
Enforcing Copyright Without Having a Registration Certificate

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Copyright attaches as soon as an author puts her original work of authorship into a tangible medium of expression. 17 U.S.C. §301(a). At that moment, the copyright holder enjoys a bucket of exclusive protections under the plain language of the copyright statute, including the right to reproduce, make derivative works based on the work, and, if for instance a music score, perform the work. 17 U.S.C. §106. But, if another party reproduces a substantially similar portion of that work without authorization (e.g., commits copyright infringement), the courthouse door has long been closed to the copyright holder unless she has filed an application for copyright registration and received the registration certificate.

Thus, failing to register a work and receive a registration certificate has long blocked one whose copyright has been infringed from filing a lawsuit in addition to the potential loss of other rights (e.g., statutory damages and attorney fees). Because there is a time delay between registering a work and receiving a registration certificate—which can be more than a year with a general filing fee, or up to a few weeks with the \$800 Special Handling fee—enforcing that exclusive bucket of copyright rights can be frustrating, expensive or foreclosed.

Some jurisdictions are making it easier by allowing a copyright infringement lawsuit to proceed after a copyright application has been filed but before a certificate of registration has been obtained. In fact, district courts are split on this issue, which has not been decided by some circuits (including the Third Circuit).

NJ District Courts Maintain the Certificate Requirement for Now

In the District of New Jersey, this issue has been consistently decided in several unreported opinions, including two recent decisions holding that a copyright holder needs the certificate of registration in hand prior to filing a lawsuit to maintain that action. See *Zany Toys v. Pearl Enters.*, No. 13-cv-5262, at *10 (D.N.J. May 23, 2014) (citing *North Jersey Media Group v. Sasson*, No. 12-cv-3568 (D.N.J. Jan. 4, 2013)). The opinion in *North Jersey Media* is brief and confined to this one issue.

There, defendant filed a 12(b)(6) motion to dismiss several counts based on photographs and articles where plaintiff held copyright ownership and had applied for copyright registration of the works but had not yet received a certificate of registration when it filed the lawsuit. The issue before the court was whether a copyright "application" is sufficient to satisfy 17 U.S.C. §441(a), which provides that "no civil action for infringement of the copyright in any United States works shall be instituted until preregistration or registration of the copyright claim has been made." *North Jersey Media* at *2 (citing *Reed Elsevier v. Muchnick*, 559 U.S. 154 (2010), §441(a) is a "precondition" to filing a copyright infringement lawsuit).

The court noted that this issue has not yet been "squarely addressed" by the Third Circuit, though other federal courts outside this circuit have entered split decisions. Moreover, the court noted that other district courts within the Third Circuit have suggested that the Third Circuit would not allow a lawsuit to continue if plaintiff had not first received a registration certificate. *Id.* (citing *Patrick Collins v. Doe*, 843 F.Supp.2d 565, 568 (E.D. Pa. 2011)). Ultimately, the court granted defendant's motion to dismiss the copyright counts, holding that an application for copyright registration is "insufficient to state a claim for copyright infringement" in the District of New Jersey, and therefore, until the plaintiff "holds a certificate of copyright registration" for the alleged infringed works, a plaintiff "cannot state a prima facie claim of copyright infringement for any of those works." *Id.* at *3.

California Holds Application Will Maintain a Lawsuit

In 2010, the U.S. Court of Appeals for the Ninth Circuit held that a copyright infringement lawsuit may be maintained as long as the copyright holder has filed an application for copyright with the U.S. Copyright Office, even if it has not yet received a copyright certificate of registration. *Cosmetic Ideas v. IAC/Interactive Corp.*, 606 F.3d 612, 621 (9th Cir. 2010). There, the court decided this issue even though by the time it set out to render its decision, the copyright holder had received a certificate of registration. (Plaintiff having received the certificate could maintain its action regardless of how the court decided the issue because "once a certificate is issued, the registration dates back to the date of application"). The court explained why it chose to decide the issue even though it was moot due to plaintiff's having obtained a certificate of registration, stating that "it is an unsettled issue of law in this Circuit, and ... it is an issue 'capable of repetition yet evading review' if the Copyright Office acts on the application during litigation." *Id.* (citations omitted).

In *Cosmetic Ideas*, the court noted that the plain language of section 411 of the Copyright Act does not give guidance because "registration" is "unhelpfully defined as 'a registration of a claim in the original or the renewed and extended term of copyright.'" *Id.* (citing text of 17 U.S.C. §101). Accordingly, the court worked to "discern" the meaning of the U.S. Copyright Act "by looking to 'the broader context of the statute as a whole' and the purpose of the statute." *Id.* at 618 (citations omitted). Among the bases for its decision are that Congress made registration optional, the Copyright Office's decision to grant or not grant registration is "largely perfunctory, and is ultimately reviewable by the courts," and the "application approach avoids delay without impairing the central goal of copyright registration," which is to provide "broad copyright protection while maintaining a robust federal register." *Id.* at 619-20, fn.13.

Issue Is Whether Complainant Has Prima Facie Case of Copyright Infringement

The Ninth Circuit in *Cosmetic Ideas* also brought to the forefront a change that year in the legitimate basis for filing a motion to dismiss a copyright infringement claim. There, defendant argued that without a registration certificate, the court lacked *subject matter jurisdiction*, and the lower court dismissed the matter on that basis (along with holding that a registration certificate was required prior to filing suit). *Id.* at 614. There the court reversed on both issues. Fast forward to the 2013 *North Jersey Media* case in the District of New Jersey, where defendant argued that without a registration certificate, plaintiff failed to assert a prima facie case for copyright infringement, not lack of subject matter jurisdiction. *N. Jersey Media Group*, at *1.

That distinction reflected a change in the law by the U.S. Supreme Court in 2010. *Cosmetic Ideas*, 606 F.3d at 614-15 (prior to 2010, motions to dismiss copyright claims where the holder failed to obtain a registration certificate were premised and sustained on the concept that the court did not have subject matter jurisdiction in the absence of a registration certificate, but that changed with the U.S. Supreme Court's decision on March 2, 2010) (citing *Reed Elsevier v. Muchnick*, 130 S.Ct. 1237 (2010) ("section 411(a)'s registration requirement ... does not restrict a federal court's subject-matter jurisdiction") (abrogating case law)).

Thus, in those districts where a registration certificate remains a requirement to maintaining a lawsuit, motions to dismiss should be premised on lack of a prima facie claim rather than lack of subject matter jurisdiction.

Conclusion

Notwithstanding the circuit split on this issue, it may be more prudent to continue to advise clients to obtain a certificate of registration even if the case is expected be filed in an application-favorable jurisdiction. For instance, if the case can be and is removed to a jurisdiction that requires a certificate of registration, the plaintiff's claim will risk dismissal. Also, the courts have not yet decided whether an "application" is enough for application of 17 U.S.C. §412, which requires "registration" as a prerequisite for certain enumerated remedies. •

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