January 10, 2019

Submitted by Online Submission Procedure

Hon. Karyn Temple
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: Registration Modernization

Dear Acting Register Temple:

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 invitation for written comments on “Registration Modernization” in the Federal Register at 83 Fed. Reg. 52336-52345 (October 17, 2018) (the “Notice”). The views expressed herein have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and, accordingly, should not be construed as representing the policy of the ABA.

The ABA is the largest voluntary professional association in the world and the Section, which was established in 1894, is the largest intellectual property organization in the world and the oldest substantive section of the ABA.

The Section appreciates the Copyright Office’s inquiry on this matter and has listed below, in the order followed by the Notice, comments specifically relating to topics on which the Section is prepared to comment.
A. The Application Process: How Users Engage with the Registration System

1. New Solutions for Delivering Application Assistance: The Section supports the Copyright Office’s efforts to create a dynamic online electronic registration system that offers in-application, multi-tiered support to prospective applicants, but has concerns regarding the substance of the information conveyed through that system and its potential legal significance.

The Section believes that certain standard information may be useful to applicants, such as, for example, links to relevant definitions from Title 17 of the U.S. Code under basic “Tier One” support, and links to excerpts from Copyright Office circulars in the more extensive “Tier Two” format. However, the inclusion within the application of a help panel offering “comprehensive information and instructions on pertinent copyright concepts” or a live chat support feature could add complications to an otherwise simple process and have unforeseen legal implications. The Section would respectfully suggest that any chat function be restricted to questions that do not constitute legal advice, such as IT support, rather than “instruction on pertinent copyright concepts,” and that information offered within the application, at least in the first instance, help users navigate only to relevant Circulars, codes and statutes, rather than provide more informal guidance. Furthermore, the record of Copyright Office applicant engagement with live chat or similar features that the Copyright Office may adopt should ideally be preserved by the Copyright Office for potential evidentiary purposes, to the extent that such communications advise the applicant on pertinent copyright issues. If such chats are retained, remitters need to be clearly informed of this before they engage in any such communications with the Office.

2. Electronic Applications and Payments: In light of the rationale set forth in the Notice, the Section supports mandating electronic applications and payments, while continuing to offer paper applications to individuals who are able to demonstrate a need for paper applications, such as those who have no ready access to high speed internet services, or who are incarcerated, and continuing to offer non-electronic payment methods for those who do not have access to credit cards or other electronic payment systems. The Section further notes that, in addition to providing overall efficiency in the processing of applications, moving to an online electronic system may also improve user authentication.¹

3. Electronic Certificates: In light of the rationale set forth in the Notice, the Section supports defaulting to electronic certificates of registration, while offering paper certificates for an additional fee.

¹ If electronic copyright applications are to be mandated, the Copyright Office's new online filing system should provide for remote signature by the copyright owner in the event that the signatory and counsel are in different locations. This functionality is already provided for with respect to patent and trademark applications filed with the U.S. Patent and Trademark Office.
4. **Dynamic Pricing**: The Section supports in principle the notion that establishing higher fees based on the kind of work submitted and/or the number of works included in each application would result in more precise and equitable fee burdens on applicants, but reserves further comment pending more information on the specific types of applications and types of creators that will likely be impacted by dynamic pricing and the proposed fees under this system.

B. **Application Information: The Information Requested on the Application for Registration**

5. **Authorship Statements and Administrative Classifications.** The Section supports the Copyright Office’s proposal to minimize applicant confusion and additional work for examiners by requiring applicants to identify the type of work submitted for registration, rather than identifying the individual elements of authorship. The Section agrees that this approach would ensure that the work as a whole, in addition to elements of authorship, would be considered by examiners. Furthermore, the Section supports the proposed usage of a dropdown list describing the work as a whole, rather than checkboxes and blank spaces, for identifying the applicant’s assertions of claims.

With respect to options (a)-(c) for replacing the Author Created and Nature of Authorship sections in applications, the Section notes that these options do not appear to be mutually exclusive. The Section believes that the Office has the expertise and experience to create a largely workable list. The Section suggests that the list include an “Other” option, with the applicant then allowed to insert his/her own description of the work if he/she thinks the options provided do not capture the type of work being submitted, or to otherwise supplement the dropdown list. The dropdown list can subsequently be expanded if appropriate based on trends in descriptions provided by those who select the “Other” option. This approach may result in a more focused result than trying to crowdsource the initial dropdown list.

The Office has also invited comment on its current administrative classifications. The Section agrees with the Office’s comments that the current classifications and corresponding application forms can be confusing, since many works do not fit neatly into a specific class (as, for example, is true for many websites). It would seem most effective to have the Office route the applications for examination based on the general description of the type of work. It should be made clear to remitters using the system that the administrative classifications are for administrative convenience only (e.g., examination and indexing registration records), and the classifications do not have any legal impact (e.g., they are not implied disclaimers of elements of the submitted content). There could also be an option to allow the examiner to input comments on the apparent nature of the deposited work in cases where comments under the “Other” selection do not lend themselves well to standard indexing and the examiner believes an appropriate classification is available.
With respect to the proposed expansion of current administrative classifications, the Section respectfully submits that new administrative classes for software and for websites would be a welcome addition.

6. **Derivative Works**: The Section supports the Office’s proposal to eliminate the step of identifying the materials to be “included” in a copyright registration claim, and instead to rely on the applicant’s identification of the type of work the author created.

The Office is also considering whether to change the process by which applicants should identify any appreciable amount of preexisting material incorporated within the work to be registered. The Office has proposed giving applicants “an opportunity to identify any elements that should be excluded from the claim using their own words, rather than a set of predetermined checkboxes.” The Section respectfully proposes that the Office discontinue use of the phrase “Material Excluded” (currently found in the eCo system), and instead extend the use of the phrase “Preexisting Material,” (currently found in Space 6(a) on current Forms TX, VA, SE, PA, and SR) to describe this section in any future application system. This would provide a clearer description for remitters of the purpose of this section of the application.

In addition, the phrase “Preexisting Material” explains the nature of the factual inquiry required for registration, without suggesting that the applicant is disclaiming any legal rights. The Copyright Act consistently describes the application as a source of “facts” or “information.” See, e.g., 17 U.S.C. §§ 408(d) (discussing “information contained in a supplementary registration”); 409(10) (granting the Register of Copyrights the authority to seek “other information” in its discretion); 410(a) (“The certificate shall contain the information given in the application . . . .”); 410(c) (extending evidentiary presumption of validity to all “facts stated in the certificate”); 411(b) (discussing certificates and applications that contain “inaccurate information”).

The phrase “Material Excluded” is potentially confusing or misleading because some of the categories of preexisting materials currently identified for selection in the eCo system may not in fact be excluded from the scope of protection afforded by a copyright registration. For example, a number of courts have held that a copyright registration for a derivative work can support a claim for infringement of elements of preexisting, unregistered versions that are owned by the same claimant and included in the registered version. See, e.g., Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1447-48 (9th Cir. 1994); Streetwise Maps, Inc. v. VanDam, Inc., 159 F.3d 739, 747 (2d Cir. 1998); Xoom, Inc. v. Imageline, Inc., 323 F.3d 279, 284 (4th Cir. 2003). As a second example, Congress can restore works from the public domain to copyright-protected status. See Golan v. Holder, 132 S. Ct. 873, 878 (2012). Because preexisting material may or may not be excluded from the scope of copyright protection associated with a particular registration (either when the application is submitted or in the future), the Section urges the Office to transition away from asking applicants to characterize preexisting material as “Material Excluded.”
The Section suggests that a simpler process for soliciting factual information about preexisting materials would be to include questions requiring “yes/no” responses. This would both assist applicants in completing this section of the application, and ease the burden of interpretation on examiners. For example, “Does this work include preexisting materials owned by the copyright claimant?” and “Does this work include preexisting materials not owned by the copyright claimant?” may be questions that facilitate the provision of information to the Office. This could be combined with the opportunity to identify the general type of preexisting material when there is an affirmative response to these questions.

To facilitate the identification of the general type of preexisting material, the Section suggests using a hybrid process, with a dropdown menu that lists common types of elements (e.g., “text”, “illustrations”), together with an “Other” option that allows the applicant to insert their own terms when desired. This should further assist applicants by giving them an overview of the types of elements that may be commonly identified and the level of specificity with which such elements should be described, while still allowing flexibility when the standard terms do not capture the applicant’s intent.

Although the Section supports the general identification of preexisting materials in works submitted for registration, the Section does not support asking applicants to affirmatively state whether the work submitted for registration is a “derivative work”, as this is ultimately a legal conclusion that even experienced lawyers may disagree on in particular cases. Asking for the factual bases on which such a determination can be made, as proposed above, provides a sufficient record while preserving flexibility for a legal determination of the impact of these facts to be made when needed.

With regard to compilations (including collective works), the Section believes that applicants and the Office will benefit if identification of preexisting materials is handled in the same manner that identification of preexisting materials for derivative works is ultimately handled. As with derivative works, the Section believes that it would be appropriate to ask applicants to identify relevant facts underlying a determination of whether a work is a compilation, rather than asking applicants to make the legal determination of whether a work is a compilation at the time of submission of an application. And, as with derivative works, the Section recommends transitioning away from use of the phrase “Material Excluded” on the application and using the phrase “Preexisting Materials” instead, as some courts have held that a copyright registration for a collective work can support a claim for infringement of constituent elements that are owned by the same claimant and included in deposit copy of the registered version. See, e.g., Religious Technology Center v. Netcom On-Line Communication Services, Inc., 923 F. Supp. 1231, 1241-42 (N.D. Cal. 1995); Woods v. Universal City Studios, Inc., 920 F. Supp. 62, 64 (S.D.N.Y. 1996).

7. **Simplifying Transfer Statements**: The Section supports the inclusion of “By Operation of Law” as an appropriate revision of the “Other” descriptor in the types of acceptable transfer statements listed in the application. However, the Section respectfully requests that the in-application support system include definitions and
examples of the three proposed options ("By Written Agreement," "By Inheritance" and "By Operation of Law") so that applicants will be able to better distinguish these options when they believe the answer is categorizable in more than one option.

8. **In-Process Corrections**: The Section supports the Copyright Office’s proposal to allow applicants to make in-process corrections and other edits to pending applications, provided that a strong user authentication process exists for applicants making such modifications, and that the registration system provides prominent warnings to users when proposed in-process changes will push back the effective date of registration. If these in-process corrections are also going to be a part of the registration record available to adverse parties submitting a “litigation statement” then remitters need to be notified, in advance of using that feature.

9. **Rights and Permissions**: The Section supports the Copyright Office’s goal of empowering users to engage with the Online Public Record. More specifically, the Section supports allowing registrants to update the Rights and Permissions information for their works posted on the public record in a simplified manner, provided that the Copyright Office takes adequate steps to authenticate online users as the registrants, and provided that it is clear that this information is voluntary, not mandatory, to successfully complete an application.

10. **Additional Data**: The Section supports the proposal that applicants be encouraged to add to an application commonly-available unique identifiers (such as ISBNs for published works), especially if such a number or code appears in or on the deposit copy submitted with the application. As with rights and permissions information, adding such identifiers should be voluntary, not mandatory step.

11. **Application Programming Interfaces**: Since this appears to be primarily a technical rather than a legal consideration, the Section does not wish to comment on this topic at this time.

C. **Public Record: How Users Engage and Manage Copyright Office Records**

12. **Online Registration Record**: The Section supports, in principle, expansion of the online registration record to include the full record of registration currently available at the Copyright Office, such as first and second requests for reconsideration.

The Section cautions, however, that retroactive publication of these records may present issues relating to unauthorized publication of applicants’ personally identifiable information, and respectfully recommends that expansion of the online record be introduced prospectively, rather than retroactively. This could better establish the informed consent of applicants to online publication of their personally identifiable information, if present in the correspondence, and also provide an opportunity for standardizing the format of such correspondence going forward, leading to greater efficiency in maintaining records.
13. **Linking Registration and Recordation Records:** The Section strongly supports connecting registration and recordation records. The Section respectfully suggests that a model for such a system and interface may be the one utilized for trademarks by the U.S. Patent and Trademark Office, consisting of the assignment of an “Assignment Abstract of Title” linked to the database entry for a mark identified in a search.

14. **Unified Case Numbers:** The Section supports the proposal that the Copyright Office unify the “service request/case number,” “THREAD ID,” “Correspondence ID” and other disparate identification numbers to a single case number.

D. **Deposit Requirements: The Deposit Requirements for Registration and Related Security Considerations**

15. **Digital First Strategy:** The Section, in principle, supports moving toward a digital approach to the deposit requirement for all classes of works. However, the digital formats for such deposit copies should not require remitters to submit copies in formats that are costly or burdensome to remitters simply to comply with Library of Congress collections policies. For example, applicants should not be required to create full digital versions of works that are not intended to be in that format, although in such cases approaches for representative digital “samples” could be developed (e.g., photographs of a sculptural work; key identifying pages and samples from a text-only publication). The Section respectfully suggests that, in the process of moving toward such a strategy, the Copyright Office consider providing detailed guidance as to the requirements for the electronic format and visual presentation of such deposits for different classes of works, particularly those where there could be confusion as to what constitutes an adequate digital deposit. This approach should ultimately allow for greater efficiency in submitting applications, searching records and reviewing deposit materials.

16. **Digital Deposit Security:** Since this appears to be primarily a technical rather than a legal consideration, the Section does not wish to comment at this topic at this time.

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Again, the Section appreciates the opportunity to comment on the Copyright Office’s inquiry regarding registration modernization and applauds the advances that the Copyright Office has made in recent years to improve its registration functions. The Section hopes that its comments will provide the Copyright Office with useful insights as it further modernizes its online services.

Very truly yours,

Mark K. Dickson
Chair, ABA Section of Intellectual Property Law