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WHY AND HOW THE ISSUE OF COPYRIGHT REGISTRATION MADE ITS WAY UP TO THE SUPREME COURT

*Justin Scharff**

I. INTRODUCTION

One of the most powerful tools an author can wield is a properly registered copyright. Article I, Section 8, Clause 8 of the United States Constitution provides Congress with the 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.”¹ Pursuant to its powers in the Constitution, Congress enacted the first copyright laws in 1790 to promote and protect creative works.² Congress enacted the Copyright Act of 1976 to address copyright protection of creative works to keep up with the emergence of some of America’s greatest technological innovations.³ The Copyright Act not only responded to some of the toughest intellectual property questions,⁴ but it also provided

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¹ U.S. CONST. art. I, § 8, cl. 8.

² See 1 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 1:19 (Sept. ed. 2018); see also *id.* § 1:45.

³ See H.R. REP. NO. 94-1476 (1976).

⁴ The Copyright Act of 1976 dealt with the explosive growth of new media—television, phonographs, and motion pictures to name a few. See Robert A. Gorman, *An Overview of the Copyright Act of 1976*, 126 U. PA. L. REV. 856, 856 (1978). Furthermore, these types of media gained the ability to be disseminated far and wide, a phenomenon that the Copyright Act of 1909 was unable to handle. *Id.* The Copyright Act of 1976 removed some of the needless formalities around obtaining a copyright, which made it easier for people to copyright their work. See 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.01 (rev. ed.

numerous incentives for those who registered their copyrights with the Copyright Office.⁵ One of the most alluring incentives was, and still is, the ability to institute an action for copyright infringement.⁶ However, for the purposes of bringing an infringement suit, when is a copyright registered?

Under 17 U.S.C. § 411(a),⁷ no civil action for copyright infringement can be instituted until preregistration or registration of the copyright claim is made in accordance with the Copyright Act of 1976.⁸ Although Congress mandates the registration of a copyright prior to a plaintiff's bringing a copyright infringement suit, Congress, through several amendments to the statute, has failed to explicitly define when a copyright is registered.⁹ The courts have developed two conflicting approaches to determine when a copyright is registered for bringing copyright infringement suits. The two approaches are the registration approach and the application approach.

Proponents of the registration approach argue that registration of a copyright is only satisfied after the Copyright Office rules on the copyright application, either accepting or rejecting the application.¹⁰ The Tenth Circuit and, more recently, the Eleventh Circuit support this approach.¹¹ On the other hand, advocates of the application approach argue that registration is satisfied when the applicant deposits the appropriate materials in the Copyright Office together with the

2018). This trend of removing unnecessary formalities continued with America's adherence to the Berne Convention in 1989. *See* 134 CONG. REC. H.29661, 30103 (daily ed. Oct. 11, 1988).

⁵ Section 106 of the Copyright Act of 1976 provides exclusive rights to those who hold a copyright. *See* 17 U.S.C. § 106 (2018). These include the ability to reproduce the copyrighted material, create derivative works, distribute the copyrighted material, and publicly perform and display the copyrighted work. *Id.*

⁶ 17 U.S.C. § 411(a).

⁷ *Id.*

⁸ *Id.* The registration requirement only applies to works created in the United States. *Id.* Foreign works are exempt from this requirement. *Id.* *See also* discussion of pre-registration *infra* Part III.A.

⁹ *See* S. REP. NO. 100-352, at 13 (1988); *see also* Copyright Reform Act of 1993, H.R. 897, 103d Cong. (1993).

¹⁰ *See* Robert Kasunic, *Copyright from Inside the Box: A View from the U.S. Copyright Office*, 39 COLUM. J.L. & ARTS 311, 318 (2016); *see also* 5 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 17:78 (Sept. ed. 2018).

¹¹ *See* *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200 (10th Cir. 2005), *abrogated on other grounds by* *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010); *see also* *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1339 (11th Cir. 2017), *cert. granted*, 138 S. Ct. 2707 (2018).

application.¹² The application approach is supported by the Fifth and Ninth Circuits.¹³

The Eleventh Circuit is the latest circuit to address the issue of copyright registration. In *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, the plaintiff filed a copyright infringement lawsuit before the Copyright Office ruled on its copyright application.¹⁴ The court held that the statutory language of the Copyright Act made it clear that registration of a copyright occurs only after the Copyright Office affirmatively acts on the applicant's copyright application.¹⁵ The Eleventh Circuit's decision in this case was not only correct, but it also deepened the split between circuits. The registration issue pitted two circuits against two others, creating a perfect platform for the United States Supreme Court's analysis. As a result of this split, on June 28, 2018, the Supreme Court granted certiorari to hear the registration issue presented in *Fourth Estate*.¹⁶ The Supreme Court finally has the opportunity to resolve the issue of registration under the Copyright Act.

The author will argue that the registration approach is the correct interpretation of the Copyright Act based on plain language, legislative history, and public policy. The author predicts that the Supreme Court, based on the statutory language of the Copyright Act, will favor the registration approach and hold that in order to institute a civil action for copyright infringement, one must have a copyright that the Copyright Office has accepted or rejected. In its analysis, the Supreme Court should read the applicable statutory sections *in pari materia*.¹⁷ When read in conjunction with each other, the statutes demonstrate Congress's clear intent for the Copyright Office to rule on a copyright application before the requirements for registration are satisfied. The consistent statutory language and scheme of the Copyright Act indicate that the Copyright Office must act

¹² See NIMMER ON COPYRIGHT, *supra* note 4; see also Brief of amicus curiae The Copyright Alliance in Support of Petitioner, *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, 138 S. Ct. 2707 (2018) (No. 17-571), 2018 WL 4252021.

¹³ See *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 385 (5th Cir. 1984); see also *Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 617 (9th Cir. 2010).

¹⁴ *Fourth Estate*, 856 F.3d at 1339.

¹⁵ *Id.* at 1341.

¹⁶ See *Fourth Estate Pub. Ben. Corp. v. Wall-Street.com, LLC*, 138 S. Ct. 2707 (2018).

¹⁷ See *Erlenbaugh v. United States*, 409 U.S. 239 (1972) (stating that "the rule of *in pari materia*—like any canon of statutory construction—is a reflection of practical experience in the interpretation of statutes: a legislative body generally uses a particular word with a consistent meaning in a given context").

affirmatively before a registrant is entitled to the benefits provided by the Copyright Act. This view is also supported by the extensive legislative history of the Copyright Act.¹⁸ The registration approach balances Congress's goal of creating a robust federal registry and ensuring that all works meet the requirements of the Copyright Act. This author argues that the Supreme Court should determine that registration is only satisfied after the Copyright Office rules on the copyright application. If the Supreme Court rules otherwise, it is vital that Congress amend the Copyright Act to uphold the registration requirement. Through amendments to the Copyright Act, Congress has created specific statutory rights that not only properly incentivize registration, but also give power and authority to the Copyright Office. "[I]f merely delivering the material were all that is required, the Copyright Office would have no need for its almost 100-person examining corps, which could be replaced by a few mailroom clerks whose duties would be limited to stamping a receipt date."¹⁹ The registration requirement ensures that each copyright is examined by officials who specialize in copyright law and any deficiency is dealt with before the case reaches the court.

This Note will examine the registration issue currently before the Supreme Court. Part II will discuss the pertinent statutory sections that the Supreme Court will inevitably analyze to determine what constitutes registration for infringement purposes. Part III will examine the circuit split regarding the copyright registration issue and the circuit courts' reasoning for supporting either the registration approach or application approach. Part IV will analyze the Eleventh Circuit's decision in *Fourth Estate*. Part V will argue that the registration approach is the correct approach based on the plain language of the pertinent statutory sections discussed in Part II, congressional intent, legislative history, and public policy. Finally, Part VI will conclude the Note and predict that the Supreme Court will affirm the Eleventh Circuit's decision.

¹⁸ See discussion of the legislative history *infra* Part II.A.

¹⁹ PATRY ON COPYRIGHT, *supra* note 10.

II. RELEVANT STATUTORY SECTIONS FOR THE COPYRIGHT REGISTRATION ISSUE

The issue of registration is fairly complex because different courts have used several different, yet pertinent, sections of the copyright statutes to support either the registration approach or application approach. These statutory sections deal with copyright protection, the role of the Copyright Office, and the importance of registration. This Part will discuss the relevant statutory sections surrounding copyright registration.

A. 17 U.S.C. § 411(a): Copyright Registration Needed For Copyright Claims

The statutory section at the forefront of this legal issue is 17 U.S.C. § 411(a). This section states:

Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), *no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.* 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.²⁰

Although the first sentence of section 411(a) succinctly states that one cannot institute a civil action until preregistration or registration of the copyright claim has been made in accordance with the title, section 411(a) fails to define the term “registration.” This undefined term has created the split among the circuit courts discussed throughout this Note. If the Supreme Court adopts the registration approach, then a copyright is registered when the Copyright Office examines and rules on the copyright application. However, if the

²⁰ 17 U.S.C. § 411(a) (2018) (emphasis added).

application approach is adopted, then a suit for infringement can be brought as soon as an applicant deposits the required materials.

Congress has continuously revised section 411(a) in various congressional sessions.²¹ One of these sessions, which focused on the potential adoption of the Berne Convention,²² dealt with the elimination of formalities in obtaining and enforcing copyright protections.²³ A Senate Judiciary Committee reported that it was concerned that the requirements set forth in section 411(a) were incompatible with the goals of the Berne Convention.²⁴ However, the sitting Congress ignored its report and chose to leave the registration requirement of section 411(a) intact.²⁵

Instead of removing the registration requirement entirely, the amendment exempted foreign works from the registration requirement.²⁶ This ensured that foreign works would be protected and enforceable at fixation. Critically, Congress kept in place the registration requirement for domestic works.²⁷ This amendment shows that registration for domestic works was not a useless formality, but one that Congress intentionally chose to keep in place for domestic works.²⁸ This is highlighted in a joint explanatory statement from members of Congress which stated that the amendment “reaffirm[ed]

²¹ See S. REP. NO. 100-352, at 13 (1988); see Copyright Reform Act of 1993, H.R. 897, 103d Cong. (1993).

²² The Berne Convention is a set of international rules and regulations and is followed by most of the global community. See Berne Convention for the Protection of Literary and Artistic Works, art. 9(2), Sept. 9, 1886, as revised July 24, 1908 and as amended Sept. 28, 1979, 102 Stat. 2853, 1161 U.N.T.S. 3 (entered into force in the United States Mar. 1, 1989). One of the main goals of the Berne Convention was to eliminate formalities surrounding copyrights. See *id.*

²³ One of the primary reasons behind eliminating needless formalities in the Copyright Act was to prevent people from losing their statutory remedies because of a draconian formality that had no place in modern society. See NIMMER ON COPYRIGHT, *supra* note 4.

²⁴ See S. REP. NO. 100-352, at 14 (1988). One goal in particular was the abolition of formalities throughout copyright law. *Id.* The Committee believed that the registration requirement was one of these formalities that needed to be removed from the Act in order to comply with the Berne Convention. *Id.*

²⁵ One member of Congress reasoned that the amended bill was a compromise. See 134 CONG. REC. H.29661, 30103 (daily ed. Oct. 11, 1988) (statement of Rep. Moorhead). While many formalities would be eliminated, the registration requirement would be upheld. *Id.* Congressman William Moorhead explained that “[the bill] create[ed] a two-tier solution to the registration issue. Registration is continued as a prerequisite to suit by domestic authors. Only foreign origin works are excepted from the registration requirement.” *Id.*

²⁶ *Id.*

²⁷ *Id.*

²⁸ *Id.*

the importance of registration—to the public, the Library of Congress, the judiciary, and the copyright community—and its ongoing validity.”²⁹

B. 17 U.S.C. § 410(a) and (b): Affirmative Power of the Copyright Office to Register or Reject a Copyright Application

17 U.S.C. § 410(a), which helps flesh out the legal issue, deals with the affirmative power of the Copyright Office. This section states:

When, after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application, together with the number and effective date of the registration.³⁰

This statutory section details the affirmative steps that the Copyright Office must take before it registers a copyright. Section 410(a) dictates that the Copyright Office shall register the claim after it examines the claim and the applicant deposits the appropriate material.³¹ The Copyright Office must examine the material and determine whether the deposited material adheres to the strict requirements of the Copyright Act. After the claim is registered, the Copyright Office will issue a certificate of registration.³² An amicus brief for Authors and Educators explains it well: “If an application alone was needed for registration, then there would not be a need for defining ‘registration’ in Section 410(a) as an action after an examination has occurred.”³³

²⁹ *Id.* at 30105.

³⁰ 17 U.S.C. § 410(a) (2018).

³¹ *Id.*

³² *Id.*

³³ Brief for Authors and Educators as Amici Curiae in Support of Respondents, Fourth Estate Public Ben. Corp. v. Wall-Street.com, LLC, 138 S. Ct. 2707 (2018) (No. 17-571), 2018 WL 5263259, at 16.

Furthermore, this section allows the Copyright Office to act as a filter for the courts and effectuate judicial economy. By examining each copyright application on an individual basis, the Copyright Office is able to weed out frivolous lawsuits that would clog up the court system. The only cases that can be brought are the ones that have passed through the strict scrutiny of trained copyright officials.

Additionally, 17 U.S.C. § 410(b) gives the Copyright Office the power to refuse registration. This section states:

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 for any other reason, the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal.³⁴

The Copyright Office's power to refuse registration highlights an important flaw in the application approach. If, in accordance with the application approach, registration is satisfied solely by depositing certain materials, the power of refusal would be superfluous, rendering this section of the statute meaningless. Under the application approach, the Copyright Office's refusal could come months after the litigation started. This would often result in a court's not being able to hear the Copyright Office's expert determination on copyrightability, which would not only greatly weaken the overall purpose of the Copyright Office, but the Copyright Act as well.

C. 17 U.S.C. § 410(d): Effective Date of Copyright Registration

17 U.S.C. § 410(d) deals with the effective date of registration. This section states that “[t]he 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.”³⁵

While some courts interpret this as a statutory section that ignores the registration requirement set forth in sections 410(a) and

³⁴ 17 U.S.C. § 410(b).

³⁵ *Id.* § 410(d).

411(a),³⁶ statutes need to be read *in pari materia*. Therefore, “it is not logical to assume that the relation-back provision [in § 410(d)] subsumes the explicit requirements of § 411 and § 410(a).”³⁷ This statutory section is Congress’s acknowledgement and solution to potential bureaucratic delays by the Copyright Office.³⁸

D. 17 U.S.C. § 408(a): The Process of Obtaining Registration

Finally, 17 U.S.C. § 408(a) provides for the requisite information that the Copyright Office needs for consideration of a copyright application. This section states:

At 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, and during the subsistence of any copyright secured on or after that date, the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708. Such registration is not a condition of copyright protection.³⁹

Section 408(a) instructs that the owner of a copyright may obtain registration of the copyright claim by delivering to the Copyright Office the deposit, application, and fee. While some courts claim that this statutory section supports the application approach,⁴⁰ those courts ignore the specific language of section 408(a). The phrase

³⁶ See *Forasté v. Brown Univ.*, 248 F. Supp. 2d 71, 77 (D.R.I. 2003) (reasoning that “[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)” (emphasis in original)).

³⁷ *La Resolana*, 416 F.3d at 1204 n.9. Furthermore, this statutory scheme of retroactive dating can be found in other statutes. See 15 U.S.C. § 1051 (2018) (stating that once trademark registration is granted, the date of registration retroactively dates back to the date of the application or the intent to use application).

³⁸ See H.R. REP NO. 94-1476, at 157 (1976) (explaining that 410(d) “takes account of the inevitable time-lag between receipt of the application and other material and the issuance of the certificate”).

³⁹ 17 U.S.C. § 408(a).

⁴⁰ See *Iconbazaar, L.L.C. v. Am. Online, Inc.*, 308 F. Supp. 2d 630, 634 (M.D.N.C. 2004).

“may obtain” shows that delivery is simply another step in the process of obtaining registration. If registration was satisfied on delivery, the language of section 408(a) would read “shall obtain.”⁴¹

Moreover, the language in section 408(a) addresses the timing of protection under the Copyright Act, not the timing of enforcement. The statute protects any person who files an application, fee, and deposit. However, the enforcement of that protection can only be brought after the Copyright Office responds to the application.⁴²

III. APPLICATION OF THE LAW IN FEDERAL COURTS

The Tenth Circuit affirmed the registration approach for handling the registration issue, which requires that the Copyright Office rule on the copyright application before a civil action for copyright infringement can be instituted.⁴³ In contrast, the Ninth and Fifth Circuits developed the application approach for handling the registration issue, which requires mere delivery of the fee, the work, and the application to the Copyright Office.⁴⁴ In *Fourth Estate*, the Eleventh Circuit deepened this circuit split by agreeing with the Tenth Circuit’s registration approach.⁴⁵ This Part will discuss the Tenth Circuit’s registration approach and the Ninth and Fifth Circuits’ application approach.

A. The Registration Approach

The registration approach, which is followed by the Tenth Circuit and, recently, the Eleventh Circuit, relies heavily on the statutory text of the Copyright Act. The registration approach requires that the Copyright Office rules on a copyright application before an

⁴¹ *Corbis Corp. v. UGO Networks, Inc.*, 322 F. Supp. 2d 520, 522 (S.D.N.Y. 2004).

⁴² *TVI, Inc. v. INFOsoft Techs., Inc.*, No. 4:06CV00697JCH, 2006 WL 2850356, at *4 (E.D. Mo. Sept. 29, 2006).

⁴³ *See La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200 (10th Cir. 2005), *abrogated on other grounds by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010).

⁴⁴ *See Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 385 (5th Cir. 1984); *Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 617 (9th Cir. 2010).

⁴⁵ *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1339 (11th Cir. 2017), *cert. granted*, 138 S. Ct. 2707 (2018) (abrogating on the ground that registration is not a subject matter jurisdiction limitation on the court).

infringement suit can be filed. Support for this approach can be found in *La Resolana Architects, PA v. Clay Realtors Angel Fire*.⁴⁶

The parties in *La Resolana* were La Resolana Architects, PA (hereinafter “La Resolana”) and Angel Fire Home Design (hereinafter “Clay Realtors”).⁴⁷ A representative from La Resolana met with a representative from Clay Realtors to discuss developing townhouses in Angel Fire, New Mexico.⁴⁸ During this meeting, La Resolana alleged that it showed Clay Realtors architectural drawings and plans that La Resolana created for potential townhouses in Angel Fire; however, the parties were unable to come to a deal.⁴⁹ A few years later, La Resolana noticed that a townhouse owned by Clay Realtor looked very similar to La Resolana’s architectural drawings, so it initiated a copyright infringement action against Clay Realtors.⁵⁰ At the time of the filing of the lawsuit, La Resolana had submitted the required materials set forth by the Copyright Act to the Copyright Office.⁵¹ However, the Copyright Office had not yet ruled on the application.⁵² As a result, Clay Realtors moved to dismiss the case.⁵³

After Clay Realtors moved to dismiss but before the district court ruled on the motion, La Resolana submitted a letter, allegedly from the Copyright Office, that stated that the Copyright Office had registered La Resolana’s copyright.⁵⁴ However, the district court ruled that this letter was hearsay because the letter could not be authenticated.⁵⁵ Therefore, because there was no evidence that La Resolana registered its copyright, the district court reasoned that La Resolana failed to meet the statutory requirement of section 411(a).⁵⁶ As a result, the court dismissed La Resolana’s claim, and La Resolana subsequently appealed.⁵⁷

⁴⁶ *La Resolana*, 416 F.3d at 1200.

⁴⁷ *Id.* at 1197.

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *La Resolana*, 416 F.3d at 1197.

⁵² *Id.*

⁵³ *Id.* at 1198.

⁵⁴ *Id.* at 1197.

⁵⁵ *Id.* at 1208.

⁵⁶ *La Resolana*, 416 F.3d at 1198.

⁵⁷ Critically, Plaintiff did not appeal the District Court’s finding that the letter was unauthenticated hearsay. *See id.* at 1208. This is important in understanding the Tenth Circuit’s decision to affirm the lower court’s decision.

The Tenth Circuit not only focused on the plain text of the Copyright Act, but it also interpreted its legislative history and analyzed public policy.⁵⁸ The court noted that section 411(a) requires affirmative action by both the applicant and the Copyright Office: the applicant must deposit the required material and the Copyright Office must rule on the application.⁵⁹ The court stated that these actions showed that satisfying the registration requirement is not as simple as merely submitting an application; the Copyright Office must examine the copyright application and rule before registration is satisfied.⁶⁰ However, this is not the only statutory section that requires affirmative action by the Copyright Office.

The court focused on the additional affirmative actions required by section 410(a).⁶¹ The court explained that, under section 410(a), the Copyright Office must examine and register the copyright before issuing a certificate.⁶² Furthermore, the court stated that similar language can be found in section 410(b).⁶³ This section allows the Copyright Office to register the claim or refuse registration, which are both affirmative acts required before registration is satisfied.⁶⁴

The court also focused on the specific verb usage in section 408(a).⁶⁵ This statutory section states that an applicant *may obtain* registration after submitting all of the required material.⁶⁶ If application was satisfied on mere application, the section would be written “shall obtain” instead of “may obtain.”⁶⁷ This section shows that the application process is preliminary to the next step of registration. After the material is deposited, the Copyright Office must register or reject the copyright application.⁶⁸

Finally, the court highlighted 17 U.S.C. § 501(b)’s statement that a copyright owner is entitled to the remedies in the Copyright Act,

⁵⁸ *Id.* at 1198-1208.

⁵⁹ *Id.* at 1200.

⁶⁰ *Id.*

⁶¹ *La Resolana*, 416 F.3d at 1201.

⁶² *Id.*

⁶³ *Id.*

⁶⁴ *Id.*

⁶⁵ *Id.*

⁶⁶ See discussion of § 408(a) *supra* Part II.D.

⁶⁷ *La Resolana*, 416 F.3d at 1201 (quoting *Corbis Corp. v. UGO Networks, Inc.*, 322 F. Supp. 2d 520, 522 (S.D.N.Y. 2004)).

⁶⁸ 17 U.S.C. § 408(a) (2018).

subject to the requirements set forth in section 411(a).⁶⁹ The court reasoned that “[t]his statutory language clearly instructs that a copyright owner can sue for infringement only after the copyright is registered, or registration is refused.”⁷⁰

After the court analyzed the statutory sections, it examined the two approaches to registration.⁷¹ The court first reviewed the registration approach, and stated that it is in good company.⁷² In this section of the opinion, it collected cases that supported the registration approach through the years.⁷³ The court noted that these cases focused on the statutory language of the Copyright Act.⁷⁴ After sifting through those cases, the court analyzed the application approach.⁷⁵ In this section of the opinion, the court acknowledged the support for the application approach by the Fifth and Ninth Circuits as well as *Nimmer on Copyright*.⁷⁶ The court then explained the basis of the application approach.⁷⁷

The court stated that allowing a person to initiate a copyright claim as soon as an application is filed could help facilitate judicial protection of copyrights.⁷⁸ Furthermore, the application approach considers registration as a needless formality⁷⁹ because regardless of

⁶⁹ *La Resolana*, 416 F.3d at 1201. The relevant portion of 17 U.S.C. § 501(b) states that [t]he legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of section 411, to institute an action for any infringement of that particular right committed while he or she is the owner of it. The court may require such owner to serve written notice of the action with a copy of the complaint upon any person shown, by the records of the Copyright Office or otherwise, to have or claim an interest in the copyright, and shall require that such notice be served upon any person whose interest is likely to be affected by a decision in the case.

17 U.S.C. § 501(b).

⁷⁰ *La Resolana*, 416 F.3d at 1201.

⁷¹ *Id.* at 1203.

⁷² *Id.*

⁷³ *Id.* The cases collected were *Vacheron & Constantin—Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958), *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990), *Mays & Assocs. v. Euler*, 370 F. Supp. 2d 362 (D. Md. 2005), *Robinson v. Princeton Review, Inc.*, 1996 WL 663880 (S.D.N.Y. Nov. 15, 1996), and *Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc.*, 315 F. Supp. 2d 1053 (C.D. Cal. 2004).

⁷⁴ *La Resolana*, 416 F.3d at 1202.

⁷⁵ *Id.* at 1203.

⁷⁶ *Id.*

⁷⁷ *Id.* at 1203-04.

⁷⁸ *Id.* at 1203.

⁷⁹ *La Resolana*, 416 F.3d at 1203.

whether registration is accepted or rejected, one can still bring a suit.⁸⁰ While the court admitted that these arguments have some appeal, the court ultimately reasoned that the application approach ignored the plain meaning of the Copyright Act as well as the legislative history.⁸¹

The court provided three reasons for why the application approach's statutory analysis is wrong.⁸² First, the court stated that the application approach requires a "topsy-turvy" reading of the Copyright Act.⁸³ The Copyright Act does not confer different benefits on those who submit copyright applications and those whose copyrights are registered by the Copyright Office; these benefits are part of a single package.⁸⁴ Second, the court reasoned that Congress created significant incentives to encourage registration of copyrights with the Copyright Office.⁸⁵ Every remedy in the Copyright Act is conditioned on registration of the copyright.⁸⁶ Finally, the court stated that the application approach created shifting legal entitlements.⁸⁷ The court declared that "[i]f, for example, an applicant could obtain the advantage of the presumption that the copyright is valid upon application, see 17 U.S.C. § 408(c), but then, after examination the Register of Copyrights determined the material is not copyrightable, the presumption of validity would swing back and forth."⁸⁸ This would create uncertainty in the law, which is at odds with Congress's intent when it enacted the Copyright Act.⁸⁹

⁸⁰ *Id.* at 1203.

⁸¹ *Id.* at 1204. The court acknowledged the arguments set forth by Nimmer and other courts. *Id.* The court further stated that there could be times when a copyright was diluted because the Copyright Office had not yet acted. *Id.* However, the court stated that "[w]hatever the practical force of this argument, we cannot ignore the plain meaning of the statute, nor change the legislative scheme." *Id.*

⁸² *Id.*

⁸³ *Id.*

⁸⁴ *La Resolana*, 416 F.3d at 1204.

⁸⁵ *Id.*

⁸⁶ *Id.*; see also 17 U.S.C. § 501 (stating that the right to file an infringement suit is subject to the registration requirement of section 411); see also 17 U.S.C. § 502 (stating that a copyright holder can obtain an injunction); § 501 (dictating that a prevailing copyright owner can recover attorney's fees). All of these remedies are available to those who file their claim within the three-year statute of limitations period. See 17 U.S.C. § 507. While not discussed by the court, prompt registration is the best way to avoid any conflict with the three-year time limit set forth in § 507. *Id.*

⁸⁷ *La Resolana*, 416 F.3d at 1205.

⁸⁸ *Id.*

⁸⁹ *Id.*

However, the court did not stop there. The court dove into the world of congressional amendments and sessions by focusing on the Berne Convention Implementation Act of 1988,⁹⁰ which is a prime example of Congress's refusal to discard the vital requirement of affirmative action by the Copyright Office.⁹¹ The goal of the Berne Act was to eliminate unnecessary formalities when obtaining copyright protection and ally the United States with the Berne Convention.⁹²

While the Berne Convention Implementation Act was being considered, a Senate Judiciary Committee expressed concern that requiring registration of a copyright claim before a lawsuit could commence was possibly an antiquated measure.⁹³ The Senate Judiciary Committee submitted a proposal to eliminate the registration requirement.⁹⁴ However, this proposal was swiftly rejected because Congress intended to keep the registration requirement for domestic works and wanted the Copyright Office to rule on every copyright application.⁹⁵ Instead, Congress eliminated the registration requirement for foreign works only.⁹⁶ The court pointed out that this amendment is in line with the Berne Convention as the Convention "does not forbid its members [from] impos[ing] formalities on works first published in [their] own territor[ies]."⁹⁷

The court also noted that Congress took up the issue of eliminating the registration requirement in 1993.⁹⁸ However, Congress once again decided to keep the stringent requirement of registration and rejected the proposal.⁹⁹ The topic of registration came up once again during the 2005 amendment to the Copyright Act. Through the

⁹⁰ See S. REP. NO. 100-352 (1988).

⁹¹ *La Resolana*, 416 F.3d at 1205.

⁹² *Id.*; see also Berne Convention for the Protection of Literary and Artistic Works, art. 9(2), Sept. 9, 1886, as revised July 24, 2971 and as amended Sept. 28, 1979, 102 Stat. 2853, 1161 U.N.T.S. 3 (entered into force in the United States Mar. 1, 1989). The Berne Convention is a set of international rules regarding copyright protection and enforcement, which eliminated most of the formalities pertaining to copyright. See discussion of the Berne Convention *supra* Part II.A.

⁹³ *La Resolana*, 416 F.3d at 1205.

⁹⁴ *Id.*; see also S. REP. NO. 100-352, at 14.

⁹⁵ *La Resolana*, 416 F.3d at 1206.

⁹⁶ *Id.* at 1205.

⁹⁷ *Id.* at 1208 n.11 (first and second alteration in original) (quoting S. REP. NO. 100-352, at 18).

⁹⁸ *Id.* at 1206; see also Copyright Reform Act of 1993, H.R. 897, 103d Cong. (1993).

⁹⁹ *La Resolana*, 416 F.3d at 1206; see also Copyright Reform Act of 1993, H.R. 897, 103d Cong. (1993).

Family Entertainment and Copyright Act of 2005,¹⁰⁰ Congress amended the Copyright Act to add preregistration to 17 U.S.C § 411.¹⁰¹ Again, Congress kept in place the registration requirement of the Copyright Act. The legislative history has consistently shown Congress's desire to keep the registration requirement set forth in § 411(a). Therefore, the court affirmed the district court's granting of Clay Realtor's motion to dismiss in accordance with the registration approach because the Copyright Office had not yet ruled on La Resolana's application.¹⁰²

B. The Application Approach

The Fifth and Ninth Circuits utilize the application approach. This approach focuses less on the statutory text of the Copyright Act and more on public policy and judicial economy. The first case that supported the application approach was *Apple Barrel Prods., Inc. v. Beard*.¹⁰³

Apple Barrel Productions, Inc (hereinafter "Apple Barrel") and R.D. Beard (hereinafter "Beard") were both producers of country music programs.¹⁰⁴ Apple Barrel claimed that Beard's performance violated Apple Barrel's copyright because the performance was virtually identical to the show Apple Barrel produced.¹⁰⁵ The district court denied Apple Barrel's motion for a preliminary injunction.¹⁰⁶ For

¹⁰⁰ See Family Entertainment and Copyright Act of 2005, H.R. 357, 109th Cong. (2005).

¹⁰¹ *La Resolana*, 416 F.3d at 1206-07. It is important to note that in most cases preregistration is not useful. See *Preregister Your Work*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/prereg> (last visited Nov. 20, 2018). The only two scenarios where preregistration is useful are where a copyright holder believes his or her work will be infringed before it is published and where the copyright holder has started the work but has not finished it. *Id.* Even in cases where a copyright holder preregisters, the work must be registered after the work is published. *Id.* This shows that registration is still important to Congress. *Id.* See also Brief for the United States as amicus curiae, *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, 138 S. Ct. 2707 (2018) (No. 17-571), 2018 WL 2264108, at 17 [hereinafter "Brief for the United States"].

¹⁰² Interestingly enough, the court held that the March 10 letter would usually have been enough to prove registration and survive a motion to dismiss. However, La Resolana did not challenge the district court's finding that the letter was unauthenticated hearsay. See *La Resolana*, 416 F.3d at 1208. As a result, the court was forced to accept the fact that registration had not occurred.

¹⁰³ *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 385 (5th Cir. 1984).

¹⁰⁴ *Id.* at 386.

¹⁰⁵ *Id.*

¹⁰⁶ *Id.* The district court denied the preliminary injunction because the court believed that Apple Barrel did not establish a substantial likelihood of success on the merits. *Id.*

the purposes of this Note, the only relevant holding of this case is that Apple Barrel had standing to bring the claim even though the Copyright Office had not ruled on Apple Barrel's application.¹⁰⁷ The court stated that Apple Barrel only needed to deposit the appropriate material, submit an application, and pay the fee to file a copyright infringement suit with the court.¹⁰⁸

The court based its decision heavily on arguments set forth by Nimmer in his treatise on Copyright.¹⁰⁹ However, Nimmer's supposed endorsement of the application approach is misleading. In reality, Nimmer does not support the application approach but instead prefers a harmonized approach that takes elements from both legal theories.¹¹⁰ Nimmer argues that when cases arise that involve complex matters of copyrightability, courts should "stay proceedings to allow the Copyright Office to weigh in with its special expertise regarding copyrightability of plaintiff's work."¹¹¹

Furthermore, Nimmer bases most of his reasoning on public policy as opposed to statutory text.¹¹² This is highlighted by Patry's criticism of Nimmer: "No analysis of the language of the statute or its purpose was undertaken."¹¹³ While public policy may be important, Nimmer's treatise says next to nothing about the actual meaning of the text of section 411(a). It is up to the courts to adjudicate and interpret law, not legislate it. The court needs to apply the law as it is written; it is not within the court's authority to reinvent what it means to register a copyright. Patry laments that "[i]t is a sad day when courts ignore the statutory scheme and the views of the agency that drafted the provision in question in order to make their own policy."¹¹⁴

It took twenty-five years after Apple Barrel for another circuit to endorse the application approach. This endorsement can be found

¹⁰⁷ *Id.*

¹⁰⁸ *Apple Barrel*, 730 F.2d at 386-87.

¹⁰⁹ *Id.*; see also NIMMER ON COPYRIGHTS, *supra* note 4, § 7.16[B][1][a].

¹¹⁰ NIMMER ON COPYRIGHTS, *supra* note 4, § 7.16[B][3][b][vi].

¹¹¹ NIMMER ON COPYRIGHTS, *supra* note 4, § 7.16[B][3][b][vi]. Nimmer explains that cases involving complex matters of copyrightability can arise in a wide spectrum of cases. *Id.* For example, a complex matter of copyrightability could come up in cases involving geometric shapes or "elastomeric filaments radiating from a core." *Id.* In these cases, Nimmer argues that the issue of copyrightability is best handled by the Copyright Office, "particularly to a judge lacking previous exposure to higher copyright doctrine." *Id.*

¹¹² PATRY ON COPYRIGHT, *supra* note 10.

¹¹³ PATRY ON COPYRIGHT, *supra* note 10.

¹¹⁴ PATRY ON COPYRIGHT, *supra* note 10.

in *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*,¹¹⁵ where Cosmetic Ideas, Inc. (hereinafter “Cosmetic”) created a piece of costume jewelry in 1997 and began to sell it in 1999.¹¹⁶ Somewhere between 2005 and 2008, IAC/InteractiveCorp., Home Shopping Network, Inc., HSN LP, and HSN General Partner LLC (collectively, hereinafter “HSN”) began to sell an allegedly virtually identical piece of jewelry.¹¹⁷ Cosmetic filed an infringement suit after submitting its application to the Copyright Office but before receiving acceptance or rejection from the Copyright Office.¹¹⁸ The district court granted HSN’s motion to dismiss, noting that the court did not have subject matter jurisdiction to hear the case because the Copyright Office had not yet ruled on Cosmetic’s copyright application.¹¹⁹

The court first focused on the statutory language of the Copyright Act.¹²⁰ However, unlike most other courts, the Ninth Circuit noted that the statutory language was ambiguous.¹²¹ The court stated that “[w]e are not persuaded that the plain language of the Act unequivocally supports either the registration or application approach.”¹²² As a result, the court turned to public policy.¹²³

The court concluded that the application approach fulfilled Congress’s goal of providing copyright protection while maintaining a robust federal register.¹²⁴ The court observed that the application approach prevented a party from being in legal limbo because the party was able to sue for infringement regardless of whether the Copyright Office accepted or rejected the copyright application.¹²⁵ The application approach allows the applicant to sue after the submission of the application and deposit of the appropriate materials.¹²⁶

¹¹⁵ 606 F.3d 612, 617 (9th Cir. 2010).

¹¹⁶ *Id.* at 614.

¹¹⁷ *Id.*

¹¹⁸ *Id.*

¹¹⁹ Notably, the district court granted the motion to dismiss based on the fact that there was no subject matter jurisdiction. However, this was an incorrect conclusion as it went against the decision made in *Reed Elsevier*. However, the Ninth Circuit did not stop its analysis and continued on.

¹²⁰ *Cosmetic*, 606 F.3d at 618.

¹²¹ *Id.*

¹²² *Id.*

¹²³ *Id.*

¹²⁴ *Id.* at 619.

¹²⁵ *Cosmetic*, 606 F.3d at 619.

¹²⁶ *Id.* at 620.

Second, the court reasoned that the application approach encouraged registration because the copyright holder still needed to apply for registration of a copyright before initiating a claim for infringement.¹²⁷ Third, the court stated that the registration approach was simply a needless formality that the Copyright Act of 1976 was intended to eliminate.¹²⁸ Fourth, the court explained that the possibility of a delay caused by the Copyright Office could cause a party to lose its ability to sue because of the three-year statute of limitations.¹²⁹ Lastly, the court held that it made no sense to defer to the Copyright Office when the “decision of whether or not to grant a registration certificate is largely perfunctory, and is ultimately reviewable by the courts.”¹³⁰ As a result, the court reversed and remanded the case back to the district court for further proceedings.¹³¹

The decision in *Cosmetic Ideas* ignored key statutory provisions and legislative history. The court lamented that there were possible scenarios where the statute of limitations would prevent someone from bringing an infringement suit.¹³² However, as will be discussed in Part V of this Note, the Copyright Office is already prepared to deal with these scenarios.¹³³ For example, the Copyright Office provides an avenue of relief for those litigants who wait until the very last moment to file for copyright registration. For a small fee, the copyright application can be expedited and processed in five business days.¹³⁴ Furthermore, while the court called the registration requirement a needless requirement, it ignored the fact that Congress has consistently retained the registration requirement when amending the Copyright Act.

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.* at 620-21.

¹³⁰ *Cosmetic*, 606 F.3d at 621.

¹³¹ *Id.* at 622.

¹³² *Id.* at 620.

¹³³ See discussion of Copyright Office *infra* Part V.

¹³⁴ See *CSS, Inc. v. Herrington*, No. CV 2:16-CV-01762, 2016 WL 4425192, at *5 (S.D.W. Va. Aug. 18, 2016), *vacated*, 318 F.R.D. 582 (S.D.W. Va. Sept. 12, 2016) (vacating an order because the plaintiff was entitled to amend the complaint). This expedited process protects litigants who are dangerously close to missing the three-year statute of limitations period.

IV. THE ELEVENTH CIRCUIT'S DECISION IN *FOURTH ESTATE*

In *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, the Eleventh Circuit endorsed the registration approach and deepened the circuit split.¹³⁵ Fourth Estate Public Benefit Corporation (hereinafter “Fourth Estate”) is an organization that produces news articles and licenses them to other companies to use, and Wall-Street.com, LLC (hereinafter “Wall-Street”) is a news website.¹³⁶ Wall-Street entered into a licensing agreement with Fourth Estate that required Wall-Street to take down the licensed news articles from Fourth Estate if it cancelled its account with Fourth Estate because Fourth Estate retained the copyright in the articles.¹³⁷ After Wall-Street cancelled its account, it did not take down the news articles.¹³⁸

As a result, Fourth Estate initiated a copyright infringement claim against Wall-Street and its owner, Jerrold Burden.¹³⁹ Fourth Estate’s complaint alleged that it submitted the appropriate registration materials to the Copyright Office.¹⁴⁰ However, the Copyright Office had not yet ruled on Fourth Estate’s copyright application.¹⁴¹ Wall-Street moved to dismiss the complaint, arguing that Fourth Estate did not satisfy the registration requirement set forth in § 411(a).¹⁴²

A. The District Court

The District Court agreed with Wall-Street and dismissed Fourth Estate’s complaint without prejudice.¹⁴³ Judge Scola, Jr. reasoned that “because a plaintiff must first obtain registration for the work at issue prior to initiating suit, the Court must dismiss Fourth Estate’s claims for copyright infringement.”¹⁴⁴ Fourth Estate subsequently appealed the dismissal to the Eleventh Circuit, arguing

¹³⁵ PATRY ON COPYRIGHT, *supra* note 10.

¹³⁶ *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1339 (11th Cir. 2017), *cert. granted*, 138 S. Ct. 2707 (2018).

¹³⁷ *Id.* at 1339.

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ *Fourth Estate*, 856 F.3d at 1339.

¹⁴² *Id.*

¹⁴³ *Id.* (citing the district judge in *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com*, 2016 WL 9045625, at *1 (S.D. Fla. May 23, 2016)).

¹⁴⁴ *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com*, No. 16-60497-CIV, 2016 WL 9045625, at *1 (S.D. Fla. May 23, 2016).

that it satisfied the registration requirement set forth in section 411(a).¹⁴⁵

B. The Eleventh Circuit

In its appeal, Fourth Estate argued that, even though there was previous case law¹⁴⁶ in the Eleventh Circuit on the matter of registration, the case law was not binding because of the Supreme Court's decision in *Reed Elsevier, Inc. v. Muchnick*.¹⁴⁷ Fourth Estate contended that the decision in *Reed Elsevier* eroded the rationale used to justify past Eleventh Circuit decisions.¹⁴⁸ On the other hand, Wall-Street argued that the Eleventh Circuit should be bound by its previous decisions.¹⁴⁹

After discussing the circuit split,¹⁵⁰ the Eleventh Circuit bluntly stated that filing a simple copyright application did not satisfy registration.¹⁵¹ The Eleventh Circuit relied heavily on the statutory language of the Copyright Act.¹⁵² The court first examined the statutory language of section 410(a).¹⁵³ In particular, the court reasoned that the fact that registration occurs only “*after* examination of an application necessarily means that registration occurs ‘[l]ater in time than’ or ‘subsequent to’ the filing of the application for

¹⁴⁵ *Fourth Estate*, 856 F.3d at 1339.

¹⁴⁶ See *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486 n.4 (11th Cir. 1990) (stating that a lawsuit cannot be initiated until plaintiff has a registered copyright); see also *Kernel Records Oy v. Mosley*, 694 F.3d 1294, 1302 (11th Cir. 2012) (stating that the Eleventh Circuit adopted the registration approach in *M.G.B. Homes*).

¹⁴⁷ 559 U.S. 154, 169 (2010).

¹⁴⁸ The *Reed Elsevier* case established that registration of a copyright pursuant to section 411(a) is not a jurisdictional requirement. See *id.* Fourth Estate contended that since previous case law in the circuit held that the registration requirement was a jurisdictional limitation, these cases should be ignored. See *Fourth Estate*, 856 F.3d at 1341. However, the registration requirement is still a procedural precondition. See *Reed Elsevier*, 559 U.S. at 157 (stating that the registration requirement is a precondition to filing a claim).

¹⁴⁹ *Fourth Estate*, 856 F.3d at 1340.

¹⁵⁰ The court stated that the Eighth Circuit supported the application approach in its dicta, the Seventh Circuit had conflicting case law, and the First and Second Circuits acknowledged the split, but refused to adopt either approach. *Id.*; see also *Action Tapes, Inc. v. Mattson*, 462 F.3d 1010, 1013 (8th Cir. 2006); compare *Chi. Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003) (requiring that an application be submitted before a copyright infringement suit can occur), with *Gaiman v. McFarlane*, 360 F.3d 644, 655 (7th Cir. 2004) (en banc) (stating that the copyright application must be granted or refused before a suit can be brought).

¹⁵¹ *Fourth Estate*, 856 F.3d at 1341.

¹⁵² *Id.*

¹⁵³ *Id.*

registration.”¹⁵⁴ Furthermore, the court stated that section 410(b) gives the Copyright Office the power to reject copyright registration.¹⁵⁵ The court then posited that if simply depositing material satisfied registration, then the Copyright Office would have no power to refuse registration.¹⁵⁶

The Eleventh Circuit was correct here. A proper reading of a statute requires that no clause, sentence, or word shall be superfluous, void, or insignificant.¹⁵⁷ If the application approach was adopted, the power given to the Copyright Office by section 410(b) would be meaningless. The Copyright Office could not refuse registration if registration was accomplished on mere application.

The court then addressed Fourth Estate’s argument that section 408(a) supported the application approach.¹⁵⁸ The court swiftly rejected this argument by stating that section 408(a) dealt with the conditions required to potentially obtain registration.¹⁵⁹ The section has nothing to do with the timing of registration or the responsibilities of the Copyright Office.¹⁶⁰ Finally, the court stated that contrary to Fourth Estate’s argument, section 410(d) supported the registration approach.¹⁶¹ While section 410(d) states that the effective date of registration is when the appropriate material was deposited, it also makes clear that registration occurs after the Copyright Office accepted the application.¹⁶² Section 410(d) is yet another example of registration occurring only after examination by the Copyright Office.

After detailing the consistent statutory support for the registration approach, the court considered Fourth Estate’s other arguments.¹⁶³ The first argument dealt with the three-year statute of limitations stated in 17 U.S.C. § 507.¹⁶⁴ Fourth Estate argued that

¹⁵⁴ *Id.* (alteration and emphasis in original).

¹⁵⁵ *Id.*

¹⁵⁶ *Fourth Estate*, 856 F.3d at 1341.

¹⁵⁷ *See Duncan v. Walker*, 533 U.S. 167, 174 (2001).

¹⁵⁸ *Fourth Estate*, 856 F.3d at 1341.

¹⁵⁹ *Id.*; *see also* 17 U.S.C. § 408(a) (2018) (providing that a deposit of the work is one of the requirements to potentially obtain registration); *see also* 17 U.S.C. § 409 (detailing the information required for the copyright application); *see also* 17 U.S.C. § 708 (requiring that a fee be sent with the deposit and application in order to potentially obtain registration).

¹⁶⁰ *Fourth Estate*, 856 F.3d at 1341.

¹⁶¹ *Id.*

¹⁶² *Id.* at 1342.

¹⁶³ *Id.*

¹⁶⁴ The statute states that no civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued.

because the statute of limitations is only three years, it would be harmful to potential litigants to have to wait for the Copyright Office to accept or reject their application.¹⁶⁵ However, the Eleventh Circuit rejected this position by stating that the statute of limitations was just another method that Congress used to incentivize registration.¹⁶⁶ The short statutory period fits the statutory scheme that encourages registration of a copyright. Support for incentivizing registration can also be found elsewhere in the Copyright Act.¹⁶⁷

The court highlighted 17 U.S.C. § 410(c), which states, “[i]n any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.”¹⁶⁸ This is yet another example of Congress’s encouraging prompt registration of a copyright.

The court ended its analysis by declining to address Fourth Estate’s arguments of legislative history and public policy.¹⁶⁹ The court succinctly reasoned that if the legislative command was straightforward, there was no need to go into the legislative history to cloud a statutory text.¹⁷⁰ In certain cases, the statutory text can be enough. The decision by the Eleventh Circuit was a strong defense of the registration approach. The Eleventh Circuit held that the statutory text of the Copyright Act clearly stated that registration is only satisfied after the Copyright Office ruled on the copyright application.¹⁷¹ As a result, the Eleventh Circuit affirmed the dismissal of Fourth Estate’s complaint.¹⁷²

¹⁶⁵ *Fourth Estate*, 856 F.3d at 1342.

¹⁶⁶ *Id.* See also discussion of statute of limitations *infra* Part V.

¹⁶⁷ See *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1204 (10th Cir. 2005), *abrogated on other grounds by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) (stating that every remedy outlined in the Copyright Act is conditioned upon a copyright owner’s obtaining registration); see also 17 U.S.C. § 502 (stating that a registrant can obtain an injunction); 17 U.S.C. § 505 (stating that a prevailing copyright owner can recover attorney’s fees).

¹⁶⁸ See 17 U.S.C. § 410(c).

¹⁶⁹ *Fourth Estate*, 856 F.3d at 1342.

¹⁷⁰ *Id.* If the court delved into the legislative history of the Copyright Act, it would have come down even more strongly on the side of the registration approach. Some of the most persuasive arguments favoring the registration approach come from the legislative history. See discussion of legislative history *supra* Part II and *infra* Part V.

¹⁷¹ *Fourth Estate*, 856 F.3d at 1342.

¹⁷² *Id.*

The court used the appropriate statutory sections to support the registration approach. One of the strongest parts of the court's analysis involved the statute of limitations. The court correctly identified section 507(b) as yet another incentive created by Congress to encourage early registration.¹⁷³ However, to strengthen its position, the court should have discussed that for a small fee, the Copyright Office will expedite an application.¹⁷⁴ This shows that if there is a need for urgency, the Copyright Office is able to decide the matter in five business days.¹⁷⁵ Moreover, if this solution is not enough, proponents of the application approach should lobby Congress to provide an exception for those who wait until the end of the statutory provision. It is up to Congress, not the courts, to legislate.

Furthermore, the Eleventh Circuit should have analyzed the legislative history and public policy that supported the registration approach. Even though it is evident from the statutory language of the Copyright Act that registration is only satisfied by action by the Copyright Office, it is still important that the courts interpret the legislative history and analyze public policy. It would have made an already strong case for the registration approach even more persuasive. If the Supreme Court finds the statutory language ambiguous, the next step of statutory analysis will involve legislative history. There is ample support for the registration approach in the legislative history and public policy.¹⁷⁶

V. WHY THE ELEVENTH CIRCUIT GOT IT RIGHT

A. *In Pari Materia*

The Eleventh Circuit's focus on the statutory text of the Copyright Act should be the baseline from which the Supreme Court begins. When interpreting a statutory text, it is vital to first examine the statutory language.¹⁷⁷ Here, the Eleventh Circuit analyzed each

¹⁷³ *Id.* (stating that the three-year statute of limitations in § 507(b) encourages prompt registration).

¹⁷⁴ See 37 C.F.R. § 201.3(d)(7) (2018) (stating that the special handling fee is \$800).

¹⁷⁵ See *CSS, Inc. v. Herrington*, No. CV 2:16-CV-01762, 2016 WL 4425192, at *5 (S.D.W. Va. Aug. 18, 2016), *vacated*, 318 F.R.D. 582 (S.D.W. Va. 2016) (vacating order because the plaintiff was entitled to amend the complaint).

¹⁷⁶ See discussion of legislative history *supra* Part II and *infra* Part V.

¹⁷⁷ See *Barnhart v. Sigmon Coal Co.*, 534 U.S. 438, 450 (2002) (stating that the first step in statutory construction is examination of the language of the statute); see also *Kingdomware*

statutory section that is pertinent to the registration debate. The court, much like the Tenth Circuit in *La Resolana*, reasoned that when the statutory sections are read *in pari materia*, a coherent line of logic is formed that dictates that registration is only satisfied when the Copyright Office acts affirmatively.¹⁷⁸

Sections 410(a) and 410(b) give the Copyright Office the explicit power of registration.¹⁷⁹ An applicant must first deposit his work, application, and fee with the Copyright Office.¹⁸⁰ After this, the Copyright Office will examine the deposited material and issue either an acceptance or rejection.¹⁸¹ This is the role that Congress, via the Copyright Act, explicitly delegated to the Copyright Office.¹⁸² The registration approach allows the Copyright Office to exercise its full power granted by Congress.

B. Legislative History

However, even if the Supreme Court finds the statutory language to be unclear, the registration approach is thoroughly supported by legislative history. The Copyright Act of 1909¹⁸³ included a registration requirement similar to that of the Copyright Act of 1976. The Copyright Act of 1909 required that “[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with.”¹⁸⁴ Courts consistently held that under the Copyright Act of 1909, an infringement suit can only be brought after a certificate of registration was obtained.¹⁸⁵ This requirement was kept in the Copyright Act of 1976 over sixty years later.

Techs., Inc. v. United States, 136 S. Ct. 1969, 1976 (2016) (stating that statutory construction starts with the language of the statute).

¹⁷⁸ See *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1201 (10th Cir. 2005), *abrogated on other grounds by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010);

¹⁷⁹ 17 U.S.C. § 410(a) (2018); *Id.* § 410(b).

¹⁸⁰ § 410(a).

¹⁸¹ § 410(b).

¹⁸² § 410(a).

¹⁸³ Act of Mar. 4, 1909, Pub. L. No. 60-349, ch. 320, § 12, 35 Stat. 1075, 1078 (1909).

¹⁸⁴ *Id.* See also Brief for the United States, *supra* note 101, at 17.

¹⁸⁵ See Brief for the United States, *supra* note 101, at 18 (detailing that the Second Circuit explained that “the 1909 Act required compliance with statutory provisions governing “registration of [the] work” as well as with those governing “deposit of copies,” and that

One of the goals of the Copyright Act of 1976 was to eliminate formalities surrounding copyrights.¹⁸⁶ However, Congress retained the requirement that works needed to be registered by the Copyright Office before a suit for copyright infringement can be instituted.¹⁸⁷ The House Report for the Copyright Act of 1976 stated “[t]he first sentence of section 411(a) restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted.”¹⁸⁸

The report highlighted the importance that Congress placed on the registration requirement. Congress affirmed that the requirement was not a formality that it sought to eliminate but was something that it intended all applicants to do. It was a necessary procedural step to have the Copyright Office rule on a copyright application before a lawsuit could be commenced. This dedication to the registration requirement can also be found when Congress considered the Berne Convention Implementation Act of 1988.¹⁸⁹ As previously discussed, the Berne Convention was a set of international rules regarding copyright law.¹⁹⁰ While Congress exempted foreign works from the registration requirement, it kept the stringent requirement that the Copyright Office register all domestic works before a lawsuit can be commenced.¹⁹¹ This amendment not only brought the United States into conformity with the requirements of the Berne Convention, but kept the registration requirement of section 411(a).¹⁹² The application approach seeks to ignore this legislative history under the guise of public policy.

This dedication to the registration requirement can again be seen in 1993 when Congress took up the question of whether to remove the registration requirement.¹⁹³ Congress decided to keep the registration requirement in place and rejected the proposal that would have removed registration from section 411(a).¹⁹⁴ This is yet another

the court could “think of no other added condition for “registration” but acceptance by the Register.”).

¹⁸⁶ NIMMER ON COPYRIGHT, *supra* note 4.

¹⁸⁷ See 17 U.S.C. § 411(a). See also Brief for the United States, *supra* note 101, at 18.

¹⁸⁸ H.R. REP. NO. 94-1476, at 157 (1976).

¹⁸⁹ See S. REP. NO. 100-352 (1988).

¹⁹⁰ See discussion of the Berne Convention *supra* Part II.A.

¹⁹¹ 134 CONG. REC. H.29661, 30103 (daily ed. Oct. 11, 1988).

¹⁹² *Id.*

¹⁹³ See Copyright Reform Act of 1993, H.R. 897, 103d Cong. (1993).

¹⁹⁴ *Id.*

example of Congress purposefully upholding the registration requirement.

However, this was not the last time that Congress considered the topic of registration. In 2005, Congress amended section 411(a) to include pre-registration in the statute.¹⁹⁵ The Copyright Office stated that the purpose of pre-registration is “to allow an infringement action to be brought before the authorized commercial distribution of a work and full registration thereof, and to make it possible, upon full registration, for the copyright owner to receive statutory damages and attorneys’ fees in an infringement action.”¹⁹⁶ Not only did this amendment keep the registration requirement in place, but it also added a subcategory for works that require immediate protection. The 2005 amendment is just another example of Congress’s steadfast commitment to the registration requirement of section 411(a).

Furthermore, the application approach would virtually eliminate the usefulness of pre-registration. According to the Copyright Office, “[it accepts] preregistration of unpublished works that are being prepared for commercial distribution for types of works that the Register of Copyrights determined have had a history of pre-release infringement.”¹⁹⁷ If registration was satisfied as soon as the appropriate deposit, fee, and application were submitted, there would never be a need for pre-registration since a potential suit would never be delayed.¹⁹⁸ The application approach once again is inconsistent with a specific statutory section.

C. Public Policy

The requirement that the Copyright Office must affirmatively rule on a copyright application before a lawsuit can commence prevents frivolous cases from clogging up the judicial process. The Copyright Office acts as a filter and certifies that only legitimate claims reach the courts.¹⁹⁹ Moreover, the Copyright Office is a bastion of institutional knowledge when it comes to the Copyright Act. Nimmer describes the Copyright Office as “the governmental agency that

¹⁹⁵ See Family Entertainment and Copyright Act of 2005, H.R. 357, 109th Cong. (2005); see 17 U.S.C. § 411(a) (2018).

¹⁹⁶ See *Preregister Your Work*, *supra* note 101.

¹⁹⁷ *Preregister Your Work*, *supra* note 101.

¹⁹⁸ Brief for the United States, *supra* note 101, at 17.

¹⁹⁹ Kasunic, *supra* note 10.

possesses special expertise in determining the bounds of copyright protection,” which “could be of great value to the court (particularly to a judge lacking previous exposure to higher copyright doctrine).”²⁰⁰

Furthermore, the Copyright Office not only deals with the legal and formal requirements of the Copyright Act, but also determines the “copyrightability, the appropriateness of the claim or facts stated in conjunction with the examination of the deposit, the sufficiency of the deposit, and many other statutory or regulatory nuances of registration.”²⁰¹ Then Solicitor General Elena Kagan said it best: “Congress evidently intended the Register’s expertise to serve as a resource to courts adjudicating copyright claims and contemplated an active role for the Register in certain infringement suits. The Register cannot perform those functions when copyright owners do not present their works for registration.”²⁰² The application approach deprives courts of the legal findings of a highly specialized governmental office that deals solely with copyrights. This denial of the Copyright Office’s authority would impact the integrity of the robust registry that Congress intended to create.

The Copyright Office is responsible for scrutinizing each and every part of a work to ensure that it is copyrightable.²⁰³ As a result, the court gives much more deference to copyright claims that are registered by the Copyright Office.²⁰⁴ This is a direct result of the prima facie validity that results when a copyright is registered within five years of publication.²⁰⁵ Moreover, while Congress wanted to create a robust registry, it also intended the works to be genuinely copyrightable.²⁰⁶ This process allows for not only a robust registry, but also a registry that is filled with genuinely copyrightable works.²⁰⁷ Furthermore, the Copyright Office assigns different rights to applicants depending on whether registration is granted or refused. An applicant whose copyright is registered has different statutory rights

²⁰⁰ NIMMER ON COPYRIGHT, *supra* note 4, § 7.16[B][3][b][vi].

²⁰¹ Kasunic, *supra* note 10, at 319.

²⁰² Brief for the United States as amicus curiae Supporting Vacatur and Remand, *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2009) (No. 08-103), 2009 WL 1601031, at *24.

²⁰³ Kasunic, *supra* note 10, at 315.

²⁰⁴ Kasunic, *supra* note 10, at 322.

²⁰⁵ Kasunic, *supra* note 10, at 322.

²⁰⁶ Kasunic, *supra* note 10, at 321.

²⁰⁷ Brief of Washington Legal Foundation as amicus curiae in Support of Respondents, *Fourth Estate Pub. Ben. Corp. v. Wall-Street.com, LLC*, 138 S. Ct. 2707 (2018) (No. 17-571), 2018 WL 5096054, at 8.

from one whose copyright application is denied. Moreover, if the application approach were to be followed, courts would be robbing the Copyright Office of clear statutory rights in cases that result in refusal. Associate Register of Copyrights Robert Kasunic stated:

In particular, the statute allows the plaintiff who files an infringement suit based on a refused application to file, only upon notice, on the Register (and under the Rules of Civil Procedure, the Department of Justice) of the initiation of the action for infringement and a copy of the complaint, and provides the Register with a statutory right to intervene in the action for infringement.²⁰⁸

If the application approach were to be followed, there would be no need to provide notice to the Copyright Office that a lawsuit is being commenced. This is because the lawsuit would be initiated before the Copyright Office rules on the copyright application. This is yet another statutory right that the application approach ignores.

Critically, allowing the highly specialized Copyright Office to affirmatively act on an application before registration is satisfied provides little to no delay in the litigation process. While some courts claim that this drags out the litigation process and conflicts with the three-year statute of limitations,²⁰⁹ those courts ignore a crucial function of the Copyright Office. As discussed, for a small fee, the Copyright Office can expedite the examination of a claim for applicants involved in pending or prospective litigation.²¹⁰ This examination is completed within five business days.²¹¹ As a result, not only is there little-to-no judicial delay, but the Copyright Office is able to rule on the application in a timely manner. This, coupled with the relation-back provision of section 410(d), protects the applicant while the Copyright Office is making its ruling. If public policy dictates that this is unacceptable, it is up to the constituents to appeal to Congress to provide an exemption in certain scenarios.

If this is truly a problem that plagues potential litigants, it is the role of Congress to change the law, not the courts. In a brief for the

²⁰⁸ Kasunic, *supra* note 10, at 319.

²⁰⁹ *Iconbazaar, L.L.C. v. Am. Online, Inc.*, 308 F. Supp. 2d 630, 634 (M.D.N.C. 2004).

²¹⁰ *See CSS, Inc. v. Herrington*, No. CV 2:16-CV-01762, 2016 WL 4425192, at *5 (S.D.W. Va. Aug. 18, 2016), *vacated*, 318 F.R.D. 582 (S.D.W. Va. 2016) (vacating order because the plaintiff was entitled to amend the complaint); *see also* 37 C.F.R. 201.3(d)(7).

²¹¹ *Id.* at 5.

United States as amicus curiae, the United States stated that “the text of Section 411(a), and of the Copyright Act as a whole, is the best indication of the balance between competing objectives that Congress sought to draw. Any adjustment of that balance is properly entrusted to Congress rather than to this Court.”²¹² Whether it was in 1976, 1988, 1993, or 2005, Congress has taken an active role in addressing registration and has repeatedly and intentionally premised the commencement of copyright infringement suits on copyright registration by the Copyright Office.

VI. CONCLUSION

The statutory text, legislative history, and public policy make it clear that the registration approach is the correct interpretation of the Copyright Act. This approach recognizes the consistent commitment by Congress to retain the registration requirement for domestic works. All of these sections should be in the forefront of the Supreme Court’s analysis of the appropriate approach to registration. The Supreme Court should recognize the consistent statutory language and clear legislative history and declare that registration is only satisfied after the Copyright Office rules on the application. In addition to being consistent with the overall statutory scheme of the Copyright Act, the registration approach better promotes the purposes of copyright law. Therefore, the Supreme Court should affirm the Eleventh Circuit’s decision and adopt the registration approach as the law of the land.

²¹² See Brief for the United States, *supra* note 101, at 22.