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## Eleventh Circuit: Obtain a Copyright Registration before Initiating Litigation

According to U.S. copyright law, an original work of authorship receives copyright protection from the time the work is created in a fixed form. However, when can a copyright owner sue an alleged infringer for copyright infringement? Is it sufficient that a copyright owner merely filed an application for registration with the U.S. Copyright Office or must the copyright owner wait until the Copyright Office either issues or refuses to issue a registration certificate? On May 18, 2017, the Eleventh Circuit widened the circuit split in its ruling, holding that the Copyright Office must register or refuse to register the copyright prior to the filing of a copyright infringement suit.

Section 411(a) of the Copyright Act states:

[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). The federal circuits are split on *when* registration of a copyright occurs. In the recently-decided case *Fourth Estate Public Benefit Corporation v. Wall-Street.com, LLC*,<sup>1</sup> the Eleventh Circuit detailed the division of the circuits, noting that the Tenth Circuit follows the “registration approach” to section 411(a), requiring the Copyright Office to have processed the application and issued or denied a registration before a copyright owner can file an infringement action. On the other side of the split, the Fifth and Ninth Circuits, along with Eighth Circuit in dicta, follow the “application

<sup>1</sup> *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, No. 16-13726, 2017 WL 2191243 (11th Cir. May 18, 2017)

approach,” requiring a copyright owner to have filed an application, deposit materials, and pay the fee before instituting an infringement action. Meanwhile, the First and Second Circuits both acknowledge the split, but have declined to adopt an approach, and the Seventh Circuit contains conflicting dicta on which approach it follows or whether it has decided the issue.

In *Fourth Estate Public Benefit Corp.*, Fourth Estate Public Benefit Corporation (Fourth Estate), an online journalism collective that licenses articles to paid subscribers, filed suit against Wall-Street.com, LLC, after Wall-Street.com cancelled its subscription and failed to remove Fourth Estate’s copyrighted content from its website, as required by the license agreement. In its complaint, Fourth Estate alleged that it had filed an application to register the allegedly infringed copyrights, but the Copyright Office had not yet registered its claims. The district court dismissed the action because “plaintiff failed to plead compliance with the registration requirement, 17 U.S.C. § 411(a).”

The Eleventh Circuit’s three-judge panel affirmed the district court, holding that “the text of the Copyright Act makes clear that...[f]iling an application does not amount to registration.” The panel noted that the registration process, as defined by the Copyright Act, involves actions by both the copyright owner and the Copyright Office. The copyright owner must file an application, deposit the material and pay a fee, and the Copyright Office must examine the deposited material to determine whether it constitutes copyrightable subject matter. The Eleventh Circuit focused on the use of the phrase “after examination” in section 410(a):

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). The Eleventh Circuit determined that the requisite “registration” of a copyright occurs only after the Copyright Office examines the material for copyrightable subject matter. Further, the panel cited to language in sections 411(a) and 410 (b) of the Copyright Act to establish the timing that registration can only occur after application and examination on the basis that “if registration occurred as soon as an application was filed, then the Register of Copyrights would have no power to ‘refuse registration.’” In the opinion, the Eleventh Circuit confirmed it had previously “endorsed” the “registration approach” in *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990) and *Kernel Records Oy v. Mosley*, 694 F.3d 1294 (11th Cir. 2012).

## Moving Forward

Copyright owners should be diligent and apply for copyright registration as soon as possible. The registration process can take four to six months and sometimes even longer due to backlogs at the Copyright Office. If a copyright owner is in the Tenth or Eleventh Circuits where the registration approach is followed, the timing of the examination and approval (or denial) of a copyright registration may be critical. When contemplating a copyright infringement action, copyright owners should consider requesting “special handling” for their applications, which entails a filing fee of \$800 per claim. Special handling expedites the issuance of a Copyright Office decision regarding registration, with decisions typically rendered within approximately one to three weeks. Since special handling of copyright registrations can be costly, copyright owners should be proactive and apply for copyright registration with the Copyright Office to avoid any potential delays or hindrances in enforcing their rights against infringers.

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