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December 2, 2009

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
U.S. Senate
Washington, D.C. 20510

The Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
U.S. Senate
Washington, D.C. 20510

Dear Chairman Leahy and Ranking Member Sessions:

I am writing on behalf of the Section of Intellectual Property Law of the American Bar Association to express views on the requirement for registration as a prerequisite to filing an action for copyright infringement. These views have not been submitted to the House of Delegates or Board of Governors of the ABA, and should not be construed as representing policy of the Association.

We recommend amending Section 411(a) of the copyright law (17 U.S.C. §411(a)) to achieve two results: (1) to assure that owners of copyrights in “United States works” (as defined in the copyright law) (“Domestic Holders”) receive a benefit that the copyright law, in its present state, confers exclusively on owners of foreign copyrights (“Foreign Holders”); and (2) to eliminate a split among the federal circuit courts and create uniformity concerning whether a Domestic Holder has standing to assert a claim for infringement.

The Copyright Act of 1976 (“Copyright Act” or “Act”) imposes on Domestic Holders a limitation that does not exist for Foreign Holders. Specifically, Section 411(a) mandates that a Domestic Holder satisfy a “registration requirement” (described below) before filing suit in a United States court to allege infringement of its copyright. No similar registration requirement exists for works of other Berne Convention member nations.¹ Indeed, Article 5 of the Berne Convention forbids registration as a condition for copyright protection of foreign copyrights.² Congress nevertheless retained such a requirement for Domestic Holders.³

¹ See *Nimmer on Copyright* §7.16[B][1][a][ii] (2007). The Berne Convention Implementation Act (BCIA) came into effect in the United States on March 1, 1989.

² Berne Convention, Art. 5, § 2; see *Nimmer, supra*, at § 7.16[B][1][a][iii].

³ During the development of the BCIA, the Senate Judiciary Committee proposed to change Section 411(a) to expressly state that registration is not a prerequisite to filing an infringement claim. See S. Rep. No. 100-352 at 46. The House rejected the Senate’s proposed modification. See 134 Cong. Rec. H. 10091, 10095. Ultimately, Congress enacted Section 411(a) with its current wording. See 134 Cong. Rec. H. at 10095.

For Domestic Holders, Section 411(a) imposes a registration requirement as a prerequisite to filing an action for copyright infringement. That section provides, in pertinent part:

Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), *no civil action for infringement of the copyright in any United States work shall be instituted until pre-registration or registration of the copyright claim has been made in accordance with this title.* In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. . . .⁴

This provision has led to a split among the federal circuit courts. Some courts have held that a Domestic Holder has standing to sue immediately after filing an application to register its copyright (the “Application Approach”). These courts include the U.S. Court of Appeals for the Fifth Circuit and U.S. District Courts in California, Delaware, the District of Columbia, New York, North Carolina, and Rhode Island.⁵ As the U.S. District Court for the District of Columbia explained: “to best effectuate the interests of justice and promote judicial economy, the court endorses the position that a plaintiff may sue once the Copyright Office receives the plaintiff’s application, work, and filing fee.”⁶

Other courts have held that a Domestic Holder has standing to sue only after the Copyright Office either has issued a registration certificate or has denied the application (the “Registration Approach”). Courts in this camp include the Tenth Circuit and district courts in California, Kansas, Maryland, Michigan,⁷ New York, Washington, and South Carolina.⁷

Enactment of the proposed amendment, which supports the Application Approach, would unify the U.S. courts and their treatment of the registration prerequisite. It would begin to level the international playing field by removing an unnecessary impediment currently imposed in federal courts solely on United States works. And it would be consistent with the current end-result of Section 411(a), which allows a party to file an

⁴ 17 U.S.C. § 411(a) (2009) (emphasis added).

⁵ See generally *Id.*; *Prunte v. Universal Music Group*, 484 F. Supp. 2d 32, 39 n. 3 (D.D.C. 2007) (comparing cases following the Registration Approach with cases following the Application Approach).

⁶ *Prunte*, 484 F. Supp. 2d at 39 n.3 (quoting *Int’l Kitchen Exhaust Cleaning Ass’n v. Power Washers of North America*, 81 F. Supp. 2d 70, 72 (D.D.C. 2000)).

⁷ See generally *La Resolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1201-05 (10th Cir. 2005) (providing an in-depth analysis of the split among the circuits).

infringement suit after the Copyright Office either approves or rejects a registration application.

The proposed amendment retains the Act's incentives to register copyrights: a registration certificate would still be needed to establish a *prima facie* case of validity of the copyright and to be eligible to recover statutory damages and attorneys' fees. Thus, this proposal would preserve the several public benefits of the registration requirement.

Accordingly, we propose amending Section 411(a) as set forth in the enclosure.

Sincerely,

A handwritten signature in black ink that reads "Don W. Martens". The signature is written in a cursive style with a large, looped initial "D".

Don W. Martens
Chair
Section of Intellectual Property

A PROPOSAL TO AMEND SECTION 411(a) of TITLE 17 U.S. CODE

RESOLVED, that 17 U.S.C. § 411(a) be amended to read as follows (insertions are underlined, deletions are lined out):

(a) Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), no 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 or the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form. ~~In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and~~ If registration is refused after an action for infringement has been instituted, the applicant is entitled to ~~institute~~ maintain the an-action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights within 60 days after the registration has been refused. If registration has been refused before an action for infringement has been instituted, the applicant must serve on the Register of Copyrights notice of the action, with a copy of the complaint, before the later of 60 days after registration has been refused and 30 days after the action has been instituted. The Register may, at his or her option, become a party to the action with respect to the issue of registrability of the copyright claim by entering an appearance within sixty days after such service, but the Register's failure to become a party shall not deprive the court of jurisdiction to determine that issue.