



# INTELLECTUAL PROPERTY AND INNOVATION AMERICAN INN OF COURT

Thursday, March 15, 2018

## Inn Luncheon Roundtable

### CLE Materials

#### Topic

*Fourth Estate Public Benefit Corp. v. Wall-Street.com* and When Copyright Registration Has Been Made

#### Facilitated By

Albany | Sarah Jaeger, Senior Associate, GE Licensing & Technology Ventures  
Syracuse | George McGuire, Member and Chairman, Intellectual Property and Technology  
Practice, Bond, Schoenck & King PLLC

#### Contents

17 U.S.C. § 411

*La Resolana Architects, PA v. Clay Realtors Angel Fire*

*Reed Elsevier, Inc. v. Muchnick*

*Cosmetic Ideas, Inc. v. LAC/Interactivecorp*

SCOTUSblog Coverage of *Fourth Estate Public Benefit Corp. v. Wall-Street.com*

*Fourth Estate Public Benefit Corp. v. Wall-Street.com*

The Deepening Appellate Divide Over When Copyright Owners Can Sue

SCOTUS Invites Solicitor General's Position on Copyright Registration Pre-Suit Requirement

Copyrights—An Overlooked IP Protection That Shouldn't Be Ignored

# 17 U.S. Code § 411 - Registration and civil infringement actions

US Code

Notes

[prev](#) | [next](#)

**(a)** Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b),<sup>[1]</sup> no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party to the action with respect to the issue of registrability of the copyright claim by entering an appearance within sixty days after such service, but the Register's failure to become a party shall not deprive the court of jurisdiction to determine that issue.

**(b)**

**(1)** A certificate of registration satisfies the requirements of this section and section 412, regardless of whether the certificate contains any inaccurate information, unless—

**(A)** the inaccurate information was included on the application for copyright registration with knowledge that it was inaccurate; and

**(B)** the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration.

**(2)** In any case in which inaccurate information described under paragraph (1) is alleged, the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.

**(3)** Nothing in this subsection shall affect any rights, obligations, or requirements of a person related to information contained in a registration certificate, except for the institution of and remedies in infringement actions under this section and section 412.

**(c)** In the case of a work consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission, the copyright owner may, either before or after such fixation takes place, institute an action for infringement under section 501, fully subject to the remedies provided by sections 502 through 505 and section 510, if, in accordance with requirements that the Register of Copyrights shall prescribe by regulation, the copyright owner—

**(1)** serves notice upon the infringer, not less than 48 hours before such fixation, identifying the work and the specific time and source of its first transmission, and declaring an intention to secure copyright in the work; and

**(2)** makes registration for the work, if required by subsection (a), within three months after its first transmission.

(Pub. L. 94-553, title I, § 101, Oct. 19, 1976, 90 Stat. 2583; Pub. L. 100-568, § 9(b) (1), Oct. 31, 1988, 102 Stat. 2859; Pub. L. 101-650, title VI, § 606(c)(1), Dec. 1, 1990, 104 Stat. 5131; Pub. L. 105-80, § 6, Nov. 13, 1997, 111 Stat. 1532; Pub. L. 105-304, title I, § 102(d), Oct. 28, 1998, 112 Stat. 2863; Pub. L. 109-9, title I, § 104(b), Apr. 27, 2005, 119 Stat. 222; Pub. L. 110-403, title I, § 101(a), title II, § 209(a)(6), Oct. 13, 2008, 122 Stat. 4257, 4264.)

**FILED**  
**United States Court of Appeals**  
**Tenth Circuit**

**February 17, 2009**

**Elisabeth A. Shumaker**  
**Clerk of Court**

PUBLISH

**UNITED STATES COURT OF APPEALS**

**TENTH CIRCUIT**

---

LA RESOLANA ARCHITECTS, PA,  
a New Mexico corporation,

Plaintiff-Appellant,

v.

RENO, INC., d/b/a Clay Realtors  
Angel Fire, a New Mexico  
Corporation; SOUTHWEST  
INVESTMENT TRUST, LP, a New  
Mexico Limited Partnership; LANCE  
K. CLAY, an individual; and GARY  
PLANTE, an individual,

Defendants-Appellees.

No. 06-2232

---

**Appeal from the United States District Court  
for the District of New Mexico  
(D.C. No. CIV-05-1017-PK)**

---

Kevin Lynn Wildenstein of Southwest Intellectual Property Services, LLC, Albuquerque, New Mexico (H. Brook Laskey and Gary Gordon of Miller Stratvert PA, Albuquerque, New Mexico, with him on the brief) for Plaintiff-Appellant.

Edward Ricco of Rodey, Dickason, Sloan, Akin & Robb, P.A., Albuquerque, New Mexico (DeWitt M. Morgan, Kurt B. Gilbert, and Todd E. Rinner of Rodey, Dickason, Sloan, Akin & Robb, P.A., Albuquerque, New Mexico; Randy S. Bartell of Montgomery & Andrews, P.A., Santa Fe, New Mexico; and Michael Plante, Albuquerque, New Mexico, with him on the brief) for Defendants-Appellees.

---

Before **BRISCOE, GORSUCH, and HOLMES**, Circuit Judges.

---

**HOLMES**, Circuit Judge.

---

Plaintiff-Appellant La Resolana Architects, PA, (“La Resolana”) brought an action against Reno, Inc., its president Lance Clay (collectively “Reno, Inc.”), Southwest Investment Trust, and its president Gary Plante (collectively “SWIT”) for copyright infringement, violation of the Lanham Act, and violation of the New Mexico Unfair Trade Practices Act (“UTPA”). After a bench trial, the district court entered judgment in favor of the defendants on all counts. We conclude that the district court did not clearly err in determining that La Resolana failed to establish copying as a matter of fact. Therefore, exercising jurisdiction pursuant to 28 U.S.C. § 1291, we **AFFIRM**.

### **I. BACKGROUND**

In late 1996, Reno, Inc. and SWIT were beginning the process of developing a residential housing complex in Angel Fire, New Mexico. In order to reduce costs, they wanted to build the homes out of prefabricated, modular segments which would only need to be combined and placed onto a foundation on site. They contacted Preferred Building Systems (“Preferred”), a company that specializes in the building of modular homes, about providing the prebuilt

segments. Preferred, in turn, enlisted the services of Earl Hilchey, an architect and the president of La Resolana, with whom Preferred often worked.

In December 1996, Lance Clay, president of Reno, Inc., and Gary Plante, president of SWIT, met with Larry Jones, a representative of Preferred, and Mr. Hilchey. The parties have markedly different recollections as to what happened at that meeting. Mr. Clay claims that, prior to the meeting, he already had a very detailed idea of how the homes should be built. Each building should “consist[] of two dwelling units, each with living space and a garage, built in the shape of a U. The garages [would occupy] the center of the structure and [would be] joined at the lot line, with the living spaces on either end forming the sides of the U.” Aplee. Br. at 4. The exterior was to be a combination of stucco and redwood siding. Mr. Clay claimed to have designed a basic floor plan and reportedly even knew such details as the location of the dormers, the size and shape of the windows, and the pitch of the roof. At the trial, Mr. Clay testified that he told all of this to Mr. Hilchey at the December meeting and even drew a sketch of what he wanted.

According to Mr. Hilchey, however, neither Mr. Clay nor Mr. Plante gave him any specific instructions. He testified that “they were looking for a home, no larger than 1200 square feet, typical two-bedroom, two-bath, and that was pretty much it.” Aplt. App. at 79.

After this initial meeting, there was an exchange of communications regarding a site development plan and other topics involving the Angel Fire development. Mr. Hilchey sent via facsimile at least five sets of architectural plans, each modified from the last and based primarily on communication with Mr. Plante. Mr. Hilchey admitted that he did not fax the plans directly to Mr. Plante; rather, he faxed three sets of plans to Mr. Plante's prior legal counsel and two sets of plans to a lawyer who was a potential investor. Mr. Plante testified that he never received any of the plans. After the spring of 1997, Mr. Hilchey heard nothing further from either Mr. Plante or Mr. Clay.

Mr. Hilchey also faxed a copy of the final plans to Mr. Jones of Preferred, who prepared a price quotation for Mr. Plante. Mr. Jones testified that it was his normal practice to send the architectural drawings along with the quotation. He could not remember, however, whether he did so in this case. Mr. Plante acknowledges that he received the quotation but denies receiving any drawings with it.

Mr. Clay submitted a proposal to the Village of Angel Fire for the use of modular homes in his development. Receiving a lukewarm reception, he decided to erect stick-built homes instead. To that end, Mr. Clay hired another architect, Charles Hasford, to draw site plans and architectural plans for the project. As with Mr. Hilchey, Mr. Clay claims to have provided Mr. Hasford a detailed drawing showing what he wanted his homes to look like.

In 2003, Mr. Hilchey saw what he thought looked like homes built from his earlier-developed architectural plans in Mr. Clay's development in Angel Fire. Mr. Hilchey's company, La Resolana, brought suit against Reno, Inc. and Lance Clay, as well as Southwest Investment Trust and Gary Plante, claiming copyright infringement, violation of the Lanham Act, 15 U.S.C. § 1125(a), and violation of the New Mexico UTPA, N.M. Stat. §§ 57-12-1 to -26. La Resolana seeks injunctive relief as well as damages.

After holding a bench trial, the district court recorded findings of fact and conclusions of law and entered judgment for Reno, Inc. and SWIT on all claims. La Resolana timely filed a notice of appeal.

## II. DISCUSSION

On appeal, La Resolana argues that Reno, Inc. and SWIT infringed La Resolana's copyright; that the district court erred in excluding lay opinion testimony regarding the substantial similarity between La Resolana's copyrighted work and Reno, Inc.'s plans; and that the district court erred in entering judgment for Reno, Inc. and SWIT on La Resolana's Lanham Act and UTPA claims. We agree with the district court that La Resolana has not established copying as a factual matter. As a result, and for the reasons noted below, La Resolana cannot prevail on this appeal.

"In an appeal from a bench trial, we review the district court's factual findings for clear error and its legal conclusions de novo." *Keys Youth Servs.*,



*Inc. v. City of Olathe, Kan.*, 248 F.3d 1267, 1274 (10th Cir. 2001). “Findings of fact are clearly erroneous when they are unsupported in the record, or if after our review of the record we have the definite and firm conviction that a mistake has been made.” *TransWestern Publ’g Co. v. Multimedia Mktg. Assocs., Inc.*, 133 F.3d 773, 775 (10th Cir. 1998) (internal quotation marks omitted). “If the district court’s account of the evidence is plausible in light of the record viewed in its entirety, the court of appeals may not reverse it even though convinced that had it been sitting as the trier of fact, it would have weighed the evidence differently.” *Anderson v. City of Bessemer City, N.C.*, 470 U.S. 564, 573-74 (1985). This admonition applies equally regardless of whether the district court’s factual findings are based on credibility determinations or on documentary evidence.<sup>1</sup> *Id.* at 574 (“Where there are two permissible views of the evidence, the factfinder’s choice between them cannot be clearly erroneous. This is so even when the

---

<sup>1</sup> La Resolana argues that in copyright cases, the district court’s factual findings as to whether the allegedly infringing work is substantially similar to the copyrighted material should be reviewed *de novo*. This is the approach adopted by the Second Circuit. *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 766 (2d Cir. 1991) (“In considering substantial similarity between two items, we review the district court’s findings *de novo*—not on the clearly erroneous standard—because what is required is only a visual comparison of the works, rather than credibility, which we are in as good a position to decide as was the district court.”). Most of the other circuits apply the clear error standard. See *Taylor Corp. v. Four Seasons Greetings, LLC*, 403 F.3d 958, 964-66 (8th Cir. 2005) (collecting cases). Because we affirm the district court’s judgment based on its finding that the defendants did not have access to La Resolana’s copyrighted plans, we do not reach the question of whether the two sets of architectural drawings are substantially similar.

district court's findings do not rest on credibility determinations, but are based instead on physical or documentary evidence or inferences from other facts." (citation omitted)).

### **A. Copyright Infringement**

There are two elements to a copyright infringement claim: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991). The plaintiff bears the burden of proof on both elements. *Palladium Music, Inc. v. EatSleepMusic, Inc.*, 398 F.3d 1193, 1196 (10th Cir. 2005). Because Reno, Inc. and SWIT do not challenge the validity of La Resolana's copyright,<sup>2</sup> we address only the second element.

La Resolana must prove that Reno, Inc. "unlawfully appropriated protected portions of the copyrighted work." *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 832 (10th Cir. 1993). This requires proving both: (1) that Reno, Inc., as a factual matter, copied portions of La Resolana's work; and (2) that those elements of the work that were copied were "protected expression and of such importance to the copied work that the appropriation is actionable." *Id.*; *see*

---

<sup>2</sup> The district court found that the application for registration and the assignment of rights from Mr. Hilchey to La Resolana contained inaccuracies and that the registration was obtained more than five years after first publication of the copyrighted work. The district court, however, did not grant the relief requested by Reno, Inc., i.e., declaring the registration invalid as a result of fraud on the U.S. Copyright Office. Reno, Inc. has not challenged this decision.

*Jacobsen v. Deseret Book Co.*, 287 F.3d 936, 942 (10th Cir. 2002). The district court determined that La Resolana had failed to prove, as a factual matter, that Reno, Inc. copied its plans. Since we uphold this finding, we need not render any conclusions concerning the second part of the analysis.

Direct proof of copying is often hard to come by. *See Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1284 (10th Cir. 1996); *Ellis v. Diffie*, 177 F.3d 503, 506 (6th Cir. 1999). Therefore, a plaintiff can indirectly prove copying (in a factual sense) “by establishing that Defendants had access to the copyrighted work and that there are probative similarities between the copyrighted material and the allegedly copied material.” *Country Kids 'N City Slicks, Inc.*, 77 F.3d at 1284.

### *I. Access*

A plaintiff may meet the initial burden of establishing access “by showing that the defendant had a reasonable opportunity to view or [an] opportunity to copy the allegedly infringed work.” *Autoskill Inc. v. Nat’l Educ. Support Sys., Inc.*, 994 F.2d 1476, 1490 (10th Cir. 1993) (internal quotation marks omitted); *see Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 508 n.5 (7th Cir. 1994). Thus, while a plaintiff is not required to demonstrate the defendant’s actual access to the work, “evidence that only creates a bare possibility that the defendant had access is not sufficient.” *Mag Jewelry Co. v. Cherokee, Inc.*, 496 F.3d 108, 117 (1st Cir. 2007) (alterations and internal quotation marks omitted);

*see* 4 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.02[A], at 13-21 (2008) (“Access may not be inferred through mere speculation or conjecture. There must be a reasonable possibility of viewing plaintiff’s work—not a bare possibility.”).

After hearing conflicting testimony about what was said at the December 1996 meeting and who faxed what to whom, the district court concluded that neither Reno, Inc., SWIT, nor Mr. Hasford ever saw La Resolana’s copyrighted plans. The court based its conclusion, in part, on its determination that both Mr. Clay and Mr. Hasford were very credible witnesses. Additionally, Mr. Hilchey admitted that he never faxed the plans directly to Mr. Clay, Mr. Plante, or Mr. Hasford. Instead, he faxed them to two law firms. But Mr. Clay had no contact with either law firm, and there was no evidence that Mr. Plante ever received any of the faxes. While Mr. Jones used the copyrighted plans to prepare a cost quotation for Mr. Plante, the district court found that Mr. Jones did not include the plans with the quotation. Finally, the court found that there were discussions between Mr. Clay, Mr. Plante, and Mr. Hilchey regarding a site plan, the number of units to be built, and square footage estimates. However, none of these topics was the subject of Mr. Hilchey’s copyright.

Even if La Resolana’s evidence demonstrated a “bare possibility” that Reno, Inc. had access to its copyrighted plans, a “bare possibility” is not sufficient to establish access. The evidence in the record supports the district

court's factual findings, which, in turn, support its legal conclusion that Reno, Inc. did not have the requisite access.

## **2. Striking Similarity**

La Resolana also argues that Reno, Inc.'s plan is so strikingly similar to its copyrighted plan that La Resolana bears a significantly lower burden of establishing access. We have stated that “[a] high degree of similarity may permit access to be inferred.” *Gates Rubber Co.*, 9 F.3d at 833 n.9. Thus, if a plaintiff is unable to demonstrate access, he may establish (factual) copying by demonstrating that the copyrighted work and the alleged infringing work are “strikingly similar.” *Corwin v. Walt Disney Co.*, 475 F.3d 1239, 1253 (11th Cir. 2007); cf. *Positive Black Talk Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 371-72 & n.10 (5th Cir. 2004) (recognizing that “other [federal] courts” have endorsed the legal principle under which a plaintiff may establish factual copying without any proof of access when the similarity between the works is sufficiently striking such that copying can be inferred solely on that basis).

Striking similarity exists when “the proof of similarity in appearance is ‘so striking that the possibilities of independent creation, coincidence and prior common source are, as a practical matter, precluded.’” *Corwin*, 475 F.3d at 1253 (quoting *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984)). Further, “the similarities should appear in a sufficiently unique or complex context as to make it unlikely that both pieces were copied from a prior common source.” *Selle*, 741

F.2d at 904. However, “[o]ne work does not violate the copyright in another simply because there is a similarity between the two if the similarity results from the fact that both works deal with the same subject or have the same common source.” *Dorsey v. Old Sur. Life Ins. Co.*, 98 F.2d 872, 873 (10th Cir. 1938).

Although the district court did not detail the similarities between the two plans, under the circumstances of this case and particularly those related to the conduct of Mr. Clay, we conclude that the district court did not err in finding that Mr. Hasford’s plans were not strikingly similar to Mr. Hilchey’s. The court found that there were “major differences in the kitchen area, living area, master bath and roof slope, placement of doors, placement of plumbing, [and] placement of door openings, all of which affect traffic-flow and articulation of space.” Aplee. Supp. App. at 143-44. And the court reasoned that “[t]hese differences so outweigh any similarities that the similarities are inconsequential within the total context of the work.” *Id.* at 144. Importantly, the district court also credited Mr. Clay’s testimony that he provided both architects with a detailed list of his requirements, including a sketch of the floor plan. The court concluded that the similarities between the two plans were adequately explained by the fact that both derived from the same common source, namely Mr. Clay.

La Resolana's expert admitted that Mr. Hasford's drawings were not exact copies of La Resolana's copyrighted plans.<sup>3</sup> On appeal, La Resolana points to no expert testimony that the existing similarities could have resulted only from copying. *See Selle*, 741 F.2d at 905 (“[T]he burden of proving ‘striking similarity,’ which, by definition, includes taking steps to minimize the possibility of common source, is on the plaintiff.”). While La Resolana's expert expressed skepticism that a client would come to an architect with such detailed ideas already formed, he conceded that if Mr. Clay had done so, Mr. Clay could be considered a common source.

Rather than identifying an evidentiary basis for its striking similarity claim, La Resolana contends that the district court erred in finding that Mr. Clay gave Mr. Hilchey a sketch. However, the record provides a sufficient basis for the district court to conclude that such a sketch existed. The court did not commit clear error simply because it chose to credit Mr. Clay's testimony over Mr. Hilchey's. Mr. Clay testified to exactly how, why, and when he developed his ideas for the design of the homes. The U-shaped design was an attempt to

---

<sup>3</sup> The expert did attempt to qualify his answer by asserting: “[T]he Hasford drawings are derivative of the earlier Hilchey drawings. . . . [T]he one came from the other, would be my expert testimony.” *Aplee*, Supp. App. at 178-79. Yet, the district court expressly rejected such similarity testimony on credibility grounds. It found that “[g]iven the obvious differences [between the two plans],” “the testimony of La Resolana's expert [is] incredible and not worthy of belief.” *Id.* at 144. Operating under a deferential clear error standard of review, we discern no basis for disturbing this finding.

maximize the number of houses on the property. The locations of the jut-outs and dormers were a compromise that allowed the homes to be built from 12-foot-wide prefabricated segments without looking “like a mobile home park.” Aplee. Supp. App. at 197. The combination of stucco and redwood siding was a style that Mr. Clay had used on a previous project. The district court was impressed with the depth of Mr. Clay’s knowledge and considered him a “very credible witness.” *Id.* at 141. Under these circumstances, the district court’s finding that Mr. Clay was a prior common source is wholly plausible, thereby negating La Resolana’s argument that this case presents a rare circumstance in which it need not show that Reno, Inc. had access to its copyrighted plans.

### ***3. Other Arguments***

We do not reach the issue of whether Reno, Inc., as a legal matter, infringed La Resolana’s copyright. Once copying has been established, “liability for copyright infringement will attach only where protected elements of a copyrighted work are copied.” *Country Kids ’N City Slicks, Inc.*, 77 F.3d at 1284. The plaintiff must prove that there is a “substantial similarity between those aspects of Plaintiff’s [work] which are legally protectable and the Defendants’ [work].” *Id.* Substantial similarity is measured by whether an “ordinary observer,” who is not specifically looking for disparities, would tend to overlook any differences between the works. *Id.* at 1288. However, because La Resolana



did not establish copying as a factual matter, whether the two plans are substantially similar is immaterial.

La Resolana contends, however, that the district court erred in excluding the testimony of Jeanette Jackson. We review a district court's evidentiary rulings for abuse of discretion. *United States v. Serrata*, 425 F.3d 886, 901 (10th Cir. 2005). Ms. Jackson was a lay witness with no personal knowledge of the facts of this case. La Resolana sought to introduce her testimony, as an "ordinary observer," that Reno, Inc.'s plans were substantially similar to La Resolana's copyrighted plans. But the "ordinary observer," like the "reasonable person" in tort law, is a legal fiction; it is the measure by which the trier of fact judges the similarity of two works. *See Country Kids 'N City Slicks, Inc.*, 77 F.3d at 1288 ("[T]he trier of fact can then assess pursuant to the ordinary observer test whether there is substantial similarity between the protected expression and the accused work." (emphasis added) (quoting *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 609 (1st Cir. 1988))). Since it was the responsibility of the district court to decide, for itself, whether the plans were substantially similar, it did not abuse its discretion by excluding Ms. Jackson's testimony as not helpful. *See Fed. R. Evid. 701*. Moreover, the district court's finding that Reno, Inc. did not copy La Resolana's plans made it unnecessary for the court to consider whether the plans were substantially similar. Thus, even if

the court had erred in excluding Ms. Jackson's testimony, such error would be harmless.

La Resolana also claims that SWIT indirectly infringed its copyright, either contributorily or vicariously. However, both contributory and vicarious infringements require someone to have directly infringed the copyright. *See Bridgeport Music, Inc. v. Diamond Time, Ltd.*, 371 F.3d 883, 889 (6th Cir. 2004) ("Liability for contributory infringement is based on the defendant's relationship to the direct infringement. There can be no contributory infringement without a direct infringement." (citation omitted)); *Ellison v. Robertson*, 357 F.3d 1072, 1076 (9th Cir. 2004) ("A defendant is vicariously liable for copyright infringement if he enjoys a direct financial benefit from *another's* infringing activity and has the right and ability to supervise the infringing activity." (internal quotation marks omitted)). *See generally Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 930-31 (2005) ("One infringes contributorily by intentionally inducing or encouraging direct infringement and infringes vicariously by profiting from direct infringement while declining to exercise a right to stop or limit it." (citations omitted)). Because La Resolana failed to establish that Reno, Inc. infringed its copyright, La Resolana's claim of indirect infringement against SWIT necessarily fails.

## B. Lanham Act and UTPA Claims

La Resolana claims that Reno, Inc. falsely designated itself as the origin or source of the architectural plans at issue, constituting a claim for “product infringement” pursuant to § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and an alleged violation of New Mexico’s UTPA. *Cottrell, Ltd. v. Biotrol Int’l, Inc.*, 191 F.3d 1248, 1252 n.3 (10th Cir. 1999). To establish a Lanham Act claim, a plaintiff must prove:

(1) that the defendant made material false or misleading representations of fact in connection with the . . . promotion of its product; (2) in commerce; (3) that are either likely to cause confusion or mistake as to (a) the origin, association or approval of the product with or by another, or (b) the characteristics of the goods or services; and (4) injure the plaintiff.

*World Wide Ass’n of Specialty Programs v. Pure, Inc.*, 450 F.3d 1132, 1140 (10th Cir. 2006) (internal quotation marks omitted); *see Cottrell, Ltd.*, 191 F.3d at 1252.

Absent a conclusion that Reno, Inc. copied its plans in the copyright context, La Resolana has no basis for either a Lanham Act or a UTPA claim.<sup>4</sup> The district court’s factual findings evidencing that Reno, Inc. did not copy La Resolana’s copyrighted plans—i.e., no access, and no striking similarity—as well

---

<sup>4</sup> La Resolana comes close to tacitly acknowledging this. *Cf.* Aplt. Br. at 36 (“If the Court finds that the Appellees infringed La Resolana’s copyrighted architectural drawings, *it follows* that the Appellees’ use and promotion of a similar architectural design in interstate commerce is likely to cause confusion among consumers . . . believing that they (the Appellees) own or have permission to use the architectural works, when they do not.” (emphasis added)).

as its factual findings that: (1) neither Mr. Clay nor Mr. Plante made any false or misleading oral or written statements or representations, (2) neither Mr. Clay nor Mr. Plante passed off or repackaged any of Mr. Hilchey's or La Resolana's drawings or works to sell as his own; and (3) Reno, Inc.'s drawings did not originate with La Resolana, all have evidentiary support in the record. If Reno, Inc.'s plan is a work independent of La Resolana's, it is impossible to establish that Reno, Inc. made false or misleading statements (as alleged by La Resolana) about the origin of its plan, a required element of La Resolana's Lanham Act and UTPA claims.

Because the district court's factual findings are not clearly erroneous, its judgment in favor of Reno, Inc. and SWIT on La Resolana's Lanham Act and UTPA claims must stand.

### **III. CONCLUSION**

For the foregoing reasons, we **AFFIRM** the district court's judgment.

 KeyCite Yellow Flag - Negative Treatment  
Declined to Extend by [A.I.M. Controls, L.L.C. v. C.I.R.](#), 5th Cir.,  
February 24, 2012

130 S.Ct. 1237  
Supreme Court of the United States

REED ELSEVIER, INC., et al., Petitioners,  
v.  
Irvin MUCHNICK et al.

No. 08–103.

Argued Oct. 7, 2009.

Decided March 2, 2010.

### Synopsis

**Background:** Freelance authors who contracted with publishers to author works for publication in print media, and who retained the copyrights in those works, and trade groups representing such authors brought class action against the publishers alleging electronic reproduction of the works by the publishers infringed their copyrights. The United States District Court for the Southern District of New York, [George B. Daniels, J.](#), certified class and approved settlement, and plaintiffs who objected to settlement appealed. The United States Court of Appeals for the Second Circuit, [Straub](#), Circuit Judge, [509 F.3d 116](#), vacated and remanded. Certiorari was granted.

**Holdings:** The Supreme Court, Justice [Thomas](#), held that:

[1] Copyright Act's registration requirement is a precondition to filing a copyright infringement claim that does not restrict a federal court's subject-matter jurisdiction with respect to infringement suits involving unregistered works, abrogating *Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp.*, 354 F.3d 112, *Morris v. Business Concepts, Inc.*, 259 F.3d 65, *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, *Positive Black Talk Inc. v. Cash Money Records Inc.*, 394 F.3d 357, *Xoom, Inc. v. Imageline, Inc.*, 323 F.3d 279, *Murray Hill Publications, Inc. v. ABC Communications, Inc.*, 264 F.3d 622, *Brewer-Giorgio v. Producers Video, Inc.*, 216 F.3d 1281, and *Data Gen. Corp. v. Grumman Systems Support Corp.*, 36 F.3d 1147, and

[2] print publishers and owners of online databases were not judicially estopped from asserting that Copyright Act's registration requirement was not jurisdictional.

Court of Appeals reversed; remanded.

Justice [Ginsburg](#) filed an opinion concurring in part and concurring in the judgment, in which Justices [Stevens](#) and [Breyer](#) joined.

Justice [Sotomayor](#) took no part in the consideration or decision of the case.

West Headnotes (9)

### [1] Federal Courts

➤ [Jurisdiction, Powers, and Authority in General](#)

“Jurisdiction” refers to a court's adjudicatory authority, and accordingly, the term “jurisdictional” properly applies only to prescriptions delineating the classes of cases and the persons implicating that authority.

56 Cases that cite this headnote

### [2] Federal Courts

➤ [Grounds or Exclusions of Jurisdiction in General](#)

In light of the important distinctions between jurisdictional prescriptions and claim-processing rules, federal courts and litigants are encouraged to facilitate clarity by using the term “jurisdictional” only when it is apposite.

66 Cases that cite this headnote

### [3] Federal Courts

➤ [Statutory provisions in general](#)

If Congress clearly states that a threshold limitation on a statute's scope shall count as jurisdictional, then courts and litigants will be duly instructed and will not be left to wrestle with the issue, but when Congress does

not rank a statutory limitation on coverage as jurisdictional, courts should treat the restriction as nonjurisdictional in character.

83 Cases that cite this headnote

**[4] Federal Courts**

— Statutory provisions in general

A statutory condition that requires a party to take some action before filing a lawsuit is not automatically a jurisdictional prerequisite to suit; rather, the jurisdictional analysis must focus on the legal character of the requirement, which may be discerned by looking to the condition's text, context, and relevant historical treatment.

55 Cases that cite this headnote

**[5] Copyrights and Intellectual Property**

— Conditions precedent; registration

Copyright Act's registration requirement is a precondition to filing a copyright infringement claim that does not restrict a federal court's subject-matter jurisdiction with respect to infringement suits involving unregistered works; abrogating *Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp.*, 354 F.3d 112, *Morris v. Business Concepts, Inc.*, 259 F.3d 65, *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, *Positive Black Talk Inc. v. Cash Money Records Inc.*, 394 F.3d 357, *Xoom, Inc. v. Imageline, Inc.*, 323 F.3d 279, *Murray Hill Publications, Inc. v. ABC Communications, Inc.*, 264 F.3d 622, *Brewer-Giorgio v. Producers Video, Inc.*, 216 F.3d 1281, and *Data Gen. Corp. v. Grumman Systems Support Corp.*, 36 F.3d 1147. 17 U.S.C.A. §§ 411(a), 501(a, b).

132 Cases that cite this headnote

**[6] Federal Civil Procedure**

— Particular Classes Represented

District court had subject-matter jurisdiction to certify a class, in copyright infringement action, that included not only holders of registered copyrights but also holders of

unregistered copyrights, and had subject-matter jurisdiction to approve a class action settlement encompassing the alleged infringement of both registered and unregistered works. 17 U.S.C.A. §§ 411(a), 501(a, b); Fed.Rules Civ.Proc.Rule 23, 28 U.S.C.A.

225 Cases that cite this headnote

**[7] Federal Courts**

— Statutory provisions in general

A statutory condition that requires a party to take some action before filing a lawsuit should not be ranked as jurisdictional merely because it promotes important congressional objectives.

19 Cases that cite this headnote

**[8] Estoppel**

— Claim inconsistent with previous claim or position in general

Defendant print publishers and defendant owners of online databases were not judicially estopped, upon certiorari review by Supreme Court after Court of Appeals vacated district court's approval of settlement of copyright-infringement class action filed by freelance authors who held registered or unregistered copyrights in works republished by defendants, from asserting that Copyright Act's registration requirement was not jurisdictional and that objections to some authors' failure to register therefore could be waived by defendants, though some prior statements in defendants' submissions to District Court and Court of Appeals were in tension with their arguments before Supreme Court, where Supreme Court's acceptance of defendants' arguments could not create inconsistent court determinations in their favor; prior statements were made when negotiating or defending the settlement agreement, District Court did not adopt defendants' interpretation of registration requirement as being jurisdictional when it approved the settlement, and when Court of

Appeals asked defendants to brief whether Copyright Act restricted District Court's subject-matter jurisdiction, they argued that it did not, and the Court of Appeals rejected their arguments. 17 U.S.C.A. §§ 411(a), 501(a), b).

285 Cases that cite this headnote

## [9] Estoppel

🔑 Claim inconsistent with previous claim or position in general

The doctrine of judicial estoppel typically applies when, among other things, a party has succeeded in persuading a court to accept that party's earlier position, so that judicial acceptance of an inconsistent position in a later proceeding would create the perception that either the first or the second court was misled.

33 Cases that cite this headnote

\*\*1239 \*154 Syllabus\*

The Copyright Act (Act) generally requires copyright holders to register their works before suing for copyright infringement. 17 U.S.C.A. § 411(a). The complaint in this consolidated, class-action copyright infringement suit alleged that the named plaintiffs each own at least one copyright, typically in a freelance article written for a newspaper or magazine, that they had registered in accordance with § 411(a). The class, however, included both authors who had registered their works and authors who had not. The parties moved the District Court to certify a settlement class and approve a settlement agreement. The District Court did so over the objections of some freelance authors. On appeal, the Second Circuit *sua sponte* raised the question whether § 411(a) deprives federal courts of subject-matter jurisdiction over infringement claims involving unregistered copyrights, concluding that the District Court lacked jurisdiction to certify the class or approve the settlement.

*Held:* Section 411(a)'s registration requirement is a precondition to filing a copyright infringement claim.

A copyright holder's failure to comply with that requirement does not restrict a federal court's subject-matter jurisdiction over infringement claims involving unregistered works. Pp. 1243 – 1249.

(a) "Jurisdiction" refers to "a court's adjudicatory authority," *Kontrick v. Ryan*, 540 U.S. 443, 455, 124 S.Ct. 906, 157 L.Ed.2d 867. Thus, "jurisdictional" properly applies only to "prescriptions delineating the classes of cases (subject-matter jurisdiction) and the persons (personal jurisdiction)" implicating that authority. *Ibid.* Because the distinction between jurisdictional conditions and claim-processing rules can be confusing in practice, federal courts and litigants should use the term "jurisdictional" only when it is apposite. *Ibid.* A statutory requirement is considered jurisdictional if Congress "clearly states that [it] count[s] as jurisdictional"; a condition "not rank[ed]" as such should be treated "as nonjurisdictional in character." *Arbaugh v. Y & H Corp.*, 546 U.S. 500, 515–516, 126 S.Ct. 1235, 163 L.Ed.2d 1097. In *Arbaugh*, the Court held that the employee numerosity coverage requirement of Title VII of the Civil Rights Act of 1964 was not a jurisdictional requirement because the provision did not "clearly stat[e]" that the numerosity rule counted as jurisdictional, this Court's prior Title VII cases did not \*155 compel the conclusion that the rule nonetheless was jurisdictional, and the requirement's location in a provision separate from Title VII's jurisdiction-granting section indicated that Congress had not ranked the rule as jurisdictional. Pp. 1243 – 1245.

(b) Like the Title VII numerosity requirement in *Arbaugh*, § 411(a) does not "clearly stat[e]" that its registration requirement is "jurisdictional." 546 U.S. at 515, 126 S.Ct. 1235. Although § 411(a)'s last sentence contains the word "jurisdiction," that sentence speaks to a court's adjudicatory authority to determine a copyright claim's registrability and says nothing about whether a federal court has subject-matter jurisdiction to adjudicate claims for infringement of unregistered works. Moreover, § 411(a)'s registration requirement, like Title VII's employee-numerosity \*\*1240 requirement, is located in a provision "separate" from those granting federal courts subject-matter jurisdiction over those respective claims, *ibid.*, and no other factor suggests that § 411(a)'s registration requirement can be read to "speak in jurisdictional terms or refer in any way to the jurisdiction of the district courts," *ibid.* This conclusion is not affected by the fact that the employee numerosity requirement in



*Arbaugh* was considered an element of a Title VII claim rather than a prerequisite to initiating a lawsuit. See *Zipes v. Trans World Airlines, Inc.*, 455 U.S. 385, 393, 102 S.Ct. 1127, 71 L.Ed.2d 234. Pp. 1245 – 1247.

(c) A contrary result is not required by *Bowles v. Russell*, 551 U.S. 205, 127 S.Ct. 2360, 168 L.Ed.2d 96. There, in finding that Congress had ranked as jurisdictional 28 U.S.C. § 2107's requirement that parties in a civil action file a notice of appeal within 30 days of the judgment, this Court analyzed § 2107's specific language and the historical treatment accorded to that type of limitation. That analysis is consistent with the *Arbaugh* framework because context is relevant to whether a statute "rank[s]" a requirement as jurisdictional. Pp. 1247 – 1248.

(d) The Court declines to apply judicial estoppel to affirm the Second Circuit's judgment vacating the settlement. While some of petitioners' arguments below are in tension with those made in this Court, accepting their arguments here does not create the type of "inconsistent court determinations" in their favor that estoppel is meant to address. See *New Hampshire v. Maine*, 532 U.S. 742, 121 S.Ct. 1808, 149 L.Ed.2d 968. Pp. 1248 – 1249.

(e) Because § 411(a) does not restrict a federal court's subject-matter jurisdiction, this Court need not address the question whether the District Court had authority to approve the settlement under the Second Circuit's erroneous reading of § 411. The Court also declines to decide whether § 411(a)'s registration requirement is a mandatory precondition to suit that district courts may or should enforce *sua sponte* by dismissing \*156 copyright infringement claims involving unregistered works. P. 1249.

509 F.3d 116, reversed and remanded.

THOMAS, J., delivered the opinion of the Court, in which ROBERTS, C.J., and SCALIA, KENNEDY, and ALITO, JJ., joined. GINSBURG, J., filed an opinion concurring in part and concurring in the judgment, in which STEVENS and BREYER, JJ., joined. SOTOMAYOR, J., took no part in the consideration or decision of the case.

#### Attorneys and Law Firms

Charles S. Sims, New York, NY, for petitioners.

Ginger Anders for the United States as amicus curiae, by special leave of the Court, supporting the petitioners.

Deborah Jones Merritt, appointed by this Court, as amicus curiae, supporting the judgment below.

Michael J. Boni, Counsel of Record, Joanne Zack, Joshua D. Snyder, Boni & Zack LLC, Bala Cynwyd, PA, for respondents Letty Cottin Pogrebin.

Diane S. Rice, Hosie Rice LLP, San Francisco, CA, A.J. De Bartolomeo, Girard Gibbs LLP, San Francisco, CA, Gary S. Fergus, Fergus, A Law Office, San Francisco, CA, Robert J. LaRocca, George W. Croner, Kohn Swift & Graf, P.C., Philadelphia, PA, for respondents.

David Nimmer, Irell & Manella LLP, Los Angeles, CA, Charles S. Sims, Counsel of Record, Jon A. Baumgarten, Mark D. Harris, Anna G. Kaminska, Proskauer Rose LLP, New York, NY, for petitioners.

\*\*1241 Henry B. Gutman, Simpson Thacher & Bartlett LLP, New York, NY, for petitioner Dow Jones Reuters Business Interactive LLC, d/b/a Factiva.

James L. Hallowell, Richard A. Bierschbach, Gibson, Dunn & Crutcher LLP, New York, NY, for petitioners Dow Jones & Company, Inc.

Ian Ballon, Greenberg Traurig LLP, Santa Monica, CA, for petitioners Knight-Ridder, Inc., Knight Ridder Digital, and Mediastream, Inc.

Matthew W. Walch, Latham & Watkins, Chicago, IL, for petitioner ProQuest Company.

Michael S. Denniston, Bradley Arant, Boult & Cummings LLP, Birmingham, AL, for petitioner EBSCO Industries, Inc.

Pamela S. Karlan, Jeffrey L. Fisher, Stanford Law School, Supreme Court Litigation Clinic, Stanford, CA, Charles D. Chalmers, Counsel of Record, Fairfax, CA, Amy Howe, Kevin K. Russell Howe & Russell, P.C., Bethesda, MD, for Muchnick respondents.

#### Opinion

Justice THOMAS, delivered the opinion of the Court.

\*157 Subject to certain exceptions, the Copyright Act (Act) requires copyright holders to register their works



before suing for copyright infringement. 17 U.S.C. § 411(a) (2006 ed., Supp. II). In this case, the Court of Appeals for the Second Circuit held that a copyright holder's failure to comply with § 411(a)'s registration requirement deprives a federal court of jurisdiction to adjudicate his copyright infringement claim. We disagree. Section 411(a)'s registration requirement is a precondition to filing a claim that does not restrict a federal court's subject-matter jurisdiction.

## I

## A

The Constitution grants Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors ... the exclusive Right to ... their ... Writings.” Art. I, § 8, cl. 8. Exercising this 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.” 17 U.S.C. § 102(a). This scheme gives copyright owners “the exclusive rights” (with specified statutory exceptions) to distribute, reproduce, or publicly perform their works. § 106. “Anyone who violates any of the exclusive rights of the copyright owner as provided” in the Act “is an infringer of the copyright.” § 501(a). When such infringement occurs, a copyright owner “is entitled, *subject to the requirements of section 411*, to institute an action” for copyright infringement. § 501(b) (emphasis added).

This case concerns “the requirements of section 411” to which § 501(b) refers. Section 411(a) provides, *inter alia* and with certain exceptions, that “no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright \*158 claim has been made in accordance with this title.”<sup>1</sup> This provision is part of \*\*1242 the Act's remedial scheme. It establishes a condition—copyright registration—that plaintiffs ordinarily must satisfy before filing an infringement claim and invoking the Act's remedial provisions. We address whether § 411(a) also deprives federal courts of subject-matter jurisdiction to adjudicate infringement claims involving unregistered works.

## B

The relevant proceedings in this case began after we issued our opinion in *New York Times Co. v. Tasini*, 533 U.S. 483, 121 S.Ct. 2381, 150 L.Ed.2d 500 (2001). In *Tasini*, we agreed with the Court of Appeals for the Second Circuit that several owners of online databases and print publishers had infringed the copyrights of six freelance authors by reproducing the authors' works electronically without first securing their permission. See *id.* at 493, 121 S.Ct. 2381. In so holding, we affirmed the principal theory of liability underlying copyright infringement suits that other freelance authors had filed after the Court of Appeals had issued its opinion in *Tasini*. These other suits, which were stayed pending our decision in *Tasini*, resumed after we issued our opinion and were consolidated in the United States District Court for the Southern District of New York by the Judicial Panel on Multidistrict Litigation.

The consolidated complaint alleged that the named plaintiffs each own at least one copyright, typically in a freelance article written for a newspaper or a magazine, that they had registered in accordance with § 411(a). The class, however, included both authors who had registered their copyrighted works and authors who had not. See App. 94.

Because of the growing size and complexity of the lawsuit, the District Court referred the parties to mediation. For \*159 more than three years, the freelance authors, the publishers (and their insurers), and the electronic databases (and their insurers) negotiated. Finally, in March 2005, they reached a settlement agreement that the parties intended “to achieve a global peace in the publishing industry.” *In re Literary Works in Electronic Databases Copyright Litigation*, 509 F.3d 116, 119 (C.A.2 2007).

The parties moved the District Court to certify a class for settlement and to approve the settlement agreement. Ten freelance authors, including Irvin Muchnick (hereinafter Muchnick respondents), objected. The District Court overruled the objections; certified a settlement class of freelance authors under *Federal Rules of Civil Procedure* 23(a) and (b)(3); approved the settlement as fair, reasonable, and adequate under *Rule* 23(e); and entered final judgment. At no time did the Muchnick

respondents or any other party urge the District Court to dismiss the case, or to refuse to certify the class or approve the settlement, for lack of subject-matter jurisdiction.

The Muchnick respondents appealed, renewing their objections to the settlement on procedural and substantive grounds. Shortly before oral argument, the Court of Appeals *sua sponte* ordered briefing on the question whether § 411(a) deprives federal courts of subject-matter jurisdiction over infringement claims involving unregistered copyrights. All parties filed briefs asserting that the District Court had subject-matter jurisdiction to approve the settlement agreement even though it included unregistered works.

**\*\*1243** Relying on two Circuit precedents holding that § 411(a)'s registration requirement was jurisdictional, see 509 F.3d, at 121 (citing *Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp.*, 354 F.3d 112, 114–115 (C.A.2 2003); *Morris v. Business Concepts, Inc.*, 259 F.3d 65, 72–73 (C.A.2 2001)), the Court of Appeals concluded that the District Court lacked jurisdiction to certify a class of claims arising from the infringement of unregistered works, and also lacked jurisdiction to approve a settlement **\*160** with respect to those claims, 509 F.3d, at 121 (citing “widespread agreement among the circuits that section 411(a) is jurisdictional”).<sup>2</sup>

Judge Walker dissented. He concluded “that § 411(a) is more like the [nonjurisdictional] employee-numerosity requirement in *Arbaugh v. Y & H Corp.*, 546 U.S. 500, 126 S.Ct. 1235, 163 L.Ed.2d 1097 (2006) ]” than the jurisdictional statutory time limit in *Bowles v. Russell*, 551 U.S. 205, 127 S.Ct. 2360, 168 L.Ed.2d 96 (2007). 509 F.3d, at 129. Accordingly, he reasoned that § 411(a)'s registration requirement does not limit federal subject-matter jurisdiction over infringement suits involving unregistered works. *Ibid.*

We granted the owners' and publishers' petition for a writ of certiorari, and formulated the question presented to ask whether § 411(a) restricts the subject-matter jurisdiction of the federal courts over copyright infringement actions. 555 U.S. 1211, 129 S.Ct. 1523, 173 L.Ed.2d 655 (2009). Because no party supports the Court of Appeals' jurisdictional holding, we appointed an *amicus curiae* to defend the Court of Appeals' judgment.<sup>3</sup> 556 U.S. 1161, 129 S.Ct. 1693, 173 L.Ed.2d 1053 (2009). We now reverse.

## II

### A

[1] “Jurisdiction” refers to “a court's adjudicatory authority.” *Kontrick v. Ryan*, 540 U.S. 443, 455, 124 S.Ct. 906, 157 L.Ed.2d 867 (2004). Accordingly, the term “jurisdictional” properly applies only to “prescriptions delineating the classes of cases (subject-matter jurisdiction) **\*161** and the persons (personal jurisdiction)” implicating that authority. *Ibid.*; see also *Steel Co. v. Citizens for Better Environment*, 523 U.S. 83, 89, 118 S.Ct. 1003, 140 L.Ed.2d 210 (1998) (“subject-matter jurisdiction” refers to “the courts' statutory or constitutional power to adjudicate the case” (emphasis in original)); *Landgraf v. USI Film Products*, 511 U.S. 244, 274, 114 S.Ct. 1483, 128 L.Ed.2d 229 (1994) (“[J]urisdictional statutes ‘speak to the power of the court rather than to the rights or obligations of the parties’ ” (quoting *Republic Nat. Bank of Miami v. United States*, 506 U.S. 80, 100, 113 S.Ct. 554, 121 L.Ed.2d 474 (1992) (THOMAS, J., concurring))).

While perhaps clear in theory, the distinction between jurisdictional conditions and claim-processing rules can be confusing in practice. Courts—including this Court—have sometimes mischaracterized claim-processing rules or elements of a **\*\*1244** cause of action as jurisdictional limitations, particularly when that characterization was not central to the case, and thus did not require close analysis. See *Arbaugh*, *supra*, at 511–512, 126 S.Ct. 1235 (citing examples); *Steel Co.*, 523 U.S., at 91, 118 S.Ct. 1003 (same). Our recent cases evince a marked desire to curtail such “drive-by jurisdictional rulings,” *ibid.*, which too easily can miss the “critical difference[s]” between true jurisdictional conditions and nonjurisdictional limitations on causes of action, *Kontrick*, *supra*, at 456, 124 S.Ct. 906; see also *Arbaugh*, 546 U.S., at 511, 126 S.Ct. 1235.

[2] [3] In light of the important distinctions between jurisdictional prescriptions and claim-processing rules, see, e.g., *id.*, at 514, 126 S.Ct. 1235, we have encouraged federal courts and litigants to “facilitat[e]” clarity by using the term “jurisdictional” only when it is apposite, *Kontrick*, *supra*, at 455, 124 S.Ct. 906. In *Arbaugh*, we described the general approach to distinguish “jurisdictional” conditions from claim-processing requirements or elements of a claim:

"If the Legislature clearly states that a threshold limitation on a statute's scope shall count as jurisdictional, then courts and litigants will be duly instructed and will not be left to wrestle with the issue. But when Congress \*162 does not rank a statutory limitation on coverage as jurisdictional, courts should treat the restriction as nonjurisdictional in character." 546 U.S., at 515–516, 126 S.Ct. 1235 (citation and footnote omitted).

The plaintiff in *Arbaugh* brought a claim under Title VII of the Civil Rights Act of 1964, which makes it unlawful "for an employer ... to discriminate," *inter alia*, on the basis of sex. 42 U.S.C. § 2000e-2(a)(1). But employees can bring Title VII claims only against employers that have "fifteen or more employees." § 2000e(b). *Arbaugh* addressed whether that employee numerosity requirement "affects federal-court subject-matter jurisdiction or, instead, delineates a substantive ingredient of a Title VII claim for relief." 546 U.S., at 503, 126 S.Ct. 1235. We held that it does the latter.

Our holding turned principally on our examination of the text of § 2000e(b), the section in which Title VII's numerosity requirement appears. Section 2000e(b) does not "clearly stat[e]" that the employee numerosity threshold on Title VII's scope "count[s] as jurisdictional." *Id.*, at 515–516, and n. 11, 126 S.Ct. 1235. And nothing in our prior Title VII cases compelled the conclusion that even though the numerosity requirement lacks a clear jurisdictional label, it nonetheless imposed a jurisdictional limit. See *id.*, at 511–513, 126 S.Ct. 1235. Similarly, § 2000e(b)'s text and structure did not demonstrate that Congress "rank[ed]" that requirement as jurisdictional. See *id.*, at 513–516, 126 S.Ct. 1235. As we observed, the employee numerosity requirement is located in a provision "separate" from § 2000e-5(f)(3), Title VII's jurisdiction-granting section, distinguishing it from the "amount-in-controversy threshold ingredient of subject-matter jurisdiction ... in diversity-of-jurisdiction under 28 U.S.C. § 1332." *Arbaugh*, 546 U.S., at 514–515, 126 S.Ct. 1235. Accordingly, the numerosity requirement could not fairly be read to "speak in jurisdictional terms or in any way refer to the jurisdiction of the district courts." *Id.*, at 515, 126 S.Ct. 1235 (quoting *Zipes v. Trans World Airlines, Inc.*, 455 U.S. 385, 394, 102 S.Ct. 1127, 71 L.Ed.2d 234 (1982)). We thus "refrain[ed] from" construing the numerosity \*163 requirement to "constric[t] § 1331 or

Title VII's jurisdictional provision." *Arbaugh, supra*, at 515, 126 S.Ct. 1235 (internal quotation marks omitted).

**\*\*1245** We now apply this same approach to § 411(a).

## B

Section 411(a) provides:

"Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party to the action with respect to the issue of registrability of the copyright claim by entering an appearance within sixty days after such service, but the Register's failure to become a party shall not deprive the court of jurisdiction to determine that issue."

We must consider whether § 411(a) "clearly states" that its registration requirement is "jurisdictional." *Arbaugh, supra*, at 515, 126 S.Ct. 1235. It does not. *Amicus* disagrees, pointing to the presence of the word "jurisdiction" in the last sentence of § 411(a) and contending that the use of the term there indicates the jurisdictional cast of § 411(a)'s first sentence as well. Brief for Court–Appointed *Amicus Curiae* in support of Judgment Below 18 (hereinafter *Amicus* Brief). But this reference to "jurisdiction" cannot

bear the weight that *amicus* \*164 places upon it. The sentence upon which *amicus* relies states:

“The Register [of Copyrights] may, at his or her option, become a party to the [copyright infringement] action with respect to *the issue of registrability of the copyright claim* by entering an appearance within sixty days after such service, but the Register’s failure to become a party shall not deprive the court of jurisdiction to determine *that issue*.” § 411(a) (emphasis added).

Congress added this sentence to the Act in 1976, 90 Stat. 2583, to clarify that a federal court can determine “the issue of registrability of the copyright claim” even if the Register does not appear in the infringement suit. That clarification was necessary because courts had interpreted § 411(a)’s precursor provision,<sup>4</sup> which imposed a similar registration requirement, as prohibiting copyright owners who had been *refused* registration by the Register of Copyrights from suing for infringement until the owners *first* sought mandamus against the Register. See *Vacheron & Constantin—Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 640–641 (C.A.2 1958) (construing § 411(a)’s precursor). The 1976 amendment made it clear that a federal court plainly has adjudicatory authority to determine “*that issue*,” § 411(a) (emphasis added)—*i.e.*, the issue of *registrability*—regardless of whether the Register is a party to the *infringement* suit. The word “jurisdiction,” as used here, thus says nothing about whether a federal court has subject-matter jurisdiction to adjudicate claims for infringement of unregistered works.

Moreover, § 411(a)’s registration requirement, like Title VII’s numerosity requirement, is located in a provision “separate” \*\*1246 from those granting federal courts subject-matter jurisdiction over those respective claims. See *Arbaugh, supra*, at 514–515, 126 S.Ct. 1235. Federal district courts have subject-matter \*165 jurisdiction over copyright infringement actions based on 28 U.S.C. §§ 1331 and 1338. But neither § 1331, which confers subject-matter jurisdiction over questions of federal law, nor § 1338(a), which is specific to copyright claims, conditions its jurisdictional grant on whether copyright holders have registered their works before suing for infringement. Cf. *Arbaugh, supra*, at 515, 126 S.Ct. 1235 (“Title VII’s jurisdictional provision” does not “specif[y] any threshold ingredient akin to 28 U.S.C. § 1332’s monetary floor”).

Nor does any other factor suggest that 17 U.S.C.A. § 411(a)’s registration requirement can be read to “speak in jurisdictional terms or refer in any way to the jurisdiction of the district courts.” *Arbaugh*, 546 U.S., at 515, 126 S.Ct. 1235 (quoting *Zipes*, 455 U.S., at 394, 102 S.Ct. 1127). First, and most significantly, § 411(a) expressly *allows* courts to adjudicate infringement claims involving unregistered works in three circumstances: where the work is not a U.S. work, where the infringement claim concerns rights of attribution and integrity under § 106A, or where the holder attempted to register the work and registration was refused. Separately, § 411(c) permits courts to adjudicate infringement actions over certain kinds of unregistered works where the author “declare[s] an intention to secure copyright in the work” and “makes registration for the work, if required by subsection (a), within three months after [the work’s] first transmission.” 17 U.S.C. §§ 411(c)(1)–(2). It would be at least unusual to ascribe jurisdictional significance to a condition subject to these sorts of exceptions.<sup>5</sup>

[4] That the numerosity requirement in *Arbaugh* could be considered an element of a Title VII claim, rather than a prerequisite \*166 to initiating a lawsuit, does not change this conclusion, as our decision in *Zipes* demonstrates. *Zipes* (upon which *Arbaugh* relied) held that Title VII’s requirement that sex-discrimination claimants timely file a discrimination charge with the EEOC before filing a civil action in federal court was nonjurisdictional. See 455 U.S., at 393, 102 S.Ct. 1127; 42 U.S.C. § 2000e–5(f)(1) (establishing specific time periods within which a discrimination claimant must file a lawsuit after filing a charge with the EEOC). A statutory condition that requires a party to take some action before filing a lawsuit is not automatically “a *jurisdictional* prerequisite to suit.” *Zipes*, 455 U.S., at 393, 102 S.Ct. 1127 (emphasis added). Rather, the jurisdictional analysis must focus on the “legal character” of the requirement, *id.*, at 395, 102 S.Ct. 1127, which we discerned by looking to the condition’s text, context, and relevant historical treatment, *id.*, at 393–395, 102 S.Ct. 1127; see also *National Railroad Passenger Corporation v. Morgan*, 536 U.S. 101, 119–121, 122 S.Ct. 2061, 153 L.Ed.2d 106 (2002). We similarly have treated as nonjurisdictional other types of threshold requirements that claimants \*\*1247 must complete, or exhaust, before filing a lawsuit.<sup>6</sup>

[5] [6] The registration requirement in 17 U.S.C.A. § 411(a) fits in this mold. Section 411(a) imposes a



precondition to filing a claim that is not clearly labeled jurisdictional, is not located in a jurisdiction-granting provision, and admits of congressionally authorized exceptions. See §§ 411(a)-(c). Section 411(a) thus imposes a type of precondition to suit that supports nonjurisdictional treatment under our precedents.

### \*167 C

*Amicus* insists that our decision in *Bowles*, 551 U.S. 205, 127 S.Ct. 2360, 168 L.Ed.2d 96, compels a conclusion contrary to the one we reach today. *Amicus* cites *Bowles* for the proposition that where Congress did not explicitly label a statutory condition as jurisdictional, a court nevertheless should treat it as such if that is how the condition consistently has been interpreted and if Congress has not disturbed that interpretation. *Amicus* Brief 26. Specifically, *amicus* relies on a footnote in *Bowles* to argue that here, as in *Bowles*, it would be improper to characterize the statutory condition as nonjurisdictional because doing so would override “ ‘a century’s worth of precedent’ ” treating § 411(a)’s registration requirement as jurisdictional. *Amicus* Brief 26 (quoting *Bowles*, *supra*, at 209, n. 2, 127 S.Ct. 2360). This argument focuses on the result in *Bowles*, rather than on the analysis we employed.

*Bowles* did not hold that any statutory condition devoid of an express jurisdictional label should be treated as jurisdictional simply because courts have long treated it as such. Nor did it hold that all statutory conditions imposing a time limit should be considered jurisdictional.<sup>7</sup> Rather, \*168 *Bowles* \*\*1248 stands for the proposition that context, including this Court’s interpretation of similar provisions in many years past, is relevant to whether a statute ranks a requirement as jurisdictional.

In *Bowles*, we considered 28 U.S.C. § 2107, which requires parties in a civil action to file a notice of appeal within 30 days of the judgment being appealed, and Rule 4 of the Federal Rules of Appellate Procedure, which “carries § 2107 into practice.” 551 U.S., at 208, 127 S.Ct. 2360. After analyzing § 2107’s specific language and this Court’s historical treatment of the type of limitation § 2107 imposes (*i.e.*, statutory deadlines for filing appeals), we concluded that Congress had ranked the statutory condition as jurisdictional. Our focus in *Bowles* on the historical treatment of statutory conditions for taking an

appeal is thus consistent with the *Arbaugh* framework. Indeed, *Bowles* emphasized that this Court had long treated such conditions as jurisdictional, including in statutes *other* than § 2107, and specifically in statutes that predated the creation of the courts of appeals. See 551 U.S., at 209–210, and n. 2, 127 S.Ct. 2360.

*Bowles* therefore demonstrates that the relevant question here is not (as *amicus* puts it) whether § 411(a) itself has long been labeled jurisdictional, but whether the type of limitation that § 411(a) imposes is one that is properly ranked as jurisdictional absent an express designation. The statutory limitation in *Bowles* was of a type that we had long held *did* “speak in jurisdictional terms” even absent a “jurisdictional” label, and nothing about § 2107’s text or context, or the historical treatment of that type of limitation, justified a departure from this view. That was not the case, however, for the types of conditions in *Zipes* and *Arbaugh*.

[7] \*169 Here, that same analysis leads us to conclude that § 411(a) does not implicate the subject-matter jurisdiction of federal courts. Although § 411(a)’s historical treatment as “jurisdictional” is a factor in the analysis, it is not dispositive. The other factors discussed above demonstrate that § 411(a)’s registration requirement is more analogous to the nonjurisdictional conditions we considered in *Zipes* and *Arbaugh* than to the statutory time limit at issue in *Bowles*.<sup>8</sup> We thus conclude that § 411(a)’s registration requirement is nonjurisdictional, notwithstanding its prior jurisdictional treatment.<sup>9</sup>

### III

[8] *Amicus* argues that even if § 411(a) is nonjurisdictional, we should nonetheless affirm on estoppel grounds the Court of Appeals’ judgment vacating the \*\*1249 District Court’s order approving the settlement and dismissing the case. According to *amicus*, petitioners asserted previously in these proceedings that copyright registration was jurisdictional, and this assertion should estop them from now asserting a right to waive objections to the authors’ failure to register. *Amicus* urges us to prevent the parties “from ‘playing fast and loose with the courts’ by ‘deliberately changing positions according \*170 to the exigencies of the moment.’ ” *Amicus* Brief 58 (quoting *New Hampshire v. Maine*, 532 U.S. 742, 750, 121 S.Ct. 1808, 149 L.Ed.2d 968 (2001)).

[9] We agree that some statements in the parties' submissions to the District Court and the Court of Appeals are in tension with their arguments here. But we decline to apply judicial estoppel. As we explained in *New Hampshire*, that doctrine typically applies when, among other things, a "party has succeeded in persuading a court to accept that party's earlier position, so that judicial acceptance of an inconsistent position in a later proceeding would create the perception that either the first or the second court was misled." *Id.*, at 750, 121 S.Ct. 1808 (internal quotation marks omitted).

Such circumstances do not exist here for two reasons. First, the parties made their prior statements when negotiating or defending the settlement agreement. We do not fault the parties' lawyers for invoking in the negotiations binding Circuit precedent that supported their clients' positions. Perhaps more importantly, in approving the settlement, the District Court did not adopt petitioners' interpretation of § 411(a) as jurisdictional. Second, when the Court of Appeals asked petitioners to brief whether § 411(a) restricted the District Court's subject-matter jurisdiction, they argued that it did not, and the Court of Appeals rejected their arguments. See App. to Reply Brief for Petitioners 3a–5a, and n. 2. Accepting petitioners' arguments here thus cannot create "inconsistent court determinations" in their favor. *New Hampshire, supra*, at 751, 121 S.Ct. 1808 (internal quotation marks omitted). We therefore hold that the District Court had authority to adjudicate the parties' request to approve their settlement.

#### IV

Our holding that § 411(a) does not restrict a federal court's subject-matter jurisdiction precludes the need for us to address the parties' alternative arguments as to whether the District Court had authority to approve the settlement even under the Court of Appeals' erroneous reading of § 411. In \*171 concluding that the District Court had jurisdiction to approve the settlement, we express no opinion on the settlement's merits.

We also decline to address whether § 411(a)'s registration requirement is a mandatory precondition to suit that—like the threshold conditions in *Arizona v. California*, 530 U.S. 392, 412–413, 120 S.Ct. 2304, 147 L.Ed.2d 374 (2000)

(res judicata defense); *Day v. McDonough*, 547 U.S. 198, 205–206, 126 S.Ct. 1675, 164 L.Ed.2d 376 (2006) (habeas statute of limitations); and *Hallstrom v. Tillamook County*, 493 U.S. 20, 26, 31, 110 S.Ct. 304, 107 L.Ed.2d 237 (1989) (Resource Conservation and Recovery Act of 1976 notice provision)—district courts may or should enforce *sua sponte* by dismissing copyright infringement claims involving unregistered works.

\*\*\*

We reverse the judgment of the Court of Appeals for the Second Circuit and remand this case for proceedings consistent with this opinion.

*It is so ordered.*

Justice SOTOMAYOR took no part in the consideration or decision of this case.

\*\*1250 Justice GINSBURG, with whom Justice STEVENS and Justice BREYER join, concurring in part and concurring in the judgment.

I agree with the Court's characterization of 17 U.S.C.A. § 411(a) (Supp.2009). That provision, which instructs authors to register their copyrights before commencing suit for infringement, "is a precondition to filing a claim that does not restrict a federal court's subject-matter jurisdiction." *Ante*, at 1241. I further agree that *Arbaugh v. Y & H Corp.*, 546 U.S. 500, 126 S.Ct. 1235, 163 L.Ed.2d 1097 (2006), is the controlling precedent, see *ante*, at 1244, and that *Bowles v. Russell*, 551 U.S. 205, 127 S.Ct. 2360, 168 L.Ed.2d 96 (2007), does not counsel otherwise. There is, however, undeniable tension between the two decisions. Aiming to stave off continuing controversy over what qualifies \*172 as "jurisdictional," and what does not, I set out my understanding of the Court's opinions in *Arbaugh* and *Bowles*, and the ground on which I would reconcile those rulings.

In *Arbaugh*, we held nonjurisdictional a prescription confining Title VII's coverage to employers with 15 or more employees, 42 U.S.C. § 2000e–2(a)(1). After observing that "the 15–employee threshold ... 'd[id] not speak in jurisdictional terms or refer in any way to the jurisdiction of the district courts,' " 546 U.S., at 515, 126

S.Ct. 1235 (quoting *Zipes v. Trans World Airlines, Inc.*, 455 U.S. 385, 394, 102 S.Ct. 1127, 71 L.Ed.2d 234 (1982)), the *Arbaugh* opinion announced and applied a “readily administrable bright line”:

“If the Legislature clearly states that a threshold limitation on a statute’s scope shall count as jurisdictional, then courts and litigants will be duly instructed and will not be left to wrestle with the issue. But when Congress does not rank a statutory limitation on coverage as jurisdictional, courts should treat the restriction as nonjurisdictional in character. Applying that readily administrable bright line to this case, we hold that the threshold number of employees for application of Title VII is an element of a plaintiff’s claim for relief, not a jurisdictional issue.” 546 U.S., at 515–516, 126 S.Ct. 1235 (citation and footnote omitted).

As the above-quoted passage indicates, the unanimous *Arbaugh* Court anticipated that all federal courts would thereafter adhere to the “bright line” held dispositive that day.

*Bowles* moved in a different direction. A sharply divided Court there held “mandatory and jurisdictional” the time limits for filing a notice of appeal stated in 28 U.S.C. § 2107(a), (c). 551 U.S., at 209, 127 S.Ct. 2360 (internal quotation marks omitted). *Bowles* mentioned *Arbaugh* only to distinguish it as involving a statute setting “an employee-numerosity requirement, not a time limit.” 551 U.S., at 211, 127 S.Ct. 2360. Section 2107’s time limits were “jurisdictional,” *Bowles* explained, \*173 because they were contained in a statute, not merely a rule, *id.*, at 210–213, 127 S.Ct. 2360, and because “[t]his Court ha[d] long held that the taking of an appeal within the prescribed time is ‘mandatory and jurisdictional,’ ” *id.*, at 209, 127 S.Ct. 2360. Fidelity to *Arbaugh* and similarly reasoned decisions,\* the dissent in *Bowles* observed, would have yielded the conclusion that statutory time limits “are only jurisdictional if Congress says so.” 551 U.S., at 217, 127 S.Ct. 2360 (opinion of Souter, J.).

\*\*1251 *Bowles* and *Arbaugh* can be reconciled without distorting either decision, however, on the ground that *Bowles* “rel[ie]d on a long line of this Court’s decisions left undisturbed by Congress.” *Union Pacific R. Co. v. Locomotive Engineers and Trainmen Gen. Comm. of Adjustment, Central Region*, 558 U.S. 67, —, 130 S.Ct. 584, 597, 175 L.Ed.2d 428 (2009) (citing *Bowles*, 551 U.S.,

at 209–211, 127 S.Ct. 2360). The same is true of our decision, subsequent to *Bowles*, in *John R. Sand & Gravel Co. v. United States*, 552 U.S. 130, 128 S.Ct. 750, 169 L.Ed.2d 591 (2008). There the Court concluded, largely on *stare decisis* grounds, that the Court of Federal Claims statute of limitations requires *sua sponte* consideration of a lawsuit’s timeliness. *Id.*, at 136, 128 S.Ct. 750 (“[P]etitioner can succeed only by convincing us that this Court has overturned, or that it should now overturn, its earlier precedent.”).

Plainly read, *Arbaugh* and *Bowles* both point to the conclusion that § 411(a) is nonjurisdictional. Section 411(a) “does not speak in jurisdictional terms or refer in any way to the jurisdiction of the district courts.” *Zipes*, 455 U.S., at 394, 102 S.Ct. 1127. *Arbaugh*’s “readily administrable bright line” is therefore controlling. 546 U.S., at 516, 126 S.Ct. 1235.

*Bowles* does not detract from that determination. *Amicus*, reading *Bowles* as I do, urges on its authority that we hold § 411(a) jurisdictional lest we disregard “a century’s worth of precedent.” Brief for Court–Appointed *Amicus Curiae* in Support of Judgment Below 26 (quoting *Bowles*, 551 U.S., at 209, n. 2, 127 S.Ct. 2360); see *ante*, at 1247. But in *Bowles* and \*174 *John R. Sand & Gravel Co.*, as just explained, we relied on longstanding decisions of *this Court* typing the relevant prescriptions “jurisdictional.” *Bowles*, 551 U.S., at 209–210, 127 S.Ct. 2360 (citing, *inter alia*, *Scarborough v. Pargoud*, 108 U.S. 567, 2 S.Ct. 877, 27 L.Ed. 824 (1883), and *United States v. Curry*, 6 How. 106, 12 L.Ed. 363 (1848)); *John R. Sand & Gravel Co.*, 552 U.S., at 136, 128 S.Ct. 750. *Amicus* cites well over 200 opinions that characterize § 411(a) as jurisdictional, but not one is from this Court, and most are “‘drive-by jurisdictional rulings’ that should be accorded ‘no precedential effect.’ ” *Arbaugh*, 546 U.S., at 511, 126 S.Ct. 1235 (quoting *Steel Co. v. Citizens for Better Environment*, 523 U.S. 83, 91, 118 S.Ct. 1003, 140 L.Ed.2d 210 (1998)); see *Arbaugh*, 546 U.S., at 514–515, 126 S.Ct. 1235; *ante*, at 1243–1244.

\*\*\*

For the reasons stated, I join the Court’s judgment and concur in part in the Court’s opinion.



All Citations

Media L. Rep. 1321, 10 Cal. Daily Op. Serv. 2542, 2010 Daily Journal D.A.R. 3142, 22 Fla. L. Weekly Fed. S 143

559 U.S. 154, 130 S.Ct. 1237, 176 L.Ed.2d 18, 78 USLW 4176, 2009 Copr.L.Dec. P 29,914, 93 U.S.P.Q.2d 1719, 38

Footnotes

- \* The syllabus constitutes no part of the opinion of the Court but has been prepared by the Reporter of Decisions for the convenience of the reader. See *United States v. Detroit Timber & Lumber Co.*, 200 U.S. 321, 337, 26 S.Ct. 282, 50 L.Ed. 499.
- 1 Other sections of the Act—principally §§ 408–410—detail the registration process, and establish remedial incentives to encourage copyright holders to register their works, see, e.g., § 410(c); 17 U.S.C.A. § 412 (2005 ed. and Supp. 2009).
- 2 See *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200–1201 (C.A.10 2005); *Positive Black Talk Inc. v. Cash Money Records Inc.*, 394 F.3d 357, 365 (C.A.5 2004); *Xoom, Inc. v. Imageline, Inc.*, 323 F.3d 279, 283 (C.A.4 2003); *Murray Hill Publications, Inc. v. ABC Communications, Inc.*, 264 F.3d 622, 630, and n. 1 (C.A.6 2001); *Brewer–Giorgio v. Producers Video, Inc.*, 216 F.3d 1281, 1285 (C.A.11 2000); *Data Gen. Corp. v. Grumman Systems Support Corp.*, 36 F.3d 1147, 1163 (C.A.1 1994).
- 3 We appointed Deborah Jones Merritt to brief and argue the case, as *amicus curiae*, in support of the Court of Appeals' judgment. Ms. Merritt has ably discharged her assigned responsibilities.
- 4 See Act of Mar. 4, 1909, § 12, 35 Stat. 1078.
- 5 Cf. *Zipes*, 455 U.S., at 393–394, 397, 102 S.Ct. 1127 (relying on the fact that Congress had “approved” at least some cases awarding Title VII relief to claimants who had not complied with the statute’s Equal Employment Opportunity Commission (EEOC) filing requirement in holding that the filing requirement was not a jurisdictional prerequisite to suit); *United States v. Colton*, 535 U.S. 625, 630, 122 S.Ct. 1781, 152 L.Ed.2d 860 (2002) (“[J]urisdiction” properly refers to a court’s power to hear a case, a matter that “can never be forfeited or waived”).
- 6 See *Jones v. Bock*, 549 U.S. 199, 211, 127 S.Ct. 910, 166 L.Ed.2d 798 (2007) (treating the administrative exhaustion requirement of the Prison Litigation Reform Act of 1995 (PLRA)—which states that “no action shall be brought with respect to prison conditions under § 1983 of this title, or any other Federal law, by a prisoner ... until such administrative remedies as are available are exhausted,” 42 U.S.C. § 1997e(a)—as an affirmative defense even though “[t]here is no question that exhaustion is mandatory under the PLRA and that unexhausted claims cannot be brought in court”); *Woodford v. Ngo*, 548 U.S. 81, 93, 126 S.Ct. 2378, 165 L.Ed.2d 368 (2006) (same).
- 7 *Bowles*, for example, distinguished *Scarborough v. Principi*, 541 U.S. 401, 124 S.Ct. 1856, 158 L.Ed.2d 674 (2004), which characterized as nonjurisdictional an express statutory time limit for initiating postjudgment proceedings for attorney’s fees under the Equal Access to Justice Act. See 551 U.S., at 211, 127 S.Ct. 2360. As we explained, the time limit in *Scarborough* “concerned ‘a mode of relief ... ancillary to the judgment of a court’ that already had plenary jurisdiction.” 551 U.S., at 211, 127 S.Ct. 2360 (quoting *Scarborough, supra*, at 413, 124 S.Ct. 1856; (emphasis added)). *Bowles* also distinguished *Kontrick v. Ryan*, 540 U.S. 443, 124 S.Ct. 906, 157 L.Ed.2d 867 (2004), and *Eberhart v. United States*, 546 U.S. 12, 126 S.Ct. 403, 163 L.Ed.2d 14 (2005) (*per curiam*), as cases in which the Court properly held that certain time limits were nonjurisdictional because they were imposed by rules that did not purport to have any jurisdictional significance. See 551 U.S., at 210–211, 127 S.Ct. 2360. *Kontrick* involved “time constraints applicable to objections to discharge” in bankruptcy proceedings. 540 U.S., at 453, 124 S.Ct. 906. In that case, we first examined 28 U.S.C. § 157(b) (2)(J), the statute “conferring jurisdiction over objections to discharge,” and observed that it did not contain a timeliness requirement. *Kontrick*, 540 U.S., at 453, 124 S.Ct. 906. Rather, the “time constraints applicable to objections to discharge” were contained in the Bankruptcy Rules, which expressly state that they “shall not be construed to extend or limit the jurisdiction of the courts.” See *ibid.* (quoting *Fed. Rule Bkrtcy. Proc.* 9030). *Eberhart*, in turn, treated as nonjurisdictional certain rules that the Court held “closely parallel[ed]” those in *Kontrick*. 546 U.S., at 15, 126 S.Ct. 403.
- 8 This conclusion mirrors our holding in *Zipes* that Title VII’s EEOC filing requirement was nonjurisdictional, even though some of our own decisions had characterized it as jurisdictional. See 455 U.S., at 393, 102 S.Ct. 1127 (noting that “the legal character of the requirement was not at issue in those” earlier cases); see also *National Railroad Passenger Corporation v. Morgan*, 536 U.S. 101, 109, 121, 122 S.Ct. 2061, 153 L.Ed.2d 106 (2002) (relying on the analysis in *Zipes*).
- 9 *Amicus*’ remaining jurisdictional argument—that the policy goals underlying copyright registration support construing § 411(a)’s registration provisions as jurisdictional, see *Amicus* Brief 45—is similarly unavailing. We do not agree that a condition should be ranked as jurisdictional merely because it promotes important congressional objectives. See *Arbaugh*



*v. Y & H Corp.*, 546 U.S. 500, 504, 515–516, 126 S.Ct. 1235, 163 L.Ed.2d 1097 (2006) (holding that Title VII's numerosity requirement is nonjurisdictional even though it serves the important policy goal of "spar[ing] very small businesses from Title VII liability").

- \* *E.g.*, *Eberhart v. United States*, 546 U.S. 12, 126 S.Ct. 403, 163 L.Ed.2d 14 (2005) (*per curiam*); *Scarborough v. Principi*, 541 U.S. 401, 124 S.Ct. 1856, 158 L.Ed.2d 674 (2004); *Kontrick v. Ryan*, 540 U.S. 443, 124 S.Ct. 906, 157 L.Ed.2d 867 (2004).

**United States Court of Appeals, Ninth Circuit.**

**COSMETIC IDEAS, INC., a California corporation, doing business as Sweet Romance Jewelry Manufacturing, Plaintiff-Appellant, v. IAC/INTERACTIVECORP, a Delaware corporation; Home Shopping Network, Inc., a Delaware corporation; HSN LP, a Delaware limited partnership; HSN General Partner LLC, a Delaware limited liability company, Defendants-Appellees.**

**No. 08-56079.**

**Decided: May 25, 2010**

Before ANDREW J. KLEINFELD and RICHARD C. TALLMAN, Circuit Judges, and DAVID G. TRAGER,\* District Judge. Evan S. Cohen and S. Martin Keleti, Los Angeles, CA, for plaintiff-appellant Cosmetic Ideas, Inc. Edward T. Colbert, William H. Merone, and Erik C. Kane, Washington, DC, and Vicki E. Land, Los Angeles, CA, for defendants-appellees HSN LP, IAC/InterActiveCorp, Home Shopping Network, Inc. and HSN General Partner LLC.

OPINION

Plaintiff-Appellant Cosmetic Ideas, Inc. (“Cosmetic”) appeals the decision of the United States District Court for the Central District of California (“district court”) dismissing its claims against Defendants-Appellees IAC/InteractiveCorp, Home Shopping Network, Inc., HSN LP, and HSN General Partner LLC (collectively, “HSN”) for lack of subject-matter jurisdiction. The district court determined that Cosmetic failed to comply with the registration requirement of 17 U.S.C. § 411(a), which makes registration of a copyright a prerequisite to bringing an infringement suit, then concluded that lack of registration deprived it of jurisdiction. Cosmetic contends that it complied with § 411(a), because it submitted a completed registration application to the Copyright Office before instituting its infringement action. HSN argues that registration occurs only after the Copyright Office has affirmatively granted a registration.

Background

(1)

In 1997, Cosmetic, doing business as Sweet Romance Jewelry Manufacturing, created a piece of costume jewelry known as the “Lady Caroline Lorgnette” (“the necklace”). Cosmetic began manufacturing and selling copies of the necklace in 1999, and continues to manufacture and sell copies through various stores and websites. Cosmetic claims that sometime between 2005 and 2008, HSN began manufacturing and distributing copies of a “virtually identical” necklace.

On March 6, 2008, Cosmetic submitted an application to the Copyright Office for registration of its copyright in the necklace, and received confirmation of receipt of the application on March 12, 2008. On March 27, 2008, Cosmetic filed a complaint alleging that HSN had infringed on Cosmetic's copyright in the necklace. Although the Copyright Office ultimately issued Cosmetic a registration certificate for its copyright in the necklace, it did not do so before Cosmetic filed its complaint.

On June 2, 2008, HSN filed a motion to dismiss for failure to state a claim and lack of subject-matter jurisdiction. HSN argued that Cosmetic did not possess a valid copyright registration when it commenced its action, and thus the court lacked subject-matter jurisdiction over the claim of copyright infringement. On June 17, 2008, the district court granted the motion to dismiss on the basis that it lacked subject-matter jurisdiction. Cosmetic timely appealed.

We have jurisdiction pursuant to 28 U.S.C. § 1291, and we reverse.

(2)

The district court's dismissal for lack of subject-matter jurisdiction is reviewed de novo. *Rattlesnake Coal v. U.S. EPA*, 509 F.3d 1095, 1100 (9th Cir.2007). In this case, the district court's decision to dismiss was necessarily—though without discussion—based on its interpretation of the Copyright Act, 17 U.S.C. § 101 et seq. (2006). Questions of statutory interpretation are reviewed de novo. *Mollison v. United States*, 568 F.3d 1073, 1075 (9th Cir.2009).

## Discussion

(1)

We first address HSN's argument that § 411(a)'s registration requirement—which mandates that a copyrighted work be registered before an infringement action can be brought—is a jurisdictional prerequisite to suit. In *Reed Elsevier, Inc. v. Muchnick*, --- U.S. ---, 130 S.Ct. 1237 (2010), the Supreme Court held otherwise.<sup>2</sup> Specifically, *Reed Elsevier* held that, although “[s]ection 411(a)'s registration requirement is a pre-condition to filing a claim,” it “does not restrict a federal court's subject-matter jurisdiction.” 130 S.Ct. at 1241. Therefore, the district court's dismissal of *Cosmetic's* complaint on the basis of lack of subject-matter jurisdiction—which must have been predicated on a conclusion that *Cosmetic* had not registered its copyright—was error.

(2)

However, this conclusion does not end our inquiry, as the district court still may have correctly dismissed the suit on another basis. This court “may affirm the district court on any ground supported by the record, even if the ground is not relied on by the district court.” *Charley's Taxi Radio Dispatch Corp. v. SIDA of Hawaii, Inc.*, 810 F.2d 869, 874 (9th Cir.1987). Below, HSN moved to dismiss the complaint for failure to state a claim, pursuant to Federal Rule of Civil Procedure 12(b)(6). Specifically, HSN argued that *Cosmetic* failed to register the necklace, and post-*Reed Elsevier*, registration is an element of an infringement claim, rather than a jurisdictional bar.

Thus, we are asked to answer the question: What does it mean to “register” a copyrighted work? Stated another way, is a copyright registered at the time the copyright holder's application is received by the Copyright Office (the “application approach”), or at the time that the Office acts on the application and issues a certificate of registration (the “registration approach”)?<sup>3</sup> Our sister circuits have split in answering this question.<sup>4</sup> For instance, the Fifth and Seventh Circuits have adopted the application approach. *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). The Tenth and Eleventh Circuits have adopted the registration approach. *La Resolana*, 416 F.3d at 1202-04; *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1489 (11th Cir.1990), abrogated in part by *Reed Elsevier*, 120 S.Ct. at 1243 & n. 2.

We now turn to this issue.<sup>5</sup>

A

We first note that, according to the representations of *Cosmetic* at oral argument and in subsequent briefing, the Copyright Office has now acted on *Cosmetic's* application and issued a certificate of registration of copyright in the necklace. Once a certificate is issued, the registration dates back to the date of application. 17 U.S.C. § 410(d). Thus, *Cosmetic* can now allege the registration element of an infringement claim, irrespective of whether registration accrues at application or issuance. Nonetheless, we address the issue of the point at which a work is registered because it is an unsettled issue of law in this Circuit, and because it is an issue “capable of repetition yet evading review” if the Copyright Office acts on the application during litigation. See *Gerstein v. Pugh*, 420 U.S. 103, 110 n. 11 (1975) (citing *Sosna v. Iowa*, 419 U.S. 393, 402 n. 11 (1975)); *United States v. Brandau*, 578 F.3d 1064, 1067 (9th Cir.2009).

B

In interpreting a statutory provision, we begin with the plain language of the statute. See *K & N Eng'g, Inc. v. Bulat*, 510 F.3d 1079, 1081 (9th Cir.2007). Section 411(a) of the Copyright Act of 1976 (the “Act” or “1976 Act”) provides, in relevant part: “[N]o civil action for infringement of the copyright in any United States work shall be instituted until pre-registration or registration of the copyright claim has been made in accordance with this title.”<sup>6</sup> 17 U.S.C. § 411(a). “Registration” is unhelpfully defined as “a registration of a claim in the original or the renewed and extended term of copyright.” 17 U.S.C. § 101.

Because the clause at issue gives no guidance in interpreting the meaning of “registration,” we turn to the language of the statute as a whole to determine the intended meaning. See *United States v. Cruz-*

Gramajo, 570 F.3d 1162, 1167 (9th Cir.2009) (“While the starting point is always the language of the statute itself . [r]ather than focusing just on the word or phrase at issue, this court looks to the entire statute to determine . intent.” (internal quotation marks and citations omitted)). An examination of the statutory language here, however, reveals ambiguity that leaves us no closer to determining which interpretation to adopt.

Looking to the Act as a whole, copyright registration is addressed in five consecutive sections: §§ 408 through 412. Two subsections of the Act, § 410(a) and portions of § 411(a), contain language that suggests that registration requires some affirmative steps to be taken by the Copyright Office. Section 410(a) details the role of the Register of Copyrights (“the Register”):

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.

17 U.S.C. § 410(a) (emphasis added). This provision places an active burden of examination and registration upon the Register, suggesting that registration is not accomplished by application alone. See, e.g., Loree Rodkin, 315 F.Supp.2d at 1055 (reading the provision in this way). But see Iconbazaar, 308 F.Supp.2d at 634 (pointing out that this section “could be read to apply only to the requirements for issuance of a registration certificate, not to the requirements for instituting an action for infringement”).

The latter portion of § 411(a) can be read similarly. The portion of § 411(a) setting forth the registration requirement is followed by an exception:

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.

17 U.S.C. § 411(a) (emphasis added). Because registration in this subsection is juxtaposed with the separate act of delivering the necessary application materials to the Copyright Office, this subsection could be read to mean that Congress intended registration to require acceptance or refusal by the Register, not mere delivery. See, e.g., Strategy Source, 233 F.Supp.2d at 3-4; Loree Rodkin, 315 F.Supp.2d at 1055-56.

Other sections of the Act, however, cast doubt on this interpretation. In particular, § 408 blurs the line between application and registration and favors the application approach. In setting forth the permissive registration requirements, § 408 states: “[T]he owner of copyright or of any exclusive right in the work may obtain registration . by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified .” 17 U.S.C. § 408(a) (emphasis added). This section implies that the sole requirement for obtaining registration is delivery of the appropriate documents and fee. See Prunté, 484 F.Supp.2d at 40 (concurring in this analysis and adopting the application approach); Iconbazaar, 308 F.Supp.2d at 634 (same); but see Ryan, 1998 WL 320817, at \*3 (adopting the registration approach and concluding that § 408(a) means “merely that the delivery of the application is a step the applicant must take, not that delivery is sufficient by itself to obtain a registration”).<sup>7</sup>

One final relevant subsection of the Act, § 410(d), could be read as supporting either the application or registration approach. Section 410(d) provides: “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.” 17 U.S.C. § 410(d). Because this subsection dates a later-approved registration as of the date of its application, it supports the interpretation that application is the critical event. See, e.g., Dielsi, 916 F.Supp. at 994 n. 6; Prunté, 484 F.Supp.2d at 40. However, because this back-dating does not occur until after the Copyright Office or a court has deemed the registration acceptable, the statute could be read to require action by the Register to effect registration. See, e.g., La Resolana, 416 F.3d at 1204 n. 9 (“It is not

logical to assume that the relation-back provision subsumes the explicit requirements of § 411 and § 410(a).”); Ryan, 1998 WL 320817, at \*2; Brush Creek, 2002 WL 1906620, at \*3-4.

We are not persuaded that the plain language of the Act unequivocally supports either the registration or application approach. Although in some places the Act seems to equate registration with affirmative approval by the Copyright Office, in others the Act suggests registration is accomplished by completing the process of submitting an application. This ambiguity makes it necessary to go beyond the Act's plain language to determine which approach better carries out the purpose of the statute.

C

When statutory language proves unclear, we work to discern its meaning by looking to “the broader context of the statute as a whole” and the purpose of the statute. See *United States v. Olander*, 572 F.3d 764, 768 (9th Cir.2009) (quoting *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341 (1997)). An understanding of the history of § 411 is helpful in discerning the statute's purpose. Section 411 is a product of the 1976 Act, which drastically amended the 1909 Act. See Pub.L. No. 94-553, 90 Stat. 2541 (1976); see also H.R.Rep. No. 94-1476, at 129 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5745. Under the 1909 Act, federal copyright protection attached only upon publication, and even then, only if proper notice, registration, and deposit occurred.<sup>8</sup> See H.R.Rep. No. 94-1476, at 129, 143, 146, 150. Protection of unpublished works was left to the states. *Id.* at 129. The 1976 Act, however, created a unitary system that attached federal copyright protection to all works-published and unpublished-at the time of their creation. Pub.L. No. 94-553, § 301(a) (codified at 17 U.S.C. § 301(a)); see also H.R.Rep. No. 94-1476, at 129. It also eliminated some of the prior formalities of copyright law by relaxing notice requirements and eliminating mandatory registration. See Pub.L. No. 94-553, §§ 301, 401-412 (codified at 17 U.S.C. §§ 301, 401-412); see also H.R.Rep. No. 94-1476, at 147, 150.<sup>9</sup> These changes vastly increased the scope of works subject to copyright protection, thus providing an incentive to create expressive works. See, e.g., *Chicago Bd. of Educ.*, 354 F.3d at 631.

Although registration was made optional, Congress still valued having a robust federal register of existing copyrights. See H.R.Rep. No. 94-1476, at 158.<sup>10</sup> To this end, it chose to encourage copyright holders to register with the Office of Copyright through various statutory incentives. See 17 U.S.C. §§ 410-412. For instance, if a copyright holder secures a registration certificate within five years after first publication, such certificate will constitute prima facie evidence of both the validity of the copyright and the facts stated in the certificate. 17 U.S.C. § 410(c). Moreover, certain remedies, such as statutory damages and attorney's fees, are available only after registration.<sup>11</sup> 17 U.S.C. § 412. Finally, registration is required for U.S. works prior to bringing any infringement action.<sup>12</sup> 17 U.S.C. § 411(a). Indeed, because registration is not mandatory under the Act, copyright holders frequently register specifically for the purpose of being able to bring suit.

With this framework in mind, we conclude that the application approach better fulfills Congress's purpose of providing broad copyright protection while maintaining a robust federal register.

First, the application approach avoids unnecessary delay in copyright infringement litigation, which could permit an infringing party to continue to profit from its wrongful acts. Section 411(a) allows a party, after applying for registration, to litigate the claim whether the Copyright Office accepts or rejects the registration. See 17 U.S.C. § 411(a) (permitting an applicant to bring an infringement suit after the Register has rejected his or her registration, so long as the Register is notified of the suit); see also *Forasté*, 248 F.Supp.2d at 77 n. 10; *Prunté*, 484 F.Supp.2d at 40. Under the registration approach, however, a party must wait on the Copyright Office's affirmative acceptance or rejection, despite knowing that suit can proceed in either event. As the leading treatise on copyright explains, the registration approach thus creates a strange scheme: “[G]iven that the claimant . . . will ultimately be allowed to proceed regardless of how the Copyright Office treats the application, it makes little sense to create a period of ‘legal limbo’ in which suit is barred.” See 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 7.16[B][1][a][i] (2008) (“Nimmer”). The application approach avoids this legal limbo-and avoids prolonging the period of infringement-by allowing a litigant to proceed with an infringement suit as soon as he has taken all of the necessary steps to register the copyright at issue.

Moreover, the application approach avoids delay without impairing the central goal of copyright registration. As explained above, copyright registration is now a voluntary procedure, with the pre-litigation registration requirement acting as an incentive to help Congress maintain a robust national register of copyrights. See H.R.Rep. No. 94-1476, at 158 (“Copyright registration for published works, which is useful and important to users and the public at large . should . be induced in some practical way.”). This goal, however, is accomplished equally by the registration and application approaches, as either approach requires a party to submit the information necessary to add the copyright to the federal registry. See 17 U.S.C. §§ 408-409 (setting forth the steps an applicant must take to register a copyright).

The registration approach's added requirement of affirmative approval or rejection before suit thus amounts to little more than just the type of needless formality Congress generally worked to eliminate in the 1976 Act. On this point, it is telling that even many courts adopting the registration approach have recognized that “construing the statute this way leads to an inefficient and peculiar result.” *Brush Creek*, 2002 WL 1906620, at \*4 (quoting *Ryan*, 1998 WL 320817, at \*2); *Loree Rodkin*, 315 F.Supp.2d at 1056-57 (same); *Strategy Source*, 233 F.Supp.2d at 3 (same). We agree. It makes little sense to dismiss a case (which will likely be refiled in a matter of weeks or months) simply because the Copyright Office has not made a prompt decision that will have no substantive impact on whether or not a litigant can ultimately proceed.

Furthermore, in addition to being generally inefficient, in the worst-case scenario the registration approach could cause a party to lose its ability to sue. The Act provides a three-year statute of limitations for copyright infringement actions. 17 U.S.C. § 507(b). Thus, under the registration approach, a plaintiff who applied for registration towards the end of the three-year period could see the statute of limitations expire during the time it took the Copyright Office to act on the application. See *Nimmer* § 7.16[B][1] [a] [i] (“[G]iven . a three-year statute of limitations for recovery of all damages caused by copyright infringement, the narrow[registration] approach may indeed occasion complete inability to recover damages.”). This result does not square well with § 410(d)'s mandate that an application's effective registration date should be the day that a completed application is received. In specifying that registration is to be dated as of the date of application-not approval-Congress sought to ensure that an applicant did not suffer the consequences of a delay by the Register. See H.R.Rep. No. 94-1476 at 157 (noting that the provision is designed to “take[ ] account of the inevitable timelag between receipt of the application and other material and the issuance of the certificate.”). Only the application approach fully protects litigants from any disadvantage caused by this timelag.

Finally, we find unpersuasive the argument that deference to the Register requires adoption of the registration approach. This argument posits that Congress structured the Act to require the Register's approval or rejection of registration before suit because it wanted the Register to determine the propriety of granting copyright registration in the first instance. See, e.g., *Strategy Source*, 233 F.Supp.2d at 4. However, as *Nimmer* explains, “the pace of litigation entails that the Copyright Office will typically have granted or refused registration during its pendency.” *Nimmer* § 7.16[B][1][a][i]. Thus, should the Register determine that it wanted to reject an application already in litigation, it would still have an opportunity to appear. *Id.* Furthermore, the Register's decision of whether or not to grant a registration certificate is largely perfunctory, and is ultimately reviewable by the courts.<sup>13</sup> There is, therefore, no compelling justification for delaying litigation until after the Register has acted on an application. The two processes-registration approval by the Copyright Office and an underlying infringement case in the courts-can occur simultaneously with little or no prejudice to any involved parties.<sup>14</sup>

We therefore hold that receipt by the Copyright Office of a complete application satisfies the registration requirement of § 411(a). This interpretation ensures the broad copyright protection that the 1976 Act provided. It “best effectuate[s] the interests of justice and promote[s] judicial economy.” *Int'l Kitchen Exhaust Cleaning Ass'n v. Power Washers of North America*, 81 F.Supp.2d 70, 72 (D.D.C.2000). This approach also fully accomplishes the central purpose of registration-the compilation of a robust national register of existing copyrights-and at the same time avoids unfairness and waste of judicial resources. Cf. *Lau Ow Bew v. United States*, 144 U.S. 47, 59 (1892) (“Nothing is better settled than that statutes should receive a sensible construction, such as will effectuate the legislative intention, and, if possible, so as to

avoid an unjust or an absurd conclusion.”); *United States v. Leon H.*, 365 F.3d 750, 753 (9th Cir.2004) (citing *Lau Ow Bew*, 144 U.S. at 59).

(3)

Under the application approach, Cosmetic satisfied § 411(a)'s registration requirement before it instituted this action. Cosmetic alleged in its complaint that the Copyright Office received its complete application on March 12, 2008, weeks before Cosmetic filed its complaint. Thus, § 411(a) does not bar Cosmetic's infringement claim, which should proceed on its merits.

### Conclusion

The judgment of the district court dismissing this action is VACATED and REVERSED. This case is REMANDED to the district court for further proceedings consistent with this opinion.

### FOOTNOTES

1. At oral argument and in supplemental briefing, Cosmetic confirmed that it has now received a registration certificate and has filed a new infringement action against HSN, which has been stayed pending the outcome of this appeal. See *Cosmetic Ideas, Inc. v. HSN, Inc.*, CV-09-01215 (R)(RZx), Doc. No. 29 (C.D.Cal. May 18, 2009).
2. *Reed Elsevier* was pending before the Supreme Court at the time of the October 6, 2009 oral argument in this case. Submission was withdrawn on October 19, 2009, pending the Supreme Court's opinion. *Reed Elsevier* was handed down on March 2, 2010, and the parties have both filed briefs at this Court's direction discussing the effect of that case here. This case was resubmitted for decision on April 27, 2010.
3. The Tenth Circuit appears to have coined the terms “application approach” and “registration approach” in describing the two schools of thought. See *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1202-04 (10th Cir.2005), abrogated in part by *Reed Elsevier*, 130 S.Ct. at 1243 & n. 2.
4. The district courts are also split, sometimes even within the same circuit. District courts adopting the application approach include: *Tri-Mktg., Inc. v. Mainstream Mktg. Servs., Inc.*, No. CV-09-13, 2009 WL 1408741, at \*3 (D.Minn. May 19, 2009); *Precision Automation, Inc. v. Technical Servs., Inc.*, 628 F.Supp.2d 1244, 1248 (D.Or.2008); *Prunté v. Universal Music Group*, 484 F.Supp.2d 32, 39-40 (D.D.C.2007); *Phoenix Renovation Corp. v. Rodriguez*, 403 F.Supp.2d 510, 514-15 (E.D.Va.2005); *Iconbazaar, L.L.C. v. America Online, Inc.*, 308 F.Supp.2d 630, 633-34 (M.D.N.C.2004); *Forasté v. Brown Univ.*, 248 F.Supp.2d 71, 77-78 (D.R.I.2003); *Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp.*, 210 F.Supp.2d 147, 157 (E.D.N.Y.2002), *aff'd*, 354 F.3d 112 (2d Cir.2003); *Dielsi v. Falk*, 916 F.Supp. 985, 994 n. 6 (C.D.Cal.1996); *Havens v. Time Warner, Inc.*, 896 F.Supp. 141, 142-43 (S.D.N.Y.1995); *Sebastian Int'l, Inc. v. Consumer Contact (PTY) Ltd.*, 664 F.Supp. 909, 912 (D.N.J.1987), vacated on other grounds, 847 F.2d 1093 (3d. Cir.1988). District courts that adhere to the registration approach include: *Specific Software Solutions, LLC v. Inst. of Workcomp Advisors*, 615 F.Supp.2d 708, 715-16 (M.D.Tenn.2009); *Just Water Heaters, Inc. v. Affordable Water Heaters and Plumbing, Inc.*, No. C-05-4996, 2006 WL 449136, at \*3 (N.D.Cal. Feb. 23, 2006); *Mays & Assocs., Inc. v. Euler*, 370 F.Supp.2d 362, 370 (D.Md.2005); *Corbis Corp. v. Amazon.com, Inc.*, 351 F.Supp.2d 1090, 1112 (W.D.Wash.2004); *Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc.*, 315 F.Supp.2d 1053, 1056-57 (C.D.Cal.2004); *Corbis Corp. v. UGO Networks, Inc.*, 322 F.Supp.2d 520, 521-22 (S.D.N.Y.2004); *Strategy Source, Inc. v. Lee*, 233 F.Supp.2d 1, 3-4 (D.D.C.2002); *Brush Creek Media, Inc. v. Boujaklian*, No. C-02-3491, 2002 WL 1906620, at \*4 (N.D.Cal. Aug. 19, 2002); *Gerig v. Krause Publ'ns, Inc.*, 33 F.Supp.2d 1304, 1306 (D.Kan.1999); *Ryan v. Carl Corp.*, No. C-97-3873, 1998 WL 320817, at \*3 (N.D. Cal. June 15, 1998); *Kregos v. Associated Press*, 795 F.Supp. 1325, 1331 (S.D.N.Y.1992), *aff'd*, 3 F.3d 656 (2d Cir.1993); *Demetriades v. Kaufmann*, 680 F.Supp. 658, 661 (S.D.N.Y.1988). Many of these cases have been abrogated, in part, by the Supreme Court's decision in *Reed Elsevier*, 130 S.Ct. at 1243 & n. 2.



5. Although we addressed a similar issue in *Roth Greeting Cards v. United Card Co.*, that opinion does not control the outcome here, because it construed the language of the Copyright Act of 1909 (“1909 Act”), which has since been substantially amended. See 429 F.2d 1106, 1108-09 (9th Cir.1970) (holding that under the 1909 Act, a plaintiff could maintain his action the day he fully complied with the registration requirements by mailing in a revised application, and that the revised application's filing date related back to the original application).
6. Preregistration is allowed only for certain commercial works within categories that the Register of Copyrights has determined to have a history of infringement prior to commercial release, and is not applicable to the work in question here. See 17 U.S.C. § 408(f); 37 C.F.R. § 202.16(c) (2008).
7. The Tenth Circuit read § 408(a) to support the registration approach by positing that “may,” as used in that section, indicates that registration requires review. See *La Resolana*, 416 F.3d at 1201 (“This provision . . . envisions substantive review of the material by the Register of Copyrights. If it were otherwise, the verb would be ‘shall obtain’ instead of ‘may obtain.’” (internal quotation marks omitted)). But the word “may,” as used here, is better read to indicate that registration is now permissive, especially as the subsection is entitled “Registration Permissive”; if “shall obtain” were used, it would create a mandatory registration requirement.
8. Unlike the 1976 Act's registration procedures, registration under the 1909 Act did not allow for any discretionary determination by the Register of Copyright. Rather, if the proper steps had been taken—publication, notice, deposit, and payment of a fee—“it[was] the duty of the Register of Copyrights to issue a certificate of registration under the seal of the copyright office.” *Roth Greeting Cards*, 429 F.2d at 1108.
9. Notice has since been made entirely permissive, see 17 U.S.C. § 401(a), as Congress further relaxed copyright formalities in order to join the Berne Convention for the Protection of Literary and Artistic Works (“Berne Convention”), which requires that foreign works not be subject to formalities. See Berne Convention art. 5, Sept. 9, 1886 (Paris Text 1971), S. Treaty Doc. No. 99-27; Pub.L. No. 100-568, Sec. 7, 102 Stat. 2853 (1988) (adopting laws consistent with the Berne Convention, thus becoming party to the agreement).
10. In discussing the need for proposed registration incentives in the 1976 Act, the House Judiciary Committee explained: “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.
11. For infringement occurring prior to the effective date of registration, a copyright owner may still obtain actual damages and/or injunctive relief. See 17 U.S.C. §§ 502-505.
12. As a result of the Berne Convention's mandate that foreign works not be subject to formalities, § 411's pre-suit registration requirement does not apply to non-U.S. works. See Berne Convention, art. 5.
13. The Register looks only to ensure that the material deposited is “copyrightable subject matter” and that the legal and formal requirements of the Title have been met. 17 U.S.C. § 410(a). After the Register's determination, the courts are empowered to review any denial of a certificate, and approval by the Register gives an applicant only prima facie evidence of copyright, leaving the courts to make the ultimate determination in either instance. See §§ 411(a), 410(c).
14. In fact, a defendant is in some ways aided by a plaintiff's lack of a certificate, because if a party proceeds to litigation without a registration certificate, it bears a greater evidentiary burden of proving the validity of its copyright. See 17 U.S.C. § 410(c) (“In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.”).

TRAGER, District Judge:



## Fourth Estate Public Benefit Corp. v. Wall-Street.com *Pending petition*

Docket No.	Op. Below	Argument	Opinion	Vote	Author	Term
17-571	11th Cir.	TBD	TBD	TBD	TBD	TBD

**Issue:** Whether the “registration of [a] copyright claim has been made” within the meaning of 17 U.S.C. § 411(a) when the copyright holder delivers the required application, deposit, and fee to the Copyright Office, as the U.S. Courts of Appeal for the 5th and 9th Circuits have held, or only once the Copyright Office acts on that application, as the U.S. Courts of Appeals for the 10th and, in the decision below, the 11th Circuits have held.

### SCOTUSblog Coverage

- [Petition of the day \(Aurora Barnes\)](#)

Date	Proceedings and Orders
Aug 04 2017	Application (17A150) to extend the time to file a petition for a writ of certiorari from August 16, 2017 to October 13, 2017, submitted to Justice Thomas.
Aug 07 2017	Application (17A150) granted by Justice Thomas extending the time to file until October 13, 2017.
Oct 13 2017	<a href="#">Petition for a writ of certiorari filed. (Response due November 15, 2017)</a>
Oct 13 2017	Waiver of right of respondents Wall-Street.com, LLC, et al. to respond filed.
Nov 01 2017	DISTRIBUTED for Conference of 11/21/2017.
Nov 02 2017	Response Requested. (Due December 4, 2017)
Nov 28 2017	<a href="#">Brief of respondents Wall-Street.com, LLC, et al. in opposition filed.</a>
Dec 13 2017	DISTRIBUTED for Conference of 1/5/2018.
Dec 13 2017	<a href="#">Reply of petitioner Fourth Estate Public Benefit Corporation filed. (Distributed)</a>
Jan 08 2018	The Solicitor General is invited to file a brief in this case expressing the views of the United States.

[PUBLISH]

IN THE UNITED STATES COURT OF APPEALS  
FOR THE ELEVENTH CIRCUIT

---

No. 16-13726

---

D.C. Docket No. 0:16-cv-60497-RNS

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,

Plaintiff - Appellant,

versus

WALL-STREET.COM, LLC,  
JERROLD D. BURBEN,

Defendants - Appellees.

---

Appeal from the United States District Court  
for the Southern District of Florida

---

(May 18, 2017)

Before WILLIAM PRYOR, MARTIN, and BOGGS,\* Circuit Judges.

WILLIAM PRYOR, Circuit Judge:

“Registration” of a copyright is a precondition to filing suit for copyright infringement. 17 U.S.C. § 411(a). This appeal requires us to decide an issue that

---

\* Honorable Danny J. Boggs, United States Circuit Judge for the Sixth Circuit, sitting by designation.

has divided the circuits: whether registration occurs when an owner files an application to register the copyright or when the Register of Copyrights registers the copyright. *Compare Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 619 (9th Cir. 2010) (concluding that registration occurs when the owner files an application), *with La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1197 (10th Cir. 2005) (concluding that registration occurs when the Register approves an application), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 157 (2010). Fourth Estate Public Benefit Corporation filed a suit for infringement against Wall-Street.com and Jerrold Burden. The complaint alleged that Fourth Estate had filed an application to register its allegedly infringed copyrights, but that the Copyright Office had not registered its claims. The district court dismissed the action because Fourth Estate failed to plead compliance with the registration requirement, 17 U.S.C. § 411(a). Because registration occurs when the Register of Copyrights “register[s] the claim,” *id.* § 410(a), we affirm.

## I. BACKGROUND

Fourth Estate Public Benefit Corporation is a news organization that produces online journalism. It licenses articles to websites but retains the copyright to the articles. Wall-Street.com, a news website, obtained licenses to a number of articles produced by Fourth Estate. The license agreement required Wall-Street to

remove all of the content produced by Fourth Estate from its website before Wall-Street cancelled its account. But when Wall-Street cancelled its account, it continued to display the articles produced by Fourth Estate.

Fourth Estate filed a complaint for copyright infringement, 17 U.S.C. § 501, against Wall-Street and its owner, Jerrold Burden. The complaint alleged that Fourth Estate had filed “applications to register [the] articles with the Register of Copyrights.” But the complaint did not allege that the Register of Copyrights had yet acted on the application.

Wall-Street and Burden moved to dismiss the complaint. They argued that the Copyright Act, *id.* § 411(a), permits a suit for copyright infringement only after the Register of Copyrights approves or denies an application to register a copyright. The district court agreed and dismissed the complaint without prejudice.

## II. STANDARD OF REVIEW

“We review *de novo* the district court’s grant of a motion to dismiss under [Federal Rule of Civil Procedure] 12(b)(6) for failure to state a claim, accepting the factual allegations in the complaint as true and construing them in the light most favorable to the plaintiff.” *Glover v. Liggett Grp., Inc.*, 459 F.3d 1304, 1308 (11th Cir. 2006) (emphasis added).

### III. DISCUSSION

As a preliminary matter, the issue presented does not involve jurisdiction. Until 2010, our precedent held that registration was a jurisdictional prerequisite to filing an action for infringement. *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488 (11th Cir. 1990). But in *Reed Elsevier, Inc. v. Muchnick*, the Supreme Court held that the “registration requirement is a precondition to filing a claim that does not restrict a federal court’s subject-matter jurisdiction.” 559 U.S. 154, 157 (2010).

Although registration is voluntary under the Copyright Act, Congress created several incentives for a copyright owner to register his copyright, *Kernel Records Oy v. Mosley*, 694 F.3d 1294, 1301 (11th Cir. 2012), one of which is the right to enforce a copyright in an infringement action:

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

17 U.S.C. § 411(a); *see also id.* § 408(f) (explaining that the Register “shall permit preregistration” for a limited class of works that have “a history of infringement prior to authorized commercial distribution”); 37 C.F.R. § 202.16(b)(1) (defining the limited class of works capable of preregistration to include material such as

movies and sound recordings not at issue in this appeal). The question we must decide is when registration occurs.

The question when registration occurs has split the circuits. The Tenth Circuit follows the “registration” approach to section 411(a), which requires a copyright owner to plead that the Register of Copyrights has acted on the application—either by approving or denying it—before a copyright owner can file an infringement action. *La Resolana*, 416 F.3d at 1197–1203. In contrast, the Ninth and Fifth Circuits follow the “application” approach, which requires a copyright owner to plead that he has filed “the deposit, application, and fee required for registration,” 17 U.S.C. § 411(a), before filing a suit for infringement. *Cosmetic Ideas*, 606 F.3d at 618–19; *Positive Black Talk Inc. v. Cash Money Records Inc.*, 394 F.3d 357, 365 (5th Cir. 2004), *abrogated in part by Muchnick*, 559 U.S. 154; *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386–87 (5th Cir. 1984); *see also* Melville B. Nimmer, et al., 2 *Nimmer on Copyright* § 7.16[B][3][b][v] (2016). The Eighth Circuit, in dicta, also endorsed the application approach. *Action Tapes, Inc. v. Mattson*, 462 F.3d 1010, 1013 (8th Cir. 2006). The caselaw of the Seventh Circuit contains conflicting dicta on whether it follows the application approach, *Chi. 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.”), or the registration approach, *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.”), or whether it has even decided this question, *Brooks-Ngwenya v. Indianapolis Pub. Sch.*, 564 F.3d 804, 806 (7th Cir. 2009). And both the First and Second Circuits have acknowledged the circuit split but have declined to decide whether to adopt the application approach or the registration approach. *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).

The parties dispute whether our precedents bind us to follow either approach. Wall-Street argues that our Circuit has adopted the registration approach and cites *M.G.B. Homes*, where we stated that a “lawsuit for copyright infringement cannot be filed unless plaintiff has a *registered* copyright.” *M.G.B. Homes*, 903 F.2d at 1488 n.4 (quoting *Haan Crafts Corp. v. Craft Masters, Inc.*, 683 F. Supp. 1234, 1242 (N.D. Ind. 1988)); *see also Kernel Records*, 694 F.3d at 1302 n.8 (stating that “[w]e adopted the ‘registration’ approach in *M.G.B. Homes*.”). Fourth Estate counters that we are not bound by *M.G.B. Homes* because *Muchnick* eroded the rationale for following the registration approach.

We need not decide this dispute about our precedents because the text of the Copyright Act makes clear that the registration approach that we endorsed in *M.G.B. Homes* and *Kernel Records* is correct. “[R]egistration of [a] copyright . . . has [not] been made in accordance with . . . title [17],” 17 U.S.C. § 411(a), until

“the Register . . . register[s] the claim,” *id.* § 410(a). Filing an application does not amount to registration.

The Copyright Act defines registration as a process that requires action by both the copyright owner and the Copyright Office. A copyright owner must first deposit a copy of the material with the Copyright Office, file an application, and pay a fee. *Id.* § 408(a). The Register of Copyrights then examines the material and determines whether “the material deposited constitutes copyrightable subject matter.” *Id.* § 410(a). If the material is copyrightable “the Register shall register the claim and issue to the applicant a certificate of registration.” *Id.* If “the material deposited does not constitute copyrightable subject matter . . . , the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal.” *Id.* § 410(b).

The use of the phrase “after examination” in section 410(a) makes explicit that an application alone is insufficient for registration:

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.

*Id.* § 410(a) (emphasis added). That registration occurs only *after* examination of an application necessarily means that registration occurs “[l]ater in time than” or



“subsequent to” the filing of the application for registration. *After, Webster’s New International Dictionary* 45 (2d ed. 1961).

Section 410(b) also establishes that registration can occur only after application and examination. That section states, “In any case in which the Register of Copyrights determines that . . . the material deposited does not constitute copyrightable subject matter . . . the Register shall refuse registration.” 17 U.S.C. § 410(b). And section 411(a) allows a copyright holder who filed an application for registration to file an infringement suit if “registration has been refused.” *Id.* § 411(a). If registration occurred as soon as an application was filed, then the Register of Copyrights would have no power to “refuse registration.” *Id.* § 410(b).

Fourth Estate argues that section 408(a) supports the application approach because it fails to mention the certificate of registration, but we disagree. Section 408(a) states, “[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 specified by sections 409 and 708.” *Id.* § 408(a). This section states only the conditions a copyright owner must satisfy to obtain registration. It does not speak to the timing of registration or the obligation of the Register of Copyrights to examine and approve or refuse an application.

Section 410(d) also supports the registration approach, notwithstanding the argument of Fourth Estate to the contrary. That section states that “[t]he effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.” § 410(d). To be sure, section 410(d) relates registration back to the date that the owner files an application, but section 410(d) also makes evident that registration occurs only after the Register of Copyrights deems an application “to be acceptable.” *Id.* Like other provisions of Title 17, section 410(d) establishes that registration occurs only after review and approval by the Register of Copyrights.

Fourth Estate argues that the three-year statute of limitations for infringement suits, *id.* § 507(b), supports the application approach, but we disagree. Considered together, the registration requirement and the three-year statute of limitations reflect a statutory plan to encourage registration. *See La Resolana*, 416 F.3d at 1199 (“Although Congress established a voluntary registration system, it created incentives for copyright owners to register their copyrights.”). True, an owner who files an application late in the statute of limitations period risks losing the right to enforce his copyright in an infringement action because of the time needed to review an application. But this potential loss

encourages an owner to register his copyright soon after he obtains the copyright and before infringement occurs. And section 507(b) is not the only provision of the Copyright Act that favors prompt registration. *See* 17 U.S.C. § 410(c) (“[R]egistration *made before or within five years* after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.” (emphasis added)). That is, far from undermining the registration approach, the three-year statute of limitations further evidences that the Copyright Act encourages registration.

Fourth Estate devotes its remaining statutory arguments to legislative history and policy, but “[w]hen,” as here, “the words of a statute are unambiguous, then . . . judicial inquiry is complete.” *Villarreal v. R.J. Reynolds Tobacco Co.*, 839 F.3d 958, 969 (11th Cir. 2016) (en banc) (internal quotation marks omitted) (quoting *Conn. Nat’l Bank v. Germain*, 503 U.S. 249, 254 (1992)). Indeed, “[e]ven if a statute’s legislative history evinces an intent contrary to its straightforward statutory command, we do not resort to legislative history to cloud a statutory text that is clear.” *Id.* (internal quotation marks omitted) (quoting *Harry v. Marchant*, 291 F.3d 767, 772 (11th Cir. 2002) (en banc)).

Finally, this appeal is not akin to the “unusual circumstance” presented by *Pacific & Southern Co. v. Duncan*, 744 F.2d 1490 (11th Cir. 1984), in which we “allowed injunctive relief to be sought prior to registration” where there was

“infringement of a registered work, a continuing series of original works created with predictable regularity, and a substantial likelihood of future infringements.” *Stuart Weitzman, LLC v. Microcomputer Res., Inc.*, 542 F.3d 859, 865 n.6 (11th Cir. 2008) (citing *Pacific*, 744 F.2d at 1499 & n.17). As explained, Fourth Estate has not alleged infringement of any registered work. And this appeal, unlike *Pacific*, does not involve the ongoing creation of original works, or potential future infringement of works not yet created.

#### IV. CONCLUSION

We **AFFIRM** dismissal of the complaint filed by Fourth Estate.

## The deepening appellate divide over when copyright owners can sue

Alison Frankel



(Reuters) - The 11th U.S. Circuit Court of Appeals ruled last week in Fourth Estate v. Wall-Street.com that copyright holders can't sue for infringement until the U.S. Copyright Office has registered their works, deepening a split in the federal circuits over whether the copyright enforceability kicks in when IP owners apply for protection or when the federal government acts on their applications.

The U.S. Supreme Court held in 2010's Reed Elsevier v. Muchnick that federal courts have jurisdiction over actions involving unregistered copyrights, but reiterated that copyright owners have to register their works in order to sue.

The justices did not specify when the moment of registration occurs. The 10th Circuit, now joined by the 11th, requires copyright holders to have completed the application process and obtained formal registration. The 5th and 9th Circuits have said registrants can sue as long they've filed applications to register their works. The 7th Circuit, according to the 11th Circuit's ruling last week, has gone both ways, and the 1st and 2nd Circuits have so far declined to take sides, even though they've both acknowledged the split.

The muddle is not merely a technicality, either. According to the Copyright Office, it takes between six and 10 months for applications to be processed and copyrights to be registered. The statute of limitations for copyright infringement is three years. So as the 11th Circuit noted in the Fourth Estate case, if you want to enforce control over your IP, you don't have a lot of time to waste in applying to register your copyright.

Florida-based Fourth Estate, which bills itself as “an international, independent nongovernmental journalism public benefit corporation,” argued that such a rule doesn't make sense. The Copyright Office grants about 98 percent of the applications it receives, according to Fourth Estate. Forcing owners to wait for the bureaucratic machinery to crank to a conclusion serves no “public, private or statutory interest,” wrote the company's lawyers at Schneider Rothman Intellectual Law Group, citing (among other things) the definitive text Nimmer on Copyright.

“The registration approach makes courts subservient to ministerial requirements and compounds the work of judges by unnecessarily forcing them to dismiss cases without prejudice,” Fourth Estate said.

The 11th Circuit held, however, that the statutory text of the Copyright Act is clear: The registration process requires action by both the copyright owner and the Copyright Office.

The Copyright Act means to encourage authors to register their works, wrote Judge William Pryor for a panel that also included Judge Beverly Martin and 6th Circuit Judge Danny Boggs, sitting by designation, which is consistent with the 11th Circuit's interpretation of when authors can sue. "True, an owner who files an application late in the statute of limitations period risks losing the right to enforce his copyright in an infringement action because of the time needed to review an application. But this potential loss encourages an owner to register his copyright soon after he obtains the copyright and before infringement occurs."

Wall-Street.com, which Fourth Estate accused of continuing to publish its content after ending a subscription agreement, was represented by the Geller Law Group, which didn't return my call. I also reached out to Joel Rothman of the Schneider Rothman firm to see whether Fourth Estate planned to seek review of the 11th Circuit's decision but didn't hear back.

*Our Standards: The Thomson Reuters Trust Principles.*

We use cookies to customise content for your subscription and for analytics.

If you continue to browse Lexology, we will assume that you are happy to receive all our cookies. For further information please read our Cookie Policy.

# LEXOLOGY®

**Register now** for your free, tailored, daily legal newsfeed service.

Questions? Please contact [customerservices@lexology.com](mailto:customerservices@lexology.com)

[Register](#)

## SCOTUS invites Solicitor General's position on copyright registration pre-suit requirement

[Blog](#) Sports, Media and Entertainment Online

**USA** February 2 2018

The Copyright Act (the “Act”) permits copyright holders to bring civil infringement actions in federal district courts to enforce the exclusive rights provided under the Act, namely, the rights to reproduce, distribute, display, publicly perform, and create derivatives of an original work of authorship. However, an infringement action cannot be brought for a “United States work” until preregistration or registration of the copyright “has been made in accordance with [the Act].” 17 U.S.C. § 411. Due to differing interpretations of this provision, United States courts are currently split over whether a plaintiff in a copyright action is required to have an issued copyright registration before suing for infringement of a domestic work, or if all that is necessary in order to commence a federal litigation is the filing with the United States Copyright Office of a copyright application.

In particular, U.S. Circuit Courts of Appeal disagree on when a copyright registration “has been made” in order to satisfy the Act’s pre-suit registration requirement. The Fifth and Ninth Circuits interpret the Act to require only that an application be on file with the Copyright Office prior to commencement of litigation (“the application approach”). The Tenth and Eleventh Circuits, in contrast, maintain that a copyright must first be registered (“the registration approach”). The Seventh Circuit has expressed conflicting views on the applicable approach, and the First, Second, Third, Fourth, Sixth and Eighth Circuits have yet to directly address this issue. Whether this provision requires a completed registration or merely an application before filing suit is directly at issue in *Fourth Estate Public Benefit Corp. v. Wall-Street.com LLC* (“*Fourth Estate*”), a case currently making its way up through the federal appeals process, most recently by a cert. petition that was filed with the U.S. Supreme Court.

The practical distinction between the differing approaches is the timing of the filing of a federal copyright action. Unlike the submission of a copyright application which can be done quickly, registration requires the Copyright Office to examine an application and certify that the applied-for work qualifies for protection, a process that generally takes several months. Thus, *Fourth Estate* raises statutory and procedural issues potentially critical to U.S. copyright holders seeking to enforce their exclusive rights expeditiously, in any available forum.

The *Fourth Estate* case involves copyright infringement claims for “United States works,” thereby triggering the Act’s registration requirement.<sup>[1]</sup> Plaintiff Fourth Estate Public Benefit (FEPB) sued defendant Wall-Street.com, asserting infringement of copyrights in articles posted on defendant’s website after its license from FEPB allegedly lapsed. Although FEPB had filed applications for registration for the allegedly infringed works with the U.S. Copyright Office, it did not receive certificates of registration before filing suit. The



Florida district court thus dismissed the action, reasoning that FEPB failed to comply with the Act's registration requirement. In May 2017, the Eleventh Circuit Court of Appeals affirmed the dismissal, holding that merely filing an application is insufficient to satisfy the Act's registration requirement.

In October 2017, FEPB petitioned the U.S. Supreme Court for review of the Eleventh Circuit's decision. FEPB asks the Court resolve the current circuit split in favor of the more lenient, and plaintiff-friendly, application approach. In response, Wall-Street.com advocates for the stricter registration approach, relying on the Act's statutory text and contending that this approach better serves the Act's underlying policy goal of encouraging registration.

Most recently, on January 8, 2018, the Supreme Court invited the U.S. Solicitor General (SG) to file a brief expressing the U.S. government's views on this issue. The SG was not given any deadline to file its brief, and thus there is currently no definitive timeline for when the Supreme Court may decide FEPB's petition. However, the Court's request for the SG's view is an indication of serious interest in the petition. If the SG recommends granting FEPB's petition, then there is a strong chance that the Court may weigh in to resolve the current discrepancy among the lower courts.

Should the Supreme Court grant cert., this is a case all content owners should be watching. A holding in favor of the registration approach could create greater incentives for copyright owners to promptly register their works in order to guarantee that any subsequent litigation is filed within the Act's three year statute of limitations. Such a holding would also have the added effect of increasing the opportunity for plaintiffs to seek statutory damages, which are generally only available if a copyright registration is filed prior to an infringing act. Alternately, a holding in favor of the application approach will eliminate a defense previously available in district courts around the country, and allow serial copyright litigants to relentlessly commence federal actions without waiting to see if the Copyright Office issues a registration in connection with the applied-for work.

**DLA Piper** - Tamar Y. Duvdevani and Matthew Ganas

Powered by  
**LEXOLOGY.**

# Copyrights—An Overlooked IP Protection That Shouldn't Be Ignored

by Anthony S. Volpe and Thomas P. Gushue | UPDATED Feb 27, 2018 at 01:38 PM



Thomas P. Gushue, left, and Anthony S. Volpe, right of Volpe & Koenig.

Copyright protection is an often overlooked component of an intellectual property portfolio. However, it is important to consider pursuing copyright protection in order to provide a more robust intellectual property portfolio. Given the relatively low costs to acquire a copyright registration and the ability to collect statutory damages, pursuing a copyright registration can prove to be a worthwhile expense. Although copyright registration is often a relatively simple process, there is an ongoing split among various circuit courts as to the effectiveness of a pending copyright application for registration versus that of an issued copyright registration. The difference can have important consequences for pursuing a copyright infringement action.

A copyright protects an author's "original works" once they are fixed in a tangible medium. The hallmark of copyright protection is creativity that is manifested in an original work. While creativity is a basic requirement for copyright protection, the requisite level of creativity is low and most original works meet the standard. In fact, the U.S. Supreme Court stated that even an "extremely low" or "slight amount" of creative expression meets the standard, see *Feist Publications v. Rural Telephone Service*, 499 U.S. 340, 346 (1991)). Under this standard, copyright protection is available for original works in things as diverse as marketing or promotional materials, instruction manuals, specification sheets, catalogues, movie posters, painting and software code. As a general matter, copyright protection is available for most materials generated in connection with a product or service, even if it is not a new product or service. There is no required level of artist achievement required for copyright protection.

Although the creativity bar is low, it is not nonexistent, and courts will examine whether that bar is satisfied. Recently, Taylor Swift was accused of copyright infringement for her song "Shake It Off" by the song writers of pop group 3LW's song "Playas Gon' Play." In examining the threshold and dismissing the song writers' claim, the judge held the lyrics "playas, they gonna play" and

"haters, they gonna hate" from the song "Playas Gon' Play" were not sufficiently creative enough in the first instance to warrant copyright protection, and, therefore, Swift was not liable for copyright infringement. The judge did not rule on whether Swift's song itself was original enough to warrant copyright protection. Rather, the ruling addressed the fact that the allegedly copied terms or phrases were not original enough to warrant copyright protection, so there could be no infringement.

The desirability of securing copyright protection becomes even more evident when the application process and cost are weighed against the investment in time and cost. Keeping in mind that the copyright manifests itself upon fixation in a tangible medium, there is no further action needed. Putting aside intricacies that can arise in a particular situation, the process is relatively simple and inexpensive. A copyright application only requires three items: an application form, a filing fee, which can be a little as \$35 or \$55, and a nonreturnable deposit copy of the subject work. The attorney fees, if an attorney is engaged to prepare the application and there are no intricacies or unforeseen complexities, are relatively inexpensive compared to the fees associated with other types of intellectual property issues, such as trademark clearances and patent applications.

There are some caveats that must be heeded and they most often precede the decision to file an application. If there are possibly multiple authors, it is important to secure assignment of any "work for hire." There are very specific rules for assignments, such as they must be in writing, but once an organization becomes familiar with the requirements, the collection of this information can become routine.

Putting aside unusual complexities, copyright applications do not undergo substantive examination by in the Copyright Office. The Copyright Office overwhelmingly grants copyrights and only rejects applications for a few reasons, such as the work being ineligible subject matter or the work lacking the requisite level of creativity. Registration usually does not take more than a few months, but it is still recommended to file an application as soon as possible, either as a published or unpublished work.

The copyright application for registration is relatively straight forward; however, the effectiveness of filling the application but not having the registration in the area of enforcement is unsettled. The relevant copyright statute seems straight forward in requiring "registration" to bring an infringement action, see 17 U.S. Code Section 411. Nevertheless, there is significant disagreement among the various circuits regarding when an infringement suit can be filed. This has resulted in two interpretations regarding this statute and the timing of bringing an infringement suit.

One approach, known as the "application approach," allows a copyright applicant to bring an infringement suit as soon the application is submitted to the Copyright Office, see, e.g., *Cosmetic Ideas v. IAC/InteractiveCorp.*, 606 F.3d 612 (9th Cir. 2010)). Under this approach, plaintiffs do not need to await the Copyright Office's review and grant of a copyright registration prior to bringing an infringement action. This approach is considered pro-plaintiff/pro-applicant because it allows for the filing of a lawsuit immediately after applying for the copyright registration. Since the registration process is mostly *pro forma*, this approach has been interpreted as a common sense approach, albeit not necessarily in line with the text of the copyright statute.

The other approach, known as the "registration approach," requires an applicant to complete the registration process and obtain an issued copyright registration prior to bringing an infringement suit, as in *Fourth Estate Public Benefit v. Wall-Street.com*, No. 16-13726 (11th Cir. 2017)). This

approach is seen as complying with the statutory language of requiring registration to bring an infringement action.

The distinction between these two approaches is significant. The registration approach focuses on what the plaintiff-applicant did and the registration approach focuses on what the Copyright Office did with the registration application. In January of this year, the Supreme Court, in *Fourth Estate Public Benefit v. Wall-Street.com*, Docket No. 17-571 (docketed Oct. 16, 2017), invited the solicitor general to submit a brief on this dispute. This appears to be a clear signal that the Supreme Court believes this dispute is ripe for a final, clarifying decision. The decision on this issue could have far-reaching implications for copyright owners and the timing for commencing infringement litigation.

The importance of the upcoming Supreme Court decision can be a critical consideration in bringing suit. Will a copyright owner be required to have a registration as a precondition to filing suit? Will a copyright owner still be required to have a registration before collecting statutory damages pursuant to 17 U.S. Code Section 504? Statutory damages are "not less than \$750 or more than \$30,000 as the court considers just," see 17 U.S. Code Section 504 (c)(1)). "In a case where the copyright owner sustains the burden of proving, and the court finds, that infringement was committed willfully, the court in its discretion may increase the award of statutory damages to a sum of not more than \$150,000," see 17 U.S. Code Section 504 (c)(2)). Given the relatively low cost for copyright registration, there is a very persuasive economic incentive for pursuing a copyright registration.

The entertainment industry is acutely aware of the importance of copyright registrations and enforcement. In December 2017, Wixen Music Publishing, which represents many famous music acts, filed a \$1.6 billion copyright infringement suit against Spotify USA Inc. for copyright infringement, as in *Wixen Music Publishing v. Spotify USA*, No. 2:17-cv-09288-GW-GJS (C.D. Cal. Dec. 29, 2017)). Wixen alleged that there were approximately 10,784 musical compositions that Spotify was infringing. Wixen reached the \$1.6 billion request by multiplying the number of works, i.e., 10,784, by the statutory damages amount, i.e., \$150,000. This case illustrates just how important registration can be for pursuing considerable damages in any infringement suit.

Copyright registration has the additional benefit that enforcement against importation of **infringing works is available through the U.S. Customs.**

Regardless of how the current circuit split is resolved by the U.S. Supreme Court, the relative easy and low-cost availability of copyright protection in most noncomplex matters argues for a robust program of filing for copyright protection. It is critical to remain mindful of the scope of protection provided by a copyright, and to understand the scope of materials protectable by copyrights. Most commercial entities generate multiple works that are copyrightable. Copyright may be low-hanging intellectual property that is being ignored.

**Anthony S. Volpe** is a shareholder at Volpe & Koenig. He has has corporate and private practice experience in all aspects of intellectual property rights.

**Thomas P. Gushue**, an associate with the firm, focuses his practice on U.S. and international patent prosecution and intellectual property litigation.