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A Unanimous Supreme Court Decision Holds That A Copyright Registration Is Required to Commence Litigation



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The Opinion
Last week the Supreme Court issued a unanimous opinion resolving a long-standing circuit split and affirming that a copyright owner must hold a *registration* from the Copyright Office before it can file a lawsuit for copyright infringement. The Copyright Act 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." 17 U.S.C. §411(a). Courts have been split as to whether this section of the Copyright Act required the Copyright Office to grant a *certificate of registration* (the “registration approach,” previously followed by the 10th and 11th Circuits), or whether that requirement was satisfied once an application was filed (the “application approach,” previously followed by the 5th and 9th Circuits).

This case was brought by Fourth Estate, a news organization that licensed works to news website, Wall-Street.com. When the licensing agreement terminated, Wall-Street.com failed to remove the licensed articles from its website, and Fourth Estate sued. Although Fourth Estate had filed a copyright application to register the articles in question, the official registration certificate was not yet granted when Fourth Estate filed its Complaint. The District Court dismissed the complaint and the Eleventh Circuit affirmed.

In a 9-0 decision the Supreme Court (J. Ginsburg) relied on Wall-Street's statutory construction arguments and affirmed the Eleventh Circuit ruling finding that “registration…has been made” only when the certificate of registration has been issued after examination. In response to Fourth Estate's strong policy arguments, including that a registration approach is unduly burdensome on copyright owners, causes delay and limits their ability to seek preliminary injunctions, Justice Ginsberg acknowledge the issues, but noted there are issues for Congress to alleviate, and ones that "courts cannot cure."

Copyright Registrations
In addition to conferring standing for an infringement lawsuit, a copyright registration permits a rights holder to seek statutory damages and attorneys' fees. Upon application, the Copyright Office generally examines and issues a registration in 6-12 months (average time 7 months). An applicant can seek to expedite the process to roughly one week for a $800

fee, although the Copyright Office does not guarantee it will be able to meet the one-week timeline. Moreover, if the Fourth Estate decision results in an influx of copyright owners seeking to expedite their registrations, we expect that that delays may become more likely. Copyright owners can seek statutory damages when they register their work either (1) within three months of publication of the work, or (2) before the infringement starts.

Foreign Rights Holders
The Fourth Estate decision does not change anything for foreign copyright owners who are seeking to enforce their rights in the U.S., pursuant to the Berne Convention. Foreign registrants in this position still do not need to hold a registration to sue for infringement in the U.S. seeking injunctive relief or actual damages. **However, they still must secure a U.S. registration prior to seeking statutory damages or attorneys' fees.**

Given these realities, best practices for copyright owners are to secure registration upon publication of their work.

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