

No. 08-103

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IN THE  
*Supreme Court of the United States*

REED ELSEVIER INC., ET AL.,

*Petitioners,*

v.

IRVIN MUCHNICK, ET AL.,

*Respondents.*

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On a Writ of Certiorari  
to the United States Court of Appeals  
for the Second Circuit

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**BRIEF FOR THE MUCHNICK RESPONDENTS**

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### **QUESTION PRESENTED**

Does 17 U.S.C. § 411(a) restrict the subject matter jurisdiction of the federal courts over copyright infringement actions?

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## **BRIEF FOR THE RESPONDENTS**

Respondents Irvin Muchnick, et al. respectfully request that this Court reverse the judgment of the United States Court of Appeals for the Second Circuit.

### **OPINIONS BELOW**

The opinion of the United States Court of Appeals for the Second Circuit (Pet. App. 1a-45a) is reported at 509 F.3d 116 (2d Cir. 2007). The oral opinion of the district court (Pet. App. 48a-58a) is unpublished. The order of the district court approving the settlement and entering final judgment (J.A. 152-57) is unpublished.

### **JURISDICTION**

The district court had jurisdiction over this case pursuant to 28 U.S.C. §§ 1331, 1338(a), and 1367(a). The court of appeals had jurisdiction under 28 U.S.C. § 1291. The judgment of the court of appeals was entered on November 29, 2007; a timely petition for rehearing was denied on April 15, 2008. Pet. App. 1a, 59a. After receiving an extension of the time within which to file a petition for a writ of certiorari to and including August 13, 2008, petitioners filed their petition on July 21, 2008. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

## RELEVANT STATUTORY PROVISIONS

17 U.S.C. § 302(a) provides in pertinent part:

Copyright in a work created on or after January 1, 1978, subsists from its creation and ... endures for a term consisting of the life of the author and 70 years after the author's death.

17 U.S.C. § 408(a) provides in pertinent part:

**Registration Permissive.**— At any time during the subsistence of the first term of copyright in any published or unpublished work in which the copyright was secured before January 1, 1978, and during the subsistence of any copyright secured on or after that date, the owner of copyright or of any exclusive right in the work 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. Such registration is not a condition of copyright protection.

17 U.S.C. § 411(a) provides in pertinent part:

[N]o 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.

28 U.S.C. § 1367(a) provides in pertinent part:

Except as . . . expressly provided otherwise by Federal statute, in any civil action of which the district courts have original jurisdiction, the district courts shall have supplemental jurisdiction over all other claims that are so related to claims in the action within such original jurisdiction that they form part of the same case or controversy under

Article III of the United States Constitution. Such supplemental jurisdiction shall include claims that involve the joinder or intervention of additional parties.

### STATEMENT OF THE CASE

Under U.S. law, copyright protection for a work created on or after January 1, 1978, exists in the work “from its creation.” 17 U.S.C. § 302(a). The Copyright Act expressly provides that formal registration with the U.S. Copyright Office “is not a condition of copyright protection.” *Id.* § 408(a). The question presented in this case involves the circumstances under which federal courts have the power to adjudicate claims of copyright infringement involving certain kinds of unregistered works. The court of appeals read Section 411(a) of the Copyright Act to deprive federal courts of subject-matter jurisdiction over claims involving unregistered “United States works” – in particular, works first published in the United States. *Id.* § 101.<sup>1</sup>

1. The impetus for this case was this Court’s decision in *New York Times, Inc. v. Tasini*, 533 U.S. 483 (2001). *Tasini* involved a copyright infringement

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<sup>1</sup> The category of “United States works” is broader, involving also, *inter alia*, works by U.S. nationals or domiciliaries first published abroad in nations that are not parties to international copyright treaties and sculptural works incorporated into buildings located in the United States. *See* 17 U.S.C. § 101. This case, however, concerns solely a subset of U.S. works – those that were first published in the United States.

suit by six freelance authors who had contributed work to three print periodicals that subsequently entered into agreements to have the freelancers' work included in electronic databases. This Court held that the defendant corporations – the original publishers plus the database creators with whom they had contracted – had infringed the authors' copyrights by including their work without the authors' consent. Responding to the defendants' concern that its ruling would require removing freelancers' work from databases and thereby “punch gaping holes in the electronic record of history,” *id.* at 505, the Court observed that there might be a range of possible solutions including that the “parties” might “enter into an agreement allowing continued electronic reproduction of the Authors' works.” *Id.* It further noted that such an agreement might “draw on numerous [existing] models for distributing copyrighted works and remunerating authors for their distribution,” *id.* (citing the ASCAP-BMI membership-based licensing system for permitting the use of copyrighted musical works).

This case concerns an effort to craft a method of settling potential infringement claims and permitting the continued use of freelance authors' copyrighted works by electronic databases. Following the decision in *Tasini*, the United States District Court for the Southern District of New York consolidated three class action infringement suits then pending against a number of publishers and media corporations and coordinated the consolidated case with yet a fourth pending class action. *See* J.A. 1, 16, 48, 69; *id.* at 80. The district court then referred the parties to mediation. *See* Pet. App. 6a. The named

plaintiffs (who appear in this Court as respondents in support of petitioners) and the defendants (petitioners in this Court) ultimately reached a proposed settlement agreement in 2005. Pet. App. 7a.

While *Tasini* involved only six individual plaintiffs and a limited number of publications and electronic database creators, the proposed settlement here sweeps far more broadly. Its proposed plaintiff class consists of “[a]ll persons” holding copyright under U.S. laws “in an English language literary work that has been reproduced, displayed, adapted, licensed, sold and/or distributed in any electronic or digital format, without the person’s express authorization” by any of the defendants since August 15, 1997. J.A. 110-11. The parties agree that this plaintiff class has tens of thousands of members.

Similarly, the defendants covered by the settlement (the “Defense Group”) consist of at least 36 individual print and electronic media corporations, *id.* at 108, 150-51, almost all of which operate electronic databases that published copyrighted works owned by various freelance authors, *id.* at 93.

The proposed settlement covers all the plaintiff class’s claims “whether arising under federal, state, or foreign law, . . . with respect to any and all of the Subject Works, including but not limited to all claims arising out of the same facts as their claims of copyright infringement, past, present, or future, known or unknown,” *id.* at 113-14, and would provide a release against “any known or unknown, suspected or unsuspected, contingent or non-contingent claim,” *id.* at 143.

The proposed settlement would give the defendants what the agreement “consider[s]” a “license,” *id.* at 128, to continue using a class member’s works in their database, without compensation, unless a class member files a timely notice within the 120-day claims period demanding the removal of his or her work. *See id.* at 130 (authorizing the “Continuing Use of Subject Works”). The settlement paragraph governing the release of the class members’ claims clarifies that this de facto license is “irrevocable, worldwide, and continuing,” and can be transferred in a variety of ways. *See id.* at 140.

The proposed agreement also provides a possibility of compensation to members of the plaintiff class. It caps the settling defendants’ potential payments at \$18 million. *Id.* at 119. It divides the plaintiff class’s works into three subcategories, with potential compensation depending on a work’s categorization. *See id.* at 122-23; Pet. App. 8a. Authors must file claims under the settlement’s claims process in order to receive compensation. *See* J.A. 122, 130.

“Category A” works are those that an author “properly registered as an individual work with the United States Copyright Office in time to be eligible for statutory damages under 17 U.S.C. § 412(2).” J.A. 121-22.<sup>2</sup>

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<sup>2</sup> Section 412(2) provides for statutory damages and attorney’s fees if an author has registered the work either before any infringement occurs or “within three months after the first publication of the work.”

“Category B” works are those that an author “properly registered before December 31,2002, but not in time to be eligible for statutory damages under 17 U.S.C. § 412(2).” J.A. 123.

“Category C” covers all other works, J.A. 123, including works that were registered with the Copyright Office after December 31, 2002, and works that were not registered at all, whether U.S. works or foreign works. Pet. App. 8a. The overwhelming majority of the works at issue in this litigation fall into Category C. *See id.* at 7a (noting the publishers’ estimate that 99 percent of claims at issue would fall in this category).

The settlement agreement sets out a plan of allocation for making payments to authors who file claims under the settlement’s claims process. For Category A works, the proposed payments range from \$875 to \$1500 per infringed work. *See* J.A. 122-23. For Category B works, the proposed payment would be the “greater of \$150 or 12.5% of the original sale price” of the infringed work. *See id.* at 123. For Category C works, the proposed payments would range from \$5 to \$60 per work. *See id.* at 123.

In light of the proposed agreement’s \$18 million cap, the agreement also provides a formula for reducing the compensation to be paid to copyright holders who file claims. If the monetary value of claims filed plus the agreed-upon fees and costs (including a \$4.4 million award for class counsel, \$800,000 in administrative expenses and a credit of \$1 million for the required notices to class members) were to exceed \$18 million, then the payments for Category C works would be reduced pro rata. *See* J.A. 124. Payments for Category A and B works

would be reduced “only if necessary,” *id.* – that is, only once payments for Category C works are eliminated altogether through the “C-reduction,” Pet. App. 9a.

2. After reaching the settlement, the named plaintiffs and the publishers moved for class certification and settlement approval. Pet. App. 9a. Objectors, led by respondent Irvin Muchnick, a well-known freelance writer, opposed the settlement on several grounds. Among these were their objection to the settlement’s granting irrevocable and transferable licenses for continued use of the class members’ work and their objection to the way that claims involving works in Category C were both calculated initially and subject to potential reductions. In light of these problems with the settlement, they also objected to the adequacy of the representation provided by the named plaintiffs. *See* Objector-Appellants, C.A. Br. at 26-31, 45-52. The district court rejected the objections, certified the class, and approved the settlement. Pet. App. 10a.

3. The objector-respondents appealed both the class certification and the approval of the settlement. Shortly before oral argument, the Second Circuit *sua sponte* ordered additional briefing on the question whether 17 U.S.C. § 411(a) – which provides that “[n]o action for infringement of the copyright in any United States work shall be instituted until ... registration of the copyright claim has been made” – deprives federal courts of subject-matter jurisdiction over unregistered copyright claims. Pet. App. 10a. After hearing oral arguments on both this issue and respondents’ objections, a divided panel of the Second Circuit held that federal courts lack subject-matter

jurisdiction over infringement claims involving unregistered U.S. works. *Id.* at 11a.

The panel majority first found that Section 411(a)'s "registration requirement," Pet. App. 10a, was "jurisdictional," *id.* at 11a. While 28 U.S.C. §§ 1331 and 1338 might "initially" provide federal district courts with jurisdiction over copyright actions, Pet. App. 11a, the court of appeals, relying on prior circuit precedent outside the class-action context, found that Section 411(a) "limits a district court's subject matter jurisdiction to claims arising from registered copyrights only," Pet. App. 13a. Indeed, "absent registration," the court of appeals concluded that a "copyright claim does not [even] exist." *Id.* at 18a n.5.

The court of appeals then rejected the parties' arguments that the undoubted presence of some registered claims by the named plaintiffs could confer jurisdiction over related claims involving unregistered U.S. works. In particular, the court declared that the "class action certification device . . . does not offer any alternative source of jurisdiction." Pet. App. 21a. Each claim by each member of any certifiable class, it held, must independently satisfy Section 411(a)'s jurisdictional requirement.<sup>3</sup>

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<sup>3</sup> In a footnote, the court of appeals rejected petitioners' argument that even if the district court would have lacked subject-matter jurisdiction to certify a litigation class containing claims involving unregistered works, it had power to certify a settlement-only class under *Matsushita Electric Indust. Co. v. Epstein*, 516 U.S. 367 (1996). *See* Pet. App. 14a n.2.

Finally, the court of appeals held that the supplemental jurisdiction statute, 28 U.S.C. § 1367(a), could not provide jurisdiction over unregistered copyright claims. Section 1367(a) does not provide supplemental jurisdiction when “expressly provided otherwise by Federal statute,” and the court of appeals read Section 411(a) as such an express prohibition. *See* Pet. App. 26a. More broadly, the court of appeals refused to find supplemental jurisdiction because it saw Section 1367(a) as directed to conferring federal jurisdiction only over pendent state-law claims. Pet. App. 25a-26a.

Judge Walker dissented. He identified three reasons to treat Section 411(a) not as a jurisdictional provision, but rather as a “prerequisite” to bringing suit. Pet. App. 31a. First, Judge Walker observed that Section 411(a) did not itself “provide the copyright holder with any of the sticks in his bundle of rights,” but rather “simply sets forth a prerequisite to suit . . . speak[ing] not to rights but to the means of their vindication.” Pet. App. 30a-31a. Second, he thought that the legislative history of Section 411(a) showed it to embody a sort of nonjurisdictional administrative exhaustion requirement. *See* Pet. App. 33a. Finally, he declined to treat Section 411(a) as jurisdictional in light of its being “riddled” with exceptions. Pet. App. 35a. For example, some courts permitted plaintiffs to bring suits for damages while registration was still pending (and others permitted plaintiffs to amend their complaints once registration was obtained, despite the general rule that subject-matter jurisdiction must be established at the outset of a lawsuit); still other courts entertained suits for

injunctive relief even on behalf of unregistered claims; and authors of unregistered foreign works were not required to satisfy Section 411(a)'s registration requirement at all. "Taken together," Judge Walker concluded, "§ 411(a)'s language, legislative history, jurisdictional exceptions, and exception for foreign works strongly indicate that the registration requirement is more akin to a claim-processing rule than a jurisdictional prerequisite." Pet. App. 38a. In light of his conclusion that Section 411(a) was nonjurisdictional, Judge Walker believed that its registration requirement need not be satisfied by every member of the plaintiff class. *Id.* at 38a-42a.

All the parties sought rehearing and rehearing en banc. Their motions were denied.

6. The publishers petitioned this Court for review. The settling plaintiffs and the objectors agreed that review was warranted, but disagreed with petitioners as to the questions presented and their resolution. This Court granted certiorari limited to the following question: "whether 17 U.S.C. § 411(a) restricts the subject matter of the federal courts over copyright infringement actions?," and subsequently appointed an *amicus curiae* to argue in support of the judgment.

### SUMMARY OF ARGUMENT

The court of appeals erred in construing 17 U.S.C. § 411(a) as an absolute limitation on federal courts' subject-matter jurisdiction over copyright infringement actions. Section 411(a)'s directive that no infringement action involving a U.S. work "shall

be instituted until ... registration of the copyright claim has been made” is a species of claim-processing rule: namely, a procedural prerequisite to filing suit, much like a notice-of-claim or administrative exhaustion requirement. As such, it is subject to waiver and, in the context of class actions such as this, need be satisfied in any event only by the named representatives of the class.

I. Section 411(a) neither identifies the elements of a copyright infringement claim nor sets out a jurisdictional limitation on federal judicial power. Under U.S. law, copyright in a work “subsists from its creation,” 17 U.S.C. § 302(a), and “registration is not a condition of copyright protection,” *id.* § 408(a). A copyright owner who has not registered his claim in a U.S. work therefore has a valid cause of action against someone who has infringed his copyright; Section 411(a) simply provides that he cannot enforce his right until he has satisfied the procedural prerequisite of seeking registration.

That procedural prerequisite, however, is not a jurisdictional limitation, given this Court’s insistence on distinguishing between jurisdictional restrictions and claim-processing rules. Section 411(a) does not itself “speak in jurisdictional terms.” *Zipes v. Trans World Airlines, Inc.*, 455 U.S. 385, 394 (1982). Congress did not rank the registration requirement as jurisdictional – by, for example, including it within the provisions expressly governing subject-matter jurisdiction over copyright cases (or even within the chapter of the Copyright Act dealing with remedies). The primary function Congress intended Section 411(a) to perform – ensuring that the Library of Congress continues to receive copies of published

works – has little if any connection to the concerns that normally animate jurisdictional provisions. The fact that a plaintiff whose registration has been rejected or a plaintiff who holds copyright in a foreign, rather than U.S. work, can bring an infringement action involving an unregistered work reinforces the conclusion that Section 411(a) is a claim-processing rule rather than a restriction on the subject-matter jurisdiction of the district courts.

Section 411(a)'s use of the word “until” underscores that the section is at most akin to an exhaustion requirement. The word reflects the fact that a plaintiff can fulfill the registration requirement at any time during the lengthy duration of his copyright term, before or after infringement, and subsequently file suit. Thus, Section 411(a) closely resembles the administrative exhaustion requirement of the Prison Litigation Reform Act, 42 U.S.C. § 1997e(a) (which uses similar phraseology to articulate when a prisoner can bring a civil action) and the charge-filing provision of Title VII of the Civil Rights Act, 42 U.S.C. § 2000e-5(e)(1), each of which this Court has emphasized is a prerequisite to bringing suit that is “not jurisdictional” and that is subject to waiver if not invoked by the defendant. *See, e.g., Jones v. Bock*, 549 U.S. 199 (2007); *Woodford v. Ngo*, 548 U.S. 81 (2006); *Nat'l Railroad Passenger Corp. v. Morgan*, 536 U.S. 101, 109 (2002); *Zipes, supra*. Indeed, given the availability of registration for at least the life of the author plus 70 years, Section 411(a) is, if anything, far *less* restrictive than most nonjurisdictional exhaustion requirements. Because petitioners do not argue, before this Court, that holders of unregistered works

should be precluded from recovery, Section 411(a) poses no bar to their claims.

II. Because this case involves a class action, the district court would have jurisdiction in any event to hear class members' claims involving unregistered works as long as the named class representatives satisfied Section 411(a), which they have. This Court has held that unnamed class members in a Title VII case do not need to have filed charges with the EEOC. *See Franks v. Bowman Transp. Co.*, 424 U.S. 747 (1976); *Albemarle Paper Co. v. Moody*, 422 U.S. 405 (1975). Similar reasoning should apply in the context of class actions for copyright infringement. The underlying rights of registered and unregistered copyright holders with respect to their works are identical (although, to be sure, the panoply of available remedies will differ in some respects). The nature of the infringement does not differ according to whether the copyrights were registered or not. Here, as in the Title VII context, the costs of requiring each and every unnamed class member to register every copyright that might have been infringed would far outweigh the benefits to the public provided by registration.

III. Even if this Court were to conclude that Section 411(a) constitutes a jurisdictional limitation on the original subject-matter jurisdiction of the federal courts not subject to waiver by defendants and that the named class representatives' fulfillment of the notice requirement does not suffice to confer jurisdiction across the board, the district court still had power in this case under 28 U.S.C. § 1367 to exercise supplemental jurisdiction over the

infringement claims involving unregistered copyrights.

There is no doubt that the district court had original subject-matter jurisdiction over the named plaintiffs' claims involving registered works. Furthermore, the claims of unregistered copyright holders form part of the same case or controversy as the claims involving registered works. This case involves the wholesale inclusion of freelance authors' work in massive electronic databases. Nothing in the record suggests that the defendants considered whether a particular copyright was registered or not in deciding which works to include. In fact, the infringement of registered and unregistered work often occurred as the result of a single transaction between petitioner publishers and petitioner database operators.

The court of appeals was clearly wrong to hold that supplemental jurisdiction is available only over state-law claims, and cannot confer power to adjudicate otherwise jurisdictionally-deficient federal claims. Section 1367(a) unambiguously overruled the holding and the result in *Clark v. Paul Gray, Inc.*, 306 U.S. 583 (1939), which had held that there can be no pendent jurisdiction over related, jurisdictionally-deficient federal claims. See *Exxon Mobil Co. v. Allapattah Services*, 545 U.S. 546 (2005). In any event, the registration requirement of Section 411(a) cannot in some way be *more* "jurisdictional" than other jurisdictional elements that this Court has held not to bar supplemental jurisdiction.

Section 411(a) does not rise to the level of an "expres[s]" exception to the exercise of supplemental jurisdiction; indeed, it does not speak in jurisdictional

terms at all. *Cf. Breuer v. Jim's Concrete of Brevard*, 538 U.S. 691 (2003). Section 411(a) simply does not provide, in “unmistakable terms” – indeed, in any terms – for an exception to the supplemental jurisdiction statute.

Not only does the plain text of Section 411(a) counsel against treating the section’s silence as if it somehow “expressly provid[es]” an exception to Section 1367(a)’s broad grant of authority, but there is also no policy rationale for treating Section 411(a) as exempting the claims involving unregistered copyrights from the operation of the supplemental jurisdiction provision. The only risk that permitting supplemental jurisdiction here poses to the policies behind Section 411(a) comes from the probability that allowing holders of unregistered U.S. works to vindicate their copyrights in cases brought by holders of registered works will decrease somewhat the incentive individual authors would otherwise have to register their works and provide copies to the Library of Congress. In contrast to the speculative policy implications of finding supplemental jurisdiction in this case, the negative policy implications of refusing to permit supplemental jurisdiction are quite concrete. The broad availability of supplemental jurisdiction was intended to enable efficient litigation. Disposing of all the infringement claims arising out of petitioners’ databases in a single proceeding will do exactly that. Requiring registration and then individual litigation threatens to swamp the courts with a series of repetitious lawsuits.

IV. Finally, it is important for this Court to decide whether Section 411(a) limits federal courts’

jurisdiction, and not to dispose of this case on the alternative theory that the federal court had power to approve the settlement under *Matsushita Electric Indust. Co. v. Epstein*, 516 U.S. 367 (1996). The question the court of appeals will have to answer on remand, should this Court reverse its judgment, is whether to approve the particular settlement agreement in this case. The answer to that question depends not only on *whether* the district court had authority to approve the settlement but on *why*. If the district court can resolve claims involving unregistered works only in the context of a settlement, then those claims are, as a practical matter, worth less than if plaintiffs can use either the class-action device or supplemental jurisdiction to seek adjudication of unregistered copyright infringement claims along with claims involving registered works. If Section 411(a) does not restrict subject matter jurisdiction and either class-action litigation or supplemental jurisdiction is available, then unregistered claims have a higher practical value since the class members could proceed to trial and receive actual damages even over a defendant's objection. Given that possibility, a settlement that offers holders of unregistered copyrights only nominal damages might be unreasonable. In short, the fairness of the proposed settlement in this case depends in part on the available alternatives to settlement. A decision that does not squarely resolve the jurisdictional question will leave in place an erroneous court of appeals ruling that may lead that court to undervalue respondents' infringement claims in assessing the fairness of the settlement.

## ARGUMENT

I. SECTION 411(a) IS A SPECIES OF “CLAIM-PROCESSING RULE” – NAMELY, A PROCEDURAL PREREQUISITE TO FILING SUIT – AND NOT A RESTRICTION ON SUBJECT-MATTER JURISDICTION.

This Court has repeatedly recognized that “[j]urisdiction is a word of many, too many, meanings.” *Steel Co. v. Citizens for Better Environment*, 523 U.S. 83, 90 (1998) (internal quotation marks omitted). In recent years, it has drawn a distinction between those provisions that are truly jurisdictional – because they “delineat[e] the class of cases ... falling within a court’s adjudicatory authority,” *Kontrick v. Ryan*, 540 U.S. 443, 455 (2004) – and those provisions, “however emphatic,” *Arbaugh v. Y & H Corp.*, 546 U.S. 500, 510 (2006) that are better understood as “claim-processing rules.” *Kontrick*, 540 U.S. at 455; *see also Bowles v. Russell*, 551 U.S. 205, 212 (2007); *Eberhart v. United States*, 546 U.S. 12, 18 (2005) (explaining this distinction). Claim-processing rules articulate requirements that litigants must meet in order to obtain adjudication of claims over which federal courts have subject-matter jurisdiction.

In this case, registration of a copyrighted work under Section 411(a) *neither* “affects federal-court subject-matter jurisdiction [n]or, instead, delineates a substantive ingredient of a . . . claim for relief.” *Arbaugh*, 546 U.S. at 503. Rather, it simply sets out a condition precedent to filing suit on a legal claim that does not itself depend on registration.

**A. A Copyright Holder's Legal Rights – And Hence The Existence Of A Cause Of Action – Do Not Depend On Registration Under Section 411(a).**

A linchpin of the court of appeals' decision in this case was its belief that registration of a work is "essential to the existence of the [underlying] claim" – that is, that "a copyright claim does not exist absent registration or preregistration." Pet. App. 18a n.5 (internal quotation marks omitted). That view misconstrues copyright law and the role of registration within the overall statutory scheme.

1. An author's copyright comes into force immediately upon creation of the work. "Copyright in a work created on or after January 1, 1978, subsists from its creation." 17 U.S.C. § 302(a). The rights that attach to copyright – among them, exclusive control over the ability to distribute, reproduce, or prepare derivative works from a copyrighted work, *id.* § 106 – similarly flow automatically, without the need for any "formality," *see* 1 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 1.2 (3d ed. 2007). In this case, for example, freelance authors acquired copyright in their articles simply by writing them, and were able to sell those articles to publishers who surely knew that the authors had exclusive control over their works.

The Copyright Act makes clear that "registration is not a condition of copyright protection." 17 U.S.C. § 408(a). The fact that 99 percent of freelance authors did not register their copyrights prior to selling their work was irrelevant to publishers' understanding that, in order to use the authors' work, they were required to obtain the authors' consent.

2. Copyright law places virtually no time limit on when an author can seek registration of his work. Under current law, for works created on or after January 1, 1978, copyright protection “endures for a term consisting of the life of the author and 70 years after the author’s death.” 17 U.S.C. § 302(a). “At any time” during that lengthy period, the copyright holder “may obtain registration,” *id.* § 408(a), from the U.S. Copyright Office by following the procedures laid out in Chapter 4 of the Copyright Act. Thus, copyright registration is quite unlike many other statutory schemes that give potential rights holders only a very limited period within which to perfect their entitlement.

Once a copyright holder registers his or her work, he or she can bring suit and recover actual damages for infringing acts that occurred both after and before registration.<sup>4</sup> *See* 1 GOLDSTEIN, *supra*, § 3.15, at 3:152 (2006 Supplement), 2 DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[B][1][a] (2008), at 7-154 (citing H.R. REP. NO. 94-1476, at 157 (1976)). Similarly, a court can issue an injunction against further or future infringement even if a copyright was only registered well after a work’s creation. *See*

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<sup>4</sup> There is a three-year statute of limitations for civil actions in copyright cases, 17 U.S.C. § 507(b), but in cases where the violation involves continuing infringement – as, for example, would be true in cases involving electronic databases – the limitations period runs from the last act of infringement. *See* 2 GOLDSTEIN, *supra*, § 11.1.1.

17 U.S.C. § 502(a); S. REP. NO. 100-352, at 21 (1988) (Conf. Rep.).<sup>5</sup>

3. The violation of respondents' legal rights, then, occurred at the moment of infringement. The fact that their copyrights were unregistered had no bearing on the nature of their legal entitlements nor on the wrongfulness of petitioners' actions. As this Court long ago recognized, a "cause of action" consists "of the unlawful violation of a right which the facts show." *American Fine & Cas. Co. v. Finn*, 341 U.S. 6, 13 (1951) (quoting *Baltimore S.S. Co. v. Phillips*, 274 U.S. 316, 321 (1927)); see also Black's Legal Dictionary 235 (8th ed. 2004) (defining a cause of action as "[a] group of operative facts giving rise to one or more bases for suing"). The question of what steps a copyright holder must take in order to vindicate his legal claim – ranging from bringing suit within the limitations period, see 17 U.S.C. § 507(b), to paying the civil filing fee, see 28 U.S.C. § 1914(a), to registering his copyright under Section 411(a) – are not themselves elements of his claim.

4. The interaction of Sections 302(a) and 408(a) means that each member of the putative plaintiff class with a copyright in a U.S. work retains the

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<sup>5</sup> To be sure, there are some important advantages to registering a copyright quickly. Section 410(c), for example, provides that a certificate of 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." Similarly, under Section 412, early registration of a work is a precondition for obtaining statutory damages and attorney's fees under Sections 504 and 505 of the Copyright Act.

ability, absent a binding settlement, to register his or her work at some point in the future and then to bring suit against any infringing defendant for actual damages as well as for injunctive relief. While the vast majority of putative class members would likely conclude that the costs of registering their work and prosecuting a lawsuit would outweigh the potential benefit, *cf.* Petr. Br. 3, 40, some copyright holders would likely decide otherwise. And the certain prospect of liability in light of *Tasini* would induce defendants to remove even unregistered works from their databases, thereby rendering those databases less complete and less valuable.

5. Finally, Section 411(a) would permit copyright holders of the many foreign works covered by the proposed settlement to file suits for damages and injunctive relief without first obtaining registration.<sup>6</sup> Congress exempted foreign works from Section 411(a) as part of the United States' accession to the Berne Convention. See 2 NIMMER, *supra*, at § 7.16[B][1][b][iii]. Because the Berne Convention

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<sup>6</sup> The scope of the settlement is enormous. It includes every published English language work, regardless of where it was created or originally published, that was contained in one of the covered databases since 1997 without the copyright owner's permission. *See* J.A. 110-11. Over 26,000 publications are covered by the settlement, including thirty-five encyclopedias and numerous foreign English-language publications such as the Aberdeen Evening Express (Scotland); Agence France Presse English Wire; China Daily (English language); the Moscow Times; and the Saigon Times Daily. For a list of the covered publications, see <http://cert.gardencitygroup.com/edb/fs/publications> (last visited May 24, 2009).

requires that copyright protection “shall not be subject to any formality,” Berne Convention for the Protection of Literary and Artistic Works art. 5(2), July 24, 1971 (available at <http://www.law.cornell.edu/treaties/berne/5.html>), Congress restricted the application of formalities such as registration solely to United States works. See Berne Convention Implementation Act of 1988, Pub. L. 100-568, 102 Stat. 2853 (1988); 2 NIMMER, *supra*, at § 7.16[B][1][b][iii].

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Thus, while many of the class members’ works have relatively small economic value, that economic value exists and they are legally entitled to exercise exclusive control over their works without regard to whether those works have been registered.

**B. The Text And Structure Of Section 411(a) Show That It Simply Sets Out A Condition Precedent To Filing Suit On Infringement Claims Over Which Federal Courts Have Subject-Matter Jurisdiction.**

The text of Section 411(a) and the overall structure of copyright law show that registration is “simply a condition to be performed prior to invoking an exercise of jurisdiction by the courts” rather than an element that “goes to the existence of judicial power in the basic jurisdictional sense.” *Aircraft & Diesel Equipment Corp. v. Hirsch*, 331 U.S. 752, 764 (1947).

1. There is “no more persuasive evidence of the purpose of a statute than the words by which the legislature undertook to give expression to its

wishes.” *United States v. American Trucking Ass’n*, 310 U.S. 534, 543 (1940). When examining the text of a statutory provision to determine whether its requirements are jurisdictional, this Court has asked two questions. First, the Court has looked to relevant jurisdictional provisions to see whether they envision limitations on the jurisdiction they confer. *See Arbaugh*, 546 U.S. at 514-515 (looking at 28 U.S.C. § 1331 – the general federal-question jurisdictional provision – and 42 U.S.C. § 2000e-5(f)(3) – the specific jurisdictional provision for Title VII cases – to answer the question whether the “employee-numerosity requirement” was “jurisdictional”). Second, the Court has asked whether the provision at issue itself “speak[s] in jurisdictional terms.” *Zipes v. Trans World Airlines, Inc.*, 455 U.S. 385, 394 (1982). With respect to Section 411(a), both inquiries point to the same conclusion: the registration provision is not jurisdictional.

The express jurisdictional provisions governing copyright infringement cases provide no support for the courts of appeals’ conclusion that registration is jurisdictional. Federal district courts obtain subject-matter jurisdiction over copyright infringement actions not from Section 411(a), but from two other statutes, 28 U.S.C. § 1331 (the general federal-question jurisdictional provision) and 28 U.S.C. § 1338(a) (which both expressly confers jurisdiction over copyright claims on federal district courts and makes that jurisdiction exclusive). As the court of appeals itself acknowledged, nothing in either provision suggests any limitation on the courts’ jurisdiction. Pet. App. 11a. As in *Arbaugh*, where

this Court emphasized that Congress did not include the employee-numerosity requirement within the relevant jurisdictional provision to conclude that it did not constitute a jurisdictional “threshold,” 546 U.S. at 515, so too here: Congress did not “rank” Section 411(a)’s registration requirement “as jurisdictional.” 546 U.S. at 516.

Nor does Section 411(a) itself “speak in jurisdictional terms” about its registration requirement. *Zipes*, 455 U.S. at 394. This Court recently noted in *Fla. Dept. of Revenue v. Picadilly Cafeterias, Inc.*, 128 S. Ct. 2326 (2008), that the title of the chapter in which Congress places a provision can be an “informative” tool “for the resolution of a doubt about the meaning of a statute.” *Id.* at 2336 (quoting *Porter v. Nussle*, 534 U.S. 516, 528 (2002)). Here, the placement and language of Section 411(a) undercuts the suggestion that it is jurisdictional. The registration provision appears in Chapter 4 of Title 17, which covers “Copyright Notice, Deposit, and Registration,” rather than Chapter 5, which addresses “Copyright Infringement and Remedies” – the more plausible location (given that it also contains provisions such as the statute of limitations for infringement actions, § 507(b)) for jurisdictional limitations not actually contained in the jurisdiction-granting statutes themselves (as, for example, the amount in controversy requirement is contained within 28 U.S.C. § 1332, *see Arbaugh*, 546 U.S. at 514-15).

When Congress intends to use a separate provision to restrict the application of a jurisdiction-conferring statute that would otherwise confer power to adjudicate a plaintiff’s claim, it does so explicitly.

In 42 U.S.C. § 405(h), for example, Congress expressly restricted general federal-question jurisdiction over certain claims arising under the Social Security Act: “No action . . . shall be brought under section 1331 or 1346 of Title 28 to recover on any claim arising under this subchapter.” *See Weinberger v. Salfi*, 422 U.S. 749, 756-759 (1975) (treating § 405(h) as jurisdictional). *See also Breuer v. Jim’s Concrete of Brevard, Inc.*, 538 U.S. 691, 696-97 (2003) (internal quotation marks omitted) (holding that in order to bar removal of a suit from state to federal court, Congress must use “unmistakable terms”). None of the words used by Congress in Section 411(a) invoke subject matter jurisdiction, and “when Congress does not rank a statutory limitation on coverage as jurisdictional, courts should treat the restriction as nonjurisdictional in character.” *Arbaugh*, 546 U.S. at 516.<sup>7</sup>

2. The language Congress used in Section 411(a) reflects the unique character of the registration requirement within copyright law and suggests that Section 411(a) is far more akin to a nonjurisdictional exhaustion requirement than to a jurisdictional bar. Section 411(a) states that no copyright infringement action “shall be instituted *until*” registration has been made. 17 U.S.C. § 411(a) (emphasis added).

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<sup>7</sup> That Section 411(a) *does* explicitly address jurisdiction with respect to a different issue – the Registrar of Copyright’s “failure to become a party” in a case where the registrability of the copyright claim is at issue “shall not deprive the court of jurisdiction to determine that issue” – reinforces the conclusion that the registration requirement is a claim-processing rule rather than a jurisdictional prerequisite.

The use of the word “until” reflects the fact that there is virtually no time limit on registration itself; subject to the statute of limitations for copyright infringement claims, a plaintiff can fulfill the registration requirement at any time before or after infringement, and subsequently file suit. *See supra* at 20.<sup>8</sup> Long ago, in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30, 39 (1939), this Court emphasized that “[t]he use of the word ‘until’ ... rather than ‘unless’” to describe the requirements of registration and deposit prior to bringing an infringement action under § 12 of the Copyright Act of 1909 indicated that Congress did not intend “to cause forfeiture of the right” to bring suit.

This Court has recently had several occasions to construe a section of the Prison Litigation Reform Act that uses similar language: 42 U.S.C. § 1997e(a). That section provides that “[n]o action shall be brought” by a prisoner challenging prison conditions “until such administrative remedies as are available are exhausted.” While Section 1997e(a), like Section 411(a) creates a precondition to bringing suit in federal court – a prisoner’s complaint will be dismissed for failure to properly exhaust prison administrative procedure, *see Woodford v. Ngo*, 548 U.S. 81, 93 (2006) – nevertheless “the PLRA

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<sup>8</sup> At least one circuit has allowed a plaintiff to fulfill the registration requirement after filing suit. *See Positive Black Talk v. Cash Money Records*, 394 F.3d 357, 365 (5th Cir. 2004) (refusing to dismiss a copyright infringement action where the plaintiff had filed suit four days before the Copyright Office received its application, deposit, and fee).

exhaustion requirement is not jurisdictional.” *Id.* at 101. Instead, this Court held unanimously in *Jones v. Bock*, 549 U.S. 199 (2007), that failure to exhaust administrative remedies is an affirmative defense that must be timely raised by the defendant. *See id.* at 212-16.

Similarly, in employment discrimination cases, 42 U.S.C. § 2000e-5(e)(1) “is a charge filing provision that ‘specifies with precision’ the prerequisites that a plaintiff must satisfy before filing suit.” *Nat’l Railroad Passenger Corp. v. Morgan*, 536 U.S. 101, 109 (2002) (quoting *Alexander v. Gardner-Denver Co.*, 415 U.S. 36, 47 (1974)).<sup>9</sup> This Court has enforced its provisions rigorously when a defendant has timely raised a plaintiff’s failure to satisfy them. And yet here too, the Court has consistently held that compliance with the filing requirement “is not a jurisdictional prerequisite to filing a Title VII suit,” but rather “is a requirement subject to waiver,” among other things. 536 U.S. at 121; *see also Zipes*, 455 U.S. at 398.

So, too, with Section 411(a). Like Sections 1997e(a) and 2000e-5(e), Section 411(a), sets out a

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<sup>9</sup> Ironically, the actual language in *Gardner-Denver* states that Title VII “specifies with precision the *jurisdictional* prerequisites that an individual must satisfy before he is entitled to institute a lawsuit.” 415 U.S. at 47 (emphasis added). That *Morgan* squarely rejected this characterization of the prerequisite highlights the importance of according “drive-by jurisdictional rulings ... no precedential effect” on the question whether federal courts have subject-matter jurisdiction over a class of cases. *Arbaugh*, 546 U.S. at 511 (quoting *Steel Co. v. Citizens for Better Environment*, 523 U.S. 83, 91 (1998)).

prerequisite to filing suit. But just like those statutes, the prerequisite is not jurisdictional but rather is a requirement subject to waiver. Indeed, given the availability of registration for at least the life of the author plus 70 years, Section 411(a) is, if anything, far *less* restrictive than most nonjurisdictional exhaustion requirements, which involve stringent statutes of limitations.<sup>10</sup>

By contrast, jurisdictional requirements traditionally operate to cut off forever a plaintiff's ability to prosecute his or her case. In *Bowles v. Russell*, 551 U.S. 205 (2007), for example, once the thirty days for filing an appeal under 28 U.S.C. § 2107(a) had run, there was nothing the plaintiff could do to confer power on the court of appeals to adjudicate his case. Similarly, in cases involving jurisdictional amounts under statutes like 28 U.S.C. § 1332 (the diversity-jurisdiction provision) or 16 U.S.C. § 814 (setting a jurisdictional amount for eminent domain cases) a plaintiff hoping to sue in federal court cannot do anything to increase the

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<sup>10</sup> For example, a potential Title VII plaintiff must file a charge with the Equal Employment Opportunity Commission or the cognate state fair-employment agency within 180 (or 300) days of the alleged discrimination. 42 U.S.C. § 2000e-5(e)(1). And under 42 U.S.C. § 1997e(a), which provides that prisoners cannot bring civil actions challenging prison conditions “until such administrative remedies as are available are exhausted,” prisoners are required to comply with quite stringent time limits. *See Woodford v. Ngo*, 548 U.S. 81, 116 n. 12 (2006) (Stevens, J., dissenting) (noting that many states give prisoners periods of between 48 hours and one month in which to file, or forever waive, their claims for mistreatment).

value of his claim and thereby invoke federal jurisdiction. The ability of a plaintiff in a copyright infringement action to fulfill the registration requirement at any time, however, stands in sharp contrast. Section 411(a) is “simply a condition to be performed prior to invoking an exercise of jurisdiction by the courts,” *Aircraft & Diesel Equipment Corp.*, 331 U.S. at 764, rather than a jurisdictional limitation.

3. Finally, other details in the text of Section 411 also indicate that the registration requirement is a procedural formality rather than a jurisdictional restriction. First, a plaintiff is not actually required to *obtain* registration to pursue an infringement action: even if the Copyright Office refuses registration, the plaintiff may proceed with his or her lawsuit. 17 U.S.C. § 411(a). This undercuts the proposition that Section 411(a) restricts the jurisdiction of the federal courts to only registered copyrights; by definition, if registration has been refused, the plaintiff’s claim is over an unregistered work, and yet the district courts have the power to hear the case. *See* NIMMER, *supra* § 7.16 (B)(1)(a)(iii) (discussing the courts’ power to hear such cases once registration has been sought). The requirement thus resembles a court filing fee more than a jurisdictional requirement. Similarly, the fact that holders of unregistered foreign works can bring suit under Section 411(a) undercuts the proposition that Section 411(a) was intended as a jurisdictional bar, rather than as a simple formality connected to enforcing a claim.

**C. The Legislative History And Policies Behind Section 411(a) Reinforce The Conclusion That Registration Is Simply A Condition Precedent.**

1. When determining whether a statutory requirement imposes a limit on the federal courts' subject-matter jurisdiction, this Court has also looked to the legislative history to see how Congress characterized the requirement. *See Zipes*, 455 U.S. at 394-95. Nothing in the legislative history of Section 411(a) suggests Congress viewed the registration requirement as restricting the subject-matter jurisdiction conferred by 28 U.S.C. §§ 1331 and 1338(a).

The House Report accompanying the Copyright Act of 1976 describes Section 411(a) in these terms:

The first sentence of section 411(a) restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted. Under the bill, as under the law now in effect, a copyright owner who has not registered his claim can have a valid cause of action against someone who has infringed his copyright, but he cannot enforce his rights in the courts until he has made registration.

H.R. Rep. 94-1476, p. 157 (1976). This characterization of an unregistered claim as embodying a "valid cause of action" cannot be reconciled with idea, inherent in the concept of jurisdiction, that a claim lies outside courts' potential "adjudicatory authority." *Kontrick*, 540 U.S. at 455.

2. Moreover, the purposes behind the registration requirement also lead to the conclusion that it is a prerequisite to suit rather than a jurisdictional limit. The primary purpose of the registration requirement has nothing to do with adjudication of infringement actions. Congress preserved the requirement of copyright registration for U.S. works “to create a useful public record and ... to ensure an efficient acquisition program for the Library of Congress” (because registration requires depositing a copy of the work to be registered). 2 NIMMER, *supra*, at § 7.16 [B][1][b][iv] (2009). Although these are worthwhile purposes, they have little if any relationship to the reasons for which Congress generally tailors *jurisdictional* requirements, such as keeping federal court caseloads manageable (by, for example, restricting subject-matter jurisdiction over diversity actions to cases involving substantial amounts in controversy) or precluding judicial review of actions it wishes to commit to agency discretion. (Perhaps that explains why Congress has authorized copyright holders to seek registration, and then to file suit, at virtually any time during the lengthy duration of a copyright.)

Second, while Section 411(a)’s registration requirement may sometimes “simplif[y] and expedit[e] litigation,” S. REP. NO. 100-352, at 23 (1988) (Conf. Rep.), by providing the Copyright Office with a chance to weigh in on whether the deposited material constitutes copyrightable subject matter or is otherwise not subject to copyright registration, 17 U.S.C. § 410(b), the registration requirement sometimes threatens the opposite effect. For example, in this case, insisting on the formality of

registration prior to suit would thwart significant interests in judicial economy. If federal courts lack the adjudicatory power to dispose of the claims of the currently unregistered copyright holders at issue here, individual authors will be completely within their rights to file separate suits all across the country for myriad injunctions and claims for actual damages, which are “not inconsequential.” J.A. 8. Given that “thousands” of claims relating to “hundreds of thousands of newspaper and magazine articles,” Pet. 7, exist, and that each one could be litigated as soon as the copyright holder complied with Section 411(a), if this Court were to hold that Section 411(a) is a jurisdictional prerequisite that must be met individually by each member of the class, that holding would threaten to flood the federal court system with repetitive litigation. The purpose of expediting litigation would be far better served by treating Section 411(a) as a claim-processing rule.

**II. IN A CLASS ACTION SUCH AS THIS, ONLY THE NAMED PLAINTIFFS WERE REQUIRED TO SATISFY SECTION 411(a)’s CLAIM-PROCESSING RULE.**

The named plaintiffs in this case clearly satisfied the registration requirement of Section 411(a) with respect to at least some of their works. Petr. Br. 4 (citing J.A. 3-4, 18-24, 27, 34, 49-58, 69-72). Thus, as to those works, the district court undeniably had subject-matter jurisdiction. While the court of appeals correctly observed that “the class action certification device ... does not offer any alternative source of jurisdiction,” Pet. App. 21a, citing *Amchem Prods., Inc., v. Windsor*, 521 U.S. 591, 613 (1997),

once Section 411(a) is properly understood as a prerequisite to suit or a claim-processing rule, rather than as a jurisdictional limitation, the court of appeals' observation does not answer the question whether every member of the class must satisfy the registration requirement. As Judge Walker pointed out in his dissent, each member of the proposed class clearly had Article III standing, having suffered an injury in fact through the infringement of his or her copyrights that would be redressed by an award of damages. The other statutory prerequisites to suit could be, as they were in this case, waived with respect to unnamed class members. *See* Pet. App. 38a-42a.

1. This Court's decisions in a closely analogous area of law suggest that universal registration is not required. This Court has repeatedly held, in class actions under Title VII, that unnamed class members do not need to have filed charges with the EEOC. *See, e.g., Albemarle Paper Co. v. Moody*, 422 U.S. 405, 414 n. 8 (1975) (“[B]ackpay may be awarded on a class basis under Title VII without exhaustion of administrative procedures by the unnamed class members.”); *see also Franks v. Bowman Transp. Co.*, 424 U.S. 747, 771 (1976) (reaffirming the decision in *Albemarle*). As the Seventh Circuit noted in one of the decisions on which this Court relied, *see Albemarle*, 422 U.S. at 414 n.8, “[t]o require that each employee file a charge with the EEOC and then join in the suit would have a deleterious effect on the purpose of the Act and impose an unnecessary hurdle to recovery for the wrong inflicted.” *Bowe v. Colgate-Palmolive Co.*, 416 F.2d 711, 720 (7th Cir. 1969).

Similar reasoning should apply in the context of class actions for copyright infringement. The underlying *rights* of registered and unregistered copyright holders are identical (although, of course, the panoply of remedies available to them differs in some respects, *see supra* at 21 n.5). The ways in which defendants infringed the class members' copyrights do not differ according to whether the copyrights were registered or not. The registered and unregistered works were wrongly included in exactly the same electronic databases, in exactly the same way. The costs of requiring each and every unnamed plaintiff to register every copyright that might have been infringed would far outweigh the benefits to the public provided by registration (particularly given that many of the periodicals or other publications in which the works were included were almost certainly themselves registered under Section 411(a)). The likely result of requiring such registration is that many claims would be left out of any agreement between authors and publishers, either leaving those authors uncompensated for the infringement of their works or creating the possibility that "gaping holes" will be left in the "electronic record of history," *Tasini*, 533 U.S. at 505, by defendants who simply remove freelance works from their databases rather than risk the possibility of future lawsuits.

2. Moreover, in class actions, as in individual litigation, Section 411(a) is a claim-processing rule, rather than a jurisdictional prerequisite. Petitioners are not asserting before this Court unnamed class members' failure to have registered their works as a barrier to their entitlement to recover. *See Petr. Br.* 2-3 (describing petitioners' desire to reach a "global"

settlement that includes nonregistered works). As this Court has emphasized, “there is ‘a critical difference between a rule governing subject-matter jurisdiction and an inflexible claim-processing rule.’” *Eberhart*, 546 U.S. at 13 (quoting *Kontrick*, 540 U.S. at 456): even rigid claim-processing rules are subject to waiver.

### **III. SUPPLEMENTAL JURISDICTION UNDER 28 U.S.C. § 1367 PROVIDES AN ALTERNATIVE BASIS IN THIS CASE FOR EXERCISING JURISDICTION OVER THE INFRINGEMENT CLAIMS OF UNREGISTERED COPYRIGHT HOLDERS.**

Even if this Court were to conclude that federal courts cannot exercise original subject-matter jurisdiction over a case brought by the holder of an unregistered copyright in a U.S. work, that conclusion should not end its inquiry. Rather this Court should hold that the federal supplemental jurisdiction statute, 28 U.S.C. § 1367, permitted the district court to exercise jurisdiction over the claims involving unregistered U.S. works in conjunction with its exercising jurisdiction over related claims involving registered works.

#### **A. The Claims Of The Unregistered Copyright Holders Meet The Criteria For The Exercise Of Supplemental Jurisdiction Set Out In 28 U.S.C. § 1367(a).**

In *Exxon Mobil Co. v. Allapattah Services*, 545 U.S. 546, 558 (2005), this Court explained that “Section 1367(a) is a broad grant of supplemental jurisdiction”; indeed “[t]he whole point of

supplemental jurisdiction is to allow the district courts to exercise pendent jurisdiction over claims as to which original jurisdiction is lacking.” *City of Chicago v. International College of Surgeons*, 522 U.S. 156, 157 (1997). Section 1367(a) identifies three elements for the exercise of supplemental jurisdiction: First, there must be some claim in the “civil action” over which the district court has “original jurisdiction.” 28 U.S.C. § 1367(a). Second, the proposed pendent claims must be “so related to” a claim over which the district court has “original jurisdiction that they form part of the same case or controversy.” *Id.* Third, supplemental jurisdiction can “include claims that involve the joinder or intervention of additional parties.” *Id.* Finally, district courts cannot exercise supplemental jurisdiction over a claim if “expressly provided otherwise by Federal statute.” *Id.*

1. There is no question that the district court in this case had original jurisdiction over the named plaintiffs’ claims involving registered works. Those claims clearly fell within the grants of subject-matter jurisdiction in 28 U.S.C. §§ 1331 and 1338(a) and by definition satisfied Section 411(a)’s registration requirement. Thus, the requirement that the federal courts possess original jurisdiction over at least one claim in the plaintiffs’ complaint is easily satisfied. *See Exxon*, 545 U.S. at 559 (“If the court has original jurisdiction over a single claim in the complaint, it has original jurisdiction over a ‘civil action’ within the meaning of § 1367(a.)”); *College of Surgeons*, 522 U.S. at 166.

2. The claims of unregistered copyright holders form part of the same case or controversy. To begin,

as respondents have already shown, the Copyright Act provides them with a legally protected interest in their work. 17 U.S.C. § 408(a); *see supra*, at 19. Congress has explained that holders of unregistered copyrights in U.S. works have “a valid cause of action against someone who has infringed [their] copyright.” H.R. Rep. 94-1476, at 157; *see supra* at 31.

Under the facts of this case, the claims of registered and unregistered copyright holders are the same. Whether a copyright was registered or not has no bearing on the authors’ rights to exclusive control over the distribution or reproduction of their work or the fact that inclusion of their work in petitioners’ databases constitutes copyright infringement. This case involves the wholesale inclusion of freelance authors’ work in massive electronic databases. Nothing in the record suggests that the defendants considered whether a particular copyright was registered or not in deciding which works to include. In fact, the infringement of registered and unregistered work often occurred in a single transaction – for example, when petitioners who operate databases purchased from the initial publishers the right to include entire issues of their publications containing both freelance work and work whose copyright was owned by the initial publishers (because, for example, it was work-for-hire created by the publishers’ own employees). *Cf. Tasini*, 533 U.S. at 489 (noting that electronic databases “contain articles from hundreds of journals (newspapers and periodicals) spanning many years”).

If anything, the claims in this case fit even more cleanly within the “same case or controversy” rubric than the claims at issue in *Exxon*. That case

concerned a class of roughly 10,000 Exxon dealers, each of whom presumably had a separate fuel-purchasing contract with the defendant, *see* 545 U.S. at 550, and each of whom might conceivably have been injured in a different way by the challenged practices. Yet, it was sufficient for purposes of supplemental jurisdiction that the plaintiffs alleged Exxon engaged in the same “intentional and systematic scheme” with regard to each of those individual fueling agreements. *Id.* In this case, by contrast, holders of registered and unregistered copyrights are identically situated with respect to *how* their rights have been violated.

3. *Exxon* also establishes that “the presence of additional parties” with claims that fall short of a jurisdictional requirement “does not mean the civil action is outside the purview of § 1367(a).” 545 U.S. at 564. To the contrary, “the last sentence of § 1367(a) expressly contemplates that the court may have supplemental jurisdiction over additional parties.” *Id.*<sup>11</sup> Thus, the inclusion of plaintiffs with related claims over whom the district court would otherwise have had no jurisdiction poses no barrier to adjudication of claims involving unregistered copyrights.

4. The court of appeals was clearly wrong to hold that supplemental jurisdiction is available only over state-law claims, and cannot confer power to

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<sup>11</sup> The one exception to this principle contained in Section 1367(b) is inapplicable here because it concerns only cases where the presence of additional parties would destroy the complete diversity requirement of 28 U.S.C. 1332.

adjudicate “jurisdictionally-deficient *federal* claims asserted together with another, jurisdictionally proper claim.” Pet. App. 25a-26a. In *Exxon*, this Court observed that the general federal-question jurisdiction statute had an amount-in-controversy requirement until quite recently. “If such a requirement were revived under § 1331,” the Court explained, “it is clear beyond peradventure that § 1367(a) provides supplemental jurisdiction over federal-question cases where some, but not all, of the federal-law claims involve a sufficient amount in controversy.” 545 U.S. at 562.

Section 1367(a) thus “unambiguously overrules the holding and the result in *Clark [v. Paul Gray, Inc., 306 U.S. 583 (1939)]*.” *Exxon*, 545 U.S. at 562. There, several businesses and individuals joined together in a single lawsuit to challenge a California statute on federal constitutional grounds, each asserting “separate and distinct demands” for relief. 306 U.S. at 589. This Court held that although one corporate plaintiff had pleaded sufficient facts to satisfy the amount-in-controversy requirement, the other plaintiffs had not, and therefore “the suit should be dismissed as to those who fail to show that the requisite amount is involved.” *Id.* at 590.

The registration requirement of Section 411(a) cannot in some way be *more* “jurisdictional” than the amount in controversy requirement. Thus, just as Section 1367(a) would have allowed all the plaintiffs in *Clark* to proceed given that their claims were related to the claims of Paul Gray, Inc., so too, all the plaintiffs in this case should be allowed to proceed, given that their claims are related to the claims of the plaintiffs who have registered their copyrights.

**B. Section 411(a) Does Not Constitute A Provision “Expressly Provid[ing] Otherwise” With Respect To The Exercise Of Supplemental Jurisdiction.**

1. As respondents have already explained, Section 411(a)’s registration provision does not “speak in jurisdictional terms.” *Zipes v. Trans World Airlines, Inc.*, 455 U.S. 385, 394 (1982). *See supra* at 23-26. Although this Court has not directly interpreted Section 1367(a)’s “expressly provided” provision, it has construed nearly identical language in the federal removal statute, 28 U.S.C. § 1441(a), which permits removal from state court to federal court of any action in which the federal courts would have original jurisdiction “except as otherwise expressly provided by Act of Congress.” 28 U.S.C. § 1441(a). Its construction there should set to rest any argument that Section 411(a) operates to limit the supplemental jurisdiction that would otherwise exist over claims involving unregistered copyrights.

In *Breuer v. Jim’s Concrete of Brevard*, 538 U.S. 691 (2003), this Court emphasized the legal significance of the word “expressly,” reasoning that “expressly” must be understood to require “something more than any verbal hook for an argument.” 538 U.S. 691, 695 (2003). Thus, where there was “no mention of removal, let alone of [prohibiting removal]” in the statute in question and where the only possible “express provision” was an ambiguous statement about “maintaining” actions in state court, the “expressly provided” qualification in the removal statute was not satisfied. *Id.* at 694-95. The Court explained that “if an ambiguous term like ‘maintain’ qualified as an express provision for purposes of [the

removal statute], then the requirement would call for nothing more than a ‘provision,’” *id.* at 695-96. Accordingly, when Congress intends to “expressly provide” for an exception to the removal statute it must do so in “unmistakable terms.” *Id.* at 697 (citation omitted).

The “expressly provided” qualification in Section 1367(a) should be construed similarly. As the D.C. Circuit noted in *Lindsay v. Government Employees Insurance Co.*, 448 F.3d 416 (D.C. Cir 2006), Congress clearly knows how to expressly exclude claims from the operation of Section 1367(a) when it wishes to do so. In the Violence Against Women Act, for example, Congress stated explicitly that “section 1367 does not ‘confer on the courts of the United States jurisdiction over any State [domestic] law claim.’” 42 U.S.C. § 13891(e)(4). Thus, when “Congress intends to divest federal courts of supplemental jurisdiction, it does so expressly—as section 1367(a) requires.” 488 F.3d at 422. Section 411(a) simply does not provide, in “unmistakable terms” – indeed, in any terms – for an exception to the supplemental jurisdiction statute.

2. Beyond the plain textual argument against treating Section 411(a)’s silence as if it somehow “expressly provid[es]” an exception to Section 1367(a)’s broad grant of authority, there is also no policy rationale for treating Section 411(a) as exempting the claims involving unregistered copyrights from the operation of the supplemental jurisdiction provision. *Cf. Exxon*, 546 U.S. at 555 (weighing the appropriateness of supplemental jurisdiction in light of the purpose behind the jurisdictional requirement).

The only risk that permitting supplemental jurisdiction here poses to the policies behind Section 411(a) comes from the possibility that allowing holders of unregistered U.S. works to vindicate their copyrights as part of the plaintiff class will decrease somewhat the incentive individual authors would otherwise have to register their works so that they could sue for their infringement. To the extent that it decreases that incentive, it may well correspondingly decrease the probability that individual authors will deposit copies of their work with the Library of Congress – a requirement of the registration process, 17 U.S.C. § 407(a). But many of the works at issue in this litigation were likely registered by the initial periodical publishers with whom the class members directly contracted when those publishers registered the publication in which the class members’ works initially appeared. More pointedly, 17 U.S.C. § 704(d) authorizes the Registrar of Copyrights and the Librarian of Congress to destroy published records after an amount of time “considered practical and desirable.” 17 U.S.C. § 704(d). This authorization reflects the practical conclusion that an article’s publication can also establish a public record.<sup>12</sup>

3. In contrast to the speculative policy implications of finding supplemental jurisdiction in

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<sup>12</sup> In fact, the discretion to destroy registered works (and the possibility that such destruction has already happened) leads to the ironic result that published works are *better* protected by the publishers and databases subject to this litigation than by the Library of Congress.

this case, the negative policy implications of refusing to permit supplemental jurisdiction are quite concrete. Congress enacted Section 1367(a) as part of the Judicial Improvements Act of 1990 “to promote . . . the just, speedy, and inexpensive resolution of civil disputes in our Nation’s Federal Courts.” S. REP. NO. 101-416, 1990 U.S.C.C.A.N. 6802, 6804. Congress was troubled by the “[h]igh costs, long delays and insufficient judicial resources” that plagued the federal system. *Id.* The broad availability of supplemental jurisdiction was intended to enable litigants “to deal economically – in single rather than multiple litigation – with related matters.” H.R. REP. NO. 101-734, 1990 U.S.C.C.A.N. 6860, 6874. Yet, as a result of the court of appeals’ decision in this case, the parties will be relegated to the same drawn-out and expensive process from which supplemental jurisdiction was intended to save them.

**IV. THIS COURT SHOULD NOT RESOLVE THIS CASE ON THE GROUNDS THAT IT INVOLVES SIMPLY APPROVAL OF A SETTLEMENT RATHER THAN EXERCISE OF ADJUDICATORY JURISDICTION.**

Both before the court of appeals and in this Court, petitioners have argued, relying on *Matsushita Elec. Indus. Co. v. Epstein*, 516 U.S. 367 (1996), that this case can be resolved by applying the principle that “courts may approve settlements that release claims they could not have tried for want of jurisdiction.” Petr. Br. 48. Respondents do not, of course, quarrel with the basic principle. But even in *Matsushita* itself, this Court felt itself required to ask

whether the federal jurisdictional statute at issue there – Section 27 of the Securities Exchange Act of 1934, 15 U.S.C. § 78aa – embodied policies preventing giving preclusive effect to the settlement approval. *See* 516 U.S. at 380-85. So before deciding whether the district court had authority to approve the settlement agreement here, this Court will still need to interpret Section 411(a) to see whether it affirmatively denies district courts power over unregistered copyright claims in a way that would make it inappropriate for federal courts to give their imprimatur to a settlement.

There is another important reason why, given the nature of this case, the Court should reach the question whether there was jurisdiction over the claims involving unregistered U.S. works. That question bears in important respects on the issue the court of appeals will have to resolve if this Court were to reverse the judgment – namely, whether the proposed settlement treats unregistered copyright holders fairly.<sup>13</sup>

If Section 411(a) is a jurisdictional prerequisite, and courts may dispose of unregistered claims only in

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<sup>13</sup> As a preliminary matter, it is unclear whether resolving this case on *Matsushita* grounds actually answers the Question Presented articulated by this Court. Rather than determining whether or not Section 411(a) restricts the jurisdiction of the federal courts, a decision relying on *Matsushita* would imply that in the context of settlement, that question is irrelevant. Moreover, failing to resolve the question presented after seeking and receiving full briefing and oral argument would forfeit an opportunity for this Court to resolve a critical and recurring question in copyright law.

the context of settlement, then those claims are, as a practical matter, less economically valuable than if plaintiffs can use either the class-action device or supplemental jurisdiction to seek adjudication of unregistered copyright infringement claims as long as the lead plaintiff can invoke the court's jurisdiction over his or her registered works. If the only ways holders of unregistered U.S. works can receive compensation for infringement are through defendants' acts of grace or through undertaking the costly and time-consuming process of obtaining registration and then undertaking the costly and time-consuming process of litigating their claims on an individual basis, then a settlement that offers them even a pittance may seem acceptable. On the other hand, if Section 411(a) does not restrict subject matter jurisdiction and either class-action litigation or supplemental jurisdiction is available, then unregistered claims have a higher practical value since the class members could proceed to trial and receive actual damages even over a defendant's objection. Given that possibility, a settlement might be unreasonable if it offered holders of unregistered copyrights only nominal damages. In short, the fairness of the proposed settlement in this case depends in part on the available alternatives to settlement and the economic value of the Category C claims. A decision that does not squarely resolve the jurisdictional question will leave in place an erroneous court of appeals ruling that may lead that court to undervalue respondents' infringement claims in assessing the fairness of the settlement.

**CONCLUSION**

For the foregoing reasons, the judgment of the court of appeals should be reversed and the case should be remanded for the court of appeals to address the fairness of the proposed settlement.

Respectfully submitted,

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