

CASE ANALYSIS ON

FOURTH ESTATE PUBLIC BENEFIT CORP. V. WALL-STREET.COM, LLC¹ :

RESOLVING THE DILEMMA OF “MAKING A REGISTRATION” AS

THE PRE-REQUISITE FOR A COPYRIGHT INFRINGEMENT SUIT

-By Nithya.C²

Introduction

According to Article 5 of the Berne Convention³, copyright protection is not dependant on obtaining a certificate of registration. Thus, an original work expressed in a fixed form would get copyright protection automatically, once it is created. However, to file a suit for infringement of that work, a copyright registration would be a pre-requisite, since it is the prima facie evidence of the copyright that a creator has on his work. However, the practical dilemma is with whether merely applying for copyright protection could enable a creator to file an infringement suit or should the creator have to wait for the registration certificate to be granted by the copyright office before filing the suit. This dilemma should be understand from the context that even after the creator applies for the certificate, the copyright office might take months to grant the registration certificate, thus causing regulatory hindrances to protecting one’s own copyright. Thus, the question arises as to whether the mere action of applying for the registration certificate would suffice for filing an infringement suit, instead

¹ 139 S. Ct. 881

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³ Berne Convention, Article 5(2): *The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work. Consequently, apart from the provisions of this Convention, the extent of protection, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where protection is claimed.*

of actually obtaining the certificate from the copyright office. It is this legal quandary that this case attempts to address, while proving to be pertinent in understanding the jurisprudence behind registration of copyright.

Facts and Main issue

The petitioner, Fourth Estate Fourth Estate Public Benefit Corp., is a news organisation that used to license their work to the respondent, Wall Street.com – as per a licensing agreement, according to which, all works licensed from the petitioner must be removed from the respondent’s website, once the licensing agreement is cancelled. However, upon cancelling the agreement, the respondent failed to remove the licensed work of the petitioner on the grounds that the works of the petitioner had not obtained the certificate of registration and that the petitioner had only applied for the same. This dispute led to the present case with the main issue being: *Has “registration ... been made” as soon as the claimant delivers the required application, copies of the work, and fee to the Copyright Office; or has “registration . . . been made” only after the Copyright Office reviews and registers the copyright?.*

Background and Legal Provisions involved

A certificate granted by the copyright office is a prima facie evidence of the copyright that a creator has on his work, and therefore making a registration with the copyright office is a pre-requisite for filing a copyright infringement suit. This is enumerated under 17 USC section 411(a)⁴. However, the issue in this case is with respect to what suffices “making a registration” – whether it would be construed as actually obtaining the certificate or would

⁴ 17 U.S.C. § 411(a) (2017): “no civil action for [copyright] infringement...shall be instituted until preregistration or registration of the copyright claim has been made.”

the mere act of applying for registration be sufficient. This conundrum has led to two schools of thought namely, “the registration approach”, where the creator has to submit an application, wait for the approval by the copyright office and obtain the registration certificate before filing a copyright infringement suit on his work; and the “application approach”, where the creator is considered to have a registered copyright by merely submitting the application and the fee to the copyright office. While the former is endorsed by the fifth and ninth circuit courts⁵, the latter has been given legal validity by the Tenth and Eleventh Circuits⁶. This split between the circuit courts is the reason why the Supreme Court has decided to settle this issue, once and for all.⁷ In the instant case, prior to approaching the Supreme Court, the Eleventh circuit had decided in favour of the “registration approach”.

Contentions raised

The main argument of the petitioner revolves around the interpretation of the phrase “registration . . . has been made” in Section 411(a), which is contended by the petitioner to be most likely to refer to a copyright owner’s compliance with statutory requirements for submitting the registration applications, rather than obtaining the certificate. The petitioner also mentions several provisions under the US Copyright law⁸, where the phrase “make registration” is used(which can be read according to the application approach), thereby contending that the statute only requires creators to make a registration by submitting the application and that the grant of the certificate is not a pre-requisite for filing an infringement suit. In response to this contention, the respondents had averred that the phrase “make registration” can only be construed to mean - to obtain the registration certificate. In order to

⁵ In the cases: *Apple Barrel Prods. v. Beard*, 730 F.2d 384, 386-87 (5th Cir. 1984); *Action Tapes, Inc. v. Mattson*, 462 F.3d 1010, 1013 (8th Cir. 2006); *Cosmetic Ideas, Inc. v. IAC/Interactive Corp.*, 606 F.3d 612, 621 (9th Cir. 2010)

⁶ In the cases : *LaResolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200-01 (10th Cir. 2005); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488 note 4 (11th Cir. 1986)

⁷ Supra no.1, 882

⁸ These provisions include : 17 U. S. C. §§110, 205(c), 408(c)(3), 411(c), 412(2)

substantiate their averments, the respondent mentions that section 410 confirm that application is different from and precedes registration and that section 408(f)'s preregistration option would have little utility if a completed application sufficed to make registration.

Another contention made by the petitioner is that all works obtain automatic protection upon creation and that copyright protection is not dependent on the registration certificate granted by the Copyright Office. In response to this contention, the respondent argued that although the concept of automatic protection for general rights of copyright prevails, the legislative language had purposefully decided to make the right to sue of a copyright owner to be dependent on the certificate provided by the Copyright Office so as to encourage early filing of copyright.

Yet another contention that was put forward by the petitioners was that a copyright owner would be barred from enforcing their copyright for months, i.e., during the time period in which the copyright office grants the certificate after applying for registration, and that making the right to sue dependent on the registration certificate would be unfair, considering the administrative delays that might take place in a copyright office. In response to this, the respondent has rightfully averred that such delays are mainly due to budgetary concerns and funding issues, based on which the meaning, intent and reading of a legislative text cannot be changed or misconstrued.

Conclusion: Judgement and its implications

Based on the afore-mentioned averments, the Supreme court had decided (through a unanimous decision written by Justice Ruth Bader Ginsburg) in favour of the respondent and held that obtaining a registration certificate is the requisite for filing a suit of copyright infringement and that merely applying for a registration would not suffice. Therefore, the phrases "registration to be made" and "make registration" in the statute would refer to

obtaining the certificate from the Copyright Office and not to applying for the same. The Court observed that if the contention of the petitioner - to interpret “registration...has been made” in the first sentence of Section 411(a) according to the ‘application-approach’ is accepted, then it would contradict the meaning of the term “registration” in the second sentence of the same section. The second sentence refers to a situation where the registration has been refused and here the term “registration” can only be interpreted according to the registration approach. Therefore, the court found that the same term used in the same statutory provision cannot be interpreted in two different ways, hence rejecting fourth estate’s ‘application approach’. Further, the court looked into the legislative history of section 411(a), where it was found that Congress has purposefully avoided interpreting the statute according to the ‘application approach’, which the petitioner endorses. Nonetheless, this case could successfully bring to light the pragmatic issues that a creator has to face to protect his work, due to administrative delays and lack of budgets in copyright offices. However, such issues were rightly held to be beyond the scope of the courts to cure.

Beyond bringing clarity to the interpretation of the statute, this decision is also of immense pertinence considering how it provides uniformity into interpreting what constitutes “making a registration” throughout America, thereby resolving the circuit split. This uniformity is important since it avoids the possibility of forum shopping, as prior to this decision there a split between the circuit courts on this issue and the party suing might have approached the court that favours their approach to copyright registration. This decision eschews such evils.
