



Client Alert

March 5, 2019

Supreme Court Rules Copyright Registration Required to File Infringement Suit

The U.S. Supreme Court ruled on March 4, 2019 that a U.S. copyright owner can file an infringement suit only after the work has been registered by the Copyright Office. The Court also clarified the meaning of “registered.”

BACKGROUND

Copyright vests at the time that an original work is fixed in a tangible medium; however, federal law requires that certain steps be taken before a U.S. rights holder can file a copyright infringement action. Hanging on the meaning of the term “registration” is the ability of a copyright holder to bring suit as quickly as possible. If a work is infringed before the Copyright Office has acted on its application, the meaning of “registration” could create a delay of many months before the rights holder can enjoin the infringing use. This has led to a split among the Federal Circuits over the meaning of the term “registration.” The 5th and 9th Circuits have interpreted registration, for the purposes of the Copyright Act, to mean that a completed application has been submitted by a rights holder to the Copyright Office (the application approach); while the 10th and 11th Circuits have interpreted registration to mean that the Copyright Office has completed its examination process and the work has been registered (the registration approach).

DECISION

This week, the Supreme Court decided *Fourth Estate Media v. Wall-Street.com* by a unanimous ruling that resolved this split between the Federal Circuits. The Court determined that the Copyright Act’s requirement that a work be “registered” prior to filing a lawsuit means that the work must actually go through the Copyright Office’s registration process and become registered. It is not sufficient that the applicant has submitted a completed application for registration with the Copyright Office.

Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC

In District Court, the respondents filed a motion to dismiss, arguing for the “registration” approach. The District Court granted the respondent’s motion to dismiss without prejudice. On appeal, the 11th Circuit affirmed the ruling, stating that “filing an application does not amount to registration.” *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1339 (11th Cir. 2017). The opinion affirmed the District Court ruling that *Reed Elsevier* did not allow the “application” approach used by the 5th and 9th Circuits.

Prior to granting cert, the Supreme Court invited the U.S. Solicitor General to file a brief expressing the U.S. government's views on the issue. In its reply brief, the government rejected the application approach. "Registration" is interpreted from plain meaning to "refer to the Copyright Office's official recording of an accepted copyright claim."¹ In support of its opinion, the government argued that the exception created in the second provision in 17 U.S.C. 411(a) would be superfluous if an applicant was entitled to commence suit as soon as he had submitted the required materials."²

The petitioners responded to the government's brief by arguing against uniform definitions of "application" and "registration" by pointing to multiple constructions of the term "registration" in numerous provisions of the Copyright Act and by distinguishing the active and passive voices used in the Copyright Act. This position was ultimately rejected by the Supreme Court.

IN SUMMARY

Rights holders will experience higher incentives to seek registration. The registration requirement will also apply to the Digital Millennium Copyright Act notice and takedown, which requires a federal action under Section 411(a) in response to a counter-notice. Rights holders, such as software companies, publishers, and online content providers, will have an increased burden to delay publishing until registration has been recorded. When time is of the essence, rights holders may want to consider filing a request for expedited examination with the Copyright Office. If you have any questions regarding the impact of this decision on your rights, please contact COJK to learn more about protecting your intellectual property.

¹ Brief for the United States as Amicus Curiae, at Page 13.

² *Id.* at Page 15.

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