What's the Problem Money Can't Solve? Why Determining the Validity of a Copyright Application is a Clear Precondition to Infringement Action

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INTRODUCTION

It is no secret. A conflict exists between idealism and reality. The conflict, raging throughout millennia, permeates almost every aspect of human interaction. The effects, in fact, of over striking one perspective at the expense of the other causes unbalance, confusion, and profligacy. Unrestrained idealism, for example, breeds naive pragmatism, unnecessary change, and wasteful inefficiency. Overshadowing reality bordering on formalism, however, precipitates dogmatic rigor, hesitancy to evolve, and stifled growth. Formalism, as one legal scholar postulated, “[t]ends to straitjacket the government's ability to respond to new needs in creative ways, even if those ways pose no threat to whatever might be posited as the basic purposes of the constitutional structure.”

The United States Congress struck the appropriate balance between idealism and reality when enacting the Copyright Act of 1976 because the Act proscribes inefficiency while simultaneously securing copyright fortification. The Act proscribes inefficiency by codifying a procedure whereby the United States Register of Copyrights must first determine the copyrightability of a submitted work instead of forcing federal courts to do so. Conversely, the Act fortifies copyright protections through, inter alia, predicking prima facie copyright validity

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2 Id. at 454.
4 Id.
5 Id.
subsequent to registration, providing for statutory damages and attorney’s fees when copyright infringement occurs, and by maintaining a copyright registry.9

Indeed, issue lies with late applicants subjugating the congressionally mandated registration process by selfishly carving out a perceived ambiguity from within the Act itself where, in fact, none exists.10 These applicants, beguilingly cloaked under terms such as “pragmatic,” “practical,” and “idealistic” refer to their created ambiguity as “legal limbo.”11 “Legal limbo,” paraphrasing Nimmer on Copyright, is the time in space between delivering a validly compiled copyright application with the Copyright Office and the Register of Copyrights issuing, or refusing to issue, a certificate of registration.12

Legal limbo, a term unfounded in jurisprudence, is the cornerstone concept supporting the idealist argument because Section 411(a) of the Act proscribes a copyright applicant from bringing forth an infringement action absent a certificate of copyright registration, or a refusal of registration, from the Register of Copyrights.13 Therefore, because registration, idealists argue, attaches retroactively to a submitted work at the moment a validly compiled application is deposited with the Copyright Office, the wait for a registration certificate is “just the type of needless formality Congress generally worked to eliminate in the 1976 Act.”14

9 See generally Circular 1.0810, Copyright Basics, United States Copyright Office, Aug. 2011.
10 The term “late applicant” refers to those creators who file an application for registration with the Copyright Office greater than three months subsequent to publishing their work or after alleged infringement of the work occurs. See e.g. Weitzman, LLC, v. Microcomputer Res. Inc., 542 F.3d 859, 863 (11th Cir. 2008) (holding that anticipatory copyright infringement suits are governed by the same prerequisite of registration as if the defendant had asserted a claim of copyright infringement and “that neither side can sue for infringement until the relevant materials have been registered consistent with Section 411(a) of the Copyright Act”).
12 Id.
14 Cosmetic Ideas, Inc. v. IAC/InterActiveCorp, 606 F.3d 612, 620 (9th Cir. 2010). The Court’s assertion here is unfounded, however, because it contradicts Congress’ express intent that “registration should be attempted and granted or denied by the Copyright Office before suit for copyright infringement can be maintained.” See supra 134 Cong. Rec. H10091, H10096 (daily ed. Oct. 12, 1988) (statement of Rep. Kastenmeier).
Conceded, “there is something “uneconomic” about dismissing a complaint simply because the plaintiff does not have a certificate of registration, especially when the plaintiff, under Section 411(a), will be allowed to sue even if the Copyright Office denies the registration and refuses to issue the certificate.”\textsuperscript{15} However, “to read the [Act] to mean that registration occurs when the applicant files his materials would be to misread and render superfluous numerous provisions of the Copyright Act, perhaps most notably Section 411(a), which provides the procedure for how a lawsuit may still be filed even if registration is refused by the Copyright Office.”\textsuperscript{16} Therefore, because copyright registration, after examination, attaches retroactively to the time of deposit, it does not necessarily follow that copyright registration automatically attaches to a work immediately on deposit because the retroactivity and effectuation of copyright registration occurs only \textit{after} the Register of Copyrights first examines the work and determines its validity.\textsuperscript{17} Findings to the contrary, as a result, render other provisions of the Act superfluous and unnecessary.

Idealists, however, ignoring superfluous implications imposed on the Act instead argue that the determinations of a submitted work by the Register of Copyrights are a senseless formality and should not impede suit because one may, regardless of the Register’s findings, commence an infringement action.\textsuperscript{18} On this basis, idealists proclaim the requisite standing to bring forth an infringement action attaches the moment a copyright applicant deposits an application and fee with the Copyright Office. The Tenth Circuit refers to this modality as the “application approach.”\textsuperscript{19}

\textsuperscript{15} Specific Software Solutions, LLC v. Institute of Workcomp Advisors, 615 F. Supp. 2d 708, 715 (M.D. Tenn. 2009).
\textsuperscript{16} \textit{Id}.
\textsuperscript{17} 17 U.S.C. § 410(a) (2006).
\textsuperscript{18} \textit{See} La Resolana Architects, PA v. Clay Realtors Angel Fire, 416 F.3d 1195, 1203 (10th Cir. 2005), \textit{abrogated in part on other grounds by} Reed Elsevier, Inc. v. Irvin Muchnick, 130 S. Ct. 1237 (2010).
\textsuperscript{19} \textit{Id}.
Alternatively, ardent readers of the Act illustrate that registration effectuates, indeed retroactively, to the time of deposit only after the Copyright Office receives the application, determines its validity, and issues a registration certificate.\(^{20}\) These readers, moreover, note that although one may commence an infringement action despite the Register’s findings, the law authorizes commencement only after the Register of Copyrights makes its determinations.\(^{21}\) This perspective is deemed the “registration approach.”\(^{22}\)

The Supreme Court has yet to decide on the issue of whether registration effectuates on deposit of the work with the Copyright Office or after the Register of Copyrights examines the submission and issues or denies a certificate of registration.\(^{23}\) Consequently, a split exists among the Circuits since the inception of both the application and registration approaches.\(^{24}\) The Tenth and Eleventh Circuits, adhering to the plain language of the Act, hold that a work is registered once the Copyright Office examines the validity of an application and issues a certificate of registration.\(^{25}\) Moreover, although the “Second Circuit has not addressed this specific question,” cases emerging from various district courts within the Second Circuit seem to advocate the registration approach as well.\(^{26}\) The Fifth, Seventh, and Ninth Circuits, conversely, collectively

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20 Id. at 1202
21 Id.
22 Id.
23 See Reed Elsevier, Inc. v. Irvin Muchnick, 130 S. Ct. 1237, 1249 (2010) (declining to “address whether § 411(a)’s registration requirement is a mandatory precondition to suit…”).
24 See Juan Point Lezica v. Cumulus Media, Inc., 2010 U.S. Dist. LEXIS 16108, at * 7 (M.D. Tenn. February 23, 2010) (recognizing that “there is a split of opinions among the Circuit Courts…” between the application and registration approaches).
25 See La Resolana Architects, PA, 416 F.3d at 1208; M.G.B. Homes, Inc. v. Ameron Homes, Inc., 903 F.2d 1486, 1489 (11th Cir. 1990), abrogated in part on other grounds by Reed Elsevier, Inc. v. Irvin Muchnick, 130 S. Ct. 1237 (2010).
26 See K-Beech, Inc. v. Does 1-29, 2010 U.S. Dist. Lexis 143728, at * 5 (E.D.N.Y. September 19, 2010) (observing that “the emerging consensus among courts in this district is that the mere filing of applications and payment of the associated fees is insufficient, as a matter of law, to meet the statutory requirement that a copyright be registered prior to the initiation of an infringement action”).
hold that registration occurs by merely delivering an application and required fee with the Copyright Office. 27  

Copyright aspirants advocating the application approach proclaim legal limbo is a sufficient basis to avoid awaiting a determination from the Copyright Office as to the copyrightability of a submitted work because it “avoids unnecessary delay in copyright infringement litigation, which could permit an infringing party to continue to profit from its wrongful acts.” 28 Instead, these applicants simply deliver an application with the Copyright Office and proceed directly toward infringement action in federal district court prior to the Register of Copyrights first determining the validity of the claim, thus forcing the judiciary to assume the role of a copyright registration clerk. 29  

This approach is manifestly unjust because it rewards procrastination, abrogates the authority of Congress, and causes wasteful inefficiency. Moreover, and regardless of any other reason, if either a federal court or the Register of Copyrights determines a work is indeed copyrightable, damages for infringement remain viable. 30 So again, what’s the problem money can’t solve?  

This article analyzes one segment of the Copyright Act; the determination of whether a plaintiff satisfies the condition precedent by merely filing an application for registration with the Copyright Office or whether the Copyright Office must examine the application and issue a certificate of registration before the plaintiff can maintain a lawsuit for copyright infringement. The author recognizes that “any call for a return to formalism…expose[s] one to the barrage of

27 See, Apple Barrel Prods., Inc. v. Beard, 730 F.2d 384, 386-87 (5th Cir. 1984); Chicago Bd. of Educ. v. Substance Inc., 354 F.3d 624, 631 (7th Cir. 2003); Cosmetic Ideas, Inc. v. IAC/InterActiveCorp, 606 F.3d 612, 621 (9th Cir. 2010).
28 Cosmetic Ideas, Inc., 606 F.3d at 619.
29 Id.
30 17 U.S.C. § 504(a) “an infringer of copyright is liable for either… actual damages… or… statutory damages…”
ridicule…traditionally reserved by modern scholars for what is almost universally deemed…naïve methodology.”

The reader is reminded that this paper does not advocate strict formalism but instead a type of “street-smart mode of interpretation” recognizing the dangers of that an “idealistic” or “balancing” perspective of the Act precipitates.

Consequently, this paper advocates the position of practicality and fairness, the same position that Congress intended when enacting the Copyright Act of 1976; that copyright registration attaches after the Register of Copyrights examines the work.

Section I deconstructs and analyzes the plain language meaning of the Copyright Act of 1976 and sets forth the current legal framework by which registration is effectuated. It also contrasts jurisprudential interpretations regarding statutory analysis as it relates to copyright registration. Section II underscores the legislative intent behind the Copyright Act of 1976. In particular, Section II illustrates intrinsic inconsistencies embedded within the reasoning deployed to circumvent Congressional intent substantiating the Act. Section III concludes by highlighting two significant policy considerations regarding the mechanism of copyright registration that Congress enacted.

I. THE PLAIN LANGUAGE OF THE ACT EXPRESSLY MANDATES THE REGISTER OF COPYRIGHTS MUST FIRST EXAMINE AN APPLICATION AS A CONDITION PRECEDENT TO INFRINGEMENT ACTION

31 Martin H. Redish and Elizabeth J. Cisar, infra note 2.

Any call for a return to “formalism” in constitutional interpretation naturally will expose one to the barrage of ridicule and disdain traditionally reserved by modern scholars for what is almost universally deemed to be an epistemologically naïve methodology. It is important, however, to distinguish “epistemological” formalism from what we call, perhaps, oxymoronically “pragmatic” formalism. The former represents a commitment to a rigidity and level of abstraction that is quite possibly not possible, and that is certainly unwise. “Pragmatic formalism” on the other hand is a “street-smart” mode of interpretation, growing out of a recognition of the dangers to which a more “functional” or “balancing” analysis of the separation of powers may create.

32 Id.

The plain language of the Act is clear. A copyright is registered only after the Copyright Office has first determined the validity of an application and issued a certificate of registration.\textsuperscript{34} Moreover, Congress demonstrated that registration is not completed solely by submitting a copyright application because it placed affirmative burdens of both examination and registration on the Copyright Office subsequent to deposit of the compiled application.\textsuperscript{35}

The Genesis supporting this conclusion must originate with the plain language itself.\textsuperscript{36} Moreover, when “the terms of a statute are unambiguous, then judicial inquiry is complete.”\textsuperscript{37} Here, the statute is unambiguous and manifestly clear, the plain language of the Act mandates the predetermination of whether a work is copyrightable or not prior to a plaintiff bringing forth an infringement action in federal court.\textsuperscript{38}

The United States Constitution vests Congress with the authority to regulate copyright protection.\textsuperscript{39} Congress validly exercised their authority when enacting the Copyright Act.\textsuperscript{40} The Act, thereafter, provides a procedural process towards securing copyright protections over a submitted work.

Section 101 of the Act defines registration as “[the] registration of a claim in the original or the renewed and extended term of copyright.”\textsuperscript{41} The language, therefore, simply defines registration as the “registration of a claim.”\textsuperscript{42}

\begin{itemize}
  \item[34] Id.
  \item[35] Id.
  \item[36] See Robinson v. Shell Oil Co., 519 U.S. 337, 340 (1997) (holding that “[o]ur first step in interpreting a statute is to determine whether the language at issue has a plain and unambiguous meaning with regard to the particular dispute in the case”).
  \item[38] 17 U.S.C. §§ 410(a) – 411(a) (2006).
  \item[39] U.S. CONST. art. I, § 8, cl. 8.
  \item[40] See Reed Elsevier, Inc., 130 S. Ct. at 1241 (finding that “[e]xercising [their Constitutional] power, Congress has crafted a comprehensive statutory scheme governing the existence and scope of “[c]opyright protection” for “original works of authorship fixed in any tangible medium of expression”).
  \item[42] Id.
\end{itemize}
The next procedural statute, Section 408, instructs the applicant of the process to obtain the “registration of a claim.” In particular, “[t]he owner of copyright…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…”

Again, the language is patently clear. The owner of a copyright “may obtain registration…by delivering…the deposit…application and fee” with the Copyright Office. This section, therefore, instructs the applicant that in order to obtain the registration of a claim, as defined in Section 101, the applicant must first deliver to the Copyright Office: (1) the work, (2) an application, and (3) the appropriate fee. However, neither Section 408 nor any other section of the Act instructs the applicant that copyright registration attaches to a submitted work immediately upon deposit of the application and requisite materials with the Copyright Office.

However, section 410(a) continues by clearly defining the moment at which “the registration of a claim” occurs. The registration of a claim occurs:

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.

A clear reading of Section 410(a) precipitates clarity that the Copyright Office shall register a claim only after its examination is complete. Section 410(a), therefore, presents manifest inconsistency with any contrary finding that merely depositing an application with the Copyright Office constitutes registration because the statute itself mandates an examination of

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43 Id.
45 Id.
46 Id.
the deposited materials prior to registering the copyright. Additionally, registration or refusal of copyright registration after examination is a mandatory precondition to an infringement action.\textsuperscript{48}

The language is unambiguous, “[w]hen, \textit{after examination}...the Register shall register...and issue...a certificate of registration (emphasis added).”\textsuperscript{49} Therefore, the \textit{after examination} clause in the preceding sentence, and not upon deposit, is the precise affirmative act that must be satisfied prior to granting registration. Only afterward does registration effectuate retroactively to when the application was first deposited with the Copyright Office.\textsuperscript{50}

Holdings to the contrary, therefore, abrogate the plain meaning of the clause \textit{after examination} because it robs the Copyright Office of their statutory mandate to first determine whether “the material deposited constitutes copyrightable subject matter.”\textsuperscript{51} Consequently, unless the Copyright Office issues or denies a certificate of registration after examination, the ensuing registration of a claim is ineffective and the applicant enjoined from pursuing infringement action.

\textbf{A. Wailing and Gnashing of Teeth! Section 411(a) Requires Copyright Registration, or a Refusal of Registration, as a Condition Precedent to an Infringement Action}

To claim copyright infringement an owner must demonstrate “(1) ownership of a valid copyright in a work, and (2) the copying of elements of the work that are original.”\textsuperscript{52} Additionally, Section 411(a) of the Act requires “copyright holders to register their works before suing for copyright infringement.”\textsuperscript{53} Specifically:

\textit{No civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration

\textsuperscript{50} 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 Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.”
\textsuperscript{52} K-Beech, Inc., 2010 U.S. Dist. LEXIS 143728 at *3.
\textsuperscript{53} Reed Elsevier, Inc. 130 S. Ct. at 1241.
of the copyright claim has been made in accordance with this title.\textsuperscript{54}

A plain reading of the first sentence of Section 411(a) clearly states that a copyright infringement action shall not be brought for any United States work “until registration of the copyright claim has been made...”\textsuperscript{55} Moreover, registration occurs after examination of the submitted work by the Copyright Office.\textsuperscript{56} Therefore, the Act clearly predicates some degree of affirmative action on the part of the Copyright Office as a mandatory precondition that must be satisfied prior to initiating a copyright infringement claim.

A reverse analysis of each step represented in the Act preceding Section 411(a) substantiates the conclusion that examination precipitates the mandatory issuance or refusal of a registration certificate.\textsuperscript{57} Section 408(a) directs the applicant to obtain registration of a claim by delivering the application and fee with the Copyright Office.\textsuperscript{58} And Section 101 defines registration as “the registration of a claim...”\textsuperscript{59} The Act, therefore, provides a clearly defined procedure toward obtaining copyright registration of a submitted work and, subsequent to registration, the requisite capacity to bring an infringement action in federal court.

The process of registration is clearly and sequentially delineated in the Act. Copyright registration simply means the “registration of a claim.”\textsuperscript{60} To obtain the “registration of a claim,” an applicant must deposit the work, the application, and fee with the Copyright Office.\textsuperscript{61} The registration of a claim effectuates after examination of the requisite materials and a

\begin{flushleft}
\textsuperscript{55} Id.
\textsuperscript{56} 17 U.S.C. § 410(a) (2006).
\textsuperscript{57} Id.
\textsuperscript{58} 17 U.S.C. § 408(a) (2006).
\textsuperscript{60} Id.
\textsuperscript{61} 17 U.S.C. § 408(a) (2006).
\end{flushleft}
determination by the Copyright Office.\textsuperscript{62} Thereafter, the registration of a claim affixes retroactively to the date of deposit and after an acceptable determination by the Copyright Office.\textsuperscript{63} Finally, the Act enjoins infringement action until “registration of the copyright claim has been made…”\textsuperscript{64}

Arguments, therefore, positing that registration predicates the standing necessary to bring an infringement action by merely depositing an application with the Copyright Office ignores the plain language meaning of the Act because the Copyright Office must first pass, in some capacity, to determine the copyrightability of a submitted work. Additionally, the capacity of a copyright applicant to bring an infringement action in federal court fails absent a certificate of registration, or refusal thereof from the Copyright Office.\textsuperscript{65}

Conceded, registration is not a condition of copyright protection.\textsuperscript{66} Works automatically receive copyright protection created on or after January 1, 1978.\textsuperscript{67} Moreover, to protect a work outside of federal court, copyright holders remain unbound to pursue “state law claim[s] in tort for unfair competition, tortuous interference, or breach of contract.”\textsuperscript{68} However, a continuing analysis of Section 411(a), particularly the second sentence of the statute, confirms an additional affirmative act on the Register of Copyrights prior to entitling an applicant to institute an infringement action.

Section 411(a) continues:

\textsuperscript{64} 17 U.S.C. § 411(a) (2006).
\textsuperscript{65} See Corbis Corp. v. UGO Networks, Inc., 322 F. Supp. 2d 520, 521-22 (S.D.N.Y. 2004) (holding that a work is not registered within the meaning of Section 411(a) unless and until “the Copyright Office has either approved or refused the pending application for registration”) abrogated in part on other grounds by Reed Elsevier, Inc. v. Irvin Muchnick, 130 S. Ct. 1237 (2010).
\textsuperscript{67} Id.
\textsuperscript{68} La Resolana Architects, PA, 416 F.3d at 1199.
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 (emphasis added).\(^{69}\)

Therefore, in addition to a certificate of registration, the refusal of copyright registration also satisfies the condition precedent necessary to initiate an infringement action. Hence, this sentence would be redundant if merely depositing an application with the Copyright Office automatically conferred copyright registration on a submitted work.

As the Court in *Specific Software Solutions, LLC* correctly noted, “if a party could file an infringement suit merely upon filing his application for registration, there would be no need to include a provision [in the Act] stating that suit could be maintained after the application is refused.”\(^{70}\) Therefore, if simply depositing an application satisfied the condition precedent, the second clause of Section 411(a) would be unnecessary and superfluous. As a result, a plaintiff is enjoined from bringing an infringement action without the Copyright Register taking some affirmative action, either first determining the validity of an application or refusing the registration completely.

\section*{B. Verb Confusion: “May” is Permissive, “Shall” is Definitive, and Independently They Are Conspicuously Clear}

\(^{70}\)See *Specific Software Solutions, LLC*, 615 F. Supp. 2d at 713 (citing Ripple Junction Design Co. v. Olaes Enters., 2005 U.S. Dist. LEXIS 32866 (S.D. Ohio Sept. 8, 2005)). The Court also notes that § 411(a) provides that an infringement suit may be initiated after the application for registration is refused. If a party could file an infringement suit merely upon filing his application for registration, there would be no need to include a provision stating that a suit can be maintained after the application is refused. A party could simply file suit when he filed his application for registration and it would make no difference whether the application was granted or refused in terms of satisfying the condition precedent.
The verb “may” is permissive. It denotes capacity to file or not file a claim. The verb “shall,” however, is restrictive. It predicates a mandatory or affirmative duty. Section 408(a) of the Act provides “the owner of copyright…may obtain registration of the copyright claim by delivering to the Copyright Office the deposit…together with the application and fee…” Section 410(a) continues stating that “[w]hen, after examination, the material deposited constitutes copyrightable subject matter…the Register shall register the claim.” These two verbs, may and shall, are mutually exclusive and independent within the context of the Act because although a copyright applicant may permissively obtain registration of a claim by depositing a valid application with the Copyright Office, the Register shall, after examination, register the claim.

Idealists advocating the application approach argue that the verb “may” is confusing because it seeds an expectation in the applicant’s mind that merely depositing a valid application is the sole statutory requirement toward obtaining copyright registration. The Ninth Circuit, in Cosmetic Ideas, Inc. v. IAC/InterActiveCorp., specifically found that the wording of Section 408 confuses the distinction between the application and registration approach because the statute implies the sole requirement for obtaining registration is delivery of the appropriate documents and fee.

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71 See United States v. Bankers Ins. Co., 245 F.3d 315, 320 (4th Cir. 2001) (holding that the phrase “may” is permissive and “refer[s] to…giving an aggrieved party the choice between arbitration and abandonment of his claim”).
72 Id.
73 See Tm Delmarva Power v. Ncp of Va., 263 Va. 116, 121 (Va. 2002) (holding that “shall is primarily mandatory in effect…”).
74 Id.
77 See Cosmetic Ideas, Inc., 606 F. 3d at 620 (holding that “§ 408 blurs the line between application and registration and favors the application approach [because the term may register] implies that the sole requirement for obtaining registration is delivery of the appropriate documents and fee”).
78 Id.
It is true. The sole requirement imposed upon an applicant to register a work is to deposit an application and fee with the Copyright Office.\(^79\) Moreover, Section 408(b) specifies the material that must accompany the application.\(^80\) However, it does not inevitably follow that merely depositing a completed application and fee with the Copyright Office is the sole requirement necessary to confer copyright registration on a submitted work because the Act imposes \textit{two} affirmative duties on \textit{two} distinct entities prior to the registration of a work.

First, an applicant desiring copyright registration has the responsibility of depositing an application and fee with the Copyright Office.\(^81\) Afterward, the Copyright Office has an affirmative duty to examine the application prior to registering the work.\(^82\) It is only after this examination that the Copyright Office shall issue a certificate of registration if it first determines the application is valid and the work indeed copyrightable.\(^83\) Moreover, copyright applicants are enjoined from bringing an infringement action without the Register of Copyright first examining an application and passing on its vitality.\(^84\) Therefore, although an applicant may obtain copyright registration by depositing the requisite materials with the Copyright Office, the Copyright Office shall, after examination, issue a certificate of registration. Consequently, these two conditions must be met prior to conferring registration on a copyrightable work.

\(^80\) 17 U.S.C. § 408(b) Deposit for copyright registration.

Except as provided by subsection (c), the material deposited shall include --
(1) in the case of an unpublished work, one complete copy or phonorecord;
(2) in the case of published work, two complete copies or phonorecords of the best edition;
(3) in the case of a work first published outside the United States, one complete copy or phonorecord as so published;
(4) in the case of a contribution to a collective work, one complete copy or phonorecord of the best edition of the collective work.

\(^83\) \textit{Id}.  
The Court in *Treadmilldoctor.com, Inc., v. Don Johnson* correctly clarified the applicability of these conditions. Following the plain language of the Act, the Court in *Treadmilldoctor.com* found that:

> [T]he registration requirement does not divest federal courts of subject-matter jurisdiction over copyright infringement claims where the copyright holder has failed to comply with the registration requirement. Instead, the “registration requirement is a precondition to filing a claim that does not restrict a federal court’s subject-matter jurisdiction.” A “precondition” is “something that must exist before something else can come about.” Webster’s Third New International Dictionary 1785 (1986). [Therefore,] “[w]hen a plaintiff files a copyright infringement action before preregistration or registration of the copyright claim has occurred, the “precondition” required by Section 411(a) is not satisfied.”

Based on the plain language of the Act, simply depositing a valid application with the Copyright Office is not the sole requirement predating copyright registration because it does not satisfy the precondition imposed by Section 411(a) requiring the Register of Copyrights to first examine the application itself. Moreover, depositing a work and immediately filing an infringement action abrogates the duty of the Copyright Office to examine the work prior to issuing a certificate of registration.

Although the copyright applicant *may* register a claim by depositing an application, appropriate fee, and copy of the work with the Copyright Office, it is only *after examination* that the Register of Copyrights *shall* issue a certificate of registration. Thence may the applicant bring suit for infringement or, alternatively, after a refusal of copyright registration.

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86 Id.

87 *See generally* Melville B. Nimmer and David Nimmer, *Nimmer on Copyright*, § 7.16[B][3][b][iii] (2010) (stating that “[i]t serves no rational purpose to require a party to wait until the Office eventually accepts or denies the application before initiating suit because § 411(a) permits a party to bring a claim even if the Office refuses the application.”) To the contrary, § 411(a) makes perfect sense because the utility of a plaintiff successfully obtaining a judgment is greatly diminished subsequent to the refusal of copyright registration for a submitted work and that, as a result, precious judicial resources are not otherwise wasted. Ironically, however, courts relying on *Nimmer on*
C. The Act, Read in Its Entirety, Distinguishes Between Application and Registration

The Supreme Court holds that “[w]hen interpreting the meaning of statutory text, courts first look to the plain meaning of the language.” However, “[i]f the text remains ambiguous, courts then consider the statute as a whole to interpret the ambiguity.” When considering the Act in its entirety, it becomes manifestly clear that mere application for copyright does not automatically confer registration upon the work because other sections of the Act require the Register of Copyrights to act in some capacity prior to issuing a certificate of registration retroactively effective to the date of deposit.

Pursuant to Section 410(a) of the Act:

When, after examination, the Register of Copyrights determines that the material deposited constitutes copyrightable subject…\text{the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office.}

The term “shall register” imposes an affirmative role on Copyright Office in the registration process. Additionally, Section 408(a) levies a duty on the Register of Copyrights to first examine the application prior to issuing a certificate of registration. This conveys the notion that registration is not simply accomplished by merely depositing an application alone.

Moreover, Section 410(b) corroborates the distinction between application and registration. In particular:

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

\textit{Copyright}, a secondary source, to substantiate the application approach fail to engage in the necessary canons of statutory interpretation.


89 \text{Kokoszka v. Belford, 417 U.S. 642, 650 (1974).}


91 \text{See Cosmetic Ideas, Inc., 606 F.3d at 617 (holding that Section 410(a) “places an active burden of examination and registration upon the Register, suggesting that registration is not accomplished by application alone”) (referencing Loree Rodkin Mgmt. Corp. v. Ross-Simmons, Inc. 315 F. Supp. 2d 1053, 1055 (C.D. Cal. 2004)).}
and shall notify the applicant in writing of the reasons for such refusal.\footnote{17 U.S.C. § 410(b) (2006).}

Again, the Act imposes an affirmative duty on the Register of Copyrights to first make a determination and then “register the claim” or “refuse registration.”\footnote{Id.} This fact is the \textit{sine qua non} of registration because the capacity of “the Register’s discretion to refuse copyright registration “drives an iron wedge” between mere application and actual registration.”\footnote{La Resolana Architects, PA, 416 F. 3d 1202 (quoting Loree Rodkin Mgmt. Corp. v. Ross-Simmons, Inc., 315 F. Supp. 2d 1053, 1056 (C.C. Cal. 2004)).}

Next, supporting the distinction between application and registration, Section 410(d) illustrates that:

\begin{quote}
[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.\footnote{17 U.S.C. § 410(d) (2006).}
\end{quote}

Section 410(d) does not read that the \textit{registration date} is the date on which an application, deposit, and fee are delivered to the Copyright Office. Instead, this section reads that \textit{the effective date} is the date of receipt. Registration, therefore, is the condition that occurs after the Register of Copyrights examines the application and subsequently “the registration is backdated to the time the time the application was received.”\footnote{La Resolana Architects, PA, 416 F.3d at 1201.}

Backdating the registration to the date of deposit provides the Register of Copyrights with the opportunity to, \textit{inter alia}, first examine the validity of the application, determine whether the work is copyrightable, and to catalogue the work as mandated by Congress.\footnote{See generally Circular 1.0810, \textit{Copyright Basics}, United States Copyright Office, Aug. 2011.}  As the
Court in *Treadmilldoctor.com, Inc.* correctly noted “[t]he plain language of the statute thus requires a series of affirmative steps by both the applicant and the Copyright Office.”

As a result of the plain language of the Act, the preceding steps are required to register a work and to confer standing to bring an infringement action in federal court. First, one must file the application and requisite fee. Second, one must deposit a copy of the work with the Register of Copyright. Third, The Register of Copyrights must examine the deposited materials to determine whether the work constitutes copyrightable materials and that the work complies with other legal and formal requirements. Lastly, the Register of Copyrights must register or refuse to register the work. No implication exists anywhere in the plain language of the Act reflecting that copyright registration occurs immediately upon deposit of an application with the Copyright Office.

II. CONGRESS INTENDED FOR THE COPYRIGHT OFFICE TO FIRST DETERMINE THE COPYRIGHTABILITY OF A SUBMITTED WORK PRIOR TO THE INITIATION OF AN INFRINGEMENT ACTION

Congressional intent, substantiating the plain language of the Act, imposes a series of affirmative duties on the Copyright Office to first examine a submitted work prior to registration and after examination issue or refuse to issue a certificate of registration. Moreover, this examination is a mandatory precondition that must occur prior to a plaintiff filing an infringement action.

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102 Id.
103 See Specific Software Solutions, LLC, 615 F. Supp. 2d at 716.

Plainly, Congress intended a scheme in which, before an entity could sue on a claim of copyright infringement, the Copyright Office would be entitled to pass, in an essentially non-binding manner, on the vitality of the copyright. Obviously such a system will cause some inevitable delays in litigation, but Congress apparently felt those delays were worth the benefit of the Copyright Office having an initial chance to pass judgment.
infringement action.\textsuperscript{104} To understand this assertion, courts should not “operate under an artificially induced sense of amnesia and ignore the Congressional intent of a statute,” but must instead “consistently look to Congressional intent each time they interpret the plain meaning of a statute.”\textsuperscript{105} Therefore, whenever a court interprets a statute, the Act in this case, it is compelled to look at the underlying Congressional intent to interpret its meaning.

Here Congressional intent is manifestly clear and consistent with the plain language of the Act. First, Congress expressed a specific desire for the Register of Copyrights to predetermine the validity of a copyright claim prior to a plaintiff commencing infringement action. Second, supporting the first conclusion, Congress created incentives for applicants to voluntarily register their works prior to bringing infringement actions.

A. Congress Expressed Their Desire that Copyright Registration, or the Refusal of Registration, Precede an Infringement Action

Congress, in 1988, amended the Copyright Act of 1976 by enacting the Berne Convention Implementation Act.\textsuperscript{106} The Berne Convention sought to standardize international copyright by “eliminat[ing] most, if not all, formalities that are required to obtain and enforce copyrights.”\textsuperscript{107} To comply with the Berne Convention, the Act exempted “certain foreign works from the registration requirement.”\textsuperscript{108} In response, a Senate bill attempted to eliminate registration formalities by entirely removing the registration statute from the Act, which failed.\textsuperscript{109} Disagreeing with the Senate bill, Congress mused “[t]he House would have preferred to make no change to section 411.”\textsuperscript{110} Congress, however, compromised by creating an exception for

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\textsuperscript{105} Amalgamated Transit Union Local 1309 v. Laidlaw Transit Servs., 448 F.3d 1092, 1093 (9th Cir. 2006).
\textsuperscript{107} La Resolana Architects, PA, 416 F.3d at 1205-06.
\textsuperscript{108} \textit{Id.}
\textsuperscript{109} S. 2904, 99th Cong., 2nd Sess. (1986) (introduced by Sen. Mathias (R-MD)).
\end{flushright}
foreign works while leaving untouched the copyright registration requirement for United States derived works.\footnote{Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853.}

Congress justified upholding within the Act the registration requirement over United States works by expressly stating that “\textit{registration should be attempted and granted or denied by the Copyright Office before suit for copyright infringement can be maintained}” (emphasis added).\footnote{134 Cong. Rec. H10091, H10096 (daily ed. Oct. 12, 1988) (statement of Rep. Kastenmeier).} The Senate, corroborating the same sentiment, said “the fact remains that a review by the Copyright Office of the validity of a copyright claim is a \textit{necessary precondition} for enforcement of copyright protection (emphasis added).”\footnote{S. Rep. No. 100-352, at 5 (1988).} The Supreme Court, moreover, held that “[t]here is, of course, no more persuasive evidence of the purpose of a statute than the words by which the legislature undertook to give expression to its wishes.”\footnote{United States v. Am. Trucking Ass’ns., Inc., 310 U.S. 534, 543 (1940).}

Indeed, no more persuasive evidence of Congressional intent exists than their own words which expressly requires the Copyright Office to first pass on the vitality of an application prior to the initiation of an infringement action. When implementing provisions of the Berne Convention, Congress could have vitiated the registration requirement entirely from the 1976 Copyright Act, but it did not. Instead, Congress chose to leave the registration requirement of Section 411(a) intact and, moreover, particularly amplified an expression of its intent behind Section 410(a). Congress’ words expressing their intention is, therefore, manifest. The question then arises as to how those advocating the application approach reconcile their position with Congress’ express intent that “registration should be attempted and granted or denied by the
Copyright Office before suit for copyright infringement can be maintained.”

Indeed, a high and difficult (this paper submits, an irreconcilable) hurdle to overcome.

Undeniably, idealists advocating the application approach seek to vitiate the registration precondition expressly mandated by Congress by citing “inefficiency,” “needless formality,” and “loss of the ability to sue.” However, in light of express Congressional intent to the contrary, these advocates are unable to reconcile the fact that although “such a system will cause some inevitable delays in litigation…Congress apparently felt those delays were worth the benefit of the Copyright Office having an initial chance to pass judgment.”

Therefore, despite inevitable delays, Congress clearly intended for the Copyright Office to first examine an application prior to issuing or denying a certificate of registration and that this examination is a mandatory precondition to a plaintiff bringing forth an infringement action.

B. Congressional Intent, Demonstrating that Registration is a Condition Precedent to Infringement Action, Is Evidenced by Incentives Embedded within the Act

If Congress intended to permit applicants to file infringement claims while their applications were pending, it would have expressed such intention. Instead, Congress codified their desire requiring the Register of Copyrights to first examine an application prior to a plaintiff commencing an infringement suit. Moreover, Congress afterward expressly galvanized their desire when implementing the Berne Convention. Supporting this conclusion, in addition to Congress’ express intent, are the statutory incentives the Legislature embedded within the Act to motivate applicants to voluntary register their claims prior to infringement action.

116 Cosmetic Ideas, Inc., 606 F. 3d at 620.
117 Specific Software Solutions, LLC, 615 F. Supp. 2d at 716, supra note 93.
First, registering a work with the Copyright Office establishes a public record of a copyright claim.\textsuperscript{120} Registration, therefore, provides the requisite public notice necessary to defeat an innocent infringement claim.\textsuperscript{121} This is important because statutorily no weight is granted to innocent infringement defenses of a previously registered work.\textsuperscript{122}

Second, registration confers prima facie evidence of the validity of the claim and the facts contained in the registration certificate.\textsuperscript{123} This is important because it alleviates courts, possessing freedom to grant evidentiary weight, from having to determine facts previously ascertained by the Register of Copyrights. Additionally, prima facie evidence of registration alleviates plaintiffs from having to first demonstrate the validity of their claim during infringement actions before a judiciary.\textsuperscript{124}

Lastly, and most significantly, both statutory damages and attorney’s fees are made available to those copyright owners who obtain registration within three months of publication or prior to an infringement action.\textsuperscript{125} In fact, Congress increased the statutory damages incentive

\textsuperscript{120} See 17 U.S.C. § 401(d) (2006)

\textsuperscript{121} Id.

\textsuperscript{122} Id.

\textsuperscript{123} See 17 U.S.C. § 410(c) (2006)

\textsuperscript{124} Id.

when implementing the Berne Convention. Specifically, “[i]n order to promote voluntary registration [Congress] doubles the statutory penalties (which were last set in the Copyright Reform Act of 1976).” Statutory penalties alone range from $750 to $150,000 per infringement. This is important because absent a statutory damage award, plaintiffs must prove actual damages to recover harms flowing from infringement. Proving actual damages is difficult at best because compiling the requisite proof is time consuming, resource intensive, and retrospective in nature. However, copyright registration makes available statutory damages as a remedy for infringement thereby eliminating the need to prove actual damages. Therefore, Congressional intent to register a work prior to bringing an infringement action is substantiated by the fact that special incentives are embedded in the Act. Moreover, supporting this argument is the fact that Congress doubled the statutory award for infringement of registered works when implementing the Berne Convention.

III. PUBLIC POLICY DEMANDS THE COPYRIGHT OFFICE MUST FIRST DETERMINE THE VITALITY OF AN APPLICATION PRIOR TO THE COMMENCEMENT OF A COPYRIGHT INFRINGEMENT ACTION

Indeed, jurisprudence and legal academia are replete with complex public policy arguments supporting both the application and registration approaches in regard to copyright registration. For example, “compliance with Berne,” “irrational,” “inefficient,” and “a robust
federal register” are but a few of the arguments presupposed. This paper, however, proffers the two most relevant arguments postulating that public policy mandates the Register of Copyrights must first determine the validity of a claim prior to an infringement action. These two policy arguments, supported by Congressional intent, are judicial efficiency and the judicial inconsistency.

A. Judicial Efficiency is Best Served by the Register of Copyrights First Examining a Work Prior to the Initiation of an Infringement Action

Federal courts are overburdened. Annually, a greater percentage of cases persist unresolved on a court’s docket than are closed. Senator Feinstein, recognizing the scarcity of judicial resources, introduced the Emergency Judicial Relief Act of 2011 and observed “[w]hen our courts become overburdened, we leave criminal matters in limbo, and civil litigants without resolution to their disputes.” Consistent with her observation, courts possess little resource to hear motions, pleadings, and other stipulations establishing copyright registration which could otherwise be resolved by the Copyright Office first making preliminary determinations, holding prima facie weight, regarding the validity of a submitted work.

Public policy, therefore, supports the position that the Register of Copyrights must first examine an application prior to the initiation of an infringement action because it relieves the judiciary of making these routine clerical determinations and, as a consequence, vacates its dockets. Moreover, Congress expressed support for this policy when stating that “these

\[\text{Registration; } \text{ a Critique of the Ninth Circuit’s Adoption of the “Application Approach” to Copyright Registration in Cosmetic Ideas, Inc. v. IAC/Interactive Corp, 79 U. Cin. L. Rev. 1547 (postulating that the registration approach best adheres to public policies of maintaining a robust register, fairness, judicial efficiency, and the formalities and accordance of the Berne Convention).}
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\[\text{131 See Cosmetic Ideas, Inc., 606 F.3d at 619.}
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\[\text{133 Id.}
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provisions [in the Act] are designed to relieve evidentiary burdens placed on Federal judges who must adjudicate copyright controversies (emphasis added).”\textsuperscript{135}

\textbf{B. Mandating the Register of Copyrights First Examine a Work Prior to a Plaintiff Initiating an Infringement Action Curtails Judicial Inconsistencies in Copyright Infringement Cases}

Congress sought to centralize copyright registration when enacting the Copyright Act of 1976.\textsuperscript{136} Moreover, by centralizing copyright registration Congress intended for “the Copyright Office to have a full opportunity to review the merits of a copyright application …”\textsuperscript{137} However, consider for a moment the application approach where an applicant gains the advantage of immediate presumptive copyright validity on application but after examination the material is later deemed not copyrightable.\textsuperscript{138} The presumption of validity would, therefore modulate and unjustly enrich the applicant.\textsuperscript{139} As one court observed, “in order for a copyright owner to sue for infringement, it must register the copyright or file an application for registration, depending on the circuit in which the suit was filed.”\textsuperscript{140} This is the type of modulation in copyright litigation that the Act was designed to curtail.\textsuperscript{141} Therefore, a policy holding that the Copyright Office first determine the copyrightability of a work prior to infringement suit would preclude judicial inconsistencies because it would curtail differing opinions modulating between the courts.


\textsuperscript{137} Specific Software Solutions, LLC, 615 F. Supp. at 713.

\textsuperscript{138} See La Resolana Architects, PA, 416 F. 3d at 1205 (holding that the “[a]pplication approach allows for shifting legal entitlements…[where] an applicant could obtain the advantage of the presumption that the copyright is valid upon application…but then, after [an] examination determined the material is not copyrightable, the presumption of validity would swing back and forth”).

\textsuperscript{139} Id.

\textsuperscript{140} Specific Software Solutions, LLC, 615 F. Supp. at 710.

\textsuperscript{141} See La Resolana Architects, PA, 416 F. 3d at 1205, supra note 134.
CONCLUSION

Courts should follow the law and adhere to the plain language of the Copyright Act of 1976 finding, as a matter of practice, the capacity to commence an infringement action vests with an applicant only after the Register of Copyrights first examines the work and issues, or refuses to issue, a certificate of copyright registration. Moreover, courts should uniformly recognize that the time between depositing an application with the Copyright Office and obtaining a certificate of registration is the precise time that Congress intended the vetting process of an application to occur and, therefore, enjoined infringement action.

“There are three ways to argue a case.”142 “You can argue emotion.”143 “You can argue the facts.”144 “Or you can argue the law.”145 The emotional argument, in this instance, considers fairness. The factual argument considers copyright infringement. However, the purely legal argument, devoid of all emotion, presents manifest clarity and irreconcilable interpretation consistent with the Register of Copyright first examining an application as a condition precedent to a plaintiff commencing an infringement action. Absent a certificate of copyright registration, or a refusal thereof, the action fails.

142 Professor Omar Saleem, Criminal Procedure – Arrest and Investigation, Florida A&M University College of Law, Lecture, April 2011.
143 Id.
144 Id.
145 Id.