

# APPLICATION OR REGISTRATION?: CONFUSION REGARDING THE COPYRIGHT ACT'S PREREQUISITE TO COPYRIGHT INFRINGEMENT LAWSUITS

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## INTRODUCTION

Section 411(a) of the Copyright Act of 1976<sup>1</sup> (“the Act”) mandates 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 this title.”<sup>2</sup> Courts interpreting the 411(a) requirement are split between two opposing approaches to interpreting this provision.<sup>3</sup> Proponents of the “registration approach” read this section literally, requiring a potential plaintiff to wait until the United States Copyright Office (“Copyright Office”) actually registers (or denies registration of) the copyright.<sup>4</sup> Proponents of the “application approach,” on the other hand, believe that for reasons of policy and practicality, submission of an application for registration is enough to allow the plaintiff to bring a claim.<sup>5</sup>

Not only are federal courts split over the meaning of the registration requirement, but cases dealing with the application versus registration issue evince a notable lack of clarity among federal judges regarding the issue and the legal precedent to follow.<sup>6</sup> As one commentator remarked, “Confused as to what events must normally occur in order for copyright registration to be achieved under federal law? So are the federal courts.”<sup>7</sup> This Note focuses specifically on cases in the Seventh and Eighth Circuits in which district courts and commentators have struggled to understand the meaning of unclear circuit court opinions.<sup>8</sup>

In *Reed Elsevier, Inc. v. Muchnick*,<sup>9</sup> the Supreme Court recently addressed the question of whether section 411(a) is a jurisdictional prerequisite or whether federal courts have discretion to hear cases when 411(a) has not been satisfied, such as the class action settlement approval which the parties in that case

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1. 17 U.S.C. §§ 101-810 (2006 & Supp. 2009).

2. *Id.* § 411(a) (Supp. 2009).

3. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1201-02 (10th Cir. 2005), *abrogated by Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

4. *Id.* at 1202.

5. *Id.* at 1203.

6. *See* discussion *infra* Part III.

7. Mose Bracey, Note, *Searching for Substance in the Midst of Formality: Copyright Registration as a Condition Precedent to the Exercise of Subject-Matter Jurisdiction by Federal Courts over Copyright Infringement Claims*, 14 J. INTELL. PROP. L. 111, 114 (2006).

8. *See* discussion *infra* Part III.

9. 130 S. Ct. 1237 (2010).

sought.<sup>10</sup> The Second Circuit had previously held that 411(a) is a jurisdictional requirement and that each plaintiff's claim would have to satisfy this requirement for a federal court to have jurisdiction to approve the settlement, noting "widespread agreement among the circuits that section 411(a) is jurisdictional."<sup>11</sup> The Supreme Court reversed, holding that 411(a) is a "precondition to filing a claim that does not restrict a federal court's subject-matter jurisdiction."<sup>12</sup> Thus, the Court decided that district courts may adjudicate disputes concerning unregistered works, and district court approval of this class action settlement was proper although the class included authors who had not registered.<sup>13</sup> Yet the Court declined to address the application versus registration issue—the question of whether filing an application satisfies this "precondition" to filing an infringement suit, or whether section 411(a) requires a decision by the Copyright Office.<sup>14</sup>

This Note examines judicial interpretation of the Copyright Act's registration requirement. Part I provides background information about copyright law and the mechanics and purpose of registration. It also discusses the recently added option of preregistration for certain types of works. Part II discusses the disagreement between federal courts' interpretations of the registration requirement as well as the various rationales underlying the two approaches. It also critiques each of the names for the "registration" approach,<sup>15</sup> alternatively referred to as the "issuance" or "approval" approach.<sup>16</sup> Part III analyzes the causes for confusion in the Seventh and Eighth Circuits. Finally, Part IV suggests that courts should follow the registration approach as followed by the Tenth Circuit as long as section 411(a) of the Copyright Act remains in its current form. It goes on to recommend, however, that Congress alter the registration requirement in section 411(a) so that this precondition is satisfied as

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10. *Id.* at 1243.

11. *In re Literary Works in Elec. Databases Copyright Litig.*, 509 F.3d 116, 121-22 (2d Cir. 2007), *rev'd sub nom.*, *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

12. *Reed Elsevier*, 130 S. Ct. at 1241.

13. *Id.* at 1242, 1249.

14. Cases discussed in this Note refer to the 411(a) requirement as jurisdictional because they precede the Supreme Court's *Reed Elsevier* decision. This Note does not attempt to redact all such "jurisdictional" references, but the reader should keep in mind that in light of *Reed Elsevier*, the 411(a) requirement is no longer characterized as restricting the district courts' subject-matter jurisdiction.

15. It is important to keep in mind the distinction between the term "registration" as required under section 411(a) of the Act and "registration" that means the Copyright Office has reviewed and actually registers the application. As discussed throughout this Note, the registration approach sees these meanings as the same, while the application approach interprets the statutory use of "registration" loosely so that application suffices without actual registration by the Copyright Office. See discussion *infra* Part II.

16. See, e.g., Bracey, *supra* note 7, at 127 ("issuance approach"); Erin Hogan, *Approval Versus Application: How to Interpret the Registration Requirement Under the Copyright Act of 1976*, 83 DENV. U. L. REV. 843, 854-55 (2006) ("approval approach").

soon as a copyright holder has submitted his application materials for registration.

## I. BACKGROUND OF RELEVANT COPYRIGHT LAW

Before the passage of the Copyright Act, unregistered copyrights were not federally recognized and were protected only to the extent provided by state property law.<sup>17</sup> Following passage of the Act in 1976 and later the Berne Convention Implementation Act of 1988,<sup>18</sup> federal law now recognizes copyright ownership without the requirement of registration, thus preempting state law.<sup>19</sup> The Act removed previous formalities to copyright existence and established the creator's automatic copyright ownership in his work.<sup>20</sup> The Act states that "registration is not a condition of copyright protection."<sup>21</sup> In other words, because federal law recognizes copyright ownership even before the creator takes any action to register, an unregistered copyright can be infringed but not sued upon. According to the Supreme Court, to show copyright infringement, a plaintiff must establish only that he owns a valid copyright and that the defendant has copied original elements in the work.<sup>22</sup>

### A. *The Purpose of Registration*

Although the law recognizes unregistered copyright ownership, an owner may realize certain benefits only by registering the copyright. The Act mandates that copyright owners register as a condition precedent to filing suit in federal court to protect their copyrights—"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."<sup>23</sup> Thus, a copyright can be valid, owned, and infringed,<sup>24</sup> yet its owner is not able to sue to enforce his copyright if he has not registered.<sup>25</sup> The Eighth Circuit summed up the primary purpose of registration by explaining that although "registration is required under section 411 of the Copyright Act in order to bring a suit for infringement, infringement itself is not conditioned upon registration of the copyright. Thus, a copyright holder can register a copyright and file suit after infringement occurs."<sup>26</sup> In addition to serving as a prerequisite to

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17. Rita Marie Cain, *Timing Is Everything: Copyright Registration and Preregistration*, 88 J. PAT. & TRADEMARK OFF. SOC'Y 381, 381 (2006).

18. Pub. L. No. 100-568, 102 Stat. 2853 (1988) (codified as amended in scattered sections of 17 U.S.C. § 101).

19. Cain, *supra* note 17, at 381-82.

20. 17 U.S.C. § 102(a) (2006).

21. *Id.* § 408(a).

22. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

23. 17 U.S.C. § 411(a) (2006 & Supp. 2009).

24. *See id.* § 408(a) ("registration is not a condition of copyright protection.").

25. *See id.* § 411(a).

26. *Olan Mills, Inc. v. Linn Photo Co.*, 23 F.3d 1345, 1349 (8th Cir. 1994) (internal citation

infringement suits, registration is also required in order to recover statutory damages and attorneys' fees under section 412.<sup>27</sup> According to the Eighth Circuit, “[t]he timing of registration only determines whether the copyright holder can recover statutory as opposed to actual damages.”<sup>28</sup>

To determine when a copyright owner is eligible for the benefits of registration, section 411(a) begs the question of when registration is made “in accordance with this title.”<sup>29</sup> This question has created confusion among federal courts, which are split as to when registration has taken place.<sup>30</sup> The Act’s circular definition of “registration” gives little guidance; “[r]egistration’, for purposes of . . . [section 411, among others], means a registration of a claim in the original or the renewed and extended term of copyright.”<sup>31</sup> Oddly enough, registration does not have to be granted by the Copyright Office for the owner to enjoy the benefits of registration—section 411(a) also allows a copyright owner to institute suit where “the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form *and registration has been refused*” as long as the Register of Copyrights is given notice of the action and a copy of the complaint.<sup>32</sup>

### B. Registration Under the Copyright Act

The Act specifies the requirements for applying for registration: the copyright owner must deliver an application, a fee, and a deposit to the Copyright Office.<sup>33</sup> The deposit essentially consists of one or more copies of the work to be registered.<sup>34</sup> After a processing time that ranges up to around twenty months, the Copyright Office reviews the application materials and sends the applicant either a certificate of registration or a rejection notice.<sup>35</sup> According to the Act, “[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

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omitted).

27. 17 U.S.C. § 412.

28. *Olan Mills*, 23 F.3d at 1349.

29. See 17 U.S.C. § 411(a) (Supp. 2009) (“no civil action for infringement . . . shall be instituted until preregistration or registration . . . has been made *in accordance with this title*.”) (emphasis added).

30. See discussion *infra* Part II.

31. 17 U.S.C. § 101 (2006).

32. *Id.* § 411(a) (emphasis added).

33. *Id.* § 408(a).

34. *Id.* § 408(b).

35. *I've Submitted My Application, Fee, and Copy of My Work to the Copyright Office. Now What?*, U.S. COPYRIGHT OFFICE, <http://www.copyright.gov/help/faq/faq-what.html#certificate> (last modified Apr. 4, 2011) (“Most online filers should receive a certificate within 3.3 months. Many will receive their certificates earlier,” and “[m]ost of those who file on these [paper] forms should receive a certificate within 11.5 months of submission. Many will receive their certificates earlier.”).

Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.”<sup>36</sup> However, this provision is poorly drafted, and it is unclear whether the copyright registration date is effective at the moment the Copyright Office receives these items, or only retroactively effective after a registration decision has been made.<sup>37</sup>

### C. Preregistration

The text of section 411(a) actually specifies “preregistration or registration” as the prerequisite to copyright infringement suits.<sup>38</sup> The language “preregistration or” was added to the statute in 2005 as part of the Family Entertainment and Copyright Act of 2005 (FECA).<sup>39</sup> FECA essentially preempts the registration versus application approach issue for certain works, allowing suit for infringement of such works once an application for preregistration has been filed.<sup>40</sup> Preregistration is available for motion pictures, sound recordings, musical compositions, literary works being prepared for publication as books, computer programs, and advertising or marketing photographs.<sup>41</sup> The Register of Copyrights has determined that these works are best for preregistration because of their “history of infringement prior to authorized commercial distribution.”<sup>42</sup> To be available for preregistration, the work must be characterized as “being prepared for commercial distribution,” which requires “a reasonable expectation that the work will be commercially distributed to the public” and that “[p]reparation of the work has commenced and at least some portion of the work has been fixed in a tangible medium of expression.”<sup>43</sup>

One commentator has suggested that the practical effect of preregistration is minimal: “In fact . . . most of the copyright cases that dealt with premature filings under the registration or application approaches would NOT be covered under the new preregistration system. Most did not involve works that were covered by the new preregistration regulations . . . .”<sup>44</sup> In fact, the commentator found only one case deciding the registration versus application approach issue in which the subject of the lawsuit would qualify for preregistration.<sup>45</sup>

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36. 17 U.S.C. § 410(d).

37. *See* *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1204 n.9 (10th Cir. 2005), *abrogated by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010) (“As to the relation-back effect of registration, the effective date serves other purposes under the Act, such as the term of registration. It is not logical to assume that the relation-back provision subsumes the explicit requirements of § 411 and § 410(a).”).

38. 17 U.S.C. § 411(a).

39. Pub. L. No. 109-9, 119 Stat. 218 (2005) (codified in scattered sections of 17-18 U.S.C.).

40. 17 U.S.C. § 408(f)(4).

41. 37 C.F.R. § 202.16(b)(1) (2009).

42. 17 U.S.C. § 408(f)(2).

43. 37 C.F.R. § 202.16(b)(2)(i)-(ii).

44. Cain, *supra* note 17, at 389.

45. *Id.* at 390 (citing *Robinson v. Princeton Rev., Inc.*, 96 Civ. 4859 (LAK), 1996 U.S. Dist.

## II. THE CIRCUIT SPLIT REGARDING ALTERNATE APPROACHES TO INTERPRETING SECTION 411(A)

Courts interpreting the Copyright Act's section 411(a) registration requirement are split between two opposing approaches: the "registration approach" and the "application approach."<sup>46</sup> As indicated previously, "[t]he dispute boils down to the issue of when a work is considered 'registered' for purposes of copyright law."<sup>47</sup> The registration approach employs a plain language view of Title 17, whereas the application approach implements an interpretation based more on policy and practicality.<sup>48</sup>

### A. *The Registration Approach*

Followed by the Tenth and Eleventh Circuits,<sup>49</sup> the registration approach interprets the registration requirement to mean that the work must actually be registered by the Copyright Office and that submission of an application alone is insufficient to satisfy 411(a) and allow filing of an infringement suit.<sup>50</sup> Because the Act distinguishes between application and registration and no language in the Act states that mere application suffices for registration, courts following the registration approach hold that registration is incomplete until the Register of Copyrights determines that copyright protection is warranted.<sup>51</sup> In recently adopting the registration approach, the Tenth Circuit summarized its position:

[W]e reject the proposition that § 411 confers federal court jurisdiction for an infringement action upon mere submission of a copyright application to the Copyright Office. In our view, the statute requires more: actual registration by the Register of Copyrights. Until that happens, an infringement action will not lie in the federal courts.<sup>52</sup>

These courts point to the plain text of section 411(a),<sup>53</sup> which gives no indication that application alone is sufficient:

[N]o civil action for infringement of the copyright in any United States

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LEXIS 16932 (S.D.N.Y. Nov. 14, 1996)).

46. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1201-03 (10th Cir. 2005), *abrogated by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

47. *Iconbazaar, L.L.C. v. Am. Online, Inc.*, 308 F. Supp. 2d 630, 632 (M.D.N.C. 2004).

48. *La Resolana*, 416 F.3d at 1202-03.

49. *See id.* at 1202; *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488 (11th Cir. 1990).

50. *La Resolana*, 416 F.3d at 1202.

51. *See id.* at 1200-02.

52. *Id.* at 1205. Section 411(a) is no longer classified as a jurisdictional restriction, but as a precondition to filing copyright infringement suits. *See supra* notes 9-14 and accompanying text.

53. *See, e.g., id.* at 1200.

work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.<sup>54</sup>

In *Mays & Associates v. Euler*,<sup>55</sup> the United States District Court for the District of Maryland pointed out that the terms “application” and “registration” are used in the same section and clearly have different meanings.<sup>56</sup> The *Mays* court reasoned that section 411 lays out “the process of seeking registration . . . without labeling this process as *registration*,”<sup>57</sup> thus drawing a distinction between the process (application) and the result sought (registration). Another district court determined that there would be no reason for the Copyright Office to examine applications if these terms were synonymous.<sup>58</sup> Since the Act’s language “does not convey certain remedies and benefits upon application and other remedies and benefits upon registration,” the Tenth Circuit stated that the application approach would require a “topsy-turvy reading of Title 17 [of the Act].”<sup>59</sup>

Section 410(a) of the Act specifies that “[w]hen, after examination, the Register of Copyrights determines that . . . the material deposited constitutes copyrightable subject matter . . . , the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office.”<sup>60</sup> Some courts adopting the registration approach have argued that this language requires the Copyright Office to examine an application and then register a copyright claim; accordingly, they view the examination by the Copyright Office as a prerequisite to registration.<sup>61</sup> Applying this reasoning, one court stated that the word registration “cannot possibly refer to the pre-examination receipt by the Copyright Office of the applicant’s fee, deposit, and application.”<sup>62</sup>

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54. 17 U.S.C. § 411(a) (2006 & Supp. 2009).

55. 370 F. Supp. 2d 362 (D. Md. 2005).

56. *Id.* at 368.

57. *Id.*

58. *Robinson v. Princeton Rev., Inc.*, No. 96 Civ. 4859 (LAK), 1996 U.S. Dist. LEXIS 16932, at \*21 (S.D.N.Y. Nov. 14, 1996).

59. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1204 (10th Cir. 2005), *abrogated by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

60. 17 U.S.C. § 410(a) (2006).

61. *See, e.g., Ryan v. Carl Corp.*, No. C 97-3873 FMS, 1998 U.S. Dist. LEXIS 9012, at \*5-7 (N.D. Cal. June 15, 1998) (“Because . . . [section 410] indicates that the Copyright Office, not the applicant, registers a claim, and that examination is a prerequisite to registration, the section cuts against plaintiffs’ position of automatic registration [through application only].”).

62. *Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc.*, 315 F. Supp. 2d 1053, 1055 (C.D. Cal. 2004).

The Tenth Circuit also argued in *La Resolana Architects, PA v. Clay Realtors Angel Fire* that two amendments to the Copyright Act since its enactment in 1976 support the registration approach.<sup>63</sup> First, Congress passed the Berne Convention Implementation Act in 1988 to “ally the United States with a set of international rules and regulations.”<sup>64</sup> While considering the Berne Act, which eliminated many previously existing formalities to copyright protection, Congress considered amending 411(a) to read “registration is not a prerequisite to the institution of a civil action for infringement of copyright.”<sup>65</sup> The House of Representatives rejected the proposed modification, instead amending 411(a) to allow only foreign authors to initiate suit without first registering.<sup>66</sup> Congress clarified that “[r]egistration is continued as a prerequisite to suit by *domestic* authors. Only foreign origin works are excepted from the registration requirement.”<sup>67</sup> The Tenth Circuit explained that this outcome “confirms our view of the Act: copyrights that originate in the United States must be registered before the owner can sue for infringement.”<sup>68</sup> Second, the Tenth Circuit pointed to the 2005 FECA amendment, which allows for preregistration of certain works.<sup>69</sup> The court argued that this amendment strengthened its registration approach position:

[T]he adoption of FECA further confirms our statutory analysis. Indeed, the availability of a preregistration scheme would in whole or in part address the problem presented by this case: the need to sue for infringement to prevent dilution of a copyright but the inability to do so without completed registration.<sup>70</sup>

1. *The Certificate*.—Some courts following the registration approach additionally require an applicant to receive a paper certificate of registration from the Copyright Office before filing an infringement action.<sup>71</sup> The Tenth Circuit, however, specifically stated in *La Resolana* that it does not require actual receipt of the certificate because the statutory language does not seem to require it and because of the delay between registration and the owner’s receipt of the certificate.<sup>72</sup> Nonetheless, a Minnesota district court in *Tri-Marketing v.*

63. 416 F.3d at 1205.

64. *Id.*

65. *Id.* at 1205-06 (quoting S. REP. NO. 100-352, at 46 (1998), *reprinted in* 1988 U.S.C.C.A.N. 3706, 3743).

66. *Id.* at 1206.

67. *Id.* (quoting 134 CONG. REC. H10095).

68. *Id.* Note that application approach courts would agree that registration is required but would argue that it is satisfied by submission of an application. *See infra* Part II.B.

69. *Id.* at 1206-07; *see supra* notes 39-45 and accompanying text for discussion of FECA.

70. *Id.* at 1207.

71. *See, e.g.,* *Strategy Source, Inc. v. Lee*, 233 F. Supp. 2d 1, 3-4 (D.D.C. 2002) (“[P]ermitt[ing] an infringement lawsuit to go forward in the absence of a registration certificate or denial of the same is in tension with the language of section 411(a) of the Copyright Act.”).

72. *La Resolana*, 416 F.3d at 1202-03 (noting that “a court’s jurisdiction does not turn on



*Mainstream Marketing Services, Inc.*,<sup>73</sup> citing to *La Resolana*, recently stated broadly that the registration approach requires receipt of a certificate as a prerequisite to an infringement lawsuit.<sup>74</sup> Ironically, this universal statement that receipt of a certificate is required is inaccurate precisely because of *La Resolana*. The *Tri-Marketing* court's citation to *La Resolana*, in which the Tenth Circuit explicitly stated that it does not require a certificate, is one of numerous examples of the confusion among federal courts regarding the copyright registration issue.

2. *Flawed Names for the Registration Approach.*—The “registration approach,” as referred to in this Note, is referred to by some commentators as the “issuance approach”<sup>75</sup> and by others as the “approval approach.”<sup>76</sup> Yet each of these terms has its problems. First, “issuance” has a connotation that the Copyright Office must actually send something out or “issue” a copyright. According to the Tenth Circuit in *La Resolana*, however, the Copyright Office need only have approved or rejected an application, and the owner need not receive anything issued by the Copyright Office.<sup>77</sup> Since the Tenth Circuit—perhaps the foremost proponent of the registration approach—does not require the copyright owner to receive any issuance, referring to this position as the “issuance approach” is undoubtedly misleading. “Approval” is more accurate in this sense; however, this name is also nonetheless imprecise because an owner may sue to enforce a rejected copyright, not just one that has been approved.<sup>78</sup> A more fitting title, one that would most accurately describe what these courts require to satisfy the section 411(a) prerequisite, would be the “approval or denial” approach. Despite its technical accuracy, this name is not very catchy and appears at first glance to be an oxymoron since it includes opposite results. It is thus doubtful that any esteemed federal judge or commentator will adopt this moniker anytime soon.

The name “registration,” while most commonly used to describe the Tenth Circuit's approach, suffers from the same defect as the name “approval” in that a copyright that has been refused registration may still be sued upon.<sup>79</sup> In addition, use of “registration” is confusing since the meaning of the word “registration” in the Act and the time when registration is accomplished are at the center of the debate among the circuit courts. Neither approach argues that “registration,” as required by section 411(a), is unnecessary,<sup>80</sup> the view of the

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the existence of a paper certificate, but rather on the fact of registration, however it is demonstrated” and that “such registration occurs when the Copyright Office approves the application.”).

73. Civ. No. 09-13 (DWF/RLE), 2009 U.S. Dist. LEXIS 42694 (D. Minn. May 19, 2009).

74. *Id.* at \*6-7.

75. See Bracey, *supra* note 7, at 127.

76. See Hogan, *supra* note 16, at 854.

77. *La Resolana*, 416 F.3d at 1202-03.

78. 17 U.S.C. § 411(a) (2006 & Supp. 2009); see also *supra* text accompanying note 32.

79. 17 U.S.C. § 411(a); see also *supra* text accompanying note 32.

80. See, e.g., *La Resolana*, 416 F.3d at 1205; *Forasté v. Brown Univ.*, 248 F. Supp. 2d 71, 76 (D.R.I. 2003) (“Copyright registration is a condition precedent and a jurisdictional prerequisite to

“application” approach is that this statutorily required “registration” occurs when a copyright owner applies for registration.<sup>81</sup> Thus, using the “registration” label titles one interpretation of the issue after the source of the issue itself—the meaning of “registration.” Perhaps some of the confusion among federal courts arises from failing to differentiate the general statutory requirement of “registration” in section 411(a)—whatever it may mean—from the one interpretation of the requirement which holds that the Copyright Office must actually examine and choose to register the copyright (or deny registration).<sup>82</sup>

### B. *The Application Approach*

Followed primarily by the Fifth Circuit,<sup>83</sup> the application approach contends that a copyright owner satisfies the registration requirement by submitting a copyright application.<sup>84</sup> The application approach essentially says that for policy and practicality reasons, the “registration” required by 411(a) as a precondition to suit does not mean *actual* registration by the Copyright Office.<sup>85</sup> Rather, the application approach holds that application for such actual registration fulfills the statutory “registration” requirement.<sup>86</sup> Courts following the application approach point to section 410(d) to justify their position: “*The effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.*”<sup>87</sup> They read this provision to mean that the effective date is effective immediately, not retroactively after the Copyright Office makes a decision.<sup>88</sup> The court in *Forasté v. Brown University* mentioned that registration approach courts interpret section 410(d) “to mean that registration is consummated only after an application is examined, considered, and accepted by the Copyright Office, and is then ‘backdated’ to the time the application is received” but that “[the registration approach interpretation] ignores the statute’s mandate that the merits of the application materials are ‘later determined,’ that is, determined at some

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the filing of an infringement action.”).

81. *Forasté*, 248 F. Supp. 2d at 77 (“[R]egistration occurs *on the day* the Copyright Office receives all of the necessary application materials . . .”).

82. See, e.g., *La Resolana*, 416 F.3d at 1205; *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386-87 (5th Cir. 1984).

83. *Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 365 (5th Cir. 2004), *abrogated by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010); *Apple Barrel*, 730 F.2d at 387-88.

84. *Forasté*, 248 F. Supp. 2d at 77.

85. See *La Resolana*, 416 F.3d at 1203.

86. See *Apple Barrel*, 730 F.2d at 386-87 (noting that federal jurisdiction is satisfied by “payment of the required fee, deposit of the work in question, and receipt by the Copyright Office of a registration application.”).

87. See 17 U.S.C. § 410(d) (2006); *Forasté*, 248 F. Supp. 2d at 77.

88. See *Forasté*, 248 F. Supp. 2d at 77 n.10.

time after the right to sue comes into being.”<sup>89</sup> In other words, application approach courts interpret the “effective date” provision in section 410(d) to mean that a copyright is effectively registered immediately when the application materials are submitted, with the effective date being that same day. According to the application approach courts’ interpretation, the copyright owner has established the right to sue on this effective date, and whether the Copyright Office decides to accept or reject the application is an issue for a separate inquiry which does not affect the owner’s right to sue.<sup>90</sup>

A leading treatise on copyright law, *Nimmer on Copyright* (“*Nimmer*”), supports the application approach.<sup>91</sup> *Nimmer* states that “[a] party who seeks to register may proceed to litigate a claim, regardless of whether the Copyright Office ultimately issues the certificate, or by contrast denies it. Accordingly, it makes sense under the 1976 Act to refer to *application for registration* as a condition to filing an infringement action . . . .”<sup>92</sup> *Nimmer* further argues that the registration approach results from “hyper-technical application” and that policy rationales support the application approach.<sup>93</sup>

The policy rationales mentioned in *Nimmer* are indeed central to the reasoning of application approach proponents. Courts adopting the application approach argue that delaying an infringement claim until the claimant has received a response from the Copyright Office is senseless since the claimant will be able to sue regardless of whether his application is ultimately granted or rejected.<sup>94</sup> The application approach also avoids the inefficient situation where an infringement claim is dismissed, then re-filed shortly thereafter following a decision by the Copyright Office.<sup>95</sup> Accordingly, one district court stated that “[t]o best effectuate the interests of justice and promote judicial economy, the court endorses the position that a plaintiff may sue once the Copyright Office receives the plaintiff’s application, work, and filing fee.”<sup>96</sup> In addition, since applications are typically pending in the Copyright Office for a number of months,<sup>97</sup> allowing copyright owners to bring a claim after applying allows them to prevent their work from being infringed while waiting for approval. Furthermore, the availability of immediate copyright enforcement under the

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89. *Id.*

90. This argument is buffered by the fact that the separate inquiry of whether the work is suitable for registration does not affect the owner’s right to sue because the Act establishes an owner’s right to sue if his or her application is rejected. *See* 17 U.S.C. § 411(a).

91. *See generally* 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16 (2009).

92. *Id.* § 7.16(B)(1)(a)(i).

93. *Id.*

94. *See, e.g.*, *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386-87 (5th Cir. 1984).

95. *Bracey, supra* note 7, at 141.

96. *Int’l Kitchen Exhaust Cleaning Ass’n. v. Power Washers of N. Am.*, 81 F. Supp. 2d 70, 72 (D.D.C. 2000).

97. *See* U.S. COPYRIGHT OFFICE, *supra* note 35.

application approach strengthens the “incentive to create.”<sup>98</sup>

### III. CONFUSION IN THE SEVENTH AND EIGHTH CIRCUITS

The lack of clarity among federal courts that have faced the application versus registration issue may be best illustrated by case law from the Seventh and Eighth Circuits. These cases exemplify the importance of precise language in opinions dealing with the application versus registration issue. In both circuits, opinions that appeared to choose an approach have been met with varied responses and confusion among their respective district courts.<sup>99</sup> By a close examination of the relevant cases in these circuits, this Note attempts to identify the reasons for confusion and the possible causes of seemingly inconsistent judicial language.

#### A. Seventh Circuit

1. *Chicago Board of Education v. Substance, Inc.*—In *Chicago Board of Education v. Substance, Inc.*,<sup>100</sup> a Chicago public school teacher published six Chicago Academic Standards Exams in order to demonstrate that they were poor tests.<sup>101</sup> The school board had expended in excess of one million dollars to create the entire series of forty-four exams.<sup>102</sup> The school board’s suit alleged that the teacher’s actions impaired the exams’ value because the exams were intended to be kept secret to allow reuse of questions.<sup>103</sup> The teacher argued that the school board lacked a valid copyright registration on which to sue.<sup>104</sup>

In response to the teacher’s claim, Judge Posner first appeared to adopt an application approach: “Although a copyright no longer need be registered with the Copyright Office to be valid, *an application for registration must be filed* before the copyright can be sued upon.”<sup>105</sup> The first part of this sentence—stating that “a copyright no longer need be registered with the Copyright Office to be valid”—is a simple statement of the fact that the law recognizes copyright ownership without registration;<sup>106</sup> it does not refer to whether the owner may sue. However, the second clause—stating that “an application for registration must be filed before the copyright can be sued upon”—certainly seems to indicate that actual registration is not required, but rather, that filing of an application will suffice. In addition, Judge Posner cited to *Nimmer*, the treatise widely recognized as advocating the application

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98. Bracey, *supra* note 7, at 141.

99. See *infra* notes 100-53 and accompanying text.

100. 354 F.3d 624 (7th Cir. 2003).

101. *Id.* at 625-27.

102. *Id.* at 626.

103. *Id.* at 628.

104. *Id.* at 631.

105. *Id.* (emphasis added) (citing 17 U.S.C. § 411(a) (2006 & Supp. 2009)).

106. See 17 U.S.C. § 102(a) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression . . .”).

approach, as support for his assertion that “an application for registration must be filed before the copyright can be sued upon.”<sup>107</sup> He cited to the same section of *Nimmer* cited to by the Fifth Circuit in *Apple Barrel Productions, Inc. v. Beard* in support of its application approach.<sup>108</sup>

It is possible that Judge Posner was unaware either of the circuit split or that his statement and citation to *Nimmer* would give the impression that he was choosing one side (the application approach). Perhaps he looked to *Nimmer* to find a discussion of the 411(a) requirement but did not mean to reference *Nimmer*’s preferred position on the split. Or perhaps Judge Posner only meant to say that filing an application for registration is necessary—a statement with which registration approach proponents would not disagree—but not that it is sufficient. Whether application alone is sufficient is where the two views differ. Regardless of Judge Posner’s thoughts while writing the *Chicago Board* opinion, the statement that “an application for registration must be filed before the copyright can be sued upon” is, at the least, confusing and misleading if indeed he did not intend to advocate the application approach.

The *Chicago Board* opinion goes on to explain that the school board had applied for registration of the exams and that the Copyright Office did indeed register the copyright.<sup>109</sup> Judge Posner then engaged in a discussion that would only be relevant under a registration approach:

Had the claim [that the school board owned copyrights in the tests] been false, the registration should not have issued and maybe therefore the copyright could not have been sued upon. . . . Or maybe yes, because the copyright would have been registered, and because the statute requires only a refused registration, which might be the equivalent of an improper registration, not an actual registration, as the premise for the suit. We need not decide [because the board’s claim that it owned registered copyrights in the tests was true].<sup>110</sup>

If Judge Posner had previously meant to say that only application is required, there would have been no reason for discussing the effects of the copyright being registered (albeit improperly) or denied. In contrast to the earlier sentence in the opinion that seemed to be espousing the application approach, this later statement appears as if Judge Posner was talking about the registration approach, where mere application would not be enough to allow a copyright to be sued upon.

2. *Gaiman v. McFarlane*.—In *Gaiman v. McFarlane*,<sup>111</sup> Judge Posner wrote again for the Seventh Circuit and explained that “[t]he significance of registration is that it is a prerequisite to a suit to enforce a copyright. More precisely, an

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107. *Chi. Bd. of Educ.*, 354 F.3d at 631 (citing NIMMER & NIMMER, *supra* note 91, § 7.16[B][1][a]); see *supra* text accompanying notes 91-93 (discussing *Nimmer*’s position).

108. See *Chi. Bd. of Educ.*, 354 F.3d at 631; *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386-87 (5th Cir. 1984).

109. *Chi. Bd. of Educ.*, 354 F.3d at 631.

110. *Id.*

111. 360 F.3d 644 (7th Cir. 2004).

application to register must be filed, *and either granted or refused*, before suit can be brought.”<sup>112</sup> As in *Chicago Board*, the court was not applying this statement to a situation where it had to choose between the two approaches in order to decide the case because McFarlane had successfully registered his copyrights.<sup>113</sup> However, *Gaiman* is still informative regarding the Seventh Circuit’s position on the issue, especially since it was written by Judge Posner less than two months after he penned the *Chicago Board* opinion.<sup>114</sup>

Immediately following this brief discussion of registration’s significance, Judge Posner wrote another sentence that provides further insight into *Chicago Board*: “There is an interesting question, left open in our recent decision in [*Chicago Board*] . . . and unnecessary to decide in this case either, whether if registration is granted by mistake the registrant may nonetheless sue.”<sup>115</sup> Again, if *Chicago Board* had intended to adopt an application approach, it would be irrelevant whether registration was later granted (even if by mistake) or refused. The plaintiff would be able to sue as soon as the Copyright Office received his application, and the hypothetical Judge Posner added as an aside here would be irrelevant. This comment is thus strong evidence of Judge Posner’s own interpretation of his *Chicago Board* opinion, fresh in his mind from less than two months prior. Even more significantly, his clear statement that application must be “either granted or refused” appears to be a strong indication that the Seventh Circuit supports the traditional plain-reading registration approach to interpreting section 411(a).<sup>116</sup>

3. *Goss International Americas, Inc. v. A-American Machine & Assembly Co.*—Despite the apparent clarity of the excerpt from *Gaiman*, the United States District Court for the Northern District of Illinois cited only to *Chicago Board* in 2007 when deciding the application versus registration issue in *Goss International Americas, Inc. v. A-American Machine & Assembly Co.*<sup>117</sup> After plaintiff Goss had applied for copyright registration, defendant A-American Machine & Assembly posted Goss’s diagrams on its website without his permission.<sup>118</sup> The court determined that Goss’s drawings were entitled to copyright protection under the Act and recognized that it was squarely facing the issue on which the circuits are split—whether the copyright could be sued upon following application but prior to a decision from the Copyright Office.<sup>119</sup> The court quoted the statement from *Chicago Board* that “an application for registration must be filed before the copyright can be sued upon.”<sup>120</sup> Oddly, it

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112. *Id.* at 654-55 (emphasis added) (citing 17 U.S.C. § 411(a)(2006 & Supp. 2009)).

113. *Id.* at 654.

114. *See id.* (decided Feb. 24, 2004); *Chi. Bd. of Educ.*, 354 F.3d 624 (decided Dec. 31, 2003).

115. *Gaiman*, 360 F.3d at 655.

116. *See id.* at 654-55.

117. No. 07 C 3248, 2007 U.S. Dist. LEXIS 88382, at \*6 (N.D. Ill. Nov. 30, 2007).

118. *Id.* at \*2.

119. *Id.* at \*5.

120. *Id.* at \*6 (quoting *Chi. Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003)).

attributed the application approach's "effective date" argument to Judge Posner,<sup>121</sup> even though Judge Posner never actually made this point: "Judge Posner bases this statement on the fact that once the Copyright Office approves an application, it retroactively lists as the effective date of the registration the date on which it received all application materials from the applicant."<sup>122</sup> This attempt to divine the reasoning behind Judge Posner's unclear *Chicago Board* opinion is essentially guesswork, but it indicates that the *Goss* court understood *Chicago Board* to be advocating an application approach. Not only did Judge Posner not make the "effective date" argument for an application approach, but it is far from clear whether he even meant to endorse this approach at all, especially in light of his comments in *Gaiman*.

The *Goss* court noted that the *Chicago Board* case did not force the Seventh Circuit to choose an approach:

[*Chicago Board*] differs somewhat from the instant case, though, because in the case before Judge Posner the Copyright Office had issued a registration certificate. In the instant case, plaintiff has been waiting since May 2007 for some action by the Copyright Office. In the meantime, plaintiff has allegedly suffered financial damage as a result of defendant's copying of its images. . . .<sup>123</sup>

Without mentioning *Gaiman*, the court followed the application approach of the Fifth Circuit.<sup>124</sup> The *Goss* court's explanation exemplifies classic application approach reasoning, based on the right of a copyright owner to sue after the Copyright Office has refused to register his application:

[Because the Copyright Act] allows a party to sue for infringement not only after approval of a copyright registration application, but also after a refusal of that registration application . . . [i]t hardly seems fair, then, to refuse plaintiff the opportunity to sue for infringement until the Copyright Office takes some action when plaintiff will be able to sue after that determination, regardless of the outcome.<sup>125</sup>

Although the district court in *Goss* recognized that *Chicago Board* had not faced the precise situation that would require choosing one approach over the other, it took note of and appears to have been influenced by what it perceived as Judge Posner's support of the application approach. The *Goss* court did not recognize that the language following the quoted section from *Chicago Board* makes uncertain which approach Judge Posner meant to advocate, if he intended to

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121. See *supra* text accompanying notes 87-90 (discussing the effective date argument based on section 410(d)).

122. *Goss*, 2007 U.S. Dist. LEXIS 88382, at \*6.

123. *Id.* at \*6-7.

124. *Id.* at \*7. The court actually stated that it adopted the reasoning of the Fifth and Eighth Circuits in choosing the application approach. However, the position of the Eighth Circuit is not clearly established, as discussed *infra*, Part III.B.

125. See *id.* at \*7.

advocate one at all. Nor did it consider what appears to be much more persuasive dicta from *Gaiman*, in which the Seventh Circuit—with Judge Posner again writing—added that the application must be either granted or refused before the owner can sue on the copyright.<sup>126</sup>

4. *Woollen v. Indianapolis-Marion County Public Library*.—The United States District Court for the Southern District of Indiana stated in *Woollen v. Indianapolis-Marion County Public Library*,<sup>127</sup> regarding the two approaches, that “[t]he Seventh Circuit has not yet addressed this issue directly, although one decision suggests that this circuit may favor the ‘application approach.’”<sup>128</sup> The court discussed the Seventh Circuit’s language from *Chicago Board* that “an application for registration must be filed before the copyright can be sued upon” but noted that “[t]he comment in *Chicago Board of Education*, however, was made in passing.”<sup>129</sup> The *Woollen* court was able to avoid deciding the case because the Copyright Office registered the plaintiff’s copyright while the defendant’s motion to dismiss was pending.<sup>130</sup> The court allowed the plaintiff to amend its complaint to assert that its copyright had been registered and a certificate had been issued,<sup>131</sup> thus satisfying section 411(a) even under the stricter registration approach. The court noted that the door was left open by the Seventh Circuit as to when federal courts obtain jurisdiction over copyright infringement suits, stating that “this court acquired jurisdiction to hear its claims, at least from the date of the Copyright Office’s registration and perhaps sooner.”<sup>132</sup>

The *Goss* and *Woollen* opinions indicate that district courts have not understood *Gaiman* as the Seventh Circuit’s adoption or promotion of the registration approach despite the seemingly clear language in that opinion. Commentaries also do not attribute either the registration or the application approach to the Seventh Circuit.<sup>133</sup> Absent a direct determination by the Seventh Circuit, the application approach adopted in *Goss* appears to be the leading persuasive authority for the Northern District of Illinois.

5. *Brooks-Ngwenya v. Indianapolis Public Schools*.—When the Seventh Circuit was recently presented with another opportunity to explain its prior holdings, it chose not to do so in *Brooks-Ngwenya v. Indianapolis Public Schools*.<sup>134</sup> The court noted that “[t]he circuits have split over whether registration is complete when an application is made or only after the Copyright

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126. See *Gaiman v. McFarlane*, 360 F.3d 644, 654-55 (7th Cir. 2004).

127. No. 1:06-cv-0662-JDT-TAB, 2006 U.S. Dist. LEXIS 52788 (S.D. Ind. July 28, 2006).

128. *Id.* at \*6.

129. *Id.*

130. *Id.* at \*7.

131. *Id.* at \*8.

132. *Id.* at \*9. Section 411(a) is no longer classified as a jurisdictional restriction, but as a precondition to filing copyright infringement suits. See *supra* notes 9-14 and accompanying text.

133. See, e.g., Joshua P. Graham, *Graham on Goss International Americas, Inc. v. A-American Machine & Assembly*, 2008 EMERGING ISSUES 1757 (2008).

134. 564 F.3d 804 (7th Cir. 2009).



Office has acted on the application.”<sup>135</sup> At the end of a string cite to courts on either side of the split, the court included “[compare to] *Chicago Board of Education v. Substance, Inc.* . . . (‘an application for registration must be filed before the copyright can be sued upon’).”<sup>136</sup> The court did not discuss its prior *Chicago Board* decision besides listing it in this string cite, apparently indicating that *Chicago Board* was not meant to take a position. As in *Chicago Board* and *Gaiman*, the facts in *Brooks-Ngwenya* did not require the court to take a position on whether application alone satisfies the section 411(a) requirement because the Copyright Office had denied the plaintiff’s application for registration.<sup>137</sup> *Brooks-Ngwenya* seems to clarify that despite indications to the contrary, the Seventh Circuit has not endorsed either the application or registration approach.

### B. Eighth Circuit

1. *Action Tapes, Inc. v. Mattson*.—In *Action Tapes, Inc. v. Mattson*,<sup>138</sup> the Eighth Circuit stated that “the copyright owner may not sue for infringement under the federal Copyright Act until the owner has delivered ‘the deposit, application, and fee required for registration’ to the United States Copyright Office, a branch of the Library of Congress.”<sup>139</sup> Perhaps all the court intended by this sentence was to paraphrase section 411(a). Instead, however, the court seemed to advocate an application approach by stating that a copyright owner must deliver the requisite application materials before suing.<sup>140</sup> This statement says nothing about needing to receive a response from the Copyright Office. Like the Seventh Circuit’s language in *Chicago Board* that “an application for registration must be filed before the copyright can be sued upon,”<sup>141</sup> however, this statement raises the “necessary vs. sufficient” distinction. The Eighth Circuit in *Action Tapes* may have intended to say only that delivering the application materials is a necessary step towards fulfilling the 411(a) prerequisite without meaning to suggest that this is all a copyright owner must do (sufficient). There would be no opposition to the statement that application, at the very least, is a necessary prerequisite to an infringement suit. The Eighth Circuit may have been simply stating this non-controversial rule without intending to hold that application alone is sufficient. As far as the issue of the 411(a) prerequisite related to the case at bar, all that mattered was that application for copyright protection was necessary.<sup>142</sup> Since *Action Tapes* had not properly applied for a computer program copyright, section 411(a) barred its infringement suit.<sup>143</sup>

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135. *Id.* at 806.

136. *Id.*

137. *Id.*

138. 462 F.3d 1010 (8th Cir. 2006).

139. *Id.* at 1013 (quoting 17 U.S.C. § 411(a) (2006 & Supp. 2009)).

140. *See id.* (quoting 17 U.S.C. § 411(a)).

141. *Chi. Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003).

142. *See Action Tapes*, 462 F.3d at 1013.

143. *Id.*

Whatever the Eighth Circuit intended in *Action Tapes*, following that decision, courts began to list the Eighth Circuit along with the Fifth Circuit as the two circuits that had adopted the application approach.<sup>144</sup> Clearly, the Eighth Circuit's statement in *Action Tapes* that "the copyright owner may not sue for infringement . . . until the owner has delivered 'the deposit, application, and fee required for registration'" was widely understood as an adoption or at least a strong endorsement of the application approach.<sup>145</sup> This understanding that the Eighth Circuit adopted the application approach in *Action Tapes* is precisely what the copyright owner relied on in the recent 2009 district court case of *Tri-Marketing v. Mainstream Marketing Services*.<sup>146</sup>

2. *Tri-Marketing v. Mainstream Marketing Services*.—In *Tri-Marketing v. Mainstream Marketing Services*,<sup>147</sup> TRI applied for registration of two versions of its website,<sup>148</sup> but it had not received any response from the Copyright Office before instituting its lawsuit.<sup>149</sup> TRI pointed to *Action Tapes* as the Eighth Circuit's adoption of the application approach, arguing that *Action Tapes* "squarely address[ed]" the issue.<sup>150</sup> The court was not persuaded:

While the language in *Action Tapes* appears to support TRI's position in this case, the Eighth Circuit in *Action Tapes* was not presented with the precise jurisdictional issue before this Court, specifically whether complying with copyright application requirements satisfies the jurisdictional requirements under § 411(a). Accordingly, the language

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144. See *Brooks-Ngwenya v. Indianapolis Pub. Sch.*, 564 F.3d 804, 806 (7th Cir. 2009) ("The circuits have split over whether registration is complete when an application is made or only after the Copyright Office has acted on the application. Compare *Action Tapes* . . . (application is sufficient) . . ."); *DO Denim, LLC v. Fried Denim, Inc.*, No. 08 Civ. 10947, 2009 U.S. Dist. LEXIS 51512, at \*5-6 (S.D.N.Y. June 17, 2009) ("Compare *La Resolana* . . . ('the Register of Copyrights must affirmatively determine copyright protection is warranted . . . before registration occurs under the Act. . .') with *Action Tapes, Inc. v. Mattson* . . . ('the copyright owner may not sue for infringement under the federal Copyright Act until the owner has delivered the deposit, application, and fee required for registration to the United States Copyright Office'"); *Goss Int'l Ams., Inc. v. A-Am. Mach. & Assemb. Co.*, No. 07 C 3248, 2007 U.S. Dist. LEXIS 88382, at \*5-6 (N.D. Ill. Nov. 30, 2007) ("The Fifth and Eighth Circuits, however, hold that a plaintiff need only send the application, deposit, and fee to the Copyright Office to file an infringement claim."); *Kaye Homes, Inc. v. Original Custom Homes Corp.*, No. 2:07-cv-392-FtM-29SPC, 2007 U.S. Dist. LEXIS 60847, at \*5-6 (M.D. Fla. Aug. 20, 2007) ("The Circuit Courts of Appeal have split in their interpretation of this statute, with one group finding that filing an application is sufficient to vest jurisdiction (citing *Action Tapes*, 462 F.3d at 1010)).

145. See *Action Tapes*, 462 F.3d at 1013 (quoting 17 U.S.C. § 411(a) (2006)).

146. Civ. No. 09-13 (DWF/RLE), 2009 U.S. Dist. LEXIS 42694 (D. Minn. May 19, 2009).

147. *Id.*

148. *Id.* at \*2.

149. *Id.* at \*6.

150. *Id.* at \*8.

relied on by TRI is persuasive but not binding on this [c]ourt.<sup>151</sup>

Although the court determined that it was not technically bound by *Action Tapes*, this persuasive precedent, along with “the interests of justice and judicial economy,” led the court to endorse the application approach.<sup>152</sup>

As copyright law in the Eighth Circuit now stands, *TRI Marketing* and the persuasive dicta from *Action Tapes* support an application approach, whereas older district court cases support the registration approach.<sup>153</sup> Another district court within the Eighth Circuit could simply choose not to follow *TRI Marketing*, however, and dismiss a case in which the Copyright Office has not registered the owner’s copyright by the time the suit is filed. The Eighth Circuit should look for an opportunity to clarify its intent for an application approach—if that was indeed its intent—so that all district courts within the circuit will be applying the same rule.

#### IV. PROPOSAL

##### *A. Absent Congressional Amendment, Courts Should Follow the Registration Approach*

As currently written, the Copyright Act by its plain language prohibits suit over a copyright after application but before a response from the Copyright Office. Simply stated, the application approach ignores the congressionally-intended plain meaning of section 411(a).<sup>154</sup> Courts should look to the Tenth Circuit’s well-reasoned opinion in *La Resolana* and follow the registration approach based on the plain meaning evident in the statute, as it has been drafted and enacted by Congress.

The law is well established that “[i]t is the province of the legislature to make the laws, and of the court to enforce them.”<sup>155</sup> The courts’ role is not to “fix” statutes that they may not see as the best policy by inventing fictions—such as that “registration” does not really mean registration, as application approach courts are essentially doing.<sup>156</sup> The Tenth Circuit began its analysis in *La Resolana* by noting that “we start with the language of the statute. If the statutory language is not ambiguous, and the ‘statutory scheme is coherent and consistent,’ our inquiry ends.”<sup>157</sup> A simple reading of section 411(a) reveals that

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151. *Id.* at \*8-9. Section 411(a) is no longer classified as a jurisdictional restriction, but as a precondition to filing copyright infringement suits. *See supra* notes 9-14 and accompanying text.

152. *Id.* at \*10.

153. *See, e.g.,* Denenberg v. Berman, No. 4:02CV7, 2002 U.S. Dist. LEXIS 20490, at \*4-5 (D. Neb. July 23, 2002); Proulx v. Hennepin Tech. Ctrs. Dist. No. 287, Civ. No. 4-79-637, 1981 U.S. Dist. LEXIS 17634, at \*4 (D. Minn. Dec. 7, 1981).

154. *See infra* note 161 and accompanying text.

155. Barrett v. State, 229 U.S. 26, 30 (1913).

156. *See supra* Part II.B.

157. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200 (10th Cir. 2005), *abrogated by* Reed Elsevier, Inc. v. Muchnick, 130 S. Ct. 1237 (2010) (quoting Barnhart

Congress used both “application” and “registration” and gave the two terms different meanings.<sup>158</sup> Thus, section 411(a)’s disallowance of a copyright infringement action before “preregistration or registration” conveys to the reader that “application,” discussed in the same subsection, is insufficient to allow an action for copyright infringement.<sup>159</sup> Otherwise, the next sentence, allowing suit where “the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused,”<sup>160</sup> would be meaningless. Although section 411(a) creates an odd result by allowing a suit whether the Copyright Office grants or refuses registration, it makes clear that the right to sue comes into being upon such grant or refusal and not upon the preliminary step of application. The United States District Court for the District of Columbia, following the registration approach, wrote that “[t]o conclude that registration or the refusal of registration by the Copyright Office are not . . . prerequisites is to disregard the plain language of these statutes and to in effect re-write them, which . . . this [c]ourt cannot do.”<sup>161</sup>

It is unlikely that any application approach courts read section 411(a) and truly come away with the understanding that the statute says application is sufficient. Section 411(a) is not an ambiguous statute that is open to multiple interpretations. No application approach court has been so bold as to claim that Congress specified in the Act that an owner’s application for copyright protection alone allows the owner to bring suit.<sup>162</sup> Rather, the application approach simply ignores the clear meaning of this provision for policy reasons. However, as the Tenth Circuit recognized, “[w]hatever the practical force of this argument . . . [courts] cannot ignore the plain meaning of the statute, nor change the legislative scheme.”<sup>163</sup>

### *B. Congress Should Amend the Act to Allow Infringement Suits After Application*

Some measure of clarity is needed with respect to section 411(a) since the registration and application approaches are currently applied seemingly at random, as each court sees fit.<sup>164</sup> Copyright holders outside of the Fifth, Tenth, and Eleventh Circuits—those in which the circuit courts have definitively ruled

v. Sigmon Coal Co., 534 U.S. 438, 450 (2002)).

158. See 17 U.S.C. § 411(a) (2006 & Supp. 2009); *Mays & Assocs., Inc. v. Euler*, 370 F. Supp. 2d 362, 368 (D. Md. 2005).

159. See 17 U.S.C. § 411(a).

160. See *id.*

161. *Strategy Source, Inc. v. Lee*, 233 F. Supp. 2d 4, 10 (D.D.C. 2002).

162. Rather, application approach courts argue that policy reasons support such an interpretation by the judiciary. See *supra* Part II.B.

163. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1204 (10th Cir. 2005), *abrogated by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

164. See *Brooks-Ngwenya v. Indianapolis Pub. Sch.*, 564 F.3d 804, 806 (7th Cir. 2009) (listing opinions on each side of the split).

on the application versus registration issue—have little idea what prerequisites they must satisfy before initiating suit. The glaring lack of certainty and uniformity regarding section 411(a)'s registration requirement is confusing copyright holders and courts alike<sup>165</sup> and can be best remedied by clarification from Congress. Notwithstanding the courts' duty to follow the registration approach in observance of the Act's plain meaning, the various courts and commentators that have advocated the application approach are indeed supported by significant policy rationales.<sup>166</sup> Congress should take note of the reasoning in support of the application approach and amend the Copyright Act to allow copyright holders to institute infringement suits after they have delivered their application materials to the Copyright Office for review.<sup>167</sup>

The most persuasive point favoring the application approach is that because an applicant will be able to sue eventually regardless of whether his application is granted or rejected,<sup>168</sup> it makes little sense to require him to wait for a response.<sup>169</sup> Requiring owners to wait until registration has been completed forces the owner-applicant whose copyright is being infringed upon to sit by idly after applying, often for more than a year,<sup>170</sup> before the Copyright Office acts on his application and he is able to seek redress from the courts. *Nimmer* thoroughly addresses this gap between application and registration and how courts have confronted it.<sup>171</sup> Some courts have sought to mitigate the effects of the gap by allowing plaintiffs who filed suit while their applications were pending in the Copyright Office to amend their complaint after the Copyright Office completed registration.<sup>172</sup> Of course, allowing plaintiffs in this situation to amend their complaint after registration does not alleviate the owner's inability to prevent infringement where the application remains pending beyond the time when a court would otherwise be ready to handle the case; the owner must continue to wait on the Copyright Office to act before the court will provide relief. Another registration approach court explained that an applicant who is unable to sue because his application is pending will ultimately be made whole through damages recovered in the suit.<sup>173</sup> Because a plaintiff's registration is backdated to the date when the Copyright Office received his application, the court contended that the damages sufficiently compensate the plaintiff, albeit after some delay.<sup>174</sup> However, *Nimmer* points out that although the backdating

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165. See *supra* Part III (discussing the Seventh and Eighth Circuits).

166. See *supra* text accompanying notes 93-98 (discussing policy rationales supporting the application approach).

167. See generally *supra* Part II.B (discussing application approach arguments).

168. See 17 U.S.C. § 411(a) (2006 & Supp. 2009).

169. See, e.g., *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386-87 (5th Cir. 1984).

170. See *supra* note 35 and accompanying text.

171. NIMMER & NIMMER, *supra* note 91, § 7.16(B)(1)(a)(i).

172. *Id.*

173. *Mays & Assocs., Inc. v. Euler*, 370 F. Supp. 2d 362, 369-70 (D. Md. 2005).

174. *Id.*; see 17 U.S.C. § 410(d) (2006) ("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

provision alleviates much of the concern over this “legal limbo” while the plaintiff is awaiting action by the Copyright Office, the plaintiff is still not made completely whole:

[G]iven that belated registration will not allow recovery of statutory damages for infringement that commenced before its effective date, and given further a three-year statute of limitations for recovery of all damages caused by copyright infringement, the [registration] approach may indeed occasion complete inability to recover damages—especially in its hyper-technical instantiation.<sup>175</sup>

The harm to plaintiffs caused by making them endure this limbo period before being able to protect their copyrights would only be worthwhile if there were some significant policy justification in favor of delaying institution of infringement suits until the Copyright Office acts. Registration approach advocates have argued that such justification exists because a decision by the Copyright Office to deny registration should be given deference.<sup>176</sup> Naturally, for courts to defer to the Copyright Office, “there must be a resolution from the Copyright Office to which to defer.”<sup>177</sup> Forcing plaintiffs to wait through the period during which their applications are pending ensures that courts will have such a resolution to afford deference. Despite the reasonable logic of this policy argument, *Nimmer* points out that the practical realities of litigation render moot any concerns that federal courts would actually be forced to act without a decision from the Copyright Office:

True, if courts following the . . . [application] approach were inexorably forced to evaluate the strength of the copyright application without guidance from the Copyright Office, there might indeed be reason to force plaintiffs to wait before instituting suit. But, in fact, the pace of litigation entails that the Copyright Office will typically have granted or refused registration during its pendency. Therefore . . . the Register typically will not be deprived of her opportunity, in due course, to appear in the litigation, even if the complaint is allowed to be filed in the interim before the application has been accepted or rejected.<sup>178</sup>

*Nimmer* also proposes that courts require plaintiffs to notify the Copyright Office of litigation so that in “the rare case in which compressed timing might prejudice the Register’s right to appear,” the Register of Copyrights “could expedite treatment of the application and, if she denies issuance of a certificate, could appear in the litigation to defend her determination.”<sup>179</sup> Along with specifying

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Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.”).

175. NIMMER & NIMMER, *supra* note 91, § 7.16(B)(1)(a)(i).

176. *See id.*

177. *Id.*

178. *Id.*

179. *Id.*

that submission of an application suffices to allow a copyright owner to institute an infringement suit, Congress should include a provision in the Copyright Act reflecting this proposal from *Nimmer* that plaintiffs must notify the Copyright Office of their pending litigation. Under such a statutory scheme, the concerns that court will be forced to act without a decision from the Copyright Office would be further alleviated.

At least one commentator has suggested that the Supreme Court should lead the way by granting certiorari and adopting the application approach.<sup>180</sup> However, under this solution the federal courts would still be acting against the Act's plain meaning, as discussed in the previous subsection.<sup>181</sup> Therefore, this Note seeks to place the onus not on the Supreme Court, but on Congress, as "[i]t is the province of the legislature to make the laws, and of the courts to enforce them."<sup>182</sup>

#### CONCLUSION

Although U.S. copyright law recognizes the rights of authors in their works immediately,<sup>183</sup> the registration requirement under section 411(a) of the Copyright Act prevents authors from being protected by federal courts without significant delay. Widespread adoption of the registration approach would only continue to place meaningless formalities above copyright owners' need for early protection. As a result, application approach courts are inventing an interpretation of "registration" that is simply not supported by the statute itself, and federal courts throughout the country are split over whether to follow this inaccurate but policy-based application approach. Courts are now confused about what section 411(a) actually requires, although the actual meaning of the language is clear. It is now time for Congress to step in and amend the statute in recognition that only harm is done by requiring authors to wait on the Copyright Office before being able to protect their copyrights.

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180. Hogan, *supra* note 16, at 845.

181. *See supra* Part IV.A.

182. *Barrett v. State*, 229 U.S. 26, 30 (1913).

183. 17 U.S.C. § 102(a) (2006).