

Registration Approach vs. Application Approach: Section 411(a)'s Copyright Registration Requirement [Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC, 856 F.3d 1338 (11th Cir. 2017)]

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The term “registration” in section 411(a) of the Copyright Act receives different treatment among federal circuit courts. The Eleventh Circuit Court of Appeals held that registration only occurs after a copyright is registered by the Register of Copyrights, adopting the “registration approach.” The Tenth Circuit also follows this approach. The Fifth and Ninth Circuits, however, apply the “application approach,” holding that filing an application is sufficient to show registration under section 411(a) to bring an infringement suit.

I. INTRODUCTION

The Copyright Act requires a copyright to be registered before the copyright owner can bring a suit for infringement.¹ Many circuit courts face the question: What counts as registration? Is it enough to file an application with the Copyright Office, or must the Register of Copyrights officially register the copyright? Circuit courts vary in their answer to this question, and no clear determination exists.

The Eleventh Circuit, in *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com*,² joined the Tenth Circuit in holding that the copyright must be registered by the Register of Copyrights, adopting the “registration approach.”³

1. See 17 U.S.C. § 411(a) (2008).

2. 856 F.3d 1338 (11th Cir. 2017).

3. *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1341 (11th Cir. 2017), cert. granted, 138 S.Ct. 2707 (2018); *La Resolana Architects, PAs v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1208 (10th Cir. 2005), abrogated on other grounds by *Reed Elsevier, Inc. v. Muchnik*, 559 U.S. 154 (2010). In *Fourth Estate*, the Eleventh Circuit reaffirmed the registration approach it originally set out in *M.G.B. Homes, Inc. v. Ameron Homes, Inc.* *Fourth Estate*, 856 F.3d at 1340 (citing *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488 n.4 (11th Cir. 1990)).

Conversely, the Fifth and Ninth Circuits apply the “application approach,” holding that filing an application is sufficient to bring an infringement suit.⁴

II. BACKGROUND

A. Case Description

Fourth Estate Public Benefit Corporation (“Fourth Estate”), an international journalism membership organization, licensed articles to Wall-Street.com (“Wall-Street”).⁵ After Wall-Street canceled its account with Fourth Estate, the website continued to display the licensed articles.⁶ Fourth Estate brought an action against Wall-Street for copyright infringement under 17 U.S.C. § 501.⁷ At the time of the lawsuit, Fourth Estate already filed applications to register the articles with the Register of Copyrights, but the copyrights had not yet been registered.⁸ Wall-Street filed a motion to dismiss the claim, arguing that a suit for copyright infringement can be brought only after a copyright has been registered.⁹ The district court agreed and ruled in favor of Wall-Street and dismissed the claim without prejudice.¹⁰ Fourth Estate appealed the dismissal to the Eleventh Circuit.¹¹

B. Legal Background

1. Copyright Act

Congress has the power to grant copyright protection under Article 1, Section 8, Clause 8 of the United States Constitution.¹² Clause 8 states, “Congress shall have 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.”¹³ Congress exercised this power through the Copyright Act.¹⁴ Although the law recognizes unregistered copyright ownership, Congress sought to incentivize copyright owners to

4. See *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386–87 (5th Cir. 1984); *Cosmetic Ideas, Inc. v. IAC/InteractivecorpC.*, 606 F.3d 612, 619 (9th Cir. 2010).

5. *Fourth Estate*, 856 F.3d at 1339. Fourth Estate licenses articles to websites while retaining the copyrights to the articles. *Id.*

6. *Id.* The license agreement between Fourth Estate and Wall-Street required Wall-Street to remove all the content licensed from Fourth Estate from its website before cancelling its account. *Id.*

7. *Id.* Fourth Estate also named Jerrold Burden, the owner of Wall-Street, in the action. *Id.*

8. *Id.*

9. *Id.*

10. *Id.*

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

12. U.S. CONST. art. I, § 8, cl. 8.

13. *Id.*

14. Pub. L. No. 94-553, § 301(a) (codified at 17 U.S.C. § 301(a9)).

register with the Copyright Office.¹⁵ Therefore, registering the copyright ensures the owner greater protections.¹⁶

One such protection, under Section 411, is the ability to bring a copyright infringement suit against another party who violates the copyright.¹⁷ Section 411 states that “no civil action for infringement of the copyright . . . shall be instituted until preregistration or registration of the copyright claim has been made.”¹⁸ The Act continues to state that a suit also can be commenced if “the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused.”¹⁹

Section 408 sets forth the steps a copyright holder must follow in order to register a copyright.²⁰ The copyright holder must file an application with the Copyright Office either in paper or electronic form.²¹ Within the application, the holder must include a nonreturnable copy of the work and a fee.²² Currently, electronic applications are usually processed in seven to nine months, and paper applications are usually processed in nine to sixteen months.²³

2. Circuit Split

Although the Copyright Act clearly requires “registration,” circuits are divided on the meaning of the term.²⁴ The Tenth Circuit follows the “registration approach,” holding that a copyright infringement suit can be brought only after a copyright has been registered or denied by the Register of Copyrights.²⁵ The Tenth Circuit based this ruling on the plain language of the Copyright Act.²⁶

15. See 17 U.S.C. § 408 (2005). Section 408(a) explains that registration is not required for copyright protection. *Id.* An unregistered copyright entitles the owner to reproduce, sell, and perform the copyright-protected work. See *id.* “Copyright registration for published works, which is useful and important to users and the public at large, would no longer be compulsory, and should therefore be induced in some practical way.” H.R. REP. NO. 94-1476, at 158 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5774.

16. H.R. REP. NO. 94-1476, at 158.

17. See 17 U.S.C. § 411(a) (2008). Another incentive is limiting statutory damages to infringements that occur after the copyright’s effective registration date. *Id.* § 412.

18. *Id.* § 411(a).

19. *Id.* If the suit commences after refusal of registration, the Register of Copyrights must be given notice of the action and a copy of the complaint. *Id.* The Register may become a party to the action. *Id.* The court initially reviews the Register’s determination regarding copyrightability for abuse of discretion. See *id.*

20. *Id.* § 408.

21. *Id.*

22. *Id.*

23. *I’ve Submitted My Application, Fee, and Copy of My Work to the Copyright Office. Now What?*, COPYRIGHT.GOV, <https://www.copyright.gov/help/faq/faq-what.html#certificate> [<https://perma.cc/SVW6-B2BE>] (last visited Sept. 14, 2018).

24. See Melissa J. Sachs, *Copyright Application Insufficient for Suit, 11th Circuit Says, Noting Split*, WESTLAW INTELL. PROP. DAILY BRIEFING, May 30, 2017, 2017 WL 2331875.

25. *La Resolana Architects, PAs v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1208 (10th Cir. 2005).

26. *Id.* at 1200 (“The plain language of the statute thus requires a series of affirmative steps by both the applicant and the Copyright Office. No language in the Act suggests that registration is accomplished by mere receipt of copyrightable material by the Copyright Office.”).

On the other hand, the Fifth and Ninth Circuits follow the “application approach,” which allows an infringement suit to be brought if the petitioner has filed “the deposit, application, and fee required for registration.”²⁷ The application need not be granted or denied.²⁸ These circuits concluded (1) “registration” is unclear and used inconsistently in other areas of the Copyright Act, and (2) the “application approach” best achieves the goals of Congress to provide broad copyright protections and maintain a robust register.²⁹

III. COURT’S DECISION

The Eleventh Circuit faced the question of what constitutes copyright registration within the Act.³⁰ Fourth Estate argued that because copyrights are backdated to the date of application, registration should mean simply filing an application.³¹ The court stated that despite backdating, registration does not occur until after application examination.³² Fourth Estate next argued the three-year statute of limitations encouraged courts to follow the “application approach.”³³ The court rejected this argument, reasoning the statute of limitations is meant to encourage registration “soon after [an owner] obtains the copyright and before infringement occurs.”³⁴

The court also rejected Fourth Estate’s arguments concerning the legislative history and policy behind the Copyright Act, finding the text clear and unambiguous.³⁵ The court relied heavily on the text of the Copyright Act to reach its conclusion, particularly Section 411.³⁶ The court found “registration” requires action by both the copyright owner and the Register of Copyrights.³⁷ The copyright owner must submit an application to be examined

27. *Action Tapes, Inc. v. Mattson*, 462 F.3d 1010, 1013 (8th Cir. 2006) (endorsing the “application approach” in dicta). See *Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 619 (9th Cir. 2010); *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386–87 (5th Cir. 1984). The Seventh Circuit is inconsistent in its approach. Compare *Chicago Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003) (“[A]n application for registration must be filed before the copyright can be sued upon.”), with *Gaiman v. McFarlane*, 360 F.3d 644, 655 (7th Cir. 2004) (“[A]n application to register must be filed, and either granted or refused, before suit can be brought.”). The First and Second Circuits recognized the circuit split, but have not chosen one approach over the other. See *Alicea v. Machete Music*, 744 F.3d 773, 779 (1st Cir. 2014); *Psihoyos v. John Wiley & Sons, Inc.*, 748 F.3d 120, 125 (2d Cir. 2014).

28. See *Apple Barrel Prods.*, 730 F.2d at 386–87; *Cosmetic Ideas*, 606 F.3d at 619.

29. Jonathan L. Kennedy, *Double Standard and Facilitated Forum Shopping: A Historical Approach to Resolving the Circuit Split on Copyright Registration Timing*, 60 *DRAKE L. REV.* 305, 339–40 (2011).

30. *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1340 (11th Cir. 2017) (recognizing the circuit split on this issue).

31. *Id.* at 1342. After an application is registered, the copyright’s registered date is deemed the date of its submission. 17 U.S.C. § 410(d).

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

33. *Id.*

34. *Id.*

35. *Id.*

36. *Id.* at 1341–42. Although the parties disputed whether precedent decided the issue, the court did not focus on precedent, finding the language of the Copyright Act sufficient. *Id.* at 1340–41.

37. See *id.* at 1342.

by the Register of Copyrights.³⁸ Therefore, the court held merely filing an application does not amount to registration.³⁹ Finally, the court held injunctive relief was not appropriate before registration because the appeal did “not involve the ongoing creation of original works, or potential future infringement of works not yet created.”⁴⁰

IV. COMMENTARY

Although the “application approach” is more practical, the language of the Copyright Act requires the “registration approach.” The key to statutory interpretation is to look at the plain language of the statute.⁴¹ Section 411 provides a copyright must be registered before filing an infringement claim, although there is no explicit definition for “registration.”⁴² Section 410 requires the copyright to be registered once “the Register of Copyrights determines that . . . the material deposited constitutes copyrightable subject matter and that the other . . . requirements . . . have been met.”⁴³ This provision requires an affirmative act by the Register of Copyright before registration occurs.⁴⁴ Section 411 also states that an infringement suit can be brought if an application has been filed and rejected by the Register of Copyright.⁴⁵ This carve-out favors the “registration approach” because Congress decided simply filing an application is insufficient to begin a suit.⁴⁶

Although courts following the “application approach” claim there is ambiguity within the statute over “registration,” it is a stretch to classify an application as “registration.”⁴⁷ These courts ultimately apply the “application approach” for policy reasons, such as efficiency and fairness.⁴⁸ In fact, many courts that apply the “registration approach” admit these policy concerns, but choose to follow a plain-language interpretation of the Copyright Act.⁴⁹

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

39. *Id.* at 1341.

40. *Id.* at 1342.

41. *See Connecticut Nat’l Bank v. Germain*, 503 U.S. 249, 254 (1992) (“When the words of a statute are unambiguous, then, this first canon is also the last: ‘judicial inquiry is complete.’”) (quoting *Rubin v. United States*, 449 U.S. 424, 430 (1981)).

42. 17 U.S.C. § 411(a).

43. *Id.* § 410(a) (2012). The Ninth Circuit reasoned these requirements are applicable for the certificate of registration, but not registration alone. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 617 (9th Cir. 2010).

44. *See* 17 U.S.C. § 410(a).

45. *Id.* § 411(a).

46. *See id.*; Matthew J. Astle, *Help! I’ve Been Infringed and I Can’t Sue!: New Approaches to Copyright Registration*, 41 U. MEM. L. REV. 449, 473 (2011).

47. *Cosmetic Ideas*, 606 F.3d at 617. The Ninth Circuit relied heavily on § 408, stating it “blurs the line between application and registration and favors the application approach.” *Id.* The court read this section to mean the only requirement for registration is the “delivery of the appropriate documents and fee.” *Id.*

48. *See id.* at 619–21.

49. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1204 (10th Cir. 2005) (“Whatever the practical force of this argument . . . [courts] cannot ignore the plain meaning of the statute, nor change the legislative scheme.”).

Because the plain language of the statute clearly requires actual registration, courts are forced to follow the “registration approach.”⁵⁰ However, applying the “registration approach” is inefficient and inconsistent with the purpose of our copyright laws.⁵¹ Therefore, Congress should amend Section 411 to adopt the “application approach,” allowing for infringement suits after an application is filed with the Copyright Office.

The purposes of requiring registration before bringing an infringement suit are to encourage registration and to maintain a robust federal register of copyrights.⁵² Applying the “application approach” will better meet these objectives. This approach incentivizes registration even more than the “registration approach” because the copyright owner receives the immediate right to sue for infringement upon filing an application, rather than waiting until some unknown point in the future.⁵³ This, in turn, will lead to a more complete federal register.⁵⁴

If copyright owners do not anticipate the need to sue, they are not likely to register their works.⁵⁵ On the other hand, a party may apply for registration immediately, and be infringed during the application process.⁵⁶ Depending on the jurisdiction, the lawsuit may be dismissed because the copyright has not yet been registered or denied.⁵⁷ It is inefficient and uneconomical to dismiss a case that could be brought a few months later once the application is granted or denied by the Copyright Office.⁵⁸ This may seem a like a short period to some, but can have a large effect on the value of these works.⁵⁹ The copyright holder will be forced to sit back and do nothing before hearing back from the Copyright Office. Also, the Copyright Act provides a three-year statute of limitations for copyright infringement actions.⁶⁰ If the copyright holder files an application near the end of the three years, the holder could potentially lose the ability to sue entirely.⁶¹

V. CONCLUSION

The circuit courts struggle to consistently interpret “registration” under Section 411 of the Copyright Act. Ultimately, the plain language of the Section

50. See 17 U.S.C. § 411(a).

51. See H.R. REP. NO. 94-1476, at 158 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5774.

52. See *id.*

53. Astle, *supra* note 46, at 481.

54. *Id.*

55. *Id.*

56. *Id.*

57. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 620 (9th Cir. 2010).

58. *Id.* Section 411(a) allows a copyright holder to bring an infringement suit even if the application was denied. 17 U.S.C. § 411(a). Thus, the Copyright Office’s final decision has nothing to do with *whether* an infringement suit can be brought, only *when* a suit can be brought. See *id.*

59. See Astle, *supra* note 46, at 484.

60. 17 U.S.C. § 507(b).

61. *Cosmetic Ideas*, 606 F.3d at 620.

requires actual registration by the Register of Copyrights in order to bring an infringement suit. This result can lead to unfair and inefficient results. Therefore, Congress should amend Section 411 to allow copyright holders with pending applications to bring an infringement lawsuit.