

No. 08-103

---

---

IN THE  
**Supreme Court of the United States**

---

REED ELSEVIER INC. *et al.*,

*Petitioners,*

*v.*

IRVIN MUCHNICK *et al.*,

*Respondents,*

LETTY COTTIN POGREBIN *et al.*,

*Respondents.*

---

ON WRIT OF CERTIORARI TO THE UNITED STATES  
COURT OF APPEALS FOR THE SECOND CIRCUIT

---

---

**REPLY BRIEF**

---

---

*Of Counsel:*

DAVID NIMMER  
IRELL & MANELLA LLP  
1800 AVENUE OF THE STARS  
LOS ANGELES, CA 90067  
(310) 203-7079

CHARLES S. SIMS  
*Counsel of Record*  
JON A. BAUMGARTEN  
MARK D. HARRIS  
ANNA G. KAMINSKA  
PROSKAUER ROSE LLP  
1585 BROADWAY  
NEW YORK, NY 10036  
(212) 969-3000

*Counsel for Petitioners*

*(Additional Counsel Listed on Signature Page)*

---

---

**CORPORATE DISCLOSURE STATEMENT**

Petitioner's Rule 29.6 Statement was set forth at page ii of Petitioner's Opening Brief, and there are no amendments to that Statement.

**TABLE OF CONTENTS**

	<i>Page</i>
CORPORATE DISCLOSURE STATEMENT ..	i
TABLE OF CONTENTS .....	ii
TABLE OF CITED AUTHORITIES .....	iii
INTRODUCTION .....	1
I. SECTION 411(a) DOES NOT RESTRICT SUBJECT MATTER JURISDICTION. ..	3
A. The Registration Requirement Does Not Pass <i>Arbaugh's</i> Clear Statement Test. .....	3
B. Under Ordinary Canons of Construction, § 411(a) Is Not Jurisdictional .....	7
1. Statutory Text and Structure ..	7
2. History .....	10
3. Purpose .....	16
II. ANY JURISDICTIONAL RESTRICTION WOULD NOT EXTEND TO SETTLING PROPERLY INSTITUTED ACTIONS. ...	18
III. THERE ARE NO GROUNDS TO FIND JUDICIAL ESTOPPEL OR PRECLUDE WAIVER. ....	19
IV. RESPONDENTS' ALTERNATIVE ARGU- MENTS MISREAD 28 U.S.C. § 1367 AND 17 U.S.C. § 411(A). ....	23
CONCLUSION .....	28

**TABLE OF CITED AUTHORITIES**

	<i>Page</i>
<b>Cases</b>	
<i>Albemarle Paper Co. v. Moody</i> , 422 U.S. 405 (1975) .....	26
<i>Amchem Prods. v. Windsor</i> , 521 U.S. 591 (1997) .....	22
<i>Ankenbrandt v. Richards</i> , 504 U.S. 689 (1992) .....	25
<i>Arbaugh v. Y&amp;H Corp.</i> , 546 U.S. 500 (2006) .....	<i>passim</i>
<i>Bowles v. Russell</i> , 551 U.S. 205 (2007) .....	12, 13
<i>Breuer v. Jim’s Concrete of Brevard, Inc.</i> , 538 U.S. 691 (2003) .....	25
<i>Califano v. Yamasaki</i> , 442 U.S. 682 (1979) .....	26
<i>Callaghan v. Myers</i> , 128 U.S. 617 (1888) .....	12

*Cited Authorities*

	<i>Page</i>
<i>Caterpillar Inc. v. Lewis</i> , 519 U.S. 61 (1996) .....	17
<i>Central Bank, N.A. v. First Interstate Bank, N.A.</i> , 511 U.S. 164 (1994) .....	16
<i>Day v. McDonough</i> , 547 U.S. 198 (2006) .....	1
<i>Director v. Newport News Shipbuilding &amp; Dry Dock Co.</i> , 514 U.S. 122 (1995) .....	16
<i>Eberhart v. United States</i> , 546 U.S. 12 (2005) .....	14, 15, 20
<i>EEOC v. Hiram Walker &amp; Sons, Inc.</i> , 768 F.2d 884 (7th Cir. 1985) .....	27
<i>Esquire, Inc. v. Ringer</i> , 591 F.2d 796 (D.C. Cir. 1978) .....	5
<i>Franks v. Bowman Transp. Co.</i> , 424 U.S. 747 (1976) .....	26
<i>Florida Trailer &amp; Equip. Co. v. Deal</i> , 284 F.2d 567 (5th Cir. 1960) .....	27

*Cited Authorities*

	<i>Page</i>
<i>Fogerty v. Fantasy, Inc.</i> , 510 U.S. 517 (1994) .....	14, 17
<i>Hallstrom v. Tillamook County</i> , 493 U.S. 20 (1989) .....	<i>passim</i>
<i>Heilman v. Houghton Mifflin Harcourt Publ'g Co.</i> , 2009 U.S. Dist. LEXIS 76231 (D. Colo. Aug. 26, 2009) .....	24
<i>Inkadinkado, Inc. v. Meyer</i> , Civ. No. 03-10332-GAO, 2003 U.S. Dist. LEXIS 17458 (D. Mass. Sept. 16, 2003) .....	21
<i>INS v. St. Cyr</i> , 533 U.S. 289 (2001) .....	3
<i>Isby v. Bayh</i> , 75 F.3d 1191 (7th Cir. 1996) .....	27
<i>John R. Sand &amp; Gravel v. United States</i> , 128 S. Ct. 750 (2008) .....	12, 13
<i>Jones v. Bock</i> , 549 U.S. 199 (2007) .....	7, 11

*Cited Authorities*

	<i>Page</i>
<i>Kontrick v. Ryan</i> , 540 U.S. 443 (2004) .....	10, 15
<i>Landgraf v. USI Film Prods.</i> , 511 U.S. 244 (1994) .....	3
<i>Local No. 93, Int’l Ass’n of Firefighters v. City of Cleveland</i> , 478 U.S. 501 (1986) .....	19, 27
<i>Lumiere v. Pathe Exch. Inc.</i> , 275 F. 428 (2d Cir. 1928) .....	13
<i>Marshall v. Marshall</i> , 547 U.S. 293 (2006) .....	25
<i>Matsushita Elec. Indus. Co. v. Epstein</i> , 516 U.S. 367 (1996) .....	18, 19, 27
<i>Morris v. Bus. Concepts, Inc.</i> , 259 F.3d 65 (2d Cir. 2001) .....	15, 20
<i>New Hampshire v. Maine</i> , 532 U.S. 742 (2001) .....	19, 21
<i>New York Times v. Star Co.</i> , 195 F. 110 (C.C.S.D.N.Y. 1912) .....	13

*Cited Authorities*

	<i>Page</i>
<i>New York Times v. Tasini</i> , 533 U.S. 483 (2001) .....	2, 19
<i>New York Times Co. v. Sun Printing &amp; Publ'g Ass'n</i> , 204 F. 586 (2d Cir. 1913) .....	13
<i>Newman-Green, Inc. v. Alfonzo-Larrain</i> , 490 U.S. 826 (1989) .....	17
<i>Raygor v. Regents of the Univ. of Minn.</i> , 534 U.S. 533 (2002) .....	24
<i>Rose v. Stephens</i> , 291 F.3d 917 (6th Cir. 2002) .....	24
<i>Stanley v. Trustees of the Cal. State Univ.</i> , 433 F.3d 1129 (9th Cir. 2006) .....	24
<i>Steel Co. v. Citizens for Better Env't</i> , 523 U.S. 83 (1998) .....	2, 14, 15
<i>Taggart v. WMAQ</i> , Civ. No. 00-4205-GPM, 2000 U.S. Dist. LEXIS 19499 (S.D. Ill. Oct. 30, 2000) .....	21
<i>Therrien v. Martin</i> , 2007 U.S. Dist. LEXIS 78090 (D. Conn. Oct. 19, 2007) .....	21



*Cited Authorities*

	<i>Page</i>
<i>United States v. Robinson</i> , 361 U. S. 220 (1960) .....	21
<i>Vacheron &amp; Constantin-Le Coultre Watches, Inc.</i> <i>v. Benrus Watch Co.</i> , 260 F.2d 637 (2d Cir. 1958) .....	5, 6
<i>Washingtonian Publ'g Co. v. Pearson</i> , 306 U.S. 30 (1939) .....	12, 16
<i>Weinberger v. Salfi</i> , 422 U.S. 749 (1975) .....	25, 26
<i>Wheaton v. Peters</i> , 33 U.S. 591 (1834) .....	11
<i>Whimsicality, Inc. v. Rubie's Costume Co.</i> , 891 F.2d 452 (2d Cir. 1989) .....	15
<i>Zipes v. TWA, Inc.</i> , 455 U.S. 385 (1982) .....	4, 5, 7

*Cited Authorities*

	<i>Page</i>
<b>Statutes</b>	
17 U.S.C. § 410(c) .....	16
17 U.S.C. § 411(a) .....	<i>passim</i>
17 U.S.C. § 412 .....	16
17 U.S.C. § 508 .....	8, 9
17 U.S.C. § 508(a) .....	8, 9
28 U.S.C. § 1331 .....	7
28 U.S.C. § 1332 .....	25
28 U.S.C. § 1338 .....	<i>passim</i>
28 U.S.C. § 1367 .....	23, 24, 25, 27
28 U.S.C. § 2072(b) .....	26
<b>Legislative Materials</b>	
Copyright Act of 1831 § 13 .....	11
Copyright Act of 1870 § 97 .....	11
Copyright Act of 1870 § 104 .....	11
Copyright Act of 1873 § 4962 .....	12
Copyright Act of 1873 § 4968 .....	12

*Cited Authorities*

	<i>Page</i>
Copyright Act of 1874 § 1 .....	12
Federal Courts Study Committee, Working Papers and Subcommittee Reports (July 1, 1990) ...	24
H.R. Rep. No. 101-734, 101 Cong. 2d Sess. (1990), <i>reprinted in</i> 1990 U.S.C.C.A.N. 6860, 6870-74 ...	24

**Rules**

Change in Procedure Regarding Filing of Notifications (17 U.S.C. § 508 Filings), 51 Fed. Reg. 29973 (Aug. 21, 1986) .....	9
C.D. Cal. R. 3-1 .....	9
Fed. R. Civ. P. 12(b)(1) .....	21
Fed. R. Civ. P. 12(b)(6) .....	21
Fed. R. Civ. P. 23(e) .....	27
E.D. Tex. R. Civ. 4(a) .....	9
W.D. Wash. R. 3(a) .....	9

*Cited Authorities*

*Page*

**Other Authorities**

Benjamin Kaplan, <i>The Registration of Copyright</i> , Study No. 17 (Comm. Print. 1960) . . . . .	14
2 Joseph M. McLaughlin, <i>McLaughlin on Class Actions: Law and Practice</i> § 7:17 (5th ed. 2009) . . . . .	27
8 Melville B. Nimmer & David Nimmer, <i>Nimmer on Copyright</i> (1998) . . . . .	12
Arthur Weil, <i>American Copyright Law</i> (1917) . . . .	14

## INTRODUCTION

The brief of the court-appointed amicus (“amicus”) attacks a straw man. According to amicus, if the registration requirement in 17 U.S.C. § 411(a) is not jurisdictional, then it is entirely optional, a “caprice” left to the whims of private litigants. Amicus Br. 13. But that is not the construction petitioners advocate, nor does it reflect the realities of copyright litigation. Petitioners assert that registration is mandatory – as much as compliance with the statute of limitations, service of process, or any other requirement where failure may give rise to a motion to dismiss. In the overwhelming majority of cases, a defendant would have no conceivable reason to waive or forfeit such a complete defense. And if it did, for example through inadvertence, petitioners agree with the United States that the district court may have some role in policing the requirement and, where appropriate, dismiss the lawsuit for failure to register. U.S. Br. 25-27; *Day v. McDonough*, 547 U.S. 198, 205-06 (2006).

The question is whether there are *any* circumstances in which waiver should be permitted, or whether instead § 411(a), being deemed jurisdictional, creates a blanket ban even on settlements that encompass unregistered works. Amicus presents no evidence that Congress ever intended registration to operate in such an absolute manner. Congress never clothed registration in the language of jurisdiction; never cross-referenced other jurisdictional provisions; and never mentioned registration in any of the statutes that grant the federal courts jurisdiction over copyright actions. Virtually the only support for amicus’s position comes from lower-court decisions, which of course are not binding on this Court and bear re-examination in any event.

See *Arbaugh v. Y&H Corp.*, 546 U.S. 500 (2006); *Steel Co. v. Citizens for Better Env't*, 523 U.S. 83 (1998). None of amicus's arguments begins to provide the "clear statement" necessary to show that Congress intended registration to be a jurisdictional requirement. *Arbaugh*, 546 U.S. at 515.

Furthermore, the settlement here promotes the interests and policies of the Copyright Act. Petitioners deliberately chose to forgo their defense against unregistered works in order to effectuate an industry-wide settlement that will allow greater access to the freelance articles. Every party involved in the settlement supports the authority of the court to approve it – even the objectors, who warn that without such a settlement, many articles would be dropped from the databases, creating "gaping holes" in the "electronic record of history" and leaving numerous authors uncompensated. Muchnick Br. 35 (quoting *New York Times v. Tasini*, 533 U.S. 483, 505 (2001)). The United States agrees that settlement is in the public interest and does not harm the Library of Congress's collections. U.S. Br. 30. No copyright purposes would be served by blocking such a salutary outcome.

Unable to sustain her case, amicus assails petitioners for supposedly taking an inconsistent position below. Amicus even claims, remarkably, that petitioners should be estopped from arguing that § 411(a) is mandatory but not jurisdictional. That argument is baseless and a distraction. Petitioners' arguments below focused on the existence of the restriction imposed by § 411(a), not on whether it was jurisdictional or mandatory. None of the courts below accepted any argument by the petitioners about whether § 411(a) is jurisdictional. This Court should follow its customary

practice and decide the question it posed to the parties based upon the merits of their positions.

**I. SECTION 411(a) DOES NOT RESTRICT SUBJECT MATTER JURISDICTION.**

**A. The Registration Requirement Does Not Pass *Arbaugh*'s Clear Statement Test.**

Amicus argues that despite *Arbaugh*'s recent, unanimous declaration of a “readily administrable bright line” test for deciding when a statutory requirement restricts jurisdiction, the Court did not intend to simplify the method for answering such questions. According to amicus, the Court’s jurisprudence should not be “condense[d] . . . [in]to a solitary ‘bright line’” or reduced to “a single query.” Amicus Br. 16.

Amicus distorts *Arbaugh*'s holding and its reasoning. *Arbaugh* announced a clear statement test for determining whether a provision restricts jurisdiction: “If the Legislature *clearly states* that a threshold provision on a statute’s scope shall count as jurisdictional,” then the provision restricts the subject-matter authority of the court. *Id.* at 515 (emphasis added). If it does not, then the restriction is not jurisdictional. *Id.* at 516. Clear statement tests are familiar to this Court’s jurisprudence. *E.g.*, *INS v. St. Cyr*, 533 U.S. 289, 299 (2001); *Landgraf v. USI Film Prods.*, 511 U.S. 244, 272-73 (1994). Their purpose is to reduce uncertainty by providing lucid signposts to lower courts and to litigants about how to interpret statutes, and to ensure that Congress rather than courts makes certain core decisions about what the law provides, including as to the scope of federal court jurisdiction. They do so by requiring Congress to speak in clear terms

and by providing that a statute will be construed to have a particular meaning only when Congress does.

The same is true of the jurisdictional test in *Arbaugh*. *Arbaugh* focused solely on the statutory text of the provision before it. The only factors it considered were that the provision in question “does not speak in jurisdictional terms” and does not “refer in any way to the jurisdiction of the district courts.” *Id.* at 515 (quoting *Zipes v. TWA, Inc.*, 455 U.S. 385, 394 (1982)).<sup>1</sup> It did not examine the statute’s history or survey the legislature’s purposes. As *Arbaugh* stated, limiting the examination to the face of the statute provides a “readily administrable” means to determine whether to classify a provision as jurisdictional or not and to ensure congressional responsibility for the scope of the court’s authority. A totality-of-the-circumstances standard as amicus advocates would not leave courts and litigants “duly instructed” about whether a statute is jurisdictional, and would force them “to wrestle with the issue” at great cost, *id.* at 516, as the history of this case proves.<sup>2</sup>

---

<sup>1</sup> *Arbaugh* of course never mandated that Congress use the word “jurisdiction” every time it wants to signal that a provision should have jurisdictional force. See Amicus Br. 16 n.1. It recognized that Congress may “speak in jurisdictional terms” or in some other unmistakable way refer to jurisdiction, and some of the examples cited by the *Arbaugh* Court do so. See 546 U.S. at 516 n.11. But *Arbaugh* deliberately did not stray beyond the statutory text.

<sup>2</sup> Amicus argues that *Arbaugh*’s test is “most useful” in distinguishing jurisdictional limits from claim elements, rather than from threshold requirements, but gives no reason why that would be so. Amicus Br. 16 n.6. To the contrary, the precedent that supplied *Arbaugh* with the statutory test for jurisdiction



Amicus argues that the use of the word “jurisdiction” in the final sentence of § 411(a) supplies the missing clear statement of Congressional intent. That is a logical fallacy. Amicus has confused the question of whether a court has the power to decide registrability with whether registration is jurisdictional. As explained in petitioners’ opening brief, that sentence was added to clarify a fundamental change in the role of the district court. Under the 1909 Act, a certificate of registration was a mandatory prerequisite to an infringement action, and only the Register could issue it. If he refused, the sole avenue for relief lay in a mandamus action against him; the court deciding the infringement action could not issue the certificate on its own. *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958); *Esquire, Inc. v. Ringer*, 591 F.2d 796, 806 (D.C. Cir. 1978). In 1976, Congress eliminated the requirement that the Register had to grant permission to sue, permitted the plaintiff to proceed whether the Register granted the application or denied it, and for the first time allowed the district court with the infringement action to review the Register’s denial even in his absence and without a mandamus claim. 17 U.S.C. § 411(a). Congress confirmed the district court’s new role in determining registrability by providing that “the Register’s failure to become a party” (as was required previously in a mandamus action) “shall not deprive the court of jurisdiction to decide that issue.” *Id.*

---

concerned a threshold requirement, not a claim element. *See Zipes*, 455 U.S. at 393 (comparing the requirement of filing an EEOC charge to a statute of limitations that is neither jurisdictional nor a claim element).

That legislative amendment thus established the authority of the district court to rule on registrability even in the absence of the Register, and the authority of the court to review the Register's denial without a separate mandamus action. But just because the court has the power to decide whether a work is registrable, it does not follow that registration is jurisdictional – i.e., that it *lacks* power to hear the infringement action unless registration has occurred. The two issues have nothing to do with each other. Indeed, even under the previous law, when the Register had sole power to authorize registration, that did not mean that registration was a jurisdictional prerequisite for an infringement action, as opposed to a mandatory condition. For this reason, amicus's argument that if Congress believed § 411(a) created a non-jurisdictional condition, it would have concluded the section with the words “but the Register's appearance is not a condition of the court determining registrability,” Amicus Br. 21, is a non-sequitur. Neither version of that clause addresses whether registration is a jurisdictional or merely a mandatory requirement. Hence, it surely cannot qualify as a supposedly clear statement of a withdrawal of jurisdiction.

The 1976 Act cut through *Vacheron's* Gordian knot by permitting the infringement court to proceed even if registration were denied and to review the Register's denial even if the Register did not appear. That does not suggest that the first sentence of § 411(a) imposed a restriction on the jurisdiction conferred by 28 U.S.C. § 1338; it means only that the third sentence makes absolutely clear Congress had removed any possible prior limitation on reviewing the Register's decisions in his or her absence.

In sum, the registration requirement in § 411(a) does not pass *Arbaugh*'s clear statement test, and amicus does not seriously argue otherwise. The text requiring registration before an infringement suit may be instituted does not speak in jurisdictional terms (it does not mention “jurisdiction,” “authority,” or “power”), and it does not refer in any way to the jurisdiction of the federal courts (there is no cross-reference to 28 U.S.C. §§ 1331 or 1338). If the requirement that Congress must speak clearly before a provision is held to restrict jurisdiction means anything, it is not met here.

**B. Under Ordinary Canons of Construction, § 411(a) Is Not Jurisdictional**

Even under the ordinary canons of construction, without application of *Arbaugh*'s clear statement test, there is no basis to conclude that the registration requirement ought to be considered jurisdictional in the strict sense now used by the Court.

1. *Statutory Text and Structure.* On the most salient textual and structural features of the statute, amicus is silent. The jurisdictional provisions of copyright law and the registration requirements of the Copyright Act are codified in two different titles of the U.S. Code, they do not refer to each other, and they have completely distinct pedigrees. *See* Pet. Br. 23-27. Moreover, the language of § 411(a) does not resemble that of other statutory withdrawals of jurisdiction, but rather exhaustion requirements that have been held not jurisdictional. *See, e.g., Zipes*, 455 U.S. at 394; *Hallstrom v. Tillamook County*, 493 U.S. 20, 30 (1989); *see also Jones v. Bock*, 549 U.S. 199, 204 (2007) (administrative exhaustion requirement in Prison Litigation Reform Act, providing that “[n]o action shall be brought . . .

until such administrative remedies are available are exhausted,” is an affirmative defense that defendant must plead and prove). These are powerful indications that Congress never intended registration to be a jurisdictional prerequisite. *See also infra* at 11-12 (predecessor registration provision was directly modeled on limitations provisions of prior copyright laws).

Instead, amicus focuses on § 508, previously unnoted by any court in assessing whether § 411(a) is jurisdictional, which supposedly “directs courts to assure that the registration requirement is met” and thus provides evidence that it should be treated as jurisdictional. Amicus Br. 24-25. That argument misreads § 508(a), which provides as follows:

Within one month after the filing of any action under this title, *the clerks* of the courts of the United States shall send written notification to the Register of Copyrights setting forth, *as far as is shown by the papers filed in the court*, the names and address of the parties and the title, author, and registration number of each work involved in the action.

17 U.S.C. § 508(a) (emphasis added).

The italicized phrases in the statute – which amicus omits, *see* Amicus Br. 24 – refute the argument. First, the section speaks to *clerks*, not federal judges. It directs them to do what clerks generally do: keep records and send out notifications, not make substantive rulings about statutory eligibility or “assure[] attention to Section 411(a)’s jurisdictional limit.” *Id.* Contrary to amicus’s contention, nothing in the statute suggests that judges ever see, or are informed of, Form AO 121, or that § 508 plays any role whatever in assisting judges

“to identify jurisdictionally deficient infringement claims at the outset of litigation.” *Id.* at 25-26, 80a. Moreover, local rules that give *plaintiffs* responsibility for preparing the notices confirm that § 508 plays no role in assuring judicial attention to a supposed jurisdictional limit. *See, e.g.*, E.D. Tex. R. Civ. 4(a); W.D. Wash. R. 3(a); C.D. Cal. R. 3-1.

Second, the notification provision is expressly limited to the information that appears in the papers submitted by the parties. The clerk is not obligated to search out additional facts about whether registration has occurred, let alone to vouch that it has. If the papers omit the registration number, all that follows is that the notification will too; the statute does not provide for any resulting “penalty,” much less dismissal. On amicus’s theory, the omission of the plaintiff’s address – another item required by § 508(a) – would also be a jurisdictional defect. That is an absurd result.<sup>3</sup>

Other supposed indications that Congress intended § 411(a) to be jurisdictional are equally unavailing. Amicus claims that it is evidence of jurisdictional status that § 411(a) delineates the “classes of cases” falling within the courts’ adjudicatory authority, because it distinguishes United States works (which must be registered) from foreign works (which need not). Amicus

---

<sup>3</sup> The § 508 notification system no longer credibly provides information to the public about copyright litigation, contrary to amicus’s contention. *See* Amicus Br. 25. Since 1986, the Copyright Office has ceased indexing new § 508 filings, explaining that it “cannot justify the time and expense required to continue the indexing procedure.” By that point, the office was receiving fewer than five requests per year for that information. *See* Change in Procedure Regarding Filing of Notifications (17 U.S.C. § 508 Filings), 51 Fed. Reg. 29973 (Aug. 21, 1986).

Br. 21-22 (quoting *Kontrick v. Ryan*, 540 U.S. 443, 455 (2004)). But this argument is pure bootstrapping, because it assumes that the distinction between United States works and foreign works is jurisdictional in the first place. Only if § 411(a) is deemed jurisdictional does it delineate a boundary between cases that fall within that authority and those that do not. If it is *not* deemed jurisdictional – like the thousands of ordinary federal statutes that draw substantive but non-jurisdictional distinctions in different situations – then its lines say nothing about jurisdiction.

2. *History.* Amicus largely ignores the historical evidence presented in petitioners’ opening brief about the jurisdictional status of § 411(a). Amicus ignores the extensive survey of the legislative history of the 1976 Act, including most significantly a report of the Register to Congress that omitted registration from a list of jurisdictional provisions of the Copyright Act. *See* Pet. Br. 27-33. Amicus also ignores the striking fact that for 200 years Congress consistently provided for copyright jurisdiction and required copyright registration in separate enactments. *Id.* at 33-34 & Add. B.

Amicus nevertheless maintains that the 1909 copyright law made registration jurisdictional and the 1976 Act maintained that approach. Amicus concedes that until 1909, the formalities that were conditions precedent to infringement claims were “claim elements” and not jurisdictional restrictions. Amicus Br. 29-30.<sup>4</sup>

---

<sup>4</sup> Amicus calls registration during the pre-1909 period an “unwaivable prerequisite for establishing a property right enforceable under federal law,” Amicus Br. 29-30, but provides no support for that conclusion, and not a single authority cited involved a defendant who sought to waive the requirement.

Amicus contends, though, that the “inflexibly unwaivable” regime established in 1790 was unsuited to national growth and required more play in the joints, and that “Congress’s solution [in 1909] was to change deposit and registration from claim elements to jurisdictional prerequisites.” Amicus Br. 30. The idea that Congress made a provision jurisdictional in order to add flexibility is highly implausible. More remarkable, amicus cites *nothing at all* to support this fanciful story other than the supposedly clear language of the 1909 Act’s registration-before-suit requirement (“No action . . . shall be maintained . . . until” registration has occurred). *See* Amicus Br. 31. Nothing about that language makes it self-evidently jurisdictional. *Jones*, 549 U.S. at 216.

To the contrary, the prior history amicus skips over directly and powerfully refutes her claim. Contrary to the argument that the phrasing of the 1909 registration precondition was selected to render registration jurisdictional, Congress drew that language directly from prior copyright laws where it had been employed six times for provisions that were plainly not jurisdictional. *See, e.g.*, Act of February 3, 1831 § 13 (“[N]o action shall be maintained . . . unless the same shall have been commenced within two years after the cause of action shall have arisen”); Act of July 8, 1870 § 97 (“[N]o person shall maintain an action for the infringement of his copyright unless he shall give notice thereof . . .”); *id.* § 104 (“[N]o action shall be maintained

---

(Other than in a settlement context, there is no reason that any defendant ever would.) The only case cited, *Wheaton v. Peters*, 33 U.S. 591 (1834), involved a defendant who vigorously sought to enforce the condition precedent.

in any case of forfeiture or penalty . . . unless the same is commenced within two years after the cause of action has arisen”); Act of 1873 § 4962 (“No person shall maintain an action for the infringement of his copyright unless he shall give notice thereof . . .”); *id.* § 4968 (“No action shall be maintained in any case of forfeiture of penalty . . . unless the same is commenced within two years”); Act of June 18, 1874, § 1 (“[N]o person shall maintain an action for the infringement of his copyright unless he shall give notice . . .”). *See generally* 8 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, App’x 7 (1998) (collecting statutory materials).

By framing the registration-before-suit requirement with language previously used in six separate non-jurisdictional provisions in prior copyright acts and maintaining the longstanding separation of provisions conferring jurisdiction and preconditions, the 1909 Congress made clear that registration before suit is a condition precedent, not a jurisdictional grant or restriction. “Conditions precedent” is how even the dissenters repeatedly characterized registration in *Washingtonian Publ’g Co. v. Pearson*, 306 U.S. 30, 51, 55 (1939) (Black, J., dissenting), and how previous similar requirements were understood, *Callaghan v. Myers*, 128 U.S. 617, 649, 652 (1888).

Amicus also invokes what is claimed to be “two centuries of judicial precedent,” Amicus Br. 42, or “a full century” of precedent, *id.* at 13, in the lower courts. Amicus relies on *Bowles* and *John R. Sand & Gravel* for the teaching that this Court should defer to precedent when it decides whether a statutory provision is jurisdictional. But this argument is severely flawed.



First, *Bowles* and *Sand* dealt with situations where there was an unbroken chain of precedent *in this Court*. See *John R. Sand v. United States*, 128 S.Ct. 750, 753-54 (2008); *Bowles v. Russell*, 551 U.S. 205, 209 (2007). Both cases took great pains to emphasize that their holdings were dictated by the commands of *stare decisis*, even if a fresh examination of the statutory provision, applying current standards, would produce a different result. There is no contention that the Court's own earlier rulings dictate decision here.

Second, there is no consensus even in the lower courts. For the period from 1909 to 1976, amicus cites only two appellate decisions, neither of which held registration to be jurisdictional. *New York Times Co. v. Sun Printing & Publ'g Ass'n*, 204 F. 586, 588 (2d Cir. 1913), is misrepresented in amicus's brief through misleading ellipses. The court did not say that it agreed with "what is there said" by the lower court in *New York Times v. Star Co.*, 195 F. 110, 112 (C.C.S.D.N.Y. 1912), with respect to registration and deposit being jurisdictional requirements under the 1909 Act. See Amicus Br. 19. The court agreed only that the provisions of the Act dealing with injunctions were subject to those requirements, whatever they were. *Id.* The *Sun Printing* court never even used the word "jurisdiction." Moreover, *Lumiere v. Pathe Exch. Inc.*, 275 F. 428, 430 (2d Cir. 1928), did not hold that the jurisdiction conferred by different provisions of law was restricted by registration, and affirmed dismissal because a "condition precedent" had not been complied with. There was no issue in the case as to any waiver or agreement to waive, and the dicta amicus cites ("the parties cannot by agreement, express or implied, alter the statute") is a truism entirely consistent with the

position of the United States and the parties. Amicus also cites four lower court decisions, *see* Amicus Br. 33-34, each of which rested on section 12 of the 1909 Act and not on its jurisdictional ranking, and in each of which nothing turned on the gratuitous reference to jurisdiction.

Although amicus cites two 1940s-vintage treatises that say registration goes to the jurisdiction of the court, Amicus Br. 32, there is no reason to think that Congress had either in mind in 1976. But Congress was informed of the 1917 copyright treatise by Arthur Weil, *American Copyright Law*, as it was expressly mentioned in Professor Kaplan's study on registration for the Senate Committee on the Judiciary.<sup>5</sup> The Weil treatise, which this Court has often cited (most recently in *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 528 (1994)), makes no reference to registration as restricting the jurisdiction over infringement actions conferred by the 1909 Act. *See* Arthur Weil, *American Copyright Law* 307-15, 509-11 (1917).

In the post-1976 period, amicus does cite numerous decisions of the inferior courts stating that § 411(a) is jurisdictional. But they are far too recent to constitute any kind of a venerable practice; the earliest appellate decisions date back only to 1990. *See* Amicus Br. App'x C. Moreover, to defer to them would defeat the entire lesson of *Steel Company, Arbaugh, Eberhart v. United States*, 546 U.S. 12 (2005), and other cases

---

<sup>5</sup> *See* Benjamin Kaplan, *The Registration of Copyright*, Study No. 17, in *Copyright Law Revision Studies* Nos. 17-19, prepared for the Subcomm. on Patents, Trademarks, and Copyrights of the Sen. Comm. on the Judiciary, 86th Cong., 2d Sess., at 22 (Comm. Print 1960), discussed at Pet. Br. 28 n.12.

holding that decisions classifying statutory provisions as jurisdictional deserve “no precedential effect” where they use the label loosely and profligately. *Arbaugh*, 546 U.S. at 510-11.<sup>6</sup> The decisions amicus cites do not consider whether registration is more accurately characterized as a mandatory requirement than as a jurisdictional one in the way *Arbaugh*, *Eberhart*, and *Kontrick* did with their respective statutory provisions. Nor did they conduct a detailed examination of statutory text, structure, history, and purpose. Their imprecise use of the jurisdictional label is not surprising as nothing turned on that characterization, since the same result would have been reached (dismissal of a claim presented for adjudication) for failure to comply with § 411(a).<sup>7</sup>

---

<sup>6</sup> Amicus takes petitioners to task for using “denigrating” language about those decisions and not giving them sufficient weight. Amicus Br. 38. But it is this Court, not petitioners, which characterized even some of its own decisions that use the term “jurisdictional” as “drive-by jurisdictional rulings . . . [entitled to] no precedential effect.” *Steel Co.*, 523 U.S. at 90. *A fortiori*, unconsidered “jurisdictional” characterizations by lower courts that have failed to undertake the proper analysis of Congress’s intentions are not entitled to weight.

<sup>7</sup> The Second Circuit initially enforced § 411(a) without reference to jurisdiction. *See Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452, 453 (2d Cir. 1989) (“[P]roper registration is a prerequisite to an action for infringement.”). Twelve years later, when it relied on *Whimsicality* in *Morris v. Bus. Concepts, Inc.*, 259 F.3d 65, 72 (2d Cir. 2001), the court imported without discussion or occasion the “jurisdictional” characterization that the district court had used (itself without discussion) in granting summary judgment. *Morris* typifies how the “jurisdictional” characterization crept into lower court decisions without analysis or need.

None of those courts was presented with a situation like that here, where the defendants deliberately waived their objections to the lack of registration for the sake of a settlement agreement. Accordingly, they present no basis for affirmance. *See also Central Bank, N.A. v. First Interstate Bank, N.A.*, 511 U.S. 164, 186 (1994) (Congress’s failure to address lower-court interpretation of a statute when amending the statute is no basis to infer Congressional acquiescence in that interpretation.)

3. *Purpose.* Amicus claims that § 411(a) furthers several “vital public purposes” that would be defeated if it were held not to be jurisdictional. Amicus Br. 44-56. But those purposes would not be significantly disserved by a regime that treated registration as a mandatory but non-jurisdictional requirement. Even if registration is not jurisdictional, failure to register will be very rare in copyright litigation. Defendants will seldom pass up the opportunity to file a winning motion to dismiss for failure to register. And there are other powerful incentives for plaintiffs to register their copyrights, including the establishment of prima facie evidence of copyright validity, 17 U.S.C. § 410(c), and eligibility for statutory damages and attorney fees, *id.* § 412. For the sake of the few situations where a defendant would deliberately waive its defense to achieve an otherwise unobtainable settlement, as here, it does not follow that Congress chose to make registration jurisdictional simply because it might marginally advance those statutory ends. *See Director v. Newport News Shipbuilding & Dry Dock Co.*, 514 U.S. 122, 136 (1995); *cf. Washingtonian*, 306 U.S. 30.

The first purpose amicus identifies, supporting a public record of copyright claims, Amicus Br. 45, would not be

harmed by the settlement in this case because the newspapers and periodicals in which the articles appeared were already recorded. Moreover, Congress's decision in 1989 to eliminate recordation as a precondition to suit largely removed the ability of consumers to identify copyright owners, as did the decision to make it optional in the first place. The second and third purposes, shielding federal courts and defendants from burdensome litigation, *id.* at 47, are insignificant because under a mandatory regime both types of actors could play a role in enforcing the requirement. And the final purpose, protecting the Library of Congress's collections, *id.* at 54, the United States itself characterizes as insubstantial in this case where the newspapers were already deposited. U.S. Br. 27 n.15.

Moreover, amicus slights the countervailing purposes that would be disserved by vacating this settlement agreement. The settlement will make available to the public many articles that would otherwise have to be purged from the electronic databases. *See Fogerty*, 510 U.S. at 527 (“[C]opyright law ultimately serves the purpose of enriching the general public through access to creative works.”). The parties invested significant time, effort, and cost into reaching the class-action resolution, all of which would be wasted if registration were now held unwaivable. *See Arbaugh*, 546 U.S. at 515. And, at a more general level, settlement furthers important federal interests of finality, efficiency, economy, fairness, and the “unprotracted administration of justice.” *Caterpillar Inc. v. Lewis*, 519 U.S. 61, 75-77 (1996); *Newman-Green, Inc. v. Alfonzo-Larrain*, 490 U.S. 826, 836 (1989). There is no basis to conclude that Congress opted for one set of the purposes over the other.

## II. ANY JURISDICTIONAL RESTRICTION WOULD NOT EXTEND TO SETTLING PROPERLY INSTITUTED ACTIONS.

Amicus contends that petitioners go beyond the grant of review in arguing that § 411(a) does not deprive the district court of jurisdiction to approve the settlement even if it restricts jurisdiction to some extent over an adjudication. But deciding whether § 411(a) restricts jurisdiction necessarily entails deciding what the provision means and how far it runs.

Amicus ignores the plain language of § 411, which expressly addresses registration as a condition of “institut[ing]” claims, not settling them. Amicus is also mistaken in contending that the parties cannot properly rely on the long line of cases holding that courts may approve settlement agreements releasing claims that they could not have adjudicated. Amicus asserts that petitioners’ argument “mistakes claims for controversies,” and that claims for unregistered works of class members are not part of the same “case” or “controversy” as was initially pleaded so as to permit broad releases. But the complaints which frame the litigation make it a “case” and “controversy.” JA 1, 16, 48, 69. Amicus’s strained distinction of *Matsushita Elec. Indus. Co. v. Epstein*, 516 U.S. 367 (1996), cites no authority and is simply a repackaged challenge to improper joinder, which has never been at issue. Since plaintiffs’ lawsuit against the databases and content providers is unquestionably a “case” or “controversy,” it is necessarily a proper occasion for the exercise of the long-established power to approve a settlement releasing claims arising from the same factual predicate, even if they could not have been presented for

adjudication in this suit. Pet. Br. 48-51. The purported distinction of the *Matsushita* cases is also belied by *Tasini*, 533 U.S. 483, which was no less a “case” or “controversy” than this one is. In *Tasini*, as here, various freelance authors sued print publishers and secondary publishers (electronic publishers like LexisNexis, and microform publishers like UMI/Proquest), claiming that the licensing of the complete contents of the periodicals was infringing.

Among the inherent powers of Article III courts is the power to approve a settlement agreement reached by the parties that releases claims that could not have been adjudicated or affords relief that the Court itself could not have afforded. This Court addressed that power expansively in *Local No. 93, Int’l Ass’n of Firefighters v. City of Cleveland*, 478 U.S. 501 (1986), and held that courts have inherent Article III power to approve consensual agreements that, as a matter of contract, afford relief that could not have been judicially awarded upon adjudication. *See* Pet. Br. 49. Amicus ignores *Firefighters* and *Matsushita*, which contradict her contention that courts may not “extinguish the very claims they could not try.” Amicus Br. 66.

### **III. THERE ARE NO GROUNDS TO FIND JUDICIAL ESTOPPEL OR PRECLUDE WAIVER.**

Nothing in the litigation history here warrants the application of judicial estoppel under *New Hampshire v. Maine*, 532 U.S. 742, 750-51 (2001), or precludes petitioners from taking advantage of their waiver of § 411(a).

First, amicus is simply wrong in contending that petitioners take a position in this Court that is inconsistent with their arguments below. Petitioners’

arguments below focused on the restriction in § 411(a), not on whether it was jurisdictional or mandatory. Their position was that registration is a mandatory condition that prevents adjudication of claims for unregistered works, but not settlement agreement approval, and it is the same position they take here. The condition in § 411(a) made it virtually certain that the claimants would not be able to litigate claims for unregistered works until the works were identified, authors located, and registration undertaken. That hurdle supported petitioners' arguments for valuing such claims lower than claims for registered works, and the discount was justified regardless of how § 411(a) was characterized. Petitioners' arguments in favor of the settlement in the district court turned on the fact that § 411(a) erected a condition precedent to litigating claims for unregistered works – not on whether that condition was “ranked” as jurisdictional under *Arbaugh*. Cf. *Hallstrom*, 493 U.S. 20.

Petitioners' arguments to the Second Circuit were no different. Petitioners' letter-brief on jurisdiction to the Second Circuit – which amicus has misleadingly characterized and excerpted, and so is reproduced in its entirety below – is consistent with the position they have taken in this Court and throughout. It did not argue that § 411(a) restricts jurisdiction; it argued that § 411(a) was at most a condition to instituting an infringement suit, and that it was inapplicable to settlement approval. While petitioners passingly used the “jurisdictional” label to express the mandatory nature of § 411(a), they merely recited the holding of controlling Second Circuit precedent at the time. See *Morris v. Bus. Concepts, Inc.*, 259 F.3d 65, 72 (2d Cir. 2001). In any event, such use was clearly incidental to their claims. Cf. *Eberhart*, 546 U.S. at 17-18



(discounting similarly loose language in *United States v. Robinson*, 361 U. S. 220, 229 (1960)). Petitioners' position, and its impact on the settlement, was the same whether lack of registration was considered jurisdictional or mandatory, because it was a defect that warranted discounting claims for unregistered works either way.<sup>8</sup>

Second, petitioners did not succeed in persuading the courts below to adopt any position about whether § 411(a) restricts jurisdiction. Section 411(a)'s effect on district court adjudication was not at issue in or decided by the district court, petitioners argued that it was not at issue on appeal, and they certainly failed to persuade the Second Circuit of their view. *See New Hampshire*, 532 U.S. at 750-51.

Third, there is no risk of a party seeking and obtaining inconsistent court determinations. *See id.* The district court was not asked to, and did not, decide the question framed by this Court, and petitioners' arguments to the Second Circuit and here are consistent.

Amicus's contention that petitioners cannot retroactively waive § 411(a) misses the mark entirely. Amicus Br. 61-65. Petitioners already waived § 411(a) below, to the extent that it applied to settlement. Rather

---

<sup>8</sup> Notably, many lower courts have dismissed claims for unregistered works under Fed. R. Civ. P. 12(b)(6) rather than under 12(b)(1), or under both. In either event, it is § 411(a) itself that requires dismissal. *See, e.g., Inkadinkado, Inc. v. Meyer*, Civ. No. 03-10332-GAO, 2003 U.S. Dist. LEXIS 17458, at \*9 (D. Mass. Sept. 16, 2003); *Taggart v. WMAQ*, Civ. No. 00-4205-GPM, 2000 U.S. Dist. LEXIS 19499, at \*10 (S.D. Ill. Oct. 30, 2000) (same); *Therrien v. Martin*, 2007 U.S. Dist. LEXIS 78090, at \*11-\*12 (D. Conn. Oct. 19, 2007).

than asking to retroactively waive § 411(a) here, petitioners seek to enforce their 2005 waiver in the interest of the settlement. If petitioners are correct that in the context of a settlement § 411(a) applies only at the front end of litigation and not separately in connection with settlement approval, there is no issue of waiver whatever. If the Court concludes that § 411(a) applies at both the front end and in the settlement context, then defendants' support of the settlement waived it, and that waiver did not "poison" the settlement but rather enabled it.

The additional argument that petitioners' waiver would destroy their own settlement (Amicus Br. 61) is well beyond the question the Court agreed to review, and makes no sense. Because § 411(a) prevents litigation of infringement claims until the subject works are registered, plaintiffs faced various obstacles to successfully litigating such claims that reduced claim value. But because those works *could* be registered and sued on thereafter, defendants were exposed to potentially unending exposure, which was worth resolving if agreement with the authors could be reached. Because the named plaintiffs had large numbers of such unregistered works, and were thus situated exactly like other members of the class – unlike in *Amchem Prods. v. Windsor*, 521 U.S. 591 (1997) – the district court was surely correct in finding adequate representation, and petitioners are confident that the Second Circuit, when it finally reviews the merits of the appeal, will agree.

#### IV. RESPONDENTS' ALTERNATIVE ARGUMENTS MISREAD 28 U.S.C. § 1367 AND 17 U.S.C. § 411(a).

Respondents' fallback argument – that 28 U.S.C. § 1367 supplies an alternative basis for vacating the Second Circuit's judgment – ignores the text and underlying purposes of § 1367, and accords insufficient meaning to § 411(a). The Second Circuit considered and rejected that argument, and it was correct to do so.

Respondents' argument, not citing even remotely pertinent case law, treats § 411(a) as if it were a circumscribed *grant* of jurisdiction whose preconditions could be ignored by relying instead on the supplemental jurisdiction afforded by § 1367. Section 411(a) is not a jurisdictional *grant*, however, but rather a restriction on instituting certain claims *whatever* the jurisdictional basis. Nothing in its text, legislative history, or application justifies according § 411(a) any different impact depending upon whether plaintiffs invoke jurisdiction under § 1338 or § 1367. Section 411(a) operates independently of the jurisdictional portal plaintiffs use.

Indeed, threshold preconditions to suit are mandatorily enforceable in the district court (absent permissible waiver or forfeiture) whether they are jurisdictional or not. *Hallstrom*, 493 U.S. at 31. It would turn *Hallstrom* and the Court's general approach to these matters upside down to conclude that courts faced with infringement claims for unregistered works may avoid § 411(a) if it is jurisdictional by relying on § 1367, but must apply § 411(a) if it is mandatory.

No court has relied on supplemental jurisdiction to adjudicate infringement claims for unregistered works, and more generally courts have uniformly rebuffed the

few attempts in which litigants have tried to avoid federal jurisdictional limitations by laundering their claims through § 1367.<sup>9</sup> The very first sentence of § 1367(a), which provides that any express requirements of federal statutes should be enforced, precludes treating § 1367 as if it neuters either § 411(a) or any of the other myriad statutory threshold requirements or other provisions that have been (or might be) held to be “jurisdictional.”

Nor does § 1367’s legislative history, which focused exclusively on state law claims supplemental to diversity cases and not at all on federal question cases, suggest that it was intended to bypass federal legislative preconditions, elements, or rules ranked as jurisdictional. The report that led directly to the statutory text, virtually without change, cautioned that supplemental jurisdiction “would not apply if Congress specified a contrary rule with respect to any particular grant of jurisdiction.” *See* Federal Courts Study Committee, Working Papers and Subcommittee Reports (July 1, 1990).<sup>10</sup>

Respondents’ argument proves far too much, and would make § 1367 a means of escaping all the various

---

<sup>9</sup> *See Heilman v. Houghton Mifflin Harcourt Publ’g. Co.*, 2009 U.S. Dist. LEXIS 76231 (D. Colo. Aug. 26, 2009) (§ 1367 cannot be used to avoid § 411(a)); *see also, e.g., Raygor v. Regents of the Univ. of Minn.*, 534 U.S. 533, 541-42 (2002); *Stanley v. Trustees of the Cal. State Univ.*, 433 F.3d 1129, 1133 (9th Cir. 2006); *Rose v. Stephens*, 291 F.3d 917, 925 (6th Cir. 2002).

<sup>10</sup> The House Report on what became § 1367 (the Senate enacted the House bill) does not mention supplemental jurisdiction of federal claims. *See* H.R. Rep. No. 101-734, 101 Cong. 2d Sess., at 27-30 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6860, 6870-74.

jurisdictional restrictions and requirements that surround many federal causes of action. But restrictions on, or preconditions to, federal statutory causes of action generally have substantive ends and are fundamentally different in kind from the limitations found in § 1332 (jurisdictional amount, diversity of citizenship jurisdiction), whose purpose is to limit the caseload of the federal courts. Such restrictions have been steadily applied, not bypassed, in such cases as *Hallstrom* and *Weinberger v. Salfi*, 422 U.S. 749, 764 (1975). Respondents' argument would also end-run the established restrictions against domestic relations or probate cases recognized in *Marshall v. Marshall*, 547 U.S. 293 (2006), and *Ankenbrandt v. Richards*, 504 U.S. 689 (1992).

Reliance on supplemental jurisdiction here also accords § 411(a) insufficient weight. If § 411(a) can be bypassed by relying on § 1367 to permit the adjudication of claims for thousands of persons so long as a single plaintiff presents a single claim for a registered work, then § 411(a)'s inducing function is almost entirely dissipated. Nothing in § 1367's text or legislative history suggests that it goes that far.

Nor does *Breuer v. Jim's Concrete of Brevard, Inc.*, 538 U.S. 691 (2003), support using § 1367 here. *See* Pogrebin Br. 21-22; Muchnick Br. 41. That decision had to do with removal, not supplemental jurisdiction, and in any event the issue here is not whether supplemental jurisdiction is available – with § 1338 unqualifiedly available, there is no need to look to it – but whether § 411(a) restricts approval of the settlement agreement proposed in a case over which the district court undoubtedly had original jurisdiction under § 1338.

The Muchnick respondents (although not the Pogrebin respondents) also contend that § 411(a) does not apply to class claims. That baseless argument rips a large hole in § 411(a) and runs contrary to the United States’ demonstration that § 411(a) generally bars institution for adjudication of infringement claims for damages. U.S. Br. 21-24. It is also contrary to 28 U.S.C. § 2072(b), which provides that the Federal Rules of Civil Procedure “shall not abridge, enlarge or modify any substantive right.”

The Muchnick respondents’ only reason for deeming § 411(a) inapplicable to class claims is this Court’s affirmance of broad remedial relief to classes not all of whose members had exhausted administrative remedies in two Title VII cases. But those two decisions rest squarely on the text and distinctive policies of Title VII, not on any general rule that federal statutory pre-conditions to suit are inapplicable to class actions. *See Franks v. Bowman Transp. Co.*, 424 U.S. 747, 758-62 (1976); *Albemarle Paper Co. v. Moody*, 422 U.S. 405, 417-422 (1975). This Court made that plain, and effectively refuted respondents’ argument, in *Califano v. Yamasaki*, 442 U.S. 682, 704 (1979), which reversed on jurisdictional grounds the lower court’s grant of injunctive relief to persons as to whom no “final decision” concerning the right to a prerecoupment hearing had been made. *See also Weinberger*, 422 U.S. 749.

Other than *Albemarle* and *Franks*, the Muchnick respondents offer no basis for deeming § 411(a) inapplicable to class claims. As the United States correctly explains, “district courts should strictly enforce the registration requirement in cases where the

defendants raise the issue,” and should ordinarily do so “at the outset of the lawsuit, when the court and the parties have not yet expended any resources.” U.S. Br. 20, 26.

Finally, the Muchnick respondents argue that the Court must address their contentions that § 411(a) does not apply to class claims or can be avoided by founding jurisdiction on § 1367. They contend that the Court may not resolve the case on the basis of *Matsushita* or *Firefighters* because, on remand, review of the settlement under Fed. R. Civ. P. 23(e) will necessarily depend upon whether plaintiffs could have litigated to adjudication claims of class members for unregistered works. Muchnick Br. 44-46.

That contention is wrong. The fairness, reasonableness, and adequacy of the settlement depends upon the parties’ assessment of risk at the time of settlement – not on the subsequent resolution, by the district court or court of appeals, of the underlying legal issues whose resolution the settlement rendered unnecessary. *See, e.g., Isby v. Bayh*, 75 F.3d 1191, 1197 (7th Cir. 1996) (“As we engage in this limited review, we are mindful that the district courts have been admonished to refrain from resolving the merits of the controversy or making a precise determination of the parties’ respective legal rights, a directive that applies to our own inquiry as well.”) (internal quotation marks omitted); *EEOC v. Hiram Walker & Sons, Inc.*, 768 F.2d 884, 889 (7th Cir. 1985) (same); *Florida Trailer & Equip. Co. v. Deal*, 284 F.2d 567, 571 (5th Cir. 1960). *See generally* 2 Joseph M. McLaughlin, *McLaughlin on Class Actions: Law and Practice* § 7:17 (5th ed. 2009).

The Muchnick respondents' plea for this Court to issue a ruling that "either class-action litigation or supplemental jurisdiction is available" so as to aid their merits contentions regarding the alleged inadequacy of the payments for unregistered works, Muchnick Br. 46, is simply a request for an advisory opinion not sought from the courts below and not pertinent to further review of the final judgment approving the settlement agreement.

### CONCLUSION

For all the foregoing reasons, the judgment below should be vacated and the case remanded for further consideration of the objectors' appeal from the district court's final judgment approving the settlement agreement.

Respectfully submitted,

*Of Counsel:*

DAVID NIMMER  
IRELL & MANELLA LLP  
1800 Avenue of the Stars  
Los Angeles, CA 90067  
(310) 203-7079

CHARLES S. SIMS  
*Counsel of Record*  
JON A. BAUMGARTEN  
MARK D. HARRIS  
ANNA G. KAMINSKA  
PROSKAUER ROSE LLP  
1585 Broadway  
New York, NY 10036  
(212) 969-3000  
*Counsel for Petitioners*



HENRY B. GUTMAN  
SIMPSON THACHER &  
BARTLETT LLP  
425 Lexington Avenue  
New York, NY 10017  
(212) 455-3180

*Counsel for Petitioner  
Dow Jones Reuters  
Business Interactive LLC,  
d/b/a Factiva*

JAMES L. HALLOWELL  
RICHARD A. BIERSCHBACH  
GIBSON, DUNN & CRUTCHER LLP  
200 Park Avenue, 47th Floor  
New York, NY 10166  
(212) 351-4000

*Counsel for Petitioner  
Dow Jones & Company, Inc.*

IAN BALLON  
GREENBERG TRAURIG LLP  
2450 Colorado Avenue  
Suite 400E  
Santa Monica, CA 90404  
(310) 586-6575

*Counsel for Petitioners  
Knight-Ridder, Inc.,  
Knight Ridder Digital, and  
Mediastream, Inc.*

MATTHEW W. WALCH  
LATHAM & WATKINS  
Sears Tower, Suite 5800  
Chicago, IL 60606  
(312) 876-7603

*Counsel for Petitioner  
ProQuest Company*

MICHAEL S. DENNISTON  
BRADLEY ARANT BOULT &  
CUMMINGS LLP  
One Federal Place  
1819 Fifth Avenue North  
Birmingham, AL 35203  
(205) 521-8244

*Counsel for Petitioner  
EBSCO Industries, Inc.*

## **ADDENDUM**

**Addendum**  
**Defendants' Letter to the Second Circuit**  
**dated February 12, 2007**

[Letterhead omitted]

February 12, 2007

BY HAND

Thomas Asreen, Acting Clerk of Court  
U.S. Court of Appeals for the Second Circuit  
Daniel Patrick Moynihan United States Courthouse  
500 Pearl Street  
New York, New York 10007

Re: *In re Literary Works in Electronic Databases*  
*Copyright Litigation*, 05-5943-cv (2d Cir.)

Dear Mr. Asreen:

I write on behalf of defendants-appellees to address the question posed by the Court's January 31, 2007 Order, namely "whether the District Court had subject matter jurisdiction over claims concerning the infringement of unregistered copyrights." Please provide this response to the panel assigned to the above-captioned case.

1. With respect, we are constrained to rephrase the question, because the question posed implicitly assumes that the District Court exercised "subject matter jurisdiction over claims concerning the infringement of unregistered copyrights." We do not understand that

the District Court did so. Rather, it asserted jurisdiction over a lawsuit in which each and every claim of each and every named plaintiff concerned a properly registered work, consistent with 17 U.S.C. § 411(a), and then exercised its power to approve a class action settlement pursuant to Fed. R. Civ. P. 23(e), as to which § 411(a) plays no role.

17 U.S.C. § 411(a) is phrased and has been understood as a pre-condition to the exercise of subject matter jurisdiction conferred by 28 U.S.C. § 1338. *See Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp.*, 354 F.3d 112, 115 (2d Cir. 2003). It provides that “no action for infringement of the copyright in any United States copyright work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title.” That requirement was literally and completely satisfied here. The actions in the District Court were not instituted until registration of the works named in suit was made in accordance with § 411(a).

Nothing in the statutory language or legislative history warrants stretching the provision beyond its simple and plain meaning to limit the usual power of district courts to approve class action settlements within the limits of Rule 23(e) and due process, as applied in such cases as *Wal-Mart Stores Inc. v. Visa U.S.A. Inc.*, 396 F.3d 96 (2d Cir.), *cert. denied sub nom Leonardo's Pizza by the Slice, Inc. v. Wal-Mart Stores, Inc.*, 544 U.S. 1044 (2005). Neither the cases referenced in the Court's Order, nor any other we have seen, suggests that § 411(a) generally proscribes remedial orders that would affect works other than those registered before initiation of a suit. The leading commentator forcefully agrees. *See 2 Nimmer on Copyright* § 7.16[C][3] (citing numerous cases holding that § 411(a) is not, for example, a condition

to the grant of injunctive relief reaching works of the plaintiffs other than those registered works on which suit was based).

To the extent the Court has asked our views on whether § 411(a) constrains a district court's power to approve a class action settlement that provides for the compensation and release of claims of authors' unregistered works, the answer is no, it does not. The cases are legion, and we believe unanimous, that a court with proper subject matter jurisdiction consistent with § 411(a) may grant injunctive copyright remedies affecting not only the registered work that created the subject matter jurisdiction but also unregistered works, and indeed works that may not yet have been created. This Court has so ruled, *see Sailor Music v. Gap Stores, Inc.*, 668 F.2d 84, 86 (2d Cir. 1981) (affirming injunction prohibiting public performance of "plaintiffs' copyrighted musical compositions," not just those registered), *cert. denied*, 456 U.S. 945 (1982), as have often-cited district court decisions in this Circuit. *See, e.g., Basic Books, Inc. v. Kinko's Graphics Corp.*, 758 F. Supp. 1522, 1542 (S.D.N.Y. 1991) (holding that plaintiffs are "entitled to

---

<sup>1</sup> *Princeton Univ. Press v. Michigan Document Servs.*, 99 F.3d 1381, 1392 (6th Cir. 1996); *Olan Mills Inc. v. Linn Photo Co.*, 23 F.3d 1345, 1349 (8th Cir. 1994) ("The power to grant injunctive relief is not limited to registered copyrights, or even to those copyrights which give rise to an infringement action"); *Walt Disney Co. v. Powell*, 897 F.2d 565, 568 (D.C. Cir. 1990) ("Where, as here, liability has been determined adversely to the infringer, there has been a history of continuing infringement and a significant threat of future infringement remains, it is appropriate to permanently enjoin the future infringement of works owned by the plaintiff but not in suit."); *A&M Records*,

an injunction against future infringement of works which may not now be copyrighted or even in existence but, in the future, may be copied by defendant”); *Encyclopaedia Britannica Educ. Corp. v. Crooks*, 542 F. Supp. 1156, 1187 (W.D.N.Y. 1982) (same). We cite some of the leading cases, including those by seven other courts of appeal, in the margin;<sup>1</sup> even more decisions are collected in *2 Nimmer on Copyright* § 7.16[C][3] at nn. 146.6, 146.7.

*A fortiori*, once the Court is properly seized of subject matter jurisdiction and the precondition of § 411(a) is met, that section does not limit the Court’s power to approve a negotiated class action settlement under Rule 23(e). Nothing in its language or structure so suggests. Instead, §411(a) is “merely the plaintiff’s ‘ticket’ to court,” *PRC Realty Sys. v. National Ass’n of Realtors, Inc.*, 766 F. Supp. 453, 461 (E.D. Va. 1991), not

---

*Inc. v. A.L. W., Ltd.*, 855 F.2d 368, 370 n.6 (7th Cir. 1988) (holding defendant in contempt who, after injunction entered by trial court, thereafter rented “recently released” records, i.e., works not created or published at the time the order was originally entered); *Columbia Pictures Indus., Inc. v. Aveco, Inc.*, 800 F.2d 59, 61 n.1 (3d Cir. 1986) (approving permanent injunction enjoining defendants from performing copyright motion pictures owned by plaintiffs); *MCA, Inc. v. Parks*, 796 F.2d 200, 202 (6th Cir. 1986) (affirming order enjoining skating rink operator “from further use of the jukebox in their establishment until they obtained an ASCAP license”); *National Football League v. McBee & Bruno’s, Inc.*, 792 F.2d 726, 732 (8th Cir. 1986) (affirming grant of permanent injunction regarding future broadcasts of “works not yet in existence”); *Pacific & S. Co. v. Duncan*, 744 F.2d 1490 (11th Cir.), *cert. denied*, 471 U.S. 1004 (1985); *Fame Publishing Co. v. Alabama Custom Tape, Inc.*, 507 F.2d 667, 669 (5th Cir.) (affirming order permanently enjoining defendant “from continued infringement of plaintiffs’ copyrights in musical compositions”), *cert. denied*, 432 U.S. 526 (1977).

the source of or any limitation on copyright protection, which arises upon creation. If § 411(a) does not strip district courts of the power to grant injunctive relief under 17 U.S.C. § 502 “to prevent or restrain infringement of a copyright” with respect to unregistered works (so long as the case has been instituted in compliance with §411(a)), it surely does not restrict the Rule 23(e) power to approve a negotiated class action settlement of a case properly before it. The latter situation entails not the grant of grant of copyright remedies but rather the exercise of Article III power to approve a class action settlement that meets the standards of Rule 23(e) and due process.<sup>2</sup>

It is settled that courts may approve class action settlements that benefit and release the claims of class members who could not themselves have been named plaintiffs, whether because their claims would have destroyed diversity or would not satisfy the amount-in-controversy requirement. *See, e.g., Exxon Mobil Corp. v. Allapattah Servs., Inc.*, 545 U.S. 546, 557-60 (2005) (if one claim satisfies the amount in controversy requirement of diversity jurisdiction, the court can exercise

---

<sup>2</sup> By arguing that courts may approve class action settlements that provide for compensation and release of claims of class members with regard to unregistered works, defendants are not agreeing that § 411(a) or any other provisions of law would permit a court to (a) award copyright damages under 17 U.S.C. § 504 with respect to unregistered works, whether in a class action or otherwise, or (b) certify a class of authors of unregistered works in a copyright infringement class action that would be litigated (rather than settled). Those scenarios raise very different considerations, and are not presented by this appeal. Defendants’ position here should not be understood to suggest they believe that courts could do so.



supplemental jurisdiction over claims that do not meet the requirement); *Supreme Tribe of Ben-Hur v. Cauble*, 255 U.S. 356, 365 (1921) (class actions meet the standard test for diversity when there is complete diversity between the named plaintiffs and named defendants); *In re “Agent Orange” Prod. Liab. Litig.*, 818 F.2d 145, 162 (2d Cir. 1987) (“complete diversity is required only between the named plaintiffs and the named defendants in a federal class action”). Just as class action settlements may provide for compensation to (and release of the claims of) third persons who could not have themselves sued and satisfied the requirements of subject matter jurisdiction, *Exxon, supra*, or of persons who have not asserted those claims in court at all, e.g., *Wal-Mart*, so too an infringement action meeting the requirements of §411(a) at the front end may terminate by a settlement agreement that compensates and releases the claims of persons who could not and did not assert those claims as named plaintiffs. *See also State Farm Fire & Cas. Co. v. Tashire*, 386 U.S. 523, 530-531 (1967) (constitutional requirements for diversity jurisdiction not defeated by the addition of non-diverse parties).

The plain language of § 411(a) affords no basis for construing it to deprive the District Court of subject matter jurisdiction to approve the settlement agreement here or to certify the class in that connection, and we see no basis for consulting its purpose and history. Nonetheless, those too point in the same direction, as carefully explained by the Nimmer treatise. *See 2 Nimmer on Copyright* § 7.16[C][3].

2. *Exxon* strongly supports this conclusion, and *Amchem Prods. v. Windsor*, 521 U.S. 591, 612-13 (1997), is inapposite to the jurisdictional issue posed by the panel’s Order.

The issue in *Exxon* was whether 28 U.S.C. § 1367 authorized supplemental jurisdiction over claims of other plaintiffs (including class members) in the same case or controversy if those claims were for less than the jurisdictional amount. The Court held that when a “well pleaded complaint contains at least one claim that satisfies the amount-in controversy requirement . . .the district court, beyond all question, has original jurisdiction over that claim”:

The presence of other claims in the complaint, over which the district court may lack original jurisdiction, is of no moment. 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), even if the civil action over which it has jurisdiction comprises fewer claims than were included in the complaint. Once the court determines it has original jurisdiction over the civil action, it can turn to the question of whether it has a constitutional and statutory basis for exercising supplemental jurisdiction over the other claims in the action.

*Exxon*, 545 U.S. at 559. Here, the District Court clearly had original jurisdiction over the lawsuit under 28 U.S.C. § 1338 (because the action arises under the copyright law), and § 411(a)’s precondition was satisfied (because every claim of every named plaintiff concerned a registered work). Under *Exxon*, the District Court accordingly had original jurisdiction over the action and the power to exercise all the Article III power that courts have to certify classes and resolve cases properly before them.

*Amchem* mandates no different conclusion. The holding there affirmed the Third Circuit's judgment that a class action should not have been certified in an asbestos class action because plaintiffs had not satisfied the requirements of Rule 23 as to common-issue predominance and adequacy of representation. The decision turned entirely on Rule 23 requirements, and the Court rendered no holding whatever with respect to subject matter jurisdiction. While Justice Kennedy's opinion for the majority *mentioned* the objector's alternative argument that the class claims were beyond the court's subject matter jurisdiction, it did not decide that issue, which was subsequently put to rest by *Exxon's* holding that only the named plaintiffs and not class members must meet the requirements for subject matter jurisdiction.

For all the above reasons, the District Court had subject matter jurisdiction over the action, and therefore the power to certify the settlement class and approve the final judgment consistent with Rule 23(e).

Very truly yours,

/s/ Charles S. Sims  
Charles S. Sims

*Counsel for Defendants-Appellees*

cc: Michael Boni, Counsel for Plaintiffs-Appellees  
Charles Chalmers, Counsel for Appellants  
All Counsel for Defendants-Appellees