



SCOTUS rules copyright owners must have registration in hand before filing infringement suit

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On Monday March 4, 2019, the United States Supreme Court issued an important opinion clarifying the requirements to file copyright infringement actions.¹ To understand this decision, it is first helpful to understand the circuit split that the Supreme Court has now resolved.

Before a copyright infringement claim can be filed, the work at issue must be registered with the Copyright Office. Specifically, title 17 U. S. C. §411(a) (the “registration requirement”) states that “no civil action for infringement of the copyright in any United States work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title.” However, this registration requirement has been interpreted by circuit courts in two different ways:

- The Fifth and Ninth Circuits applied the “application” approach. In these circuits, once a copyright owner submitted an application for a copyright (by preparing an application, paying a fee, and submitting a deposit copy), s/he could immediately file a copyright infringement claim.
- In contrast, the Tenth and Eleventh Circuits followed the “registration” approach. In these circuits, only after the Copyright Office acted on a filed application by issuing a certificate of registration, could a copyright claimant file an infringement claim.

Other circuits had not conclusively answered the question of when, precisely, a copyright was actually “registered.” But that question has now been answered by the U.S. Supreme Court: the doors to the federal courthouse are barricaded to copyright claimants, unless and until the Copyright Office acts on a copyright application by issuing a certificate of registration.

The Supreme Court’s analysis

In the case before the Court, petitioner Fourth Estate Public Benefit Corporation (Fourth Estate), a news organization, sued respondent Wall-Street.com, LLC (Wall-Street) upon learning that Wall Street continued to provide copies of Fourth Estate stories on its website after the cancellation of a

¹ *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC. et. al.*, No. 17-561, 586 U.S. ____ (2019).

license agreement between the parties. Fourth Estate relied on the “application” approach of the Eleventh Circuit in bringing its suit against Wall Street, arguing that 17 U. S. C. §411 of the Copyright Act permits the filing of a civil action for infringement immediately upon filing of a complete copyright application.

The Eleventh Circuit affirmed the district court, holding that “registration . . . has [not] been made” under §411(a) until the Copyright Office registers a copyright. The Supreme Court unanimously affirmed the Eleventh Circuit, resolving the long standing circuit split noted above, by concluding that “registration . . . has been made” within the meaning of 17 U. S. C. §411(a) only when the Copyright Office has registered a copyright after examining the application.

In its decision, the Court relied heavily on the first and second sentences of §411(a). Specifically, §411(a) provides limited circumstances upon which copyright owners may file an infringement suit prior to the issuance of a registration—including preregistered works (*see* 17 U.S.C. §408(f), allowing preregistration of works particularly susceptible to pre-distribution infringement), or when registration is refused by the Copyright Office. The Court reasoned that these express exceptions in the statute (allowing for an infringement suit upon the mere filing of an application) necessarily requires the remaining portion of 17 U. S. C. §411(a) to be read to require an issued copyright registration for a suit to proceed in all non-exception cases.

The Court briefly addresses the legislative history regarding §411(a) as well. The Court observed that Congress acted numerous times to reinforce the registration requirement:

- by failing to eliminate §411(a),
- by failing to specifically allow for infringement suits upon the filing of a mere application, and
- by allowing preregistration in certain cases to strengthen the ability of a party to sue for infringement.

Fourth Estate argued that copyright protection was immediate, as it vests at fixation (*see* 17 U.S.C. §102(a)), and therefore should not require registration as a prerequisite to protection. But the Court rejected this argument, highlighting that *upon receipt of a registration*, copyright owners can recover for infringements which occurred both before and after the registration issued, thereby allowing all potential claimants to avail themselves of their rights allowed under the Act.

The Court was equally unmoved by Fourth Estate’s argument that the statute of limitations might expire while a claimant was awaiting action by the Copyright Office. Instead, the Court simply noted the average processing time for a copyright application is only about seven months compared with the three-year statute of limitations for such claims. In a footnote, the Court also highlights the ability of a copyright owner to seek expedited processing of a copyright application for a heightened fee.

Ultimately, the Supreme Court held that in order for a party to commence a copyright infringement claim, the Copyright Office must have issued that party a copyright registration; the mere filing of an application for registration, unless specifically enumerated in the statute, is not sufficient.

Practical implications

How will the Supreme Court's ruling affect potential copyright litigants? For claimants in the "registration" circuits, it will be business as usual. But in the other circuits where either the "application" approach was followed or the issue was undecided, the answer is clear—claimants must either exercise more patience or spend more money to advance a copyright infringement claim.

Currently, the average processing wait for the Copyright Office to issue a registration is over six months (current processing times can be found [here](#)). For those unable or unwilling to wait that long, an application can be filed with "special handling" by paying a significant fee (currently \$800 per application, in addition to the standard application fee) to expedite the Copyright Office's review process. In practice, special handling applications often lead to receipt of an official certificate of registration in about two weeks. However, this response time could lengthen if the number of special handling requests increase, in response to Monday's decision.

In current practice, rights holders may often delay filing a copyright application until evidence of potential infringement is discovered. However, it would not be surprising to see additional copyright applications submitted earlier in the process in response to the Court's decision. In addition to avoiding the high cost of special handling fees, early registration may also allow for statutory damages and fee recovery in litigation. So, it "pays" to plan ahead—or, at least, planning ahead avoids a significant payment to the Copyright Office for matters that can't afford to wait over six months for a registration.

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