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April 8, 2019 | Number 2482

## Supreme Court Blocks Copyright Infringement Claims Until Actual Registration Issues

**Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC** *has important implications for copyright owners who file infringement suits, including authors of literary, musical, and dramatic works.*

### Key Points:

- The Supreme Court recently held that the Copyright Office must issue a registration before a litigant can bring a copyright infringement lawsuit. Simply filing an application for registration is not sufficient to bring suit.
- However, parties can preregister certain classes of works or pursue expedited registration, as necessary, in order to be in a position to promptly file a lawsuit.

In *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*,<sup>1</sup> the US Supreme Court unanimously held that “registration” — a prerequisite to filing a copyright infringement lawsuit in the United States — occurs when the US Copyright Office actually issues a copyright registration for a work, and not when an applicant files an application for registration with the Copyright Office. Once a copyright is properly registered, a copyright owner can recover for infringement that occurred even before registration, provided the suit is filed within the three-year statute of limitations for copyright infringement actions prescribed by the Copyright Act.

### Background

The Copyright Act establishes that copyright protection attaches to “original works of authorship fixed in any tangible medium or expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine device” and explicitly lists “literary works,” “musical works,” “dramatic works,” “motion pictures and other audiovisual works,” and “sound recordings” as specific illustrative examples of copyrightable material.<sup>2</sup> Copyright protection applies to these works regardless of whether the author has registered the works with the Copyright Office, as exclusive rights attach upon creation of copyrightable material. However, the Copyright Act expressly requires<sup>3</sup> preregistration or registration of a copyright in a United States work, in accordance with the Copyright Office’s administrative rules, as a prerequisite to filing a copyright infringement action.<sup>4</sup>

## Case Summary

Fourth Estate Public Benefit Corporation is a news organization that produces online journalism content, and Wall-Street is a news website. The two parties had entered into a licensing agreement, which included a provision requiring Wall-Street to remove any content produced by Fourth Estate prior to cancelling the agreement. When Wall-Street cancelled the agreement and then failed to remove Fourth Estate's content, Fourth Estate sued for infringement. At the time of filing, Fourth Estate alleged that it had filed applications with the Register of Copyrights for the relevant articles but had not yet received the registrations.

In granting Fourth Estate's petition for *certiorari*, the US Supreme Court sought to resolve a circuit split over the "registration approach" and the "application approach" in interpreting § 411(a) of the Copyright Act. The former approach requires the rights-holder to obtain an official registration from the Register of Copyrights in order to file an infringement action.<sup>5</sup> The latter approach only requires a claimant to show that the Copyright Office received a claimant's "complete application."<sup>6</sup>

Both the district court and the Eleventh Circuit followed the registration approach in *Fourth Estate*. Since the Register had not yet acted upon Fourth Estate's copyright applications, the copyrights were not "registered" for the purpose of bringing a lawsuit in accordance with § 411(a). As such, the district court dismissed the copyright infringement complaint, and the Eleventh Circuit affirmed the lower court's dismissal.

## Section 411(a)

Section 411(a) states: "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 preregistration 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. 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."

## The Supreme Court's Analysis

While both parties agreed that § 411(a) requires a registration to be made prior to filing an infringement lawsuit, they disagreed as to the proper definition of "registration" under § 411(a). Fourth Estate advanced the "application approach" and thus asserted that it had met the registration requirement by submitting all of the required application elements to the Copyright Office. Wall-Street advocated for the "registration approach," arguing that the registration requirement would not be met until the Copyright Office granted an actual registration to the copyright applicant. As noted above, the Court agreed with Wall-Street in concluding that the "registration approach ... reflects the only satisfactory reading of § 411(a)'s text."

In adopting the registration approach, the Court undertook a thorough analysis of the statutory meaning of "registration" as used in both § 411(a) itself and other sections of the Copyright Act. The holding drew a distinction between the uses of "registration" in the context of actions intended to apply to a claimant, and the uses of "registration" that were intended to apply to actions taken by the Copyright Office. The Court underscored that the proper meaning of this term throughout the Copyright Act depended on the particular context in which it was used. To bolster its reasoning, the Court highlighted a few specific

sections of the Copyright Act that include provisions that would otherwise be superfluous or nonsensical if the mere act of filing an application constituted “registration.” These sections included: (i) Section 408(f), allowing for preregistration, which, the Court noted, “would have little utility if a completed application constituted registration”; and (ii) Section 410, stating that the Register will issue a registration after it examines the material deposited and assesses the applicant’s compliance with other legal requirements, which clearly draws a distinction between the act of applying for registration and the act of achieving registration.

After citing the many contextual examples of how other provisions of the Copyright Act support its interpretation of what constitutes “registration” under § 411(a), the Court then addressed Fourth Estate’s various arguments in support of the “application approach.” Fourth Estate first posited that § 411(a)’s “make registration” wording and the related passive construction of “registration has been made” refer to actions taken by the copyright owner in submitting his or her application, rather than action by the Copyright Office. The application approach, Fourth Estate argued, “reflect[ed] the reality that, eventually, the vast majority of applications are granted.”

Fourth Estate additionally argued that since registration is not a precondition to copyright protection, § 411(a) should not be interpreted to require the Copyright Register to issue a registration prior to a claimant filing a lawsuit. In rejecting this argument, the Court explained that the point in time when a claimant’s exclusive rights to a work attach (*i.e.*, at creation) is distinct from the point in time when the claimant is entitled to enforce its rights against an infringing party (*i.e.*, upon registration), and that, upon registration, a claimant may still pursue an action for infringement that occurred prior to securing registration.

The Court also disagreed with Fourth Estate’s argument that a registration requirement unfairly burdens a copyright claimant seeking timely redress for infringement because of the tremendous backlog in reviewing applications at the Copyright Office. Specifically, the Court pointed to the explicit carveouts (*i.e.*, preregistration for certain works and live broadcasts) Congress included in § 411(a)’s registration rule to highlight that the statute already contemplated a waiting time between application filing and issuance of a registration in the case of “general” applications. With respect to preregistration under § 408(f), Congress noted that copyright owners of works particularly susceptible to infringement should have the right to bring a lawsuit before the Register has made a determination on the relevant application. The same is true of Congress’ treatment of live broadcasts, which also require a more immediate ability to file suit. Unlike these specific carveouts that address temporally sensitive infringement actions, and which therefore warrant special treatment, the general rule articulated by § 411(a) requires that a copyright owner wait until the Register has made a final determination on the application prior to filing an infringement lawsuit. The Court noted that in addition to the preregistration provisions, the Copyright Office allows a copyright claimant to seek expedited processing of a claim (for an additional fee) in situations involving pending or prospective litigation.

Fourth Estate also expressed concern that a copyright owner might lose the ability to assert his or her rights in the event that the three-year statute of limitations expires before the Copyright Office issues a decision on the application for registration. However, the Court refuted this concern by noting that the average processing time for an application for registration is seven months, which “leav[es] ample time to sue after the Register’s decision, even for infringement that began before submission of an application.” While this timing likely far exceeds what Congress initially envisioned, the Court stated that it cannot “revise § 411(a)’s congressionally composed text” based on the “[u]nfortunate ... administrative lag.”

Finally, the Court highlighted § 411(a)'s legislative history to further support its ruling. The holding noted that the "registration" concept, as embedded in § 411(a), has withstood repeated legislative proposals to remove the requirement from the statute. Further, the Court mentioned that Congress removed foreign works from the purview of § 411(a) in order to comply with the Berne Convention but maintained it for domestic works. Congress even considered a proposal to allow for the filing of an infringement suit immediately upon submission of an application for registration, but declined to adopt it in 1993. The Court viewed these examples of Congressional action as further evidence that Congress intended actual registration to be the proper precursor to filing an infringement suit.

Based on the above reasoning, the Court held that "registration ... has been made" for the purpose of § 411(a) only when the Register has examined a properly filed application and then issued a copyright registration and not, as Fourth Estate had advocated, when an application for registration is filed.

## Practical Considerations

### Alternative Causes of Action

Copyright owners who file copyright infringement suits under the Copyright Act must bring them in federal district court. Remedies for copyright infringement claims include injunctions, impounding infringing materials, actual damages and profits, statutory damages, and costs and attorney's fees.<sup>7</sup> Likely the most significant of these remedies are the statutory damages prescribed by § 504 that articulate a range of damages to be awarded in the cases of willful and non-willful infringement, without the need to demonstrate actual damages. However, pursuant to § 412, no award for statutory damages will be awarded for "any infringement of copyright in an unpublished work commenced before the effective date of its registration; or any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work."<sup>8</sup>

Pursuing state law causes of action might seem like a promising fall-back option to a copyright infringement suit, absent registration. However, evading the Copyright Act may be difficult if the intellectual property sought to be protected falls within copyrightable subject matter as defined by § 102. Section 301 of the Copyright Act was introduced as part of the 1976 Copyright Act and preempts certain state law rights that are equivalent to the exclusive rights protected by federal copyright law.

There may nonetheless be various state law claims to pursue as an alternative to a copyright infringement claim, such as breach of contract, common law misappropriation, and trade secret misappropriation. Each such claim would need to be evaluated in light of the facts at issue in a given case.

### Application Particulars

#### How to Register a Copyright

The US Copyright Office provides that an author can register a copyright by either submitting a paper application using the applicable form,<sup>9</sup> or by applying online on the Copyright Office website. In general, copyright owners are recommended to apply online because it is faster, more cost-effective, and usually more convenient.

An application for copyright registration requires that the author complete an application form, pay a non-refundable filing fee, and submit a copy of the work being registered (which is referred to as the "deposit"). For the deposit requirement, an online application can either include an electronic copy of the

work or a hard copy, which is submitted separately. The Copyright Office has detailed rules on whether an electronic or hard-copy deposit is required. A paper application must include a hard-copy deposit of the work.

The non-refundable filing fee for an online application is US\$55 for most basic copyright claims for individual works.<sup>10</sup> The fee for the paper application is US\$85 for most applications and must be paid by check or money order.

Generally, each work that an author wants to register requires its own application, deposit, and fee. However, there are some exceptions that allow a standard copyright registration to cover multiple works. One copyright application can be used for multiple works when, for example, separate works are combined into one collective work or when multiple works are physically sold as part of the same bundle and first published as a unit.<sup>11</sup> The Copyright Office also has provided group registration options for various types of works, including photographs, newspapers, newsletters, and database updates and revisions.

Online applications that do not require additional correspondence between the applicant and the Copyright Office are processed in an average of six months, and applications that require additional correspondence are processed in an average of nine months. Paper applications that do not require additional correspondence between the applicant and the Copyright Office are processed in an average of 13 months, and applications that require additional correspondence are processed in an average of 20 months.<sup>12</sup>

Under certain circumstances, the Copyright Office will allow an applicant to request “special handling” of an application to register a claim to copyright.<sup>13</sup> For example, if there is pending or prospective litigation or a contract or publishing deadline that necessitates the expedited issuance of a registration certificate, a copyright owner can request special handling of the application and submit a special handling fee of US\$800 per application. If an applicant is requesting special handling of a registration for litigation purposes, the special handling request must state whether the litigation is actual or prospective, whether the applicant is the prospective plaintiff or defendant, the names of the parties, and the name of the court where the litigation is pending or expected. Once a request for special handling is approved, the Copyright Office will try to complete its examination of the claim within five working days. If issues arise that prevent the Copyright Office from registering the work, the applicant will generally be notified within five working days.

### **Preregistration**

Unlike a typical copyright application, preregistration can be completed prior to the completion or publication of a work. Pursuant to the Artists’ Rights and Theft Prevention Act of 2005, preregistration is permitted for any class of works that the Register of Copyrights has determined have “a history of infringement prior to authorized commercial distribution.”<sup>14</sup>

The Register has determined that the following categories of works are eligible for preregistration:

- Motion pictures
- Sound recordings
- Musical compositions
- Literary works being prepared for publication in book form
- Computer programs (including video games)
- Advertising or marketing photographs

The work must also be currently unpublished, but in the process of being created, fixed in some tangible medium, and prepared for commercial distribution in either physical or digital form.

An advantage of preregistration is that it permits the filing of a copyright infringement lawsuit before the authorized commercial distribution of a work and full registration thereof. In addition, similar to owners of timely filed copyright applications, owners of works that have been preregistered are eligible for statutory damages and attorney's fees after a successful suit.

In the past, preregistration was typically limited to situations in which the owner of the work believed the work may be infringed before it was released and a "standard" application for copyright registration could be filed. However, given the ruling in *Fourth Estate*, creators of the enumerated classes of works above may have greater incentive to preregister eligible works so that they may commence infringement actions while their standard copyright application is pending.

In order to preregister an eligible work, the owner must complete the online application and submit a non-refundable US\$140 fee. Unlike the "standard" copyright application process, which requires that the owner submit a deposit of the work, the preregistration application only requires a description of the work that is sufficiently detailed to reasonably identify the work. For example, in an application for preregistration of a motion picture, the claimant should provide the following information, to the extent known: the subject matter; a summary or outline of the plot; the major talent; and filming locations associated with the project. The claimant must also provide the date on which creation of the work began (e.g., filming, writing, taking a photograph), the anticipated date the work will be completed, and the anticipated date on which it will be distributed.

Importantly, preregistration is not a substitute for actual registration. All preregistered works must be timely registered in order to have the full protections and rights of a copyrighted work. Specifically, a copyright owner must properly submit a preregistered work for "standard" registration within one month of becoming aware of infringement, and no later than three months after first publication. Failure to timely register a preregistered work will result in the dismissal of an action for copyright infringement that occurred within the first two months after first publication.

### **Live Performances**

The Copyright Act also exempts live broadcasts from the registration requirement. However, copyright owners wishing to use this exemption should confirm that they are in compliance with its procedural requirements, including timely filing an application for registration of the copyright following the broadcast.

For any work "consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission," the copyright owner may bring an infringement action either before or after the broadcast if the owner notifies the infringer more than 48 hours before the broadcast "identifying the work and the specific time and source of its first transmission and stating an intention to secure copyright in the work" and then "makes registration for the work ... within three months after its first transmission."<sup>15</sup>

### **Foreign Works**

The United States is a signatory to the Berne Convention for the Protection of Literary and Artistic Works, which states that "Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the right of their laws ... The enjoyment and the exercise of these rights shall not be subject to any formality."<sup>16</sup> In order to comply with the Berne Convention, Congress exempted foreign works from the requirement that a copyright be registered in the United States before an infringement suit can be filed. Therefore, even before *Fourth*

*Estate*, copyright owners of foreign works did not have to register their works in the United States in order to commence a copyright infringement lawsuit in the United States. However, as courts have explained, although authors of foreign works need not register their works in order to pursue infringement actions in the United States, such authors will not be able to avail themselves of the entitlement to statutory damages and attorney's fees afforded by the Copyright Act unless they timely register their works with the US Copyright Office.<sup>17</sup>

### **Conclusion**

In sum, the *Fourth Estate* holding makes clear that a copyright claimant cannot bring an infringement lawsuit until the Copyright Office issues a registration. However, interested parties can preregister certain classes of works or seek expedited registration, as necessary, in order to be in a position to promptly file suit.

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**Endnotes**

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- <sup>1</sup> 586 U.S. \_\_\_\_ (2019)
- <sup>2</sup> 17 U.S.C. § 102.
- <sup>3</sup> An exception to this requirement is actions brought by an author seeking to vindicate the rights protected by 17 U.S.C. § 106A(a). Section 106A ensures that an author of a work of visual art has the right to “claim authorship of that work,” prevent the false-attribution as the author of a work of visual art that he or she did not create, and other similar rights associated specifically with works of visual art.
- <sup>4</sup> 17 U.S.C. § 411(a). There are two limitations on § 411(a)’s general registration requirement: preregistration and live performances, each of which is described in the “Practical Considerations” section of this *Client Alert*.
- <sup>5</sup> See, e.g., *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1341 (11th Cir. 2017) (registration has been made under § 411(a) when the Register of Copyrights registers a copyright).
- <sup>6</sup> See, e.g., *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 621 (9th Cir. 2010) (registration has been made under § 411(a) when the copyright claimant’s “complete application” for registration is received by the Copyright Office).
- <sup>7</sup> 17 U.S.C. §§ 502, 503, 504, 505.
- <sup>8</sup> In this context, the Court seems to suggest that “registration” refers to actions of the claimant.
- <sup>9</sup> For paper applications, the various forms are Form TX (literary works); Form VA (visual arts works); Form PA (performing arts works, including motion pictures); Form SR (sound recordings); Form SE (single series issues).
- <sup>10</sup> The Copyright Office has a streamlined application (called the “single application”) for which the filing fee is US\$35. The single application, however, is available only in limited circumstances: the requirements include that only one work is being registered, the work is not a work made for hire, and the applicant is the only author and claimant.
- <sup>11</sup> *Multiple Works*, US COPYRIGHT OFFICE, <https://www.copyright.gov/circs/circ34.pdf> (last visited Mar. 17, 2019).
- <sup>12</sup> *Registration Processing Times*, US COPYRIGHT OFFICE, <https://www.copyright.gov/registration/docs/processing-times-faqs.pdf> (last visited Mar. 17, 2019).
- <sup>13</sup> *Special Handling*, US COPYRIGHT OFFICE, <https://www.copyright.gov/circs/circ10.pdf> (last visited Apr. 2, 2019).
- <sup>14</sup> 17 U.S.C. § 408(f).
- <sup>15</sup> 17 U.S.C. § 411(c).
- <sup>16</sup> *Berne Convention for the Protection of Literary and Artist Works (as amended on September 28, 1979)*, WORLD INTELLECTUAL PROPERTY ORG. (WIPO), <https://wipolex.wipo.int/en/text/283693> (last visited Mar. 24, 2019).
- <sup>17</sup> See, e.g., *Football Ass’n Premier League Ltd. V. YouTUBE, Inc.*, 633 F. Supp. 2d 159, 162-63 (S.D.N.Y. 2009).