a copyright holder can file a copyright infringement claim. Central to this debate is the sharp divide between the federal circuit courts; an equal number of circuits adopt either approach. The difference between the two approaches will be discussed in further detail in Part II of this comment. The two approaches are generally referred to as the “application approach”³ and the “registration approach.”⁴

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¹ 17 U.S.C. § 507(b) (2016). Section 507(b) reads in full: “Civil actions. No civil action shall be maintained under the provision of this title unless it is commenced within three years after the claim accrued.”

² U.S. Copyright Office, *I've Submitted My Application, Fee, and Copy of My Work to the Copyright Office. Now What?*, COPYRIGHTOFFICE.GOV, <https://www.copyright.gov/registration/docs/processing-times-faqs.pdf> (last visited Oct. 2, 2018). Even with the available online copyright registration form, the most recent statistics by the U.S. Copyright Office show that the backlogged dates of receipt can date back up to eight months before an applicant actually receives a decision from the Copyright Office.

³ See *Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 615-621 (9th Cir. 2010) (this court employed the application approach); *Action Tapes, Inc. v. Mattson*, 462 F.3d 1010, 1013 (8th Cir. 2006) (this court also used the application approach in its analysis); *Panoramic Stock Images, Ltd. v. McGraw-Hill Cos.*, 961 F. Supp. 2d 918 (N.D. Ill. 2013) (panoramic submitted an application for photographs, but did not receive a response from the Registration Office); *Iconbazaar, LLC v. Am. Online, Inc.*, 308 F. Supp. 2d 630, 634 (M.D.N.C. 2004) (this court adopted the view that filling a complete application is sufficient for initiation of a copyright lawsuit); *contra* *Positive Black Talk Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 365 (5th Cir. 2004) (this court determined that receipt of an application, deposit, and fee to the Copyright Office was required before filing an infringement action); *Chicago Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003) (stated “[a]lthough a copyright no longer need be registered with the Copyright Office to be valid, an application for registrations must be filed before the copyright can be sued upon.”).

⁴ See *La Resolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005) (this court utilized the registration approach); *M.G.B. Homes v. Ameron Homes*, 903 F.2d 1486, 1489 (11th

The split between these two approaches has led to at least five circuits to adopt the registration approach, while at least five other circuits adopt the opposing application approach.⁵

This comment agrees, in part, with the Ninth Circuit's approach, which reasons that the language of the statute is ambiguous, but still adopts the application approach because it seems to better advance Congress' intended goals regarding copyright law. This comment will also discuss the prospect of implementing an additional, subsequent requirement of submitting an amended complaint that recognizes the Copyright Office's final decision based on the application, if it is made after the initiation of the copyright infringement suit.

Part II of this comment will provide an overview of the history and substance of the Copyright Act of 1976, and will briefly discuss the various circuit court decisions regarding this issue of copyright registration and which approach to adopt. Part III will review the most recent circuit court cases that discuss this issue, and which respective approaches the court chose to adopt, coupled with an in-depth analysis of the Ninth Circuit's approach, specifically. The comment will then conclude in Part IV with a discussion of why an augmented application approach that includes a requirement for the inclusion of a subsequent amended complaint⁶ should be considered the correct approach for copyright infringement lawsuits.

II. LEGISLATIVE HISTORY AND THE CIRCUIT SPLIT

The Copyright Act of 1976 establishes the basis for copyright law in the United States. Additionally, chapter twenty-eight of the United States Code grants original and exclusive jurisdiction to the federal district courts over copyright claims.⁷ Unfortunately, the various circuit courts have established differing interpretation of the statute.⁸ Subsection A discusses the Copyright Act of 1976, subsection B will discuss circuit courts that have adopted the application approach, while subsection C will discuss the contrasting circuit courts that have elected to adopt the registration approach.

Cir. 1990) (Eleventh Circuit required that there be no errors or defects in the registration certificate); *Hawaiian Vill. Comput., Inc. v. Print Mgmt. Partner, Inc.*, 501 F. Supp. 2d 951 (E.D. Mich. 2007), *abrogated by* *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) (merely filing an application for copyright registration was insufficient to invoke subject matter jurisdiction).

⁵ *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384 (5th Cir. 1984); *see generally* *Demetriades v. Kaulmann*, 680 F. Supp. 658, 661 (S.D.N.Y. 1988).

⁶ Fed. R. Civ. P. 15(a)(2) (2009); *see* *Foman v. Davis*, 371 U.S. 178 (1962) (stating that the phrase, "when justice requires," has a very low threshold in law. In the absence of undue prejudice, undue delay, or affirmative bad faith, leave has to be "freely given" by the district court).

⁷ 28 U.S.C. § 1338 (2016). This section reads states, "[t]he district court shall have original jurisdiction of any civil action arising under any Act of Congress relating to...copyrights and trademarks."

⁸ *Gaiman v. McFarlane*, 360 F.3d 644, 655 (7th Cir. 2003) (concluded that "...an application to register must be filed, and either granted or refused, before suit can be brought"); *contra* *Chicago Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624 (7th Cir. 2003).

A. An Understanding of the Copyright Act of 1976

The United States Constitution, under Article I, § 8, grants Congress the enumerated power to, “promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”⁹ The Copyright Act attempted to resolve the conflict between federal and state laws regarding copyrightability by eliminating the various statutory formalities and broadening the scope of copyright protection; it recognized that a copyright exists the moment an idea finds an original expression in some fixed, tangible medium.¹⁰

The Copyright Act allows an individual to register the work voluntarily and provides several incentives that encourage registration, although it is not required. One of the incentives for registration enables a copyright owner to recover statutory damages from an infringing party, so long as they submit three items to the Copyright Office: (1) an application,¹¹ (2) a deposit of the work,¹² and (3) the appropriate application fee.¹³ After a thorough analysis is performed by the Copyright Office, it may issue a certificate of copyright registration, which acts as prima facie evidence of the validity of said copyright.¹⁴ The Act *does* require is a work to be registered with the Copyright Office before a copyright owner can file an infringement action, even though registration of a copyrighted work with The Office *is not* required under copyright law.¹⁵ This portion of the Act is the source of current split between the circuits and begs the question: at what point does a party have a recognizable claim under § 411?¹⁶

The registration approach presumes that a lawsuit for copyright infringement may not be brought by a copyright holder until a final decision is issued by the

⁹ U.S. Const. art. I, § 8, cl. 8. This section of the Constitution reads as follows: “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoverers.” This clause is commonly referred to as the “Copyright and Patent Clause” or the “Patent and Copyright Clauses.”

¹⁰ 17 U.S.C. § 102 (2018).

¹¹ 17 U.S.C. § 409 (2018) (this section contains an exhaustive list of information that must be included in an application for copyright registration for various types of copyrightable work, for example, “(1) name and address of the copyright claimant...(6) title of the work, together with any previous or alternative titles under which the work can be identified; (7) year in which creation of the work was completed; (8) if the work has been published, the date and nation of its first publication.”).

¹² 17 U.S.C. § 408(b) (2018). This subsection reads as follows: “(1) in the case of an unpublished work, one complete copy or phonorecord; (2) in the case of a published work, two complete copies or phonorecords of the best edition...”

¹³ 17 U.S.C. § 708 (2018); (section 708(a)(1) and section 708(a)(3) regarding the fees that shall be paid to the Register of Copyrights states, “(1) on filing each application under Section 408 [17 USCS § 408] for registration of a copyright claim or for a supplementary registration, including the issuance of a certification of registration if registration is made,” and “(3) for the issuance of a receipt for a deposit under section 407 [17 USCS § 407].”).

¹⁴ 17 U.S.C. § 410 (2018) (this section states that the Register is responsible for registering claims and, “...issues to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application, together with the number and effective date of the registration.”); *see also* *Cosmetic Ideas*, 606 F.3d at 619 (treating a copyright registration as prima facie evidence as to its validity is an incentive for copyright owners to register their works with the Copyright Office).

¹⁵ 17 U.S.C. § 411(a) (2018) (stating that “[n]o civil action for infringement of the copyright in any United States work shall be instituted until...registration...has been made”).

¹⁶ *Id.*

Copyright Office regarding the registerability of said copyright, whether registration is granted or not.¹⁷ In contrast, the application approach presumes a copyright holder may bring an infringement claim as soon as a registration application is submitted, irrespective of the Copyright Office's decision regarding registerability.¹⁸

This split went unaddressed by the Supreme Court until 2010, when the Court heard and decided *Reed Elsevier, Inc. v. Muchnick*.¹⁹ In this case, the Court reviewed whether a copyright was registered for purposes of federal jurisdiction to decide the case.²⁰ The court avoided the larger question regarding the split between the application and registration approaches by, instead, clarifying that federal courts have subject matter jurisdiction to hear infringement cases, even if the item has not been "registered" as required by § 411(a).²¹ The decision would appear to clarify the issues between the two approaches, but the interpretation now turns to the court's understanding of what "registered" means.²² Unfortunately, this decision left the split largely unresolved.

B. The Application Approach

Courts that adopt the application approach presume that a copyright infringement claim may be brought at any point after the application has been

¹⁷ *Gaiman v. McFarlane*, 360 F.3d 644, 655 (7th Cir. 2003) (stating "...an application to register must be filed, and either granted or refused, before suit can be brought"); *see, e.g., Foraste v. Brown Univ.*, 248 F. Supp. 2d 71, 78 (D.R.I. 2003) (this court utilized the registration approach); *see also Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1112 (W.D. Wash. 2004) (applications that are still pending for registration with the Copyright Office are insufficient to confer federal jurisdiction over copyright infringement lawsuits).

¹⁸ *Cosmetic Ideas*, 606 F.3d at 619 (9th Cir. 2010); *see Leventhal v. Schenberg*, 917 F. Supp. 2d 837, 844 (N.D. Ill. 2013) (the district court elected to adopt the application approach).

¹⁹ *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010). The Supreme Court case addressed whether a copyright was registered such that a federal court would have jurisdiction to hear a case of infringement. The decision appeared to clarify the current debate, but in reality, it failed to clarify the ambiguous meaning of the term 'registration,' as it is used in the Act.

²⁰ *Id.* at 163.

²¹ *Id.* at 165; 17 U.S.C. § 411(a) Section 411(a) reads in full:

Except for an action brought for violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), no action for infringement of the copyright in any United States work shall be instituted until registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute an action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party to the action with respect to the issue of registrability of the copyright claim by entering an appearance within sixty days after such service, but the Register's failure to become a party shall not deprive the court of jurisdiction to determine that issue.

²² *M.G.B. Homes*, 903 F.2d at 1489. A home builder alleged the defendant copied a floor plan for a home that the home builder was advertising in various brochures. Even though the plaintiff had filed an application for copyright registration, the Eleventh Circuit affirmed the district court's decision and dismissed the action. The court concluded that the registration requirement is a jurisdictional prerequisite to filing an infringement suit, and that "registration," in this context, refers to the issuance of a certification from the Copyright Office.

submitted to the Copyright Office.²³ Because copyright applications with the Copyright Office are backdated, the application approach allows a plaintiff to defend their work from infringing uses from any point after the application was submitted. Courts look to the statutory language in 17 U.S.C. § 408, which states a registration may be given once a party provides all relevant documents to the Copyright Office.²⁴

The First,²⁵ Fourth,²⁶ Fifth,²⁷ Seventh,²⁸ and Ninth Circuits²⁹ have adopted the application approach. Of these circuits, the Ninth Circuit's decision in *Cosmetic Ideas* provides the most thorough analysis of the application approach.³⁰

The Ninth Circuit's analysis in *Cosmetic Ideas, Inc. v. IAC/InteractiveCorp* focuses on the ambiguous language found in § 411, and discusses how courts should interpret the term "registration," as it appears in the text of the Act. Unfortunately, 17 U.S.C. § 101 does not provide any additional clarification on how to interpret the ambiguous term, "registration."³¹ The court acknowledged § 410(a),³² which states "the Register shall register the claim and issue...a certificate of registration," and the end of § 411(a)³³ which states a copy must be served on the Register of Copyrights, but the court ultimately pointed to the language in § 408 as to why the application approach was the best option. The language in § 408 states a party "*may obtain registration...by delivering*" all the appropriate paperwork and materials to the

²³ *Cosmetic Ideas*, 606 F.3d at 619 (9th Cir. 2010). This case involved a custom-made, jeweled necklace. The Ninth Circuit found that the application approach incentivized individuals to register one's creative work, yet does not *require* individuals to register their copyrighted work. This determination was in-line with Congress' intended goal of lessening the formality requirements for copyright registration.

²⁴ 17 U.S.C. § 408(a) (explaining that the "owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708. Such registration is not a condition of copyright protection.").

²⁵ *Airframe Sys. v. L-3 Commc'ns. Corp.*, 658 F.3d 100, 105 (1st Cir. 2011). The First Circuit found that "proof of registration" is still a necessary element, but did not expand upon the meanings of the terms "proof" or "registration" as they appear in the Act itself.

²⁶ *Iconbazaar, LLC v. Am. Online. Inc.*, 308 F. Supp. 2d 630, 634 (M.D.N.C. 2004). The district court relied on the history of the statute and considered Congress' intended goal regarding the inclusion of section 411 of the Act. The district court found that the application approach was most in line with Congress' expressed goal in creating this section.

²⁷ *Apple Barrell Prods. v. Beard*, 730 F.2d 384, 387 (5th Cir. 1984). This case involved a dispute regarding a country music program. The Fifth Circuit utilized the leading treatise on copyright in forming its decision for this case, and simply stated, "[o]ne need only prove payment of the required fee, deposit of the work in question, and receipt by the Copyright Office of a registration application."

²⁸ *Chicago Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624 (7th Cir. 2003). This is the first case wherein the Seventh Circuit actively applied the application approach. The Seventh Circuit referenced the leading treatise on copyright law to aid its analysis regarding the requirements necessary for § 411.

²⁹ *Cosmetic Ideas*, 606 F.3d at 612.

³⁰ *Id.* at 616. The Ninth Circuit determined that, while the issues at hand were moot, it was essential to decide whether or not to employ the application approach, rather than the registration approach, as the issues presented were "capable of repetition yet evading review."

³¹ 17 U.S.C. § 101 (2012). The definition of "registration," as defined by this section, reads, "'registration,' for purposes of sections 205(c), 405, 406, 410(d), 411, 412, and 506(e), refers to the registration of a claim in the original or the renewed and extended term of copyright."

³² 17 U.S.C. § 410(a).

³³ 17 U.S.C. § 411(a).

Copyright Office.³⁴ Additionally, a party may file a copyright infringement suit even if the Copyright Office rejects the copyright application outright, per § 411(a).³⁵ The Ninth Circuit's decision rests on its interpretation of § 408 and the fact that the plaintiff, Cosmetic, had received a certificate of registration before the court issued its opinion, which was postdated several weeks prior to the initiation of the lawsuit.

Additionally, the leading treatise on copyrights summarizes the policy reasons in support of the Ninth Circuit's rationale by saying, "[g]iven that the claimant...will ultimately be allowed to proceed regardless of how the Copyright Office treats the application, it makes little sense to create a period of 'legal limbo' in which suit is barred,"³⁶ acknowledging the reasoning in support of the application approach.

Unlike other circuits, the Seventh Circuit has flip-flopped on its approach to the interpretation issue.³⁷ After the *Reed Elsevier* decision, the Seventh Circuit took into consideration the aforementioned leading treatise on copyright law and ultimately applied the application approach.³⁸ In a subsequent case, however, the Seventh Circuit applied the opposite approach in its decision in *Chicago Board of Education v. Substance, Inc.*, flip-flopping once more to the registration approach.³⁹ In reverting back to the registration approach, the Seventh Circuit favored the opinion that either an affirmative or negative decision must be issued by the Copyright Office *prior* to the initiation of a lawsuit.⁴⁰ District courts tend to disagree with the registration approach,

³⁴ 17 U.S.C. § 408(a) (which explicitly states, "[a]t any time during the subsistence of the first term of copyright in any published or unpublished work in which the copyright was secured before January 1, 1978... the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708 [17 USCS §§ 409 and 708]. *Such registration is not a condition of copyright protection.*") (emphasis added).

³⁵ 17 U.S.C. § 411(a).

³⁶ 2 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT ¶ 7.16[B][1][a][i] (2008). Melville B. Nimmer's treatise considered the leading treatise on copyright law.

³⁷ *Chicago Bd. of Educ.*, 354 F.3d at 631. The Seventh Circuit has been known to flip-flop between which of the two approaches it chooses to adopt. The Seventh Circuit initially favored the registration approach; however, in *Chicago Board of Education*, the court, instead, adopted the application approach. Then, the Seventh Circuit flopped back to the registration approach, once again, in concluding that an issuance by the Copyright Office (whether the application was granted or not) must be made prior to the initiation of a copyright infringement lawsuit by said applicant. While, in contrast, it appears that the district courts in the seventh circuit still favor the application, as opposed to the registration approach.

³⁸ *Id.*; NIMMER, *supra* note 36. The leading treatise on copyrights summarizes the policy reasons behind the adoption of the application approach when it stated that the process of waiting for a decision to come from the Copyright Office adds an extra "legal limbo" during which a potential suit may become barred.

³⁹ *Gaiman v. McFarlane*, 360 F.3d 644, 655 (7th Cir. 2003) (stating "...an application to register must be filed, and either granted or refused, before suit can be brought"); *see generally* *TriTeq Lock & Sec., LLC v. Innovative Secured Sols, LLC*, No. 10 CV 1304, 2012 U.S. Dist. LEXIS 14147 at *11 (N.D. Ill. Feb. 1, 2012) (in stating that the "mere filing of an application for copyright registration does not satisfy the statutory requirement that a copyright must be registered prior to the initiation of an infringement action."); *see generally* *Furstperson, Inv. v. Iscopia Software, Inc.*, No. 09 C 1814, 2009 U.S. Dist. LEXIS 82520 (N.D. Ill. Sept. 10, 2009) (this case followed the same reasoning); *compare with* *Hard Drive Prods., Inc. v. Does 1-55*, No. 11 C 2798, 2011 U.S. Dist. LEXIS 118049 (N.D. Ill. Oct. 12, 2011) (this district court appeared to employ the application approach, as opposed to adopting registration approach).

⁴⁰ *Gaiman*, 360 F.3d at 655.

and, instead, favor the application approach, even though the Seventh Circuit has yet to clarify which approach it favors.⁴¹

C. The Registration Approach

Courts that have adopted the registration approach presume that a copyright infringement claim may only be brought once the Copyright Office has issued its decision regarding the registerability of the application at issue.⁴² These circuits will dismiss a copyright infringement suit for failure to state a valid claim unless the Copyright Office⁴³ has made an expressed decision regarding the registerability of the copyright at issue prior to suing; this rationale is based on the interpretation of § 411(a).⁴⁴ The Tenth⁴⁵ and Eleventh⁴⁶ Circuits have consistently interpreted this section as to allow for an infringement claim to be filed, so long as the Copyright Office has issued its decision regarding the registerability of the application at issue. The Third,⁴⁷ Sixth,⁴⁸ and Eight⁴⁹ Circuits follow the same rationale at the district court level.⁵⁰

The circuits that have adopted the registration approach, specifically the Tenth Circuit, rely on “[a]ct’s seemingly plain language.”⁵¹ The Tenth Circuit specifically

⁴¹ *Leventhal v. Schenberg*, 917 F. Supp. 2d 837, 844 (N.D. Ill. 2013) (quoting *Chicago Bd. of Educ.*, 354 F.3d at 631).

⁴² See *Enter. Mgmt. Ltd. v. Warrick*, 717 F.3d 1112, 1119 (10th Cir. 2013).

⁴³ *Strategy Source, Inc. v. Lee*, 233 F. Supp. 2d 1, 3-4 (D.D.C. 2002). The plaintiff had wait a full six months before the Copyright Office finally issued its decision regarding the registerability of the application at issue. This court determined that a certificate of registration was a necessary, jurisdictional prerequisite that needed to be fulfilled prior to the initiation of a copyright infringement suit.

⁴⁴ 17 U.S.C. § 411(a).

⁴⁵ *La Resolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1197 (10th Cir. 2005).

⁴⁶ *M.G.B. Homes*, 903 F.2d at 1489. Even though the plaintiff filed an application for copyright registration with the Copyright Office, the Eleventh Circuit affirmed the district court’s decision and dismissed the case by concluding that the registration requirement is a jurisdictional prerequisite to a copyright infringement suit, and “registration,” in this context, instead, refers to an issuance of a certification from the Copyright Office.

⁴⁷ *Patrick Collins, Inc. v. Doe*, 843 F. Supp. 2d 565, 570 (E.D. Pa. 2011). The Third Circuit considered the plain reading of the statute, and concluded that the statute was unambiguous. The Third Circuit expressly concluded that in enacting § 411(a), Congress intended to require an issuance of copyright certification by the Copyright Office to occur *before* an applicant could file a copyright infringement claim, i.e. the registration approach.

⁴⁸ *Hawaiian Vill. Comput., Inc. v. Print Mgmt. Partner, Inc.*, 501 F. Supp. 2d 951, 953-954 (E.D. Mich. 2007). This court favored the registration approach in concluding that issuance of registration by the Copyright Office is a prerequisite that must be met prior to the filing of a copyright infringement action.

⁴⁹ *Charles F. Vatterott Constr. Co. v. Esteem Custom Homes, LLP*, 686 F. Supp. 2d 934, 939 (E.D. Mo. 2010). District courts in the Eight Circuit favor the registration approach, but these courts only considered the plain reading to the statute in making their decision.

⁵⁰ *Id.*

⁵¹ *La Resolana Architects*, 416 F.3d at 1203. This case dealt with an architecture firm that came upon a realty company that was selling townhouses that “looked strikingly similar” to the townhouses that the architecture firm previous built. The Tenth Circuit affirmed the lower courts decision in dismissing the case, and stated that the registration of a copyright, under § 411(a), only occurs upon the issuance of a registration certificate by the Copyright Office.

found that the actions required under §§ 410(a)⁵² and 410(b),⁵³ to “‘examine,’ to ‘register,’ and then to ‘issue’ the certificate of registration,” are pivotal to the application of the registration approach.⁵⁴ Based on the decisions several circuit courts have reached in employing the registration approach, the interpretation of § 411 requires a valid certificate of registration *before* a valid infringement suit can be brought.

III. ANALYSIS

The lack of uniformity among the various courts in their interpretation of § 411 of the Act⁵⁵ has resulted in the aforementioned circuit split. Courts often mention the other approaches’ strengths and weakness in their judicial opinions, along with statutory and policy arguments that weigh in favor of one approach over the other. Ultimately, only one approach should be used, which would bring about uniform application of the law. Much like the court in *Cosmetic Ideas v. IAC*,⁵⁶ this comment favors the adoption of the application approach as the preferred method for interpretation, agreeing with the leading copyright treatise by Nimmer:⁵⁷ a copyright infringement suit may be brought as soon as a copyright application is submitted to the United States Copyright Office.⁵⁸ This comment also adds a caveat to the traditional application approach, which may appease the courts that have sternly adopted the registration approach: if the suit is brought prior to the issuance of a final decision, perhaps copyright owners should be required to submit an amended complaint that recognizes the Copyright Office’s decision regarding the registerability

⁵² 17 U.S.C. § 410(a).

⁵³ 17 U.S.C. § 410(b).

⁵⁴ *Id.*

⁵⁵ *La Resolana*, 416 F.3d at 1201-1202. The Tenth Circuit labeled the two conflicting approaches the “registration approach” and the “application approach,” even though other courts may use other names. *See generally* 2 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT ¶ 7.16[B][1][a][i], at 7-158 (Nimmer, for example, uses the terms “narrow” and “broad” approach, rather than the “registration” and “application” approach, but the terms can be used interchangeably).

⁵⁶ *Cosmetic Ideas, Inc.*, 606 F.3d at 612 (9th Cir. 2010) (states “[t]he Copyright Act, 17 U.S.C. § 411(a), allows a party, after applying for registration, to litigate the claim whether the Copyright Office accepts or rejects the registration.”).

⁵⁷ NIMMER, *supra* note 36. This is the leading treatise on copyright law, and has helped guide numerous courts in drawing certain conclusions regarding the application of the law.

⁵⁸ *Apple Barrel Prods. Inc. v. Beard*, 730 F.2d 384, 386-387 (5th Cir. 1984) (concluding that “[i]n order to bring suit for copyright infringement, it is not necessary to prove possession of a registration certificate. One need only prove payment of the required fee, deposit of the work in question, and receipt by the Copyright Office of a registration application.”); *Chicago Bd. Of Educ.*, 354 F.3d at 631 (similarly held that “[a]n application for registration must be filed before the copyright can be sued upon.”); *see Prunte v. Universal Music Grp.*, 484 F. Supp. 2d 32, 39-40 (D.D.C. 2007) (also concluding “[t]he plain language of this statutory provision suggests that the registration occurs on the day the Copyright Office receives all of the necessary application materials (application, deposit, and fee.”); *see also Precision Automation, Inc. v. Tech. Servs.*, 628 F. Supp. 2d 1244, 1248 (D. Or. 2008) (stating “[a] pending application for registration meets the jurisdictional prerequisite of the Act...”); *see also La Resolana*, 416 F.3d at 1203 (the court held that a certificate from the Copyright Office is not necessary to satisfy § 411(a)); *but see Demetriades v. Kaulmann*, 680 F. Supp. 658, 661 (S.D.N.Y. 1988) (where the court held that the actual receipt of a certificate from the Copyright Office *is* required).

of the application at issue. The analysis that follows will further elaborate on the reasoning behind why the application approach is the best interpretation of § 411.⁵⁹

This analysis will start by discussing the major issues regarding in the reasoning of circuit courts that have adopted the registration approach, specifically how these courts merely rely on the “plain language” of the statute, and nothing more. The next portion will discuss why the application approach is the more suitable approach because it considers both, the “plain language” and the overall purpose of the statute as a whole, as well as the policy considerations that weigh in favor of the application approach.

A. The Flawed Reasoning of Courts That Have Adopted the Registration Approach in Reliance on the Plain Meaning of §§ 411, 410, and 408

The Eleventh Circuit was the first of two circuits to adopt the interpretation that section 411(a)⁶⁰ requires a decision to be made by the Copyright Office regarding the registerability of the copyright application at issue prior to the initiation of a copyright infringement lawsuit by the applicant.⁶¹ The Eleventh Circuit made the determination that the Act, as it is read, requires “registration” of a copyright before a copyright holder may initiate an infringement lawsuit, however, failed to conduct a thorough analysis of what § 411(a) actually refers to.⁶² The court concluded that a party must have a certificate of registration “in-hand” as a prerequisite to filing an infringement suit. This determination coincides with the district court’s original finding, but fails to discuss the intended meaning of the term “registration” as it is used in the Act, which is where the ambiguity lies.

Because the term “registration” is not clear,⁶³ the second portion of § 411(a) is more helpful in understanding why some courts favor the registration approach.⁶⁴

⁵⁹ 17 U.S.C. § 411 (the relevant portion of this section states that, “...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 the title.... however, where the... 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.”).

⁶⁰ 17 U.S.C. § 411(a); see *M.G.B Homes*, 903 F.2d at 1488-1489.

⁶¹ *Id.* The district court dismissed the initial case because the plaintiff had not yet received an affirmative action (either an issuance or denial of their application) from the Copyright Office. The plaintiff eventually received a response from the Copyright Office, at which time they were able to refile the action as an amended complaint. The Eleventh Circuit approved of the district court’s decision, and agreed that waiting for an actual issuance or denial of a certificate is the appropriate approach. See *Mays & Assocs. v. Euler*, 370 F. Supp. 2d 362, 368 (D. Md. 2005) (the district court concluded that a certification of copyright registration is a jurisdictional prerequisite).

⁶² *Id.*

⁶³ *United Sav. Ass’n of Tex. v. Timbers of Inwood Forest Assocs.*, 484 U.S. 365, 371 (1988) (summarizing that, at times, statutory provisions, “that may seem ambiguous in isolation [are] often clarified by the remainder of the statutory scheme because the same terminology is used elsewhere in a context that makes its meaning clear, or because only one of the permissible meanings produces a substantive effect that is compatible with the rest of the law.”).

⁶⁴ 17 U.S.C. § 411(a). The relevant portion of the statute explains that once 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 copy of the complaint, is served on the Register of Copyrights.”

Some state courts favor the registration approach because the statute, as it is written, allows for a situation wherein the “deposit, application, and fee required for registration” are submitted, but the application is ultimately refused copyright registration. Therefore, these courts are under the impression that the application and registration are two different things,⁶⁵ and you can have one without the other. Based on this language, courts that have adopted the registration approach allow plaintiffs to bring an infringement claim, even if their applications have been denied, so long as a final decision regarding registerability has been made prior to filing. An applicant cannot file suit until a final determination has been made by the Copyright Office, regardless of what that decision may be. This exception stated in § 411(a) appears to support the application of the registration approach.

Proponents of the registration approach also rely on the plain language of section 410 as a basis for their support.⁶⁶ The relevant portion of this section states that registration of a copyright may only occur “after examination,” of the application, then the “Register shall register the claim.”⁶⁷ Essentially, the Register of Copyrights holds the most power in the decision-making process. The Register of Copyrights is not only given the power to “register” the copyright, but also has the power to “refuse” registration. As the Tenth Circuit observed, “[t]his language requires the following affirmative acts by the Register – to ‘examin[e],’ to ‘register,’ and then to ‘issue’ the certificate of registration.”⁶⁸ The language of § 410 bolsters support for the registration approach’s argument that it is the Copyright Office, not the applicant, that must take the final action step in considering “registration,”⁶⁹ prior to the bringing of an infringement lawsuit.

See generally Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc., 315 F. Supp. 2d 1053, 1056 (C. D. Cal. 2004) (the court reasoned that the second portion of section 411(a), “drives an iron wedge between the act of delivering the deposit, application, and fee to the Copyright Office and the determination of refusal of copyright registration by the Register of Copyrights. Indeed, the provision illustrates that delivery of the deposit, application, and fee can occur, yet registration can be refused.”).

⁶⁵ *Id.*

⁶⁶ 17 U.S.C. § 410. The relevant sections state:

(a) When, after examination, the Register of Copyrights determines that...the material deposited constitutes copyrightable subject matter...the Register shall register the claim and issues to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application together with the number and effective date of registration. (b) In any case in which the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited does not constitute copyrightable subject matter or that the claim is invalid...the Register shall refuse registration... (d) The effective date of a copyright registration is the day on which an application deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.

⁶⁷ *Id.*

⁶⁸ *La Resolana Architects*, 416 F.3d at 1203 (concluding that infringement claims, “can be brought when a copyright is registered, and such registration occurs when the Copyright Office approves the application.”).

⁶⁹ *See generally* Specific Software Sols., LLC v. Inst. of WorkComp Advisors, LLC, 615 F. Supp. 2d 708, 715 (M.D. Tenn. 2009) (the court concluded that § 410(b), among the other provisions of the section, “shows a clear congressional intent to have the Copyright Office review the materials submitted and pass judgment on their copyrightability before those material are considered ‘registered’ for purposes of the jurisdictional requirements of section § 411(a)”).

Lastly, proponents cite to section 408 as further support for the registration approach. Section 408(a) states, in part that, “[a]t any time during the subsistence of...any copyright...the owner of the copyright or of any exclusive right in the work *may* obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section... Such registration is not a condition of copyright protection.”⁷⁰ Courts that favor the registration approach fail to consider the term ‘may’ as it is written. Instead, these courts understand “may” as referring to further steps that *need* to be taken by the Register before any official decision regarding the registerability is made, whether it is granted or not.⁷¹

The circuits that have adopted the registration approach consider this provision in conjunction with § 410, which provides that the Copyright Office is to examine the application, register or deny the copyright, and if registered, issue a certificate to the appropriate copyright holder.⁷² The registration approach’s interpretation of § 408⁷³ is made clearer when it is read in conjunction with § 410, especially since the statute directly states that the copyright owner must “obtain” registration, which must come from the United States Copyright Office itself.⁷⁴ The Eleventh and Tenth Circuit understandably use the aforementioned interpretations of §§ 411, 410 and 408 as the basis for their adoption of the registration approach.

B. The Overwhelmingly Favorable, Purposeful, and Efficient Considerations in Favor of the Application Approach

Even though it may appear that the registration approach is supported by a broad interpretation of the statute’s “plain language,” the application approach has major advantages when one considers both the policy implications and the efficiency of the approach.⁷⁵ These considerations are very compelling, and some courts that favor the application approach have even based their opinions solely on the policy benefits that are associated with the approach.⁷⁶ Surprisingly, even some district courts that have traditionally favored the registration approach have agreed that the application approach makes more sense, and would not be an impediment to the legal system and/or copyright law.⁷⁷

⁷⁰ 17 U.S.C. § 408(a).

⁷¹ *La Resolana Architects*, 416 F.3d at 1201 (in support of its decision to adopt the registration approach, this court argued that if § 408 was intended to confer a registration merely upon submission of the specified application materials, then “the verb would be ‘shall obtain’ instead of ‘may obtain.’”); see *Corbis Corp. v. UGO Networks, Inc.*, 322 F. Supp. 2d 520, 522 (S.D.N.Y. 2004) (the use of “may obtain,” in § 408 does not specifically confer a registration upon a simple submission. Perhaps, if the statute instead read “shall obtain,” courts could have easily concluded that the statute requires every copyright holder to register each copyrightable work they create, but this clearly not what Congress intended. Instead, the statute explicitly states “may obtain.”).

⁷² *La Resolana Architects*, 416 F.3d at 1200.

⁷³ 17 U.S.C. § 408.

⁷⁴ *Id.*

⁷⁵ *Prunte v. Universal Music Grp.*, 484 F. Supp. 2d 32, 40 (D.D.C. 2007)

⁷⁶ *Ryan v. Carl Corp.*, No. C 97-3873 FMS, 1998 U.S. Dist. LEXIS 9012 at *4 (N.D. Cal. June 15, 1998).

⁷⁷ *Goebel v. Manis*, 39 F. Supp. 2d 1318, 1320-1321 (D. Kan. 1999) (while some courts may favor the application approach, “the plain language of the statute control... The court recognizes there is

Historically speaking, section 411(a), which, as mentioned above, is heavily relied upon by courts that favor the registration approach, was intended by Congress to further its intended goal of lessening the formality requirements of copyright registration and copyright law, more generally. The second portion of section 411(a)⁷⁸ makes clear that the ultimate decision regarding the registerability of an application is irrelevant; applicants can bring an infringement claim, regardless of the Copyright Office's ultimate decision.⁷⁹ When one considers the second, relevant portion of section 411(a) it becomes clear that there is no actual, direct connection between an applicant's right to sue and the Copyright Office's ultimate decision regarding registerability.⁸⁰ However, courts that have adopted the registration approach incorrectly assume that Congress' goal was to incentivize registration, but these courts are disregarding the pivotal house report that accompanied the Copyright Act, which clearly states that "copyright registration for published works, which is useful and important to uses and the public at large, would *no longer be compulsory*, and should therefore be induced in some practical way."⁸¹ Instead, Congress' intended goal was to relax the formalities of copyright law, rather than to *require* a stringent application process.

Proponents of the application approach interpret the term "may" in section 408(a) differently than the courts that have adopted the registration approach. Proponents of the application approach correctly interpret the term "may" as an option, as opposed to courts that have adopted the registration approach, which interpret section 408(a) to be a conditional *requirement*. Instead, courts that favor the application approach correctly interpret this provision to mean that a copyright owner of an exclusive work *may* obtain a registration by submitting the three specified requirements,⁸² but it is not a requirement for copyright protection.

This interpretation coincides with both the text of section 408 and the aforementioned house report that outlined the intended policy goals surrounding the statute. Similarly, the primary incentive of the application approach is to "promote the interests of justice and judicial economy."⁸³ The application approach allows an individual to enforce his or her rights immediately and without further hassle; there is no need for unnecessary motions, dismissals, amendments, and re-fillings that

some inconvenience in the court of action [the registration approach.]); *see Specific Software Sols, LLC*, 615 F. Supp. 2d at 713 (this court also recognized that "there is something 'uneconomic' about dismissing a complaint simply because the plaintiff does not have a certificate of registration.").

⁷⁸ 17 U.S.C. § 411(a). Part two of section 411 reads: "In any case, however, where the deposit, application, and fee required for registration have been delivered...registration has been refused, the applicant is entitled to institute a civil action for infringement..."

⁷⁹ *Prunte*, 484 F. Supp. 2d at 40 (the district court found that the submission of a preregistration form was sufficient to qualify as a completed application and the official "registration.").

⁸⁰ *Id.*

⁸¹ H.R. Rep. No. 94-1476, at 157 (1976).

⁸² *Prunte*, 484 F. Supp. 2d at 40; *see* 2 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT ¶ 7.16[B][1][a] (2008) (the application approach "represents the better point of view, given that the claimant at the juncture has done all that it can do, and will ultimately be allowed to proceed regardless of how the Copyright Office treats the application.").

⁸³ *See Tri-Mktg. v. Mainstream Mktg. Servs., Inc.*, No. 09-13 (DMF/RLE), 2009 WL 1408741 at *3 (D. Minn. May 19, 2009).

would overwhelm the courts.⁸⁴ This incentive is derived from the courts that favor the application approach interpretations of §§ 410(a)⁸⁵ and 410(d).⁸⁶

Courts that use the application approach insist that there is a clear-cut difference between the “registration” and the “issuance” of said registration. These courts correctly conclude that “registration” occurs the moment an applicant submits the three required items to the Office, and that “issuance” follows registration, and only occurs once the Office makes its final decision regarding the registerability of said application.⁸⁷ One court that favors the application approach correctly held that section 410(a) “could be read to apply only to the requirements for issuance of a registration certificate, not to the requirements for instituting an action for infringement.”⁸⁸

These courts’ interpretation of § 410(a) also coincides with their interpretation of § 410(d). This portion states that, “the effective date of a copyright registration is the day on which an application, deposit, and fee... have all been received in the Copyright Office.”⁸⁹ Courts that favor the application approach have correctly interpreted this provision to mean just that,⁹⁰ while other courts have failed to read the language literally. Those courts that have correctly interpreted § 410(d), have accurately determined that “registration” is effective as of the date of application, which occurs *before* an examination is made by the Copyright Office regarding the issuance of a said registration.

Proponents of the registration approach take issue with this interpretation, and instead, favor an approach that has created a very dynamic legal environment regarding copyright law, rather than favoring the more uniform and stable application approach. As one court put it, “[i]f, for example, an applicant could obtain the advantage of the presumption that the copyright is valid upon application, but then after examination the Register of Copyrights determined the material is not copyrightable, the presumption of validity would swing back and forth.”⁹¹ The

⁸⁴ *Int’l Kitchen Exhaust Cleaning Ass’n v. Power Washers of N. Am.*, 81 F. Supp. 2d 70, 77 (D.D.C. 2000) (this court acknowledged the split between the circuits, but ultimately rule in favor of the application approach in order “to best effectuate the interest of justice and promote judicial economy”).

⁸⁵ 17 U.S.C. § 410(a). The relevant portion of § 410(a) reads: “...the Register shall register the claim and issues to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application together with the number and effective date of registration.”

⁸⁶ 17 U.S.C. § 410(d). The relevant portion of § 410(d) states that the “effective date of a copyright registration is the day on which an application, deposit, and fee... have all been received in the Copyright Office.”

⁸⁷ *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 387 (5th Cir. 1984) (stating “[o]ne need only prove payment of the required fee, deposit of the work in question, and receipt by the Copyright Office” in order to bring suit for copyright infringement; possession of a registration certificate is not necessary).

⁸⁸ 17 U.S.C. § 410(a); *see Iconbazaar*, 308 F. Supp. 2d at 634 (the court reasoned that “this statute could be read to apply only to the requirements for issuance of a registration certificate, not to the requirements for instituting an action for infringement”).

⁸⁹ 17 U.S.C. § 410(d) (this section states that, “[t]he effective date of a copyright registration is the day on which an application, deposit, and fee... have all been received in the Copyright Office.”).

⁹⁰ *Id.*; *see Foraste v. Brown Univ.*, 248 F. Supp. 2d 71, 77 (D.R.I. 2003) (where the court determined that “the merits of the application materials are ‘later determined,’ that is, determined at some time after the right to sue comes into being”).

⁹¹ *La Resolana*, 416 F.3d at 1205 (for example if, “an applicant could obtain the advantage of the presumption that the copyright is valid upon application, but then, after examination the Register of Copyrights determined the material is not copyrightable, the presumption of validity would *swing*

registration approach fails to consider the broader implications that such a dynamic approach would have on the uniform application of the law.

The dynamic nature of the registration approach is a fundamental flaw that stems from its misunderstanding of the plain text of the statute; the presumption of the validity of a copyright is not the same as the right to initiate a copyright infringement lawsuit.⁹² Instead, the statute simply states that a certification of copyright registration from the Copyright Office “shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.”⁹³ A copyright holder still has the right to sue even if her application is rejected by the Copyright Office⁹⁴ because “registration” is not a condition for copyright protection under the law.

IV. PROPOSAL - A REALISTIC APPROACH THAT WILL UNITE THE COURTS AND RESOLVE DISCREPANCIES

In order to create uniformity amongst the courts, clarification of the law is essential. Additionally, potential plaintiffs are in need of clarification so as to be sure at what point an infringement suit can be brought. The above analysis and interpretation of the various circuit courts demonstrates that only the application approach can bring about both uniform application of the law and clarification for potential plaintiffs.

The most obvious way to resolve the discrepancy between the registration and application approach is for Congress to clarify section 411(a)⁹⁵ of the statute. Unfortunately, this is, perhaps, the least likely solution despite the obvious controversy that has been building between the courts. Congress could clarify the statute with a sentence similar to the following: For purposes of this subsection, the registration of a copyright will be deemed to occur as soon as the application, deposit, and required fee have been received by the Copyright Registration Office. This would invariably clarify and resolve the litany of issues that have arisen from the discrepancy.

Cooperation from Congress would allow the application approach to prevail, while maintaining the consistency and integrity of the other sections of the Copyright Act. Unfortunately, such cooperation from Congress is improbable, which is why the next

back and forth.”); *see generally In re Napster, Inc. Copyright Litig.*, 191 F. Supp. 2d 1087, 1101 (N.D. Cal. 2002) (Napster attempted to argue that, “works with pending registration application are not entitled to the same rebuttable presumption as registered works...,” even though the application is postdated to the day on which the actual application is received by the Copyright Office. The court recognized that Napster’s argument failed to consider section 410(d), and correctly concluded that works with pending registrations enjoy the same presumption of validity as registered works.).

⁹² 17 U.S.C. § 410(c).

⁹³ *Id.* (this section establishes that a copyright certificate registration certificate “shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.” The evidentiary weight of said certification is left to the discretion of the courts.).

⁹⁴ 17 U.S.C. § 411(a) (stating that even if “...registration has been refused, the applicant is entitled to institute a civil action for infringement...”).

⁹⁵ *Id.* (the relevant portion of the section explicitly states that, “...no action for infringement of the copyright... shall be instituted until registration of the copyright claim has been made... [h]owever, where...registration has been refused, the applicant is entitled to institute an action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.).

portion of this comment will examine the Ninth Circuit's recent solution in *Cosmetic Ideas*,⁹⁶ along with the potential of additional administrative requirement, which would ultimately lead to implementation of the application approach.

1. *The Importance of the Ninth Circuit's Approach in Cosmetic Ideas*

One of the most recent circuit courts to address the issue of when registration occurs for purposes of § 411(a)⁹⁷ is the Ninth Circuit in *Cosmetic Ideas, Inc. v. IAC/InteractiveCorp.*⁹⁸ In that case, the court took a decidedly different approach to interpret the statute than the other circuit or district courts that came before it.⁹⁹ Its unique reasoning is worth noting, as other courts, perhaps even courts that have already have addressed the issue, may end up emulating its reasoning. Essentially, the Ninth Circuit interpreted the statute as ambiguous,¹⁰⁰ which moved the court to ponder the policy considerations in support of the adoption of the application approach. The Ninth Circuit contemplated both, the registration and the application approach, but ultimately concluded that the plain language of the Copyright Act does not lend itself more in favor of one approach over the other.¹⁰¹ This court determined that the ambiguous language of the statute may justify the use of the registration or application approach, which is why this court could not decide between the use of one over the other.¹⁰²

The ambiguous language of the statute led the court to consider the “the broader context of the statute, as a whole, and the intended purpose of the statute.”¹⁰³ By looking into the history of § 411(a),¹⁰⁴ the court understood Congress’ intended “purpose of providing broad copyright protection while maintaining a robust federal registry.”¹⁰⁵ This intended purpose is promoted through the enforcement of the application approach, rather than the registration approach.¹⁰⁶ The court ultimately

⁹⁶ *Cosmetic Ideas, Inc. v. IAC/InteractiveCorp.*, 606 F.3d 612, 615-621 (9th Cir. 2010).

⁹⁷ 17 U.S.C. § 411(a).

⁹⁸ *Cosmetic Ideas*, 606 F.3d at 619.

⁹⁹ See *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1112 (W.D. Wash. 2004) (this district court favored the application of the registration approach); see also *Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc.*, 315 F. Supp. 2d 1053, 1056 (C. D. Cal. 2004) (this district court adopted the application approach as well. The judge in this case urged the Ninth Circuit to consider this case because, “[a] clear rule issued by the Ninth Circuit would settle the matter within the Circuit and undercut the ever-growing” debate); but see *Dielsi v. Falk*, 916 F. Supp. 985, 994 (C.D. Cal. 1996) (this district court, instead, favored the registration approach).

¹⁰⁰ *Cosmetic Ideas*, 606 F.3d at 617.

¹⁰¹ *Id.* at 618. The court was not persuaded by either the registration, nor the application approach because the plain language of the Act could be read to support either one. In some sections, the Act “...seems to equate registration with affirmative approval by the Copyright Office, in others the Act suggests registration is accomplished by completing the process of submitting an application.” The recognition of this ambiguity ultimately lead this court to look beyond the plain language of the Act in order to determine which approach “better carries out the purpose of the statute.”

¹⁰² *Id.* at 619.

¹⁰³ *Id.* at 618 (quoting *U.S. v. Olander*, 572 F.3d 764, 768 (9th Cir. 2009)).

¹⁰⁴ 17 U.S.C. § 411(a).

¹⁰⁵ *Cosmetic Ideas*, 606 F.3d at 619.

¹⁰⁶ *Id.*

held “that receipt by the Copyright Office of a complete application satisfies the registration requirement of § 411(a).”¹⁰⁷

It seems curious that the *Cosmetic Ideas*¹⁰⁸ court chose not to merely rely on the statutory language alone, as previous courts have in adopting either the registration or application approach, but instead chose to acknowledge the ambiguity in the statutory language, which was necessary in order to ensure uniformity.¹⁰⁹ Instead, this court was dissuaded by the various courts that preceded it because they relied solely on the plain language of the Copyright Act, when the plain language is obviously ambiguous in light of the differing approaches that have resulted.¹¹⁰ In determining the statute to be ambiguous, the Ninth Circuit opened the door to the possibility of adopting a practical, uniform approach, that would resolve the split between the circuits. Courts that now follow the *Cosmetic Ideas*¹¹¹ approach are beginning to acknowledge the shortcomings of the Copyright Act, and are ultimately arriving at the same conclusion: due to the ambiguous language of the statute, courts must look beyond the plain language and also consider the overall intended purpose of the Act, together with the policy implications that accompany it, in determining its true meaning.¹¹²

2. The Supreme Court has the Ability to Resolve the Pressing Conundrum

The wide disparity amongst the circuit courts begs the question of why the United States Supreme Court has not opted to weigh in on the issue, and grant certiorari to resolve the existing debate. In fact, in *Cosmetic Ideas*, the defendants urged the Supreme Court to do so, upon the issuance of the court’s ruling.¹¹³ The Supreme Court denied certiorari¹¹⁴ in *Cosmetic Ideas*, which left the litany of issues to persist regarding the differing approaches the courts are applying.¹¹⁵

¹⁰⁷ 17 U.S.C. § 411(a).

¹⁰⁸ *Cosmetic Ideas*, 606 F.3d at 619.

¹⁰⁹ *Id.*

¹¹⁰ *Id.* at 618. (the court could not decide which approach to adopt because some sections of the Act “...seem to equate registration with affirmative approval by the Copyright Office, in others the Act suggests registration is accomplished by completing the process of submitting an application. This ambiguity make[d] it necessary to go beyond the Act’s plain language to determine which approach better carries out the purpose of the statute.”).

¹¹¹ *Id.* at 616; see *Chicago Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624 (7th Cir. 2003) (the Seventh Circuit adopted the application approach); see also *Leventhal v. Schenberg*, 917 F. Supp. 2d 837, 844 (N.D. Ill. 2013) (quoting *Chicago Bd. of Educ.*, 354 F.3d at 631); see generally *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 387 (5th Cir. 1984) (this court employed the use of the leading treatise on copyright in forming its decision to follow the application approach. The court simply said, “[o]ne need only prove payment of the required fee, deposit of the work in question, and receipt by the Copyright Office.”); see generally *Iconbazaar, LLC v. Am. Online, Inc.*, 308 F. Supp. 2d 630, 634 (M.D. N.C. 2004).

¹¹² *Cosmetic Ideas*, 606 F.3d 612.

¹¹³ *Id.* (the U.S. Supreme Court subsequently denied certiorari).

¹¹⁴ *Id.*

¹¹⁵ One of the most obvious, and broad-reaching judicial solutions to resolve the discrepancy would be for the United States Supreme Court to grant certiorari for a case germane to the application/registration debate.

3. A Practical Approach to Satisfy Both the Application and Registration Approach

Even if courts in the Tenth¹¹⁶ and Eleventh¹¹⁷ Circuits do not want to adopt an outright application approach, an augmented application approach may be a more appropriate solution for courts that are still grappling with the argument. The Eleventh Circuit, for example, allowed a plaintiff to file an amended complaint to their infringement claim after the Registration Office issued their registration certificate.¹¹⁸ This approach was briefly addressed and endorsed by the Ninth Circuit, as well.¹¹⁹ Although the actual certificate of registration was not issued at the time the lawsuit was filed, the effective date, according to § 410(d),¹²⁰ relates back to the application date prior to the filing of the lawsuit. The Ninth Circuit concluded that “Cosmetic [could] now allege the registration element of an infringement claim, irrespective of whether the registration accrues at application or issuance.”¹²¹

Several district courts have now followed suit and allowed for an amendment, or in some cases, even allowed plaintiffs to refile their complaints following a response from the Copyright Copyright Office regarding the registerability of their application, which did not adversely effect the plaintiff.¹²² Additionally, requiring an amended complaint does not run afoul of the Federal Rules of Civil Procedure, which states courts “should freely give leave [to amend a complaint] when justice so requires.”¹²³ The allowance of an amended complaint, invariably, falls within the purview of what

¹¹⁶ *La Resolana Architects*, 416 F.3d at 1203 (10th Cir. 2005) (this court determined that registration only occurs once a certificate is sent by the Copyright Office, either approving or denying the application).

¹¹⁷ *M.G.B. Homes*, 903 F.2d at 1489 (11th Cir. 1990) (in accordance with the registration approach, the claim was dismissed, even though the plaintiff had filed an application because the Office had not yet issued a registration certificate, which is a prerequisite for filing an infringement claim in this court).

¹¹⁸ *Id.* (the court permitted the plaintiff to amend their complaint, but only after a registration certificate had been issued by the Office).

¹¹⁹ *Cosmetic Ideas*, 606 F.3d at 616 (even though the registration of the certificate was not issued at the time of filing of the lawsuit, it was issued at some point during the litigation of the case, and the effective date, according section 410(d), reverts back to the date on which the application was filed, which, in this case, was before the lawsuit was even filed. At this point, the court determined that the plaintiff could, now, “allege the registration element of an infringement claim,” irrespective of the debate surrounding when ‘registration’ actually occurs.).

¹²⁰ 17 U.S.C. 410(d). The pertinent portion of this section states that “the effective date of a copyright registration is the day on which an application, deposit, and fee... have all been received in the Copyright Office.” The Office, then, later determines whether the application is acceptable for registration or not.

17 U.S.C. § 410(d).

¹²¹ *Cosmetic Ideas*, 606 F.3d at 616 (9th Cir. 2010).

¹²² See generally *Demetriades v. Kaulmann*, 680 F. Supp. 658 (S.D.N.Y. 1988) (the court allowed the plaintiff to amended their complaint because the Copyright Office had issued a certificate of registration); see also *Foraste v. Brown Univ.*, 238 F. Supp. 2d 71, 78 (D.R.I. 2003) (explaining how courts “have permitted a copyright action to proceed once a plaintiff has rectified his pleadings to reflect copyright registration or attempted registration”); but see *Westport Historical Soc’y v. Lee*, No. 97-2130-GTV, 1997 U.S. Dist. LEXIS 11909 at *1860 (D. Kan. July 11, 1997) (where the plaintiff was not allowed to amend the complaint, since doing so would not cure the original deficiency for failure to state a valid claim).

¹²³ Fed. R. Civ. P. 15(a)(2) (2009). The revelant portion of this section refers to pre-trial amendment to complaints, and states, “...a party may amend its pleading only with the opposing party’s written consent or the court’s leave. The court should freely give leave when justice so requires.”

justice so requires,¹²⁴ and firmly places the courts in the middle-ground, where there would be no need to choose between the registration or the application approach. This would, effectively, resolve the discrepancy, and allow for uniform application of the law.

V. CONCLUSION

The debate between the two approaches needs to come to an end in order to provide copyright owners with clarity regarding the rights they have, as well as when they can exercise them. Barring some plaintiffs from initiating an infringement action should not be determined by the circuit court they avail themselves to, instead, it should be determined by the law. Widespread adoption of the application approach, whether by using the Ninth Circuit's methodology¹²⁵ or some other means, would make the law more uniform, efficient, and fair. The ambiguity should be resolved by adopting a uniform approach that coincides with, not only the plain language of the Act, but that also benefits the copyright holder, and continues to promote "the progress of science and useful arts."¹²⁶

VI. SUPPLEMENT DISCUSSING THE SUPREME COURT'S RECENT DECISION IN *FOURTH ESTATE PUBLIC BENEFIT CORP. V. WALL-STREET.COM*.

On March 4, 2019, the U.S. Supreme Court unanimously decided that a copyright claimant may only bring a suit for copyright infringement *after* the work in question has been registered by the Copyright Office. The decision in *Fourth Estate Pub. Ben. Corp. v. Wall-Street.com, LLC*, officially put an end to the debate surrounding these questions; the "registration approach" is now the law of the land.

The Court's decision was prompted by allegations of copyright infringement arising out of Wall-Street.com's use of articles that were originally featured on Fourth Estate's website. Upon the termination of the parties' licensing agreement, Wall-Street.com was supposed to remove Fourth Estate's articles that Wall-Street had displayed on its website. Fourth Estate was in the process of registering the articles for copyright protection, however its application remained pending before the United States Copyright Office at the time the lawsuit was initiated.

The opinion, delivered by Justice Ginsberg, clarified when registration of a copyright occurs in accordance with 17 U.S.C. § 411(a) of the Copyright Act. In reaching its conclusion, the Court remained true to the plain language of the statutory provisions prescribed by § 411(a), which reads: "no civil action for infringement of the copyright in any United States work shall be instituted until...registration of the copyright claim has been made in accordance with this title."¹²⁷ The Court concluded

¹²⁴ *Foman v. Davis*, 371 U.S. 178 (1962) (the civil procedure phrase, "when justice requires," is a very low threshold. In the absence of any undue prejudice, undue delay, or affirmative bad faith, a party may amend a complaint, so long as leave is "freely given" by the district court.).

¹²⁵ *Cosmetic Ideas*, 606 F.3d at 619 (9th Cir. 2010).

¹²⁶ U.S. Const. art. I, § 8, cl. 8.

¹²⁷ 17 U.S.C. § 411(a).

that, for purposes of this subsection, the “registration of the copyright” occurs after the Copyright Office reviews and registers the copyright for the work(s) in question. The Court’s decision puts the proverbial “nail in the coffin” for the various Circuit Courts that have previously subscribed to the “application approach.” However, the decision contains two important distinctions that are reminiscent of the arguments employed by proponents of the “application approach.”

First, the Court’s decision allows for copyright owners to file an infringement lawsuit before undertaking an official registration under limited circumstances. The exception applies narrowly to a very specific subspecies of copyrightable works – namely, works that are particularly vulnerable and/or susceptible to pre-distribution infringement.¹²⁸ This exception allows the copyright owner to initiate a lawsuit before the Copyright Office grants a registration, thus alleviating one of the contentions often espoused by “application approach” advocates.

The second important distinction established by this decision is that a copyright owner will be able to recover for any infringement that occurred during the period prior to, as well as after the work’s registration. Consequently, the Court’s decision would permit a claimant to recover for infringement that occurred within the period prior to the Copyright Office’s issuance of a decision regarding the application for registration. In issuing the Court’s opinion, Justice Ginsburg explains that the aim of the Copyright Act is to “safeguard copyright owners, irrespective of registration, by vesting them with exclusive rights upon creating their works and [to] prohibit infringement from that point forward.”¹²⁹ The exceptions contained in the Court’s decision will appease advocates of the “application approach,” as this ruling does not establish an absolute bar to a claimant’s ability to recover for infringing conduct that occurs prior to an issuance of a copyright registration.

Ultimately, the Supreme Court’s unanimous decision is consistent with what is to be expected from the Court’s present composition: interpreting the law through a careful examination of the statute’s plain language, while seeking to remain true to the legislator’s original intent when authoring this section of the Act. Now that the ambiguity concerning this facet of Copyright law has been resolved, authors should file an application for copyright registration as soon as possible after creating their works. Authors can finally rest assured that delay on the part of the Copyright Office will not preclude a claimant’s ability to recover for any infringement that occurs before receipt of an official registration.

¹²⁸ *Fourth Estate Pub. Ben. Corp.*, 2019 U.S. LEXIS 1730, *2.

¹²⁹ *Fourth Estate Pub. Ben. Corp.*, 2019 U.S. LEXIS 1730, *5.