March 19, 2020

Submitted by Online Submission Procedure

Hon. Maria Strong
Acting Register of Copyrights and
Director of the U.S. Copyright Office
U.S. Copyright Office
101 Independence Avenue, S.E.
Washington, DC 20559-6000

Re: Docket No. 2019-7: ABA Section of Intellectual Property Law response to NOI re Electronic Publication

Dear Acting Register Strong:

I write on behalf of the American Bar Association (“ABA”) Section of Intellectual Property Law (the “Section”) to respond to the U.S. Copyright Office’s Notification of Inquiry (NOI) on “Online Publication” in the Federal Register at 84 Fed. Reg. 66328-66334 (December 4, 2019). The Section appreciates the Copyright Office’s inquiry on this matter. The views expressed herein are presented on behalf of the Section and have not been approved by the House of Delegates or the Board of Governors of the American Bar Association. Accordingly, they should not be construed as representing the position of the ABA.

Since 1894, the ABA-IPL Section has advanced the development and improvement of intellectual property laws and their fair and just administration. As the forum for diverse perspectives and balanced insight on the full spectrum of intellectual property law, the Section serves within the ABA as a highly respected voice within the intellectual property profession, before policy makers, and with the public.

General Comments:

Determining how publication status should be dealt with in registration applications for works published online requires balancing at least three different goals:
• Supporting the creation of as complete and accurate a database of copyrighted works as realistically possible;
• Avoiding registration requirements that call for information that an applicant does not have and cannot reasonably attain, which can lead to errors that might invalidate the registration; and
• Protecting third parties from adverse consequences that flow from a party’s reliance on erroneous material concerning publication status on the registration certificate.

These goals sometimes conflict; for example, stringent penalties for errors in a registration application discourage registration of copyrighted works, which inevitably makes the Office’s database less comprehensive. Therefore, the Section believes policy should be created to establish a workable balance among these goals.

Because “publication” still has significance under current law, the Section’s recommendations reflect our preference to avoid amending the statutory requirement that an application for registration requires the date and place of publication. We believe that the Office can address the current problems posed by online dissemination of works by (1) providing more guidance to applicants on how to address these online publication-related issues, and (2) lessening the penalties for erroneous designation of publication status in applications. These points are discussed below, in the specific responses to each NOI question.

Specific Responses to the NOI Questions:

1. Section 409(8) of the Copyright Act requires applicants to indicate the date and nation of first publication if the work has been published. What type of regulatory guidance can the Copyright Office propose that would assist applicants in determining whether their works have been published and, if so, the date and nation of first publication for the purpose of completing copyright applications? In your response, consider how the statutory definition of publication applies in the context of digital on-demand transmissions, streaming services, and downloads of copyrighted content, as well as more broadly in the digital and online environment.

At least two problems can lead to errors concerning publication status of a work in an application for registration: uncertainty concerning the facts, and uncertainty concerning the law.

Factual uncertainty. In some cases, the applicant may not know as a factual matter whether a work was published. For example, a photographer may send to a publisher the photos the photographer took on a particular assignment, but photographers may not learn which of the shots, if any, are published.
Legal uncertainty. Determining whether a work has been “published” under the law in an online or digital environment can be a complicated inquiry that applicants are not well-suited to undertake. This is the Copyright Act definition:

“Publication” is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.

This definition was written before the digital era and contemplated the distribution of physical copies. The first part of the definition initially contemplated the distribution of physical copies of a work to the public by sale or other transfer of ownership, or by rental lease or lending. Nonetheless, the definition has been interpreted to embrace situations where copies were distributed digitally, and the end user receives a digital, retainable copy of the work. In the view of the Copyright Office, for such activity to constitute publication, the copies must be distributed with the authorization of the right holder. Compendium of Copyright Office Practices (Third), sec. 1902. It is not enough that an end user can access and save a copy by technological means – e.g., by copying the work a page at a time and reassembling it. Authorization by the right holder can be demonstrated by the terms of service, or by a download capability (e.g., a button the viewer can click on to download the document). (These aren’t the only possible indications of authorization, but they are likely the clearest.)

Even where the right holder distributes copies, there may be circumstances that would lead one to conclude that the work is not published. For example, an author may distribute a copy or copies of a work online without “publishing” the work. Also, an author may send a copy as a draft or a sample of a work to a prospective publisher or customer for review but not for further distribution.

The second way in which an online work may be published is by “offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display . . . .” So, for example, uploading one’s work to a social media site like Instagram could, under terms of an end user agreement (EUA) that allows the site to publish the work, be a publication. The activity of “offering” the work in this context surely meets one part of the statutory requirement, but this may not be sufficient to conclude whether publication has been made under the statute. The use of the term “group of persons” seems to imply that providing the work to only one social media site is not enough. On the other hand, one might argue that if the EUA permits distribution to related social media sites in other countries or to other sublicensees who are authorized to further offer, distribute, publicly perform or display the work, then loading the work to the first social media site is effectively an offer to a group of persons. However, we are not aware of any case that supports this interpretation.
The definition of publication states that “[a] public performance or display does not of itself constitute a publication.” This suggests that streaming could be a publication if there are one or more additional factors, since the activity “of itself” is not enough. One might argue that the copies made solely to enable streaming might be an additional element, but if those copies are merely incidental to the streaming and do not change hands, it’s difficult to argue that these functional copies warrant treating streaming as a publication.

The bottom line is that it is difficult to apply the definition of publication in an online environment. In order to encourage registration that benefits all parties, the Copyright Office should provide additional explanations in cases where the publication status of a work is not readily apparent to lawyers, much less lay persons.

To encourage registration that benefits all parties, the Copyright Office should provide additional explanations in easy-to-understand formats, whether in the form of circulars, FAQs or educational videos that would likely be more readily used than formal regulations. Providing a variety of different examples and explaining how to work through the issues in each would be particularly helpful. One example of a frequently-asked question is whether it constitutes publication for an author to place content on a website as a representation of the author’s portfolio of works. It would be useful for the Office to consult with practitioners for questions they frequently encounter and provide guidance on those issues to encourage registration of works.

Another deterrent to registration is the possibility that an erroneous statement concerning publication status will result in invalidation of the registration, and the inability to effectively enforce copyright. Publication issues are extremely complex, and it seems fundamentally unfair to hold an applicant to a standard that many lawyers may be unable to meet. Provided an applicant does not purposely misrepresent the publication status of a work, the Office should not invalidate the registration (likewise, a user who relied on the erroneous information to his detriment should not be penalized).

2. Specifically, should the Copyright Office propose a regulatory amendment or provide further detailed guidance that would apply the statutory definition of publication to the online context for the purpose of guiding copyright applicants on issues such as: i. How a copyright owner demonstrates authorization for others to distribute or reproduce a work that is posted online; ii. The timing of publication when copies are distributed and/or displayed electronically; iii. Whether distributing works to a client under various conditions, including that redistribution is not authorized until a “final” version is approved, constitutes publication and the timing of such publication; iv. Whether advertising works online or on social media constitutes publication; and/or v. Any other issues raised in section I(C) above.

Again, it is important to provide applicants with more guidance, including guidance in all the areas listed above; in particular, subsection (iii). Sometimes an author sends copies of a work for review and feedback or as a sample for consideration by a potential publisher
or client (e.g., an initial chapter of a proposed work, or a sample illustration) in circumstances where it is understood by agreement or industry practice that the recipient may not further distribute the work. Authors and artists may not know whether the distribution of copies in these or similar circumstances constituted publication under the law, and may be reluctant to register without further guidance.

3. Can and should the Copyright Office promulgate a regulation to allow copyright applicants to satisfy the registration requirements of section 409 by indicating that a work has been published “online” and/or identifying the nation from which the work was posted online as the nation of first publication, without prejudice to any party subsequently making more specific claims or arguments regarding the publication status or nation(s) in which a work was first published, including before a court of competent jurisdiction?

This approach would be preferable to eliminating §409(8) completely. It might be helpful to applicants who are unable to determine the place of first publication, but can nevertheless provide meaningful information to assist in that inquiry.

4. Applicants cannot currently register published works and unpublished works in the same application. Should the Copyright Office alter its practices to allow applicants who pay a fee to amend or supplement applications to partition the application into published and unpublished sections if a work (or group of works) the applicant mistakenly represented was either entirely published or unpublished in an initial application is subsequently determined to contain both published and unpublished components? What practical or administrative considerations should the Office take into account in considering this option?

If an applicant mistakenly represented the publication status of a work (e.g., including a work that was actually published in a registration application of a group of unpublished works, or including a work that was unpublished in a registration application of published works), the Office should allow the copyright owner to partition the registration if it amends or supplements the registration and pays the requisite fee. This approach is preferable to invalidating the registration; presumably works whose publication status was designated erroneously could maintain the date and registration number of the original registration, and Copyright Office records could be annotated appropriately. As long as the records clearly reflect what happened – i.e., the date of the original registration for the work(s) in question and the date and nature of the subsequent modification with respect to the work or works – this approach seems constructive and in keeping with the goals of encouraging participation in the registration process and developing and maintaining realistically accurate databases.

5. For certain group registration options, should the Copyright Office amend its regulations to allow applicants in its next generation registration system to register unpublished and published works in a single registration, with published works marked as published and the date and nation of first publication noted? What would the benefits of such a registration option be, given that applicants
will continue to be required to determine whether each work has been published prior to submitting an application? What practical or administrative considerations should the Office take into account in considering this option?

We understand this question to ask whether a partitioned application should be permissible from the outset, as distinguished from Question 4, which seems to focus on whether an application may be partitioned after the fact, when the registrant learns of a mistake in the application concerning publication status.

In general, we think this approach could be helpful to creators who create a large volume of works. The potential harm we see is possible confusion of the records. Provided the Copyright Office records can clearly indicate which works in the registration are published and which are not, we don’t see why this should make a difference. If, however, having both published and unpublished works on a single application makes it more time-consuming for the Office to process the application, this may need to be taken into account by the fee structure.

6. [No question 6 in NOI.]

7. Is there a need to amend section 409 so that applicants for copyright registrations are no longer required to identify whether a work has been published and/or the date and nation of first publication, or to provide the Register of Copyrights with regulatory authority to alter section 409(8)’s requirement for certain classes of works?

We are reluctant to recommend removing §409(8) from the registration application. The publication status of a work, and the date and place of publication, continue to have potential legal consequences under copyright law. For example, it determines copyright duration for anonymous and pseudonymous works and works made for hire; the applicability of exceptions for certain library and archives activities under §108; it determines whether a registration provides prima facie evidence of the validity of the copyright and the facts in the certificate (which requires that the registration be made before publication or within 5 years after first publication); etc. In other words, publication status provides valuable information. The rationale for removing it from the application is apparently that applicants often don’t know whether a work is published or not, and that invalidation of a registration is too great a penalty for someone who makes a mistake. Before eliminating the requirement for the applicant to provide information about publication, we believe it would be wiser to (1) provide applicants with more information for how to determine the publication status of a work, and (2) eliminate the severe consequences to applicant of errors on the application (see our answer to Question 1, above).

8. Is there a need for Congress to take additional steps with respect to clarifying the definition of publication in the digital environment? Why or why not? For example, should Congress consider amending the Copyright Act so that a different event, rather than publication, triggers some or all of the consequences
that currently flow from a work’s publication? If so, how and through what provisions?

An explicit “making available right” could better accommodate the online environment and be an appropriate trigger for some or all of the consequences that currently flow from a work’s publication. It is unlikely, however, that taking this approach would be free from controversy. Some activities such as public performance or public display would be deemed “making available.” Proprietors of such works may be reluctant to see this result, and it would be helpful to better understand how they think they might be harmed by this approach.

9. The Copyright Office invites comment on any additional considerations it should take into account relating to online publication.

We have no further comments at this time.

The Section appreciates the opportunity to provide these comments. If you have any questions regarding the above comments, please feel free to contact me.

Sincerely,

George W. Jordan III
Chair, ABA Section of Intellectual Property Law