akerman

Blog Post

Application or Registration? Eleventh Circuit Widens Circuit Split

May 22, 2017

The Eleventh Circuit has widened the circuit split on whether a copyright application or completed registration is required before filing a copyright infringement lawsuit. In *Fourth Estate Public Benefit v. Wall-Street.com*, the Eleventh Circuit held that a pending application to the Copyright Office is not sufficient. As a result, the Eleventh Circuit affirmed the Southern District of Florida's dismissal of the copyright infringement action for failure to plead compliance with the registration requirement of 17 U.S.C. § 411(a). The complaint of the plaintiff news organization had only alleged that it had filed applications to register its articles and did not allege that the Register of Copyrights had acted on its applications.

Section 411(a) of the Copyright Act states that:

> "[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."

Related People

Julia R. Lissner

Related Work

Copyrights
Intellectual Property

Marks, Works, and Secrets Blog

Akerman Perspectives on the Latest Developments in Intellectual Property Law

Visit this Akerman blog

17 U.S.C. § 411(a). The Eleventh Circuit held that "the text of the Copyright Act makes clear that ... [f]iling an application does not amount to [the] registration" required to file a copyright infringement suit. The court explained that the "Act defines registration as a process that requires action by both the copyright owner and the Copyright Office."

The Eleventh Circuit also pointed to language in sections 410(a), (b), and (d) of the Act as clearly revealing that an application alone is not enough to meet the precondition for suit. The court opined that the language shows that registration can only occur "after examination" by the Register of Copyrights. If registration occurred upon filing of the application, then the Register would have no power to "refuse registration." Specifically, the Act states:

> "(a) When, after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office....
>
> (b) In any case in which the Register of Copyrights determines that ... the material deposited does not constitute copyrightable subject matter ... the Register shall refuse registration....
>
> (d) The effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office."
>
> 17 U.S.C. § 411(a), (b), (d) (emphases added).

The question of when the requisite "registration" occurs has widely divided the circuits. The Eleventh Circuit's opinion detailed this split, as summarized below:

- 1st Circuit: acknowledged split, but declined to adopt an approach
- 2d Circuit: acknowledged split, but declined to adopt an approach
- 5th Circuit: follows the "application approach," which requires a copyright owner to plead that it has filed the application, deposit, and fee before filing suit
- 7th Circuit: contains conflicting dicta on what approach it follows or whether it has decided this question
- 8th Circuit: endorsed the "application approach" in dicta
- 9th Circuit: follows the "application approach"
- 10th Circuit: follows the "registration approach," which requires a copyright owner to plead that the Register of Copyrights has acted on the application (by either approving or denying it) before filing suit

The Eleventh Circuit's opinion also noted that it had previously "endorsed" the "registration approach" in opinions from 1990 and 2012.

Therefore, as a practice pointer, copyright owners and their attorneys should carefully consider the status of registrations and the approach taken by the jurisdiction where they wish to file their copyright infringement suits. Copyright owners should also consider seeking expedited registration – a five to 15-day process costing $800 per claim – before suit. It may also be prudent in certain circumstances for copyright owners to proactively register their works with the Copyright Office to avoid this potential obstacle to enforcing their rights.