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“REGISTRATION . . . MEANS A REGISTRATION”: A CRITIQUE OF THE NINTH CIRCUIT’S ADOPTION OF THE “APPLICATION APPROACH” TO COPYRIGHT REGISTRATION IN COSMETIC IDEAS, INC. V. IAC/ INTERACTIVECORP

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**“REGISTRATION . . . MEANS A REGISTRATION”:
A CRITIQUE OF THE NINTH CIRCUIT’S ADOPTION OF
THE “APPLICATION APPROACH” TO COPYRIGHT
REGISTRATION IN *COSMETIC IDEAS, INC. V.
IAC/INTERACTIVECORP***

*Greg Darley-Emerson**

I. INTRODUCTION

A jewelry manufacturing company created and began selling a particular costume jewelry necklace.¹ Over half a decade later, another company allegedly manufactured and sold copies of a virtually identical necklace. The first company filed for a copyright registration in an effort to protect its intellectual property, aware that such a registration is required to sue for copyright infringement.

But when is a copyright “registered?” This seemingly simple question has a surprisingly ambiguous answer. Registration of a copyright is required in order to bring an infringement action,² and a court’s determination of when registration takes effect can have significant repercussions for copyright holders seeking to enforce their rights. Federal circuit courts, however, are split regarding exactly when “registration . . . has been made.”³ Several circuit courts have found that registration occurs when the Copyright Office receives all of the applicable materials from the copyright holder.⁴ Other circuit courts have found that registration does not occur until the Register of Copyrights affirmatively approves the application and issues a certificate of registration.⁵

* Associate Member, 2010–2011 *University of Cincinnati Law Review*. The author would like to thank his editors for their feedback and suggestions, his professors for their wisdom and guidance, and his family, especially his wife, for their love and support.

1. These alleged facts are adapted from the case primarily discussed in this Note. See *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612 (9th Cir. 2010), *cert. denied*, *IAC/InterActiveCorp, v. Cosmetic Ideas, Inc.*, 131 S. Ct. 686 (2010).

2. 17 U.S.C.A. § 411(a) (West 2010) (“[N]o 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.”).

3. *Id.*

4. See *Chicago Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624 (7th Cir. 2003); *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384 (5th Cir. 1984).

5. See *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990), *abrogated in part by Reed Elsevier, Inc. v.*

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These divergent approaches may have a significant effect on the course of an infringement suit, especially in federal circuits that have not expressly considered the issue. This ambiguity may result in unfairness to litigants; a court in one circuit may allow a copyright holder's suit to proceed while a court in a different circuit may dismiss an infringement case on the exact same facts.

The Ninth Circuit's recent decision in *Cosmetic Ideas, Inc. v. IAC/Interactivecorp* widened the circuit split.⁶ The *Cosmetic Ideas* court found that a copyright registration is effective—thereby enabling the copyright holder to institute an infringement suit—when the Copyright Office receives the appropriate materials, not when the Register acts upon them.⁷

This Note argues that the *Cosmetic Ideas* court's decision was in error. Part II briefly discusses the history and substance of the Copyright Act of 1976; it also examines copyright registration decisions from federal circuit courts prior to *Cosmetic Ideas*. Part III reviews the Ninth Circuit's decision in *Cosmetic Ideas*. Part IV examines the decision in light of the plain language of 17 U.S.C. § 411(a) and related sections, the statute's legislative history, various sources of persuasive authority, and policy goals behind the Copyright Act. Part V concludes that the Ninth Circuit adopted the wrong approach to copyright registration. The section also urges the Supreme Court or Congress to clarify the meaning of "registration" under § 411(a) in order to unify United States copyright law and to resolve when a copyright holder may bring an infringement action.

II. LEGISLATIVE HISTORY AND CASE LAW

The Copyright Act of 1976 is the basis for copyright law in the United States,⁸ and § 411(a) requires that registration be made in order for an infringement action to be instituted.⁹ District and circuit courts have varied in their interpretations of this statute. Subpart A discusses the Copyright Act of 1976; subpart B discusses the circuit courts that found, prior to the Ninth Circuit's decision in *Cosmetic Ideas*,¹⁰ that copyright registration is complete upon the Copyright Office's receipt of the applicable materials (the "Application Approach"); and subpart C

Muchnick, 130 S. Ct. 1237 (2010).

6. *Cosmetic Ideas*, 606 F.3d 612.

7. *Id.* at 619.

8. 17 U.S.C.A. § 101 *et seq.* (West 2010).

9. 17 U.S.C.A. § 411(a).

10. *Cosmetic Ideas*, 606 F.3d 612.

discusses the circuit courts that have found that registration is complete only upon affirmative action by the Register of Copyrights (the "Registration Approach").¹¹

A. *The Copyright Act of 1976*

The U.S. Constitution provides the foundation for copyright law in America. Article I, § 8 grants Congress the enumerated power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."¹² The Copyright Act of 1976 (the Act or the 1976 Act)¹³ unified the confusing mix of federal and state laws regarding published and unpublished works.¹⁴ In passing the Act, Congress broadened copyright protections and eliminated some statutory formalities by recognizing that a copyright exists the moment an idea finds original expression in some tangible medium.¹⁵

Registration of a copyright is now voluntary and does not impact the protections that copyrights offer.¹⁶ In order to register a copyright, a copyright holder must submit three items to the Copyright Office: (1) an application;¹⁷ (2) a deposit (such as a photocopy) of the work;¹⁸ and (3) the appropriate fee.¹⁹

So that a robust federal register could be established, Congress created several incentives to encourage voluntary registration.²⁰ For

11. See *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1202 (10th Cir. 2005), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010). The Tenth Circuit seems to have coined the phrases "Registration Approach" and "Application Approach" in the *La Resolana Architects* opinion; this Note will use these terms to refer to these approaches throughout.

12. U.S. CONST. art. I, § 8, cl. 8. This clause is also the bedrock for America's patent laws.

13. 17 U.S.C.A. § 101 *et seq.* (West 2010).

14. See H.R. REP. NO. 94-1476 (1976), *reprinted in* 1976 U.S.C.A.N. 5659; *see also Cosmetic Ideas*, 606 F.3d at 618–19 (discussion of copyrights before and after the 1976 Act).

15. See *La Resolana Architects*, 416 F.3d at 1199; 17 U.S.C. § 102(a) (2006) ("Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression . . .").

16. 17 U.S.C. § 408(a) (2006) ("Such registration is not a condition of copyright protection."); H.R. REP. NO. 94-1476 ("[R]egistration of a claim to copyright in any work, whether published or unpublished, can be made voluntarily . . .").

17. 17 U.S.C.A. § 409 (West 2010).

18. 17 U.S.C. § 408(b) (2006).

19. 17 U.S.C.A. § 708 (West 2010).

20. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 619 (9th Cir. 2010) (Congress "chose to encourage copyright holders to register . . . through various statutory incentives."), *cert. denied*, *IAC/InterActiveCorp, v. Cosmetic Ideas, Inc.*, 131 S. Ct. 686 (2010); *La Resolana Architects*, 416 F.3d at 1204–05 ("[T]hese rights and remedies are the 'carrot' to induce registration and the 'stick' is the lack of federal court jurisdiction until registration is accomplished."), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010) (noting that registration is a precondition to suit but

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example, copyright registration enables a copyright owner to recover statutory damages and attorney's fees from an infringing party.²¹ A certificate of registration can act as prima facie evidence of the copyright's validity.²² Finally, and perhaps most importantly (and *certainly* most importantly as far as this Note is concerned), a work must be registered before a copyright owner can file an infringement action.²³

Section 411 of the 1976 Act embodies this last incentive and reads in part:

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.²⁴

In the years subsequent to the passing of the 1976 Act, Congress amended it to ensure the United States' compliance with the Berne Convention, an international copyright treaty that in part forbids the application of formalities to foreign copyright holders.²⁵ In order to join the Berne Convention, Congress established a two-tier system in which owners of U.S. copyrighted works are required to register as a precondition to an infringement suit, but owners of foreign copyrighted works are not.²⁶

Section 101 of the Act vaguely says that "[r]egistration" . . . means a registration of the claim in the original or the renewed and extended term of copyright."²⁷ This definition is unclear regarding when registration is complete so that a civil action may commence. Some

does not affect subject matter jurisdiction).

21. 17 U.S.C.A. §§ 504, 505 (West 2010).

22. 17 U.S.C. § 410 (2006).

23. 17 U.S.C.A. § 411(a) (West 2010).

24. *Id.* (emphasis added).

25. Berne Convention art. 5(1, 2), Oct. 1, 1988, 102 Stat. 2853, S. Treaty Doc. No. 99-27.

26. 17 U.S.C.A. § 411(a) ("[N]o civil action for infringement of the copyright in any United States work shall be instituted until . . . registration . . . has been made[.]" (emphasis added)).

27. 17 U.S.C.A. § 101 (West 2010).

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courts have found registration to be complete when a copyright owner's application, deposit, and fee are received by the Copyright Office;²⁸ this has been called the Application Approach. Other courts have found that registration requires an affirmative act, such as the Register's approval, the issuance of a certificate, or the receipt of a certificate;²⁹ this has been called the Registration Approach. These approaches are discussed more fully in the following subparts.

B. The Application Approach

Prior to the *Cosmetic Ideas* decision, two circuit courts and several district courts subscribed to the Application Approach³⁰—the idea that copyright "registration" is complete when the Copyright Office receives the copyright owner's application, fees, and deposit.³¹

The Fifth Circuit employed the Application Approach in *Apple Barrel Productions, Inc. v. Beard*, in which the parents of children who performed in a country music program split from the program's creator to form their own similar show.³² The creator sued for copyright infringement, and the District Court for the Northern District of Texas denied the plaintiff's motion for a preliminary injunction.³³ In finding that the plaintiff had standing for a copyright infringement action despite having not received certificate of copyright registration at the time of the injunction hearing, the Fifth Circuit wrote, "One need only prove payment of the required fee, deposit of the work in question, and receipt by the Copyright Office of a registration application."³⁴ The court gave no underlying reasons for its conclusory statement.

The Seventh Circuit has also adopted the Application Approach.³⁵ In

28. See, e.g., *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386–87 (5th Cir. 1984).

29. See, e.g., *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

30. See, e.g., *Chicago Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624 (7th Cir. 2003); *Beard*, 730 F.2d at 386–87; *Prunté v. Universal Music Group*, 484 F. Supp. 2d 32 (D.D.C. 2007); *Iconbazaar, L.L.C. v. America Online, Inc.*, 308 F. Supp. 2d 630 (M.D.N.C. 2004); *Havens v. Time Warner, Inc.*, 896 F. Supp. 141 (S.D.N.Y. 1995).

31. See also Mose Bracey, *Searching for Substance in the Midst of Formality: Copyright Registration as a Condition Precedent to the Exercise of Subject-Matter Jurisdiction by Federal Courts Over Copyright Infringement Claims*, 14 J. INTELL. PROP. L. 111 (2006) (reviewing the circuit split and recommending the Application Approach); Sara Goldfarb, Comment, *Corbis Corp. v. Amazon.com, Inc. – Needlessly Endorsing Overly Strict U.S. Registration Requirements in Copyright Infringement Litigation*, 20 ST. JOHN'S J. LEGAL COMMENT. 419 (2006) (supporting the Application Approach).

32. *Beard*, 730 F.2d 384.

33. *Id.* at 386.

34. *Id.* at 386–87 (citing 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[B][1] (1978)).

35. *Chicago Bd. of Educ.*, 354 F.3d 624.

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Chicago Board of Education v. Substance, Inc., a public school teacher, who also edited a local Chicago newspaper aimed at teachers, published the entire contents of several standardized tests in order to show that the school district was administering bad tests.³⁶ The school district sued the teacher and the publication for infringement, and the magistrate judge issued an injunction that prohibited the publication of any more tests.³⁷ Judge Posner, writing for the Seventh Circuit, found that the publication was not “fair use” but also that the injunction was overbroad.³⁸ In doing so, he dismissed as “frivolous” the defendant–infringer’s argument that the school district did not have a valid copyright registration.³⁹ In finding the registration valid, he noted that “an application for registration must be filed [with the Copyright Office] before the copyright can be sued upon.”⁴⁰ Two sentences later, however, Judge Posner hedged and said that “[h]ad the [copyright] claim been false, the registration should not have issued and maybe therefore the copyright could not have been sued upon,”⁴¹ indicating that registration may require an affirmative act by the Copyright Office, such as the issuance of a certificate.

C. The Registration Approach

At least two circuit courts and several district courts subscribe to the Registration Approach⁴²—the idea that copyright “registration” is complete only when the Copyright Office has affirmatively approved the applicant’s copyright.

The Tenth Circuit adopted the Registration Approach in *La Resolana Architects, PA v. Clay Realtors Angel Fire*,⁴³ a case in which an architecture firm discovered that a realty company was selling

36. *Id.*

37. *Id.* at 625–26.

38. *Id.* at 631–32.

39. *Id.* at 631.

40. *Id.* (citing 17 U.S.C.A. 411(a) (West 2010); NIMMER & NIMMER, *supra* note 34, § 7.16[B][1][a][i]).

41. *Id.*

42. See, e.g., *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005), *abrogated in part by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990), *abrogated in part by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010); *Mays & Assocs., Inc. v. Euler*, 370 F. Supp. 2d 362 (D. Md. 2005); *Strategy Source, Inc. v. Lee*, 233 F. Supp. 2d 1 (D.D.C. 2002); *Demetriades v. Kaufmann*, 680 F. Supp. 658 (S.D.N.Y. 1988).

43. *La Resolana Architects*, 416 F.3d 1195. By extensively discussing both the Registration and Application Approaches before adopting the Registration Approach, the opinion provides a nice yin to *Cosmetic Ideas*’s yang, which adopts the Application Approach after an equally extensive discussion.

townhouses that "looked strikingly similar" to those in architectural drawings previously produced by the firm.⁴⁴ The firm applied for copyright registration and sued for copyright infringement.⁴⁵ The District Court of the District of New Mexico dismissed the action, however, because the firm had not yet received its registration certificate.⁴⁶ After reviewing general copyright law, the plain language of the relevant statutes, the various interpretations of the statutes, and subsequent acts of Congress, the Tenth Circuit adopted the Registration Approach and affirmed the dismissal.⁴⁷ The court held that registration of a copyright under § 411(a) occurs only when the Copyright Office approves the application.⁴⁸

The Eleventh Circuit addressed the issue in *M.G.B. Homes, Inc. v. Ameron Homes, Inc.* when the plaintiff, a home builder, alleged that the defendant, a competitor, copied a home's floor plan from one of the plaintiff's advertising brochures.⁴⁹ Although the plaintiff had filed an application for copyright registration, the district court dismissed the initial case due to the plaintiff's "failure to satisfy the condition precedent of having registered its copyright before initiating the infringement action."⁵⁰ Once the Copyright Office issued the certificate, the District Court for the Southern District of Florida allowed the plaintiff to amend its complaint and proceed.⁵¹ The Eleventh Circuit approved the district court's actions, noting that the registration requirement is a jurisdictional prerequisite to an infringement suit,⁵² and

44. *La Resolana Architects*, 416 F.3d at 1197.

45. *Id.* at 1197.

46. *Id.* at 1197–98.

47. *Id.* at 1198–207; *see also* 17 U.S.C.A. §§ 408–412 (West 2010).

48. *La Resolana Architects*, 416 F.3d at 1203. Furthermore, the court found that "registration" required only the Register's approval and not necessarily the issuance or possession of a certificate, although a certificate had evidentiary value in an infringement case. *Id.* at 1207–08. In *La Resolana*, the Copyright Office had actually approved the registration but had not yet issued a certificate when the suit was filed. The district court deemed a letter from the Copyright Office saying the same inadmissible as hearsay, and because the plaintiff did not appeal the ruling, the circuit court was forced to affirm the dismissal because it had no evidence before it that showed that the work was registered. *Id.* at 1208.

49. *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990), *abrogated in part* by *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

50. *Id.* at 1488–89.

51. *Id.* at 1489. The circuit court noted the unusual procedural posture of this case: after the district court dismissed the case for lack of subject matter jurisdiction, it was technically without jurisdiction to entertain the motion to amend, and the plaintiff should have filed a new lawsuit. The circuit court, however, noted that "[i]t is too late in the day and entirely contrary to the spirit of the Federal Rules of Civil Procedure for decisions on the merits to be avoided on the basis of such mere technicalities." *Id.* (quoting *Foman v. Davis*, 371 U.S. 178, 181 (1962)).

52. *Id.* at 1488. The *Muchnick* court recently held that the registration requirement is nonjurisdictional and is instead merely a precondition to an infringement suit. *Reed Elsevier, Inc. v.*

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generally equating “registration” with the issuance of a certificate.⁵³

III. THE CASE: COSMETIC IDEAS, INC. v. IAC/INTERACTIVECORP

On May 25, 2010, the Ninth Circuit decided *Cosmetic Ideas, Inc. v. IAC/Interactivecorp* and joined the Fifth and Seventh Circuits in adopting the Application Approach to copyright registration, creating a 3–2 split among federal circuits.⁵⁴ Below, subpart A presents the facts of the case, subpart B reviews the court’s examination of the statute’s language and context, and subpart C summarizes the court’s decision and reasoning.

A. Brief Facts of Cosmetic Ideas

In *Cosmetic Ideas*, plaintiff Cosmetic Ideas, Inc. (Cosmetic) accused the defendants IAC/Interactivecorp, Home Shopping Network, Inc., HSN LP, and HSN General Partner LLC (collectively HSN) of copyright infringement.⁵⁵ Cosmetic created a costume jewelry necklace in 1997 and began selling copies in 1999.⁵⁶ Cosmetic alleged that HSN began manufacturing and selling “virtually identical” necklaces sometime between 2005 and 2008.⁵⁷ Cosmetic submitted a copyright application to the Copyright Office on March 6, 2008, and shortly thereafter received confirmation that the application had been received.⁵⁸ Cosmetic then filed a complaint against HSN on March 27, 2008, alleging copyright infringement of the necklace.⁵⁹

At the time of Cosmetic’s filing, the Copyright Office had not yet

Muchnick, 130 S. Ct. 1237, 1247 (2010). Thus, when the *M.G.B. Homes* court called the requirement a “condition precedent,” 903 F.2d at 1489, they were spot-on; when they called it a “jurisdictional prerequisite,” *id.* at 1488, they were not. The *Muchnick* court would likely consider the *M.G.B. Homes* court’s analysis a “drive-by jurisdictional rulin[g].” *Muchnick*, 130 S. Ct. at 1244 (citations omitted).

53. *M.G.B. Homes*, 903 F.2d at 1488–89 (citing *Demetriades v. Kaufmann*, 680 F. Supp. 658, 661 (S.D.N.Y. 1988) (“Receipt of an actual certificate of registration or denial of same is a jurisdictional requirement . . .”); *Int’l Trade Mgmt., Inc. v. United States*, 553 F. Supp. 402, 403 (Ct. Cl. 1982) (“A suit for copyright infringement is conditioned on obtaining (or being denied) a certificate of registration.”)) (citations omitted).

54. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612 (9th Cir. 2010), *cert. denied*, *IAC/InterActiveCorp, v. Cosmetic Ideas, Inc.*, 131 S. Ct. 686 (2010). As mentioned above, the Fifth, Seventh, and Ninth Circuits endorse the Application Approach, while the Tenth and Eleventh Circuits endorse the Registration Approach.

55. *Id.* at 613–14.

56. *Id.* at 614.

57. *Id.*

58. *Id.*

59. *Id.*

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issued a certificate of copyright.⁶⁰ HSN argued that Cosmetic did not have a valid copyright registration, and the district court granted HSN's motion to dismiss for lack of subject matter jurisdiction.⁶¹ The Ninth Circuit reversed after conducting a de novo review of the district court's statutory interpretation of the Copyright Act and finding that mere application to the Copyright Office for registration met § 411(a)'s precondition for an infringement suit.⁶²

B. The Ninth Circuit's Jurisdictional, Textual, and Contextual Examination

In determining that the Application Approach was the correct interpretation of § 411(a), the Ninth Circuit first dispensed with any jurisdictional questions. It then looked to the plain language of the statute and, finding the language ambiguous, finally turned to the overarching policy goals of the Copyright Act of 1976 and its subsequent revisions. The court's analysis of (1) its jurisdiction, (2) the statute's language, and (3) the statute's context are discussed below.

1. Jurisdictional Analysis

The Ninth Circuit Court of Appeals first addressed a jurisdictional concern. The district court dismissed the action for lack of subject matter jurisdiction, but between when the case was argued on appeal and when it was decided, the United States Supreme Court held that § 411(a)'s registration requirement was merely a precondition to filing a claim and not a restriction on a court's subject matter jurisdiction.⁶³ Therefore, the Ninth Circuit found that it had jurisdiction over the case.⁶⁴

60. *Id.* The Copyright Office did subsequently issue a certificate of copyright, and Cosmetic filed a new infringement action against HSN, which the district court stayed pending the outcome of the appeal of this case.

61. *Id.*

62. *Id.*

63. *Id.* at 614–15 (citing *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010)). *Muchnick* abrogated in part a number of the precedential cases cited by the Ninth Circuit to the extent that those cases found that § 411(a) restricted a court's subject matter jurisdiction; however, *Muchnick* did not affect determinations of when "registration" occurred (i.e., whether the courts followed an Application Approach or a Registration Approach). *Id.* at 614–615. Additionally, the Ninth Circuit recognized that the issue before the court was potentially moot as Cosmetic Ideas held a registration certificate at the time of appeal. *Id.* at 616. However, because it was an unsettled point of law that was "'capable of repetition yet evading review,'" the court addressed the issue of when copyright registration was complete. *Id.* at 616 (quoting *Gerstein v. Pugh*, 420 U.S. 103, 110 n.11 (1975) (citation omitted)).

64. *Cosmetic Ideas*, 606 F.3d at 615.

2. Plain Language of the Statute

When interpreting a statutory provision, a court begins with the statute's plain language.⁶⁵ The *Cosmetic Ideas* court began by analyzing the language of the relevant sentence of § 411(a): “[N]o civil action for infringement of the copyright in any United States work shall be instituted until pre-registration or registration of the copyright claim has been made in accordance with this title.”⁶⁶ The court found that “registration” was “unhelpfully defined” in § 101 of the Copyright Act as “a registration of a claim in the original or the renewed and extended term of copyright.”⁶⁷

Finding “no guidance” in the statutory definition,⁶⁸ the court turned to the language of the statute as a whole to determine its intended meaning and found further ambiguity.⁶⁹ In effect, it found two parts that supported the Registration Approach, one part that supported the Application Approach, and one part that could support either.⁷⁰

In support of the Registration Approach, the court found language that seemed to require affirmative action by the Register of Copyright, indicating that application alone was not enough to effect “registration.” For example, § 410(a) directs the Register, upon examination and approval, to “register the claim and issue the applicant a certificate,”⁷¹ showing that Congress meant registration to be incomplete until the Register granted approval.⁷² Section 411(a) gives an applicant the right to institute a civil infringement action when “the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused,”⁷³ indicating that the registration process is separate from the application process.⁷⁴

The Ninth Circuit, however, found that other sections of the Act

65. *Id.* (citing *K & N Eng'g, Inc., v. Bulat*, 510 F.3d 1079, 1081 (9th Cir. 2007)).

66. *Id.* at 616 (quoting 17 U.S.C.A. § 411(a) (West 2010)). The court noted that “pre-registration” was only applicable to certain commercial works that have a history of infringement prior to commercial release; the necklace at issue in this case was not one of those works. *Id.* at 616 n.6.

67. *Id.* at 616 (citing 17 U.S.C.A. § 101 (West 2010)).

68. *Id.* at 616–17.

69. *Id.* (citing *United States v. Cruz-Gramajo*, 570 F.3d 1162, 1167 (9th Cir. 2009)).

70. *Id.* at 617–18 (finding that § 410(a) and portions of § 411(a) support the Registration Approach, that § 408(a) may support the Application Approach, and that § 410(d) could be read to support either one).

71. 17 U.S.C. § 410(a) (2006) (emphasis added).

72. *Cosmetic Ideas*, 606 F.3d at 617 (“This provision places an active burden of examination and registration upon the Register, suggesting that registration is not accomplished by application alone.”).

73. 17 U.S.C.A. § 411(a) (West 2010) (emphasis added).

74. *Cosmetic Ideas*, 606 F.3d at 617 (“[T]his subsection could be read to mean that Congress intended registration to require acceptance or refusal by the Register, not mere delivery.”).

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supported the Application Approach. For example, § 408(a) states that a copyright owner “may *obtain registration . . . by delivering* to the Copyright Office” the required deposit, application, and fee,⁷⁵ indicating that mere delivery of the appropriate materials secures registration.⁷⁶

Finally, the court found that one section of that statute could support either approach. Section 410(d) provides that “[t]he 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 . . . to be acceptable for registration, have all been received* in the Copyright Office.”⁷⁷ This passage supports the Registration Approach in that the Register of Copyrights must examine the materials and deem them acceptable before the copyright’s registration date takes effect.⁷⁸ On the other hand, it may also support the Application Approach because a valid copyright’s registration takes effect on the date the materials are received by the Copyright Office, assuming that approval is granted later.⁷⁹

3. Context of the Statute

Because the Ninth Circuit Court of Appeals found that the plain language of § 411(a) and the surrounding sections did little to resolve whether “registration” of a copyright was complete upon application of materials or approval of such application, the court then looked to the context, history, and purpose of the statute.⁸⁰

It first noted that the 1976 Act differed from the 1909 Act in that it broadened its protections, increased incentives to create expressive works, and relaxed the 1909 Act’s formalities.⁸¹ The court also noted that Congress amended the 1976 Act to comply with the Berne Convention, relaxing the formalities even further.⁸² Finally, the court

75. 17 U.S.C. § 408(a) (2006) (emphasis added).

76. *Cosmetic Ideas*, 606 F.3d at 617 (“This section implies that the sole requirement for obtaining registration is delivery of the appropriate documents and fee.”).

77. 17 U.S.C. § 410(d) (emphasis added).

78. *Cosmetic Ideas*, 606 F.3d at 618 (“[T]he statute could be read to require action by the Register to effect registration.”).

79. *Id.* (noting that this section “supports the interpretation that application is the critical event”).

80. *Id.* (“We are not persuaded that the plain language of the Act unequivocally supports either the registration or application approach.”).

81. *Id.* at 618–19 (internal citations omitted). For example, the 1976 Act established copyright upon creation of the work rather than the 1909 Act’s requirement of publication, notice, registration, and deposit of the work. The 1976 Act created a unitary federal system for works both published and unpublished where the 1909 Act left the protection of unpublished works to the states. Furthermore, the 1976 Act relaxed notice requirements and eliminated mandatory registration.

82. *Id.* at 619, nn.9 & 12. The U.S. adopted amended copyright laws in 1988 in order to become

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discussed Congress's interest in maintaining a robust federal register and incentivizing registration,⁸³ and it noted that "copyright holders frequently register specifically for the purpose of being able to bring suit."⁸⁴

C. The Ninth Circuit's Decision and Reasoning

After reviewing the statute's plain language and context, the Ninth Circuit concluded that a copyright owner could bring an infringement action upon mere application for copyright registration. The court was persuaded that the Application Approach "better fulfill[ed] Congress's purpose of providing broad copyright protection while maintaining a robust federal register" for the following reasons.⁸⁵

First, the court found that the Application Approach avoided unnecessary delays in litigation. Because § 411(a) allows a copyright owner to bring suit whether the Copyright Office accepts or rejects the registration,⁸⁶ the court found no reason to force a litigant to wait for a decision that ultimately had little effect.⁸⁷ It found support in *Nimmer on Copyright*, a leading copyright treatise: "[G]iven that the claimant . . . will ultimately be allowed to proceed regardless of how the Copyright Office treats the application, it makes little sense to create a period of "legal limbo" in which suit is barred."⁸⁸

The Ninth Circuit also found that the Application Approach kept intact the various goals of the 1976 Act. For one, it maintained the incentive to register one's creative work, leading to a more robust federal register.⁸⁹ Abolishing the need to wait for the issuance of a certificate also eliminated "the type of needless formality Congress

party to the agreement. See Pub. L. No. 100-568, § 7, 102 Stat. 2853. For example, § 410(a) makes notice entirely permissive, and foreign works are not subject to § 411(a)'s pre-suit registration requirement. See also Berne Convention, art. 5(2), Oct. 1, 1988, 102 Stat. 2853, S. Treaty Doc. No. 99-27.

83. *Cosmetic Ideas*, 606 F.3d at 619 (citing H.R. REP. NO. 94-1476 (1976), reprinted in 1976 U.S.C.C.A.N. 5659). Registration is optional, but incentives associated with registration include allowing a registration certificate to be prima facie evidence of a valid copyright (§ 410(c)), making certain remedies such as statutory damages and attorney's fees available only after registration (§ 412), and requiring registration of U.S. works as a prerequisite to bringing any infringement action (§ 411(a)).

84. *Cosmetic Ideas*, 606 F.3d at 619.

85. *Id.*

86. 17 U.S.C.A. § 411(a) (West 2010) (noting that if a copyright registration is rejected, an infringement action may still proceed as long as the Register is provided with notice of the suit).

87. *Cosmetic Ideas*, 606 F.3d at 619–20.

88. *Id.* at 620 (quoting NIMMER & NIMMER, *supra* note 34, § 7.16[B][1][a][i]).

89. *Id.* The court, however, also noted that the Registration Approach preserved this goal equally well. *Id.* at 620. This Note argues below that the Registration Approach incentivizes registration even more effectively than the Application Approach.

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generally worked to eliminate in the 1976 Act."⁹⁰

According to the court, the Application Approach helps to make the judicial system more efficient.⁹¹ The possession of a certificate has no substantive impact on a copyright holder's overall right to bring a suit,⁹² and forcing litigants to wait for a registration certificate under the Registration Approach could result in the dismissal of suits that would likely be refiled in a matter of weeks or months.⁹³

Furthermore, the Application Approach protects a copyright owner from being disadvantaged by any delay inherent in the Copyright Office's processing of the application.⁹⁴ The statute of limitations for a copyright infringement suit is three years.⁹⁵ If registration did not occur until the Register issued a certificate, then copyright owners who filed for registration late in the three-year period would be penalized for any delay by the Copyright Office, potentially losing their entire right to sue.⁹⁶ If, on the other hand, registration is complete upon the Register's mere receipt of the appropriate materials, copyright holders run little risk of the statute of limitations expiring other than due to their own delay.⁹⁷

Finally, the court noted that the Register's decision did not require deference. If the Register rejects the registration of a copyright already in litigation, the Register still has an opportunity to appear regarding registrability, especially given the (slow) pace of litigation.⁹⁸ The court found the Register's decision of whether to grant a registration certificate "largely perfunctory, and . . . ultimately reviewable by the courts," lending no compelling reason for the delay of infringement litigation.⁹⁹

The Ninth Circuit ultimately adopted the Application Approach over the Registration Approach and held that the registration requirement of

90. *Id.*

91. *Id.*; see also *Brush Creek Media, Inc. v. Boujaklian*, No. C-02-3491, 2002 WL 1906620, at *4 (N.D. Cal. Aug. 19, 2002) (noting that the Registration Approach "leads to an inefficient and peculiar result").

92. *Cosmetic Ideas*, 606 F.3d at 620.

93. *Id.*

94. *Id.* at 620–21. Section 410(d) gives another protection for a timelag by making the effective date of a registration the day on which the materials are received by the Copyright Office, the date from which statutory damages may be recovered. See 17 U.S.C.A. §§ 410, 504 (West 2010).

95. 17 U.S.C. § 507(b) (2006).

96. *Cosmetic Ideas*, 606 F.3d at 620.

97. *Id.* This is especially the case given that an application for copyright registration can be made virtually instantly via the Copyright Office's online application option. See Electronic Copyright Office, www.copyright.gov/eco (last visited June 13, 2011).

98. *Cosmetic Ideas*, 606 F.3d at 621 (citing *NIMMER & NIMMER*, *supra* note 34, § 7.16[B][1][a][i]).

99. *Id.* at 621.

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§ 411(a) is fulfilled when the Copyright Office receives a completed registration application.¹⁰⁰ It found the text of the statute ambiguous and held that the Application Approach better afforded the broad protection intended by the 1976 Act, better promoted judicial economy, and better accomplished Congress's goal of compiling a robust federal register of existing copyrights.¹⁰¹ In so holding, it vacated and reversed the district court's dismissal, allowing Cosmetic Ideas's infringement claim to proceed on the merits.¹⁰²

IV. DISCUSSION

The following subparts detail how the Ninth Circuit erred in adopting the Application Approach. Subparts A and B discuss the plain language of the statute and its legislative history, respectively, and find that both support the Registration Approach. Subpart C finds that the Ninth Circuit incorrectly relied upon or ignored various sources of persuasive authority, including other federal circuit courts, the Copyright Office, and treatise authors. Finally, subpart D notes several policy reasons for adopting the Registration Approach.

A. Plain Language of the Copyright Act

The Ninth Circuit noted that “[i]n interpreting a statutory provision, [a court begins] with the plain language of the statute.”¹⁰³ The court, however, too quickly found ambiguity in § 411(a) and too quickly moved to the surrounding sections of the Act. In doing so, it failed to put the relevant clause in its proper context. The sections below examine (1) the relevant sentence of § 411(a), (2) § 411(a) as a whole, and (3) the related sections of the Copyright Act.

1. The (Most) Relevant Sentence of § 411(a)

The most relevant sentence of § 411(a) reads: “[N]o 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*.”¹⁰⁴ By moving beyond § 411(a) after simply finding that § 101 of the Act gave “no guidance”

100. *Id.*

101. *Id.*

102. *Id.* at 621–22.

103. *Id.* at 616 (citing *K & N Eng'g, Inc. v. Bluat*, 510 F.3d 1079 (9th Cir. 2007)).

104. 17 U.S.C.A. § 411(a) (West 2010) (emphasis added).

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for the definition of "registration,"¹⁰⁵ the Ninth Circuit completely ignored the last part of the sentence, which requires that registration be "made in accordance with this title."¹⁰⁶ After looking to § 101 for the definition of "registration," the appropriate next step should have been to examine the Act to determine the requirements of such registration.¹⁰⁷ In other words, the Ninth Circuit stopped at an incomplete definition of what registration *is* without proceeding to how registration is *made*, as required by § 411.¹⁰⁸

Other courts have not been so quick to make this error. The Tenth Circuit examined the Act's plain language in *La Resolana Architects* to determine when a registration has been "made in accordance with" the Copyright Act.¹⁰⁹ Citing the relevant parts of the Act, the court found that

Registration is satisfied by completing the following steps:

- a. application and payment of a fee, § 408;
- b. deposit of a copy of the copyrightable material, § 408;
- c. examination by the Register of Copyrights, § 410;
- d. registration (or refusal to register) by the Register, § 410;
- e. issuance of certificate of registration, § 410.¹¹⁰

The court went on to note that nowhere did this "series of affirmative steps by both the applicant and the Copyright Office" indicate that "mere receipt of copyrightable material" would be sufficient to establish registration under § 411.¹¹¹ Had the Ninth Circuit similarly attempted to flesh out the full meaning of § 411(a), it would have likely found that receipt by the Copyright Office of an application, a deposit, and fees was only part of a registration "made in accordance with" the Copyright Act.¹¹²

105. *Cosmetic Ideas*, 606 F.3d at 616 ("Registration' is unhelpfully defined as a 'registration of a claim in the original or the renewed and extended term of copyright.' Because the clause at issue gives no guidance in interpreting the meaning of 'registration,' we turn to the language of the statute as a whole to determine the intended meaning." (quoting 17 U.S.C.A. § 101 (West 2010)).

106. 17 U.S.C.A. § 411(a).

107. *See* *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341 (1997) ("The plainness or ambiguity of statutory language is determined by reference to the language itself, the specific context in which that language is used, and the broader context of the statute as a whole.") (citations omitted).

108. 17 U.S.C.A. § 411(a).

109. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200 (10th Cir. 2005), *abrogated in part by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

110. *Id.* (citing 17 U.S.C. §§ 408, 410 (2006)).

111. *La Resolana Architects*, 416 F.3d at 1200. The court further stated that a copyright holder is entitled to sue for infringement only after "those steps are followed and registration is 'made.'" *Id.* at 1201.

112. 17 U.S.C.A. § 411(a).

2. Section 411(a) as a Whole

Additionally, upon finding that “registration” had an ambiguous meaning as defined by § 101, the Ninth Circuit jumped immediately to examining §§ 408–412, the sections of the Act that govern copyright registration.¹¹³ Instead, it should have placed the relevant sentence in its immediate context by next examining § 411(a) as a whole.¹¹⁴

Reading the (most) relevant sentence along with the subsequent sentence is particularly illuminating:

[N]o 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.¹¹⁵

The second sentence indicates that delivery of the requisite materials and the refusal of a copyright registration are two separate acts. If *refusal* of registration is a discrete act, it then follows that its opposite, *approval* of registration, is also a discrete act. Therefore, whether a registration is refused or approved, the Register must perform an affirmative action before the applicant may file suit. The Ninth Circuit noted as much when it acknowledged that “this subsection could be read to mean that Congress intended registration to require acceptance or refusal by the Register, not mere delivery.”¹¹⁶ Plainly read together, the two sentences provide a simple roadmap for infringement litigation: (1) if the Register examines and approves a copyright’s registration, the litigant may then sue for copyright infringement with no additional steps; and (2) if the Register examines and refuses the registration, the litigant may still sue so long as he or she provides the Register with notice.

113. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 616–17 (9th Cir. 2010), *cert. denied*, *IAC/InterActiveCorp, v. Cosmetic Ideas, Inc.*, 131 S. Ct. 686 (2010). Strangely, the court looks to § 410(a) and then returns to § 411(a), which the court readily admits “contain(s) language that suggests that registration requires some affirmative steps to be taken by the Copyright Office.” *Id.* at 617. It finds no language in § 411(a), the very subsection at issue, that suggests that mere receipt of an application effects a registration, yet it finds the statute ambiguous. *Id.* at 617–18.

114. *See Robinson v. Shell Oil Company*, 519 U.S. 337, 341 (1997) (stating that determine ambiguity by “the specific context in which that language is used”).

115. 17 U.S.C.A. § 411(a) (emphasis added).

116. *Cosmetic Ideas*, 606 F.3d at 617 (citing, *e.g.*, *Strategy Source, Inc. v. Lee*, 233 F. Supp. 2d 1, 3–4 (D.D.C. 2002)) (citation omitted).

Congress used the same verb, "institut[e]," in both sentences.¹¹⁷ This redundant usage informs our understanding of Congress's intent. In general, words within the same statute should be given the same meaning.¹¹⁸ Under certain circumstances, however, the Application Approach requires two different meanings for the verb "institut[e]."¹¹⁹ Under this approach, when a registration application is submitted, a litigant may "initiate" an infringement suit; if the Register subsequently refuses to register the copyright, the suit may assumedly "continue" upon notice to the Register.¹²⁰ On the other hand, the meaning of the word "institut[e]" is static under the Registration Approach: a suit may be "initiated" upon registration approval, or it may be "initiated" upon registration refusal. Because Congress used the same word twice, it likely intended this internal consistency and did not seem to contemplate the institution of a civil action when the validity of a copyright registration was still in doubt.¹²¹ The plainest reading of the statute, the reading that gives a consistent meaning to the word "institut[e]," makes the Register a gatekeeper who must affirmatively approve or refuse a copyright registration before a litigant may initiate an infringement suit.

Furthermore, courts that have adopted the Application Approach give little credit to Congress's drafting prowess. Had Congress intended an infringement action to be able to be instituted when the Copyright Office received the appropriate application, fees, and deposit, it could have clearly written the statute as such. Indeed, it did so when describing what to do when a registration was refused.¹²² Fewer definitional acrobatics are needed when § 411(a) is read under the Registration

117. 17 U.S.C.A. § 411(a) (noting that no civil action "shall be *instituted*" until registration; upon refusal, the applicant "is entitled to *institute* a civil action" with notice to the Register (emphasis added)).

118. See *Sullivan v. Stoop*, 496 U.S. 478, 484 (1990) (presume that "identical words used in different parts of the same act are intended to have the same meaning" (internal citations omitted)); MAXWELL ON THE INTERPRETATION OF STATUTES 311-12 (Roy Wilson ed., 11th ed. 1962) (It is "reasonable to presume that the same meaning is implied by the use of the same expression in every part of the Act.").

119. Webster's Dictionary defines "institute" as "to originate" or to "initiate." WEBSTER'S THIRD NEW INT'L DICTIONARY 1171 (Philip Babcock Gove ed. 1981).

120. See 17 U.S.C.A. § 411(a). This inconsistency is particularly problematic considering that (1) this second usage (to "continue") is found nowhere in Webster's definition of "institute," and (2) the word "institute" is used in such close proximity to itself (in back-to-back sentences within the same subsection). Were Application Approach courts to apply a consistent meaning to the word "institute," they would have to read the statute as allowing the initiation of a suit upon an application for registration and then the apparent (and senseless) re-initiation of the suit upon refusal of registration. A suit cannot begin after it has already begun.

121. Put another way, Congress provided no guidance regarding what an applicant must do if registration has been refused *after* a civil suit has been instituted.

122. 17 U.S.C.A. 411(a) (discussing the situation "where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused").

Approach.

3. Other Provisions

The Ninth Circuit looked to provisions beyond § 411(a), namely § 408 and § 410, in an effort to resolve the perceived ambiguity.¹²³ Including the latter half of § 411(a) stated above, the court found four other sections relevant to when a copyright is “registered.” It effectively found that the Registration/Application Approach scorecard was 2–1–1: that § 411(a) and § 410(a) lent support to the Registration Approach; that § 408(a) lent support to the Application Approach; and that § 410(d) could support either.¹²⁴ This analysis and finding of ambiguity, however, may have been results-driven as the court just as easily could have found that all four subsections favored the Registration Approach.

The Ninth Circuit correctly noted that § 410(a) contains “language that suggests that registration requires some affirmative steps” by the Copyright Office.¹²⁵ Section 410(a) reads:

[w]hen, *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.¹²⁶

Section 410(a) clearly requires the Register’s examination and approval before a registration is complete.¹²⁷ The requirement of such an affirmative act cuts against the Application Approach, and it is difficult to understand how language that is merely arguably ambiguous elsewhere could trump the clarity of § 410(a). This view is further supported by the text of § 411(a), which seems to contemplate an approval-or-refusal regime of copyright registration, discussed above in Part IV.A.2.

The Ninth Circuit found that § 408(a) “blurs the line between application and registration and favors the application approach.”¹²⁸

123. *Cosmetic Ideas, Inc. v. IAC/Interactive*, 606 F.3d 612, 616–618 (9th Cir. 2010), *cert. denied*, IAC/InterActiveCorp, v. *Cosmetic Ideas, Inc.*, 131 S. Ct. 686 (2010).

124. *Id.*

125. *Id.* at 617.

126. 17 U.S.C. § 410(a) (2006) (emphasis added).

127. *Id.* Although the verbs are not presented sequentially in the subsection, arranging them in such a manner provides a clear roadmap for the registration process: (1) deposit, (2) examine, (3) determine, (4) register, and (5) issue.

128. *Cosmetic Ideas*, 606 F.3d at 617.

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The relevant text reads, "the owner of copyright or of any exclusive right in the work may obtain registration . . . by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified."¹²⁹ The court found that this section implied that "the sole requirement for obtaining registration is delivery of the appropriate documents and fee."¹³⁰ This reading gives short shrift to practical considerations: relevant materials must be submitted as an initial step in the process before the Register can examine and register a copyrightable work. The heading of § 408, "Copyright [R]egistration in [G]eneral,"¹³¹ also indicates that the first paragraph may simply be giving a general overview of the process rather than describing the nuts-and-bolts of the process found in subsequent sections.¹³² Given the heading, it is appropriate to read subsection (a) as being a general outline that merely indicates the materials that the Register will need in order to grant a registration.

Finally, the Ninth Circuit found that § 410(d) could be read to support either the Registration Approach or the Application Approach. The section reads, "[t]he 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 . . . to be acceptable for registration, have all been received in the Copyright Office."¹³³ The court noted that the back-dating supported the view "that application is the critical event,"¹³⁴ but it also found that "the statute could be read to require action by the Register to effect registration."¹³⁵

The court, however, took no notice of the fact that § 410(d) uses the phrase "effective date." None of the sections discussing registration as a precondition to bringing an infringement suit uses the phrase "effective date," but one other section notably does: § 412.¹³⁶ Section 412 describes "certain remedies" such as statutory damages and attorney's

129. 17 U.S.C. 408(a) (2006).

130. *Cosmetic Ideas*, 606 F.3d at 617. Although the court found that the text implied adherence to the Application Approach, it cited (but did not discuss) a contrary district court case from within its own circuit. *Id.* (citing and overruling *Ryan v. Carl Corp.*, No. C-97-3873, 1998 WL 320817, at *3 (N.D. Cal. June 15, 1998) (noting that § 408(a) means "merely that the delivery of the application is a step the applicant must take, not that delivery is sufficient by itself to obtain a registration") (citations omitted)).

131. 17 U.S.C. § 408.

132. The heading of a section may be used to resolve ambiguities in a statute. *See* SUTHERLAND, 2A STATUTES AND STATUTORY CONSTRUCTION § 47:14 (Norman Singer ed., 7th ed. 2007) ("[W]here the meaning of the act is ambiguous, . . . the headings may serve as an aid to legislative intent.").

133. 17 U.S.C. § 410(d) (2006).

134. *Cosmetic Ideas*, 606 F.3d at 618.

135. *Id.*

136. 17 U.S.C.A. § 412 (West 2010). The heading of § 412 reads "Registration as a prerequisite to certain remedies." *Id.*

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fees that are only available for infringement occurring after the effective date of registration.¹³⁷ The Act quite clearly describes how to determine the effective date¹³⁸ and how it affects infringement remedies.¹³⁹ The plain language of the statute, however, gives no indication regarding the effective date's effect on the registration itself or on when an infringement action may be instituted. Because the effective date of registration is described in § 410(d), ignored in § 411(a), and referenced in § 412, the most sensible interpretation is that the effective date is only relevant to remedies and not to the institution of an infringement suit. The back-dating that created ambiguity in the Ninth Circuit's determination of registration¹⁴⁰ turns out to be irrelevant to the discussion of § 411.

After noting two sections that supported the Registration Approach,¹⁴¹ the Ninth Circuit observed that “[o]ther sections of the Act, however, cast doubt on this interpretation.”¹⁴² The court's doubts were unfounded, however. As described above, both §§ 408(a) and 410(d), are entirely consistent with the Registration Approach, which can and should be adopted based on the plain language of the Copyright Act.¹⁴³

B. Legislative History

In addition to disregarding the plain language of § 411(a), the Ninth Circuit's adoption of the Application Approach also ignored the statute's legislative history. The report of the House Judiciary Committee¹⁴⁴ clearly contemplated the retention of an active role by the Register of Copyrights while giving copyright holders the right to sue should their registration be refused.

Section 411's precondition of registration was not unique to the Copyright Act of 1976.¹⁴⁵ As one commentator wrote, “[T]he

137. *Id.* See also 17 U.S.C.A. §§ 504, 505 (West 2010) (describing possible damages and attorney's fees, respectively).

138. 17 U.S.C. § 410(d) (“The effective date of a copyright registration is the day on which an application, deposit, and fee . . . have all been received in the Copyright Office.”).

139. 17 U.S.C.A. § 412 (“[N]o award of statutory damages or of attorney's fees . . . shall be made for . . . any infringement of copyright commenced after first publication of the work and before the effective date of its registration . . .”).

140. See *Cosmetic Ideas*, 606 F.3d at 618.

141. *Id.* at 617 (finding that §§ 410(a) and 411(a) “contain language that suggests that registration requires some affirmative steps”).

142. *Id.*

143. See 17 U.S.C.A. §§ 408–12 (West 2010).

144. H.R. REP. NO. 95-1476 (1976), reprinted in 1976 U.S.C.C.A.N. 5659.

145. 17 U.S.C.A. § 101 *et seq.* (West 2010).

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requirement that the registration formality be complied with as a prerequisite to the institution of an infringement action has been a feature of federal U.S. copyright law since 1790."¹⁴⁶ The first federal copyright act in 1790 required the deposit of a copy of the work with the clerk of the local district court.¹⁴⁷ Section 12 of the 1909 Act (later renumbered to Section 13) retained the registration requirement as a prerequisite to suit.¹⁴⁸

In 1956, the Second Circuit addressed the prerequisite of registration under the 1909 Act.¹⁴⁹ In *Vacheron*, the federal district court judge rejected a wrist watch designer's copyright registration, finding that a watch was not a "work of art" under the 1909 Act.¹⁵⁰ Because the 1909 Act "forbade any action for infringement of the copyright when the Register of Copyrights had refused, as he did, to accept the watch as copyrightable under § 5(g)," the Second Circuit held that the infringement action had been properly dismissed.¹⁵¹ Furthermore, the court found that the prerequisite of "registration" required affirmative action by the Register.¹⁵²

When Congress passed the Copyright Act of 1976, the House Judiciary Committee wrote that the purpose of the first sentence of § 411(a) was to "restat[e] the present statutory requirement that registration must be made before a suit for copyright infringement is instituted," while the purpose of the second and third sentences were to "alter the present law as interpreted in *Vacheron*."¹⁵³ In other words, the 1976 Act did not disturb the registration requirement of the 1909 Act, which had long been interpreted as requiring affirmative action by the

146. WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 17:64 (2010). The author also notes that § 411(a) is "remarkably like" the 1710 Statute of Anne, England's original copyright statute. *Id.* § 17:64.10 (citing 8 Anne c. 19 §§ 1:5-9 (1710)).

147. *Id.* § 17:64.30 ("[N]o person shall be entitled to the benefit of this act . . . unless he shall first deposit, and in all other cases, unless he shall before publication deposit a printed copy of the title of" the work. (quoting Act of May 31, 1790, 1 Stat. 124, § 3)).

148. *Id.* § 17:64.40 ("No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with." (citing Act of March 4, 1909, 60th Cong., 2d Sess.)).

149. *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958).

150. *Id.* at 638-39 (noting that copyrightable subject material includes "'works of art; models or designs for works of art'" (quoting 17 U.S.C. § 5(g) of the Copyright Act of 1909)).

151. *Id.* at 639 (citing 17 U.S.C. § 13 of the 1909 Act).

152. *Id.* at 640-41 (The Act "denies the right to sue for infringement 'until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with,' and that imports more than the mere 'deposit of copies.' Since the owner must submit an application and pay the required fees in order to make a deposit, . . . we can think of no other added condition for 'registration' but acceptance by the Register." (quoting 17 U.S.C. §§ 13, 202.3(b))).

153. H.R. REP. NO. 94-1476, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5773.

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Register of Copyrights. The only alteration Congress intended to make was to allow a litigant whose registration had been refused by the Register to bring an infringement suit so long as notice is served on the Register, who may then choose to join the suit on the issue of registrability.¹⁵⁴

Furthermore, the legislative history of § 410 indicates that registration requires an affirmative action by the Register of Copyrights. The House Judiciary Committee noted that “[t]he first two subsections of section 410 set forth the two basic duties of the Register of Copyrights with respect to copyright registration: (1) to *register* the claim and *issue* a certificate if the [application is approved], and (2) to *refuse* registration and *notify* the applicant if the” application is rejected.¹⁵⁵ This report shows that Congress envisioned the Register taking an active role. Read in conjunction with the text of § 411(a), which requires that registration be “made in accordance with this title,”¹⁵⁶ it seems clear that registration is “made” by actions of the Register, not merely by actions of the applicant; indeed, it is one of the “two basic duties” of the Register.¹⁵⁷ The process envisioned by Congress seems clear: the Register will receive the materials, examine them, and then either register or refuse the claim. The Application Approach is incompatible with this simple reading of the statute, of the history of the Act, and of Congress’s intent.

C. Misplaced Reliance on Persuasive Authority

In following the Application Approach, the Ninth Circuit misread or ignored several sources of persuasive authority. The next sections will examine (1) its overstatement of the circuit split, (2) its snub of the Copyright Office, and (3) its selective and uncritical use of commentators.

1. Misreading the Circuits

The Ninth Circuit rather cavalierly noted that its sister circuits were evenly split, two to two, between the Application and the Registration Approaches. It simply noted that “the Fifth and Seventh Circuits have adopted the application approach,”¹⁵⁸ and that “[t]he Tenth and Eleventh

154. *See id.* (“Under section 411, a rejected claimant who has properly applied for registration may maintain an infringement suit if notice of it is served on the Register of Copyrights.”).

155. *Id.* (emphasis added).

156. 17 U.S.C.A. § 411(a) (West 2010).

157. H.R. REP. NO. 94-1476.

158. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 616 (9th Cir. 2010) (citing *Apple*

Circuits have adopted the registration approach."¹⁵⁹ It made no analysis, however, of the relative strength of the holdings. In particular, the Seventh Circuit's purported adoption of the Application Approach is suspect.

The chosen approaches of several of the circuits are unambiguous. The Fifth Circuit endorses the Application Approach.¹⁶⁰ The Tenth and Eleventh Circuits, on the other hand, clearly endorse the Registration Approach.¹⁶¹ Additionally, prior to *Cosmetic Ideas*, the Tenth Circuit had been the only circuit court to provide a detailed analysis of the two approaches.¹⁶²

The position of the Seventh Circuit, however, is not as clear. In *Chicago Board of Education v. Substance, Inc.*, the alleged infringer argued that the school board did not have a valid copyright registration on the tests that the defendant published.¹⁶³ Writing for the Seventh Circuit, Judge Posner said:

Although a copyright no longer need be registered with the Copyright Office to be valid, *an application for registration must be filed* before the copyright can be sued upon. In its application for registration the school board claimed to have a copyright in the entire contents of the tests. Had the claim been false, *the registration should not have issued* and maybe therefore the copyright could not have been sued upon.¹⁶⁴

Barrel Prods., Inc. v. Beard, 730 F.2d 384, 386–87 (5th Cir. 1984); *Chicago Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003)), *cert. denied*, IAC/InterActiveCorp, v. Cosmetic Ideas, Inc., 131 S. Ct. 686 (2010).

159. *Cosmetic Ideas*, 606 F.3d at 616 (citing *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1202–04 (10th Cir. 2005), *abrogated in part by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1489 (11th Cir. 1990), *abrogated in part by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010)).

160. *See Apple Barrel Prods.*, 730 F.2d at 386–87. Parroting the general requirement of § 408 without offering any analysis of § 411(a), the Fifth Circuit noted that as a precondition to a copyright infringement, one merely needs to prove “payment of the required fee, deposit of the work in question, and receipt by the Copyright Office of a registration application,” but not actual possession of a registration certificate. *Id.* (citing *NIMMER & NIMMER*, *supra* note 34, § 7.16[B][1]).

161. *See M.G.B. Homes*, 903 F.2d at 1488–89 (dismissing an action for “failure to satisfy the condition precedent of having registered its copyright before initiating [an] infringement action” after an application had been filed but before a registration certificate had been received); *La Resolana Architects*, 416 F.3d at 1205 (noting that the Copyright Act requires “actual registration by the Register of Copyrights” and not “mere submission of a copyright application” before an infringement action may be instituted).

162. *La Resolana Architects*, 416 F.3d at 1201–05. As stated above, the court then adopted the Registration Approach. *Id.* at 1205.

163. *Chicago Bd. of Educ.*, 354 F.3d at 631.

164. *Id.* (citations omitted) (emphasis added). Judge Posner then mused in parentheses, “(Or maybe yes, because *the copyright would have been registered*, and because the statute requires only a refused registration, which might be the equivalent of an improper registration, not an actual registration, as the premise for the suit. We need not decide.)” *Id.*

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Judge Posner may be adopting the Application Approach, requiring only that “an application . . . be filed.”¹⁶⁵ He also says, however, that for a false or improper application, “the registration should not have been *issued*,”¹⁶⁶ indicating that an affirmative action by the Copyright Office is required. In the end, the Seventh Circuit did not expressly rule on whether the Registration or the Application Approach should be adopted.¹⁶⁷ Furthermore, Judge Posner’s analysis seemed to conflate application, registration, and issuance, which muddied the waters even further.¹⁶⁸ Therefore, the Seventh Circuit’s position is not as clear as the Ninth Circuit makes it out to be, and it certainly does not stand on the same strong foundation of reasoning as does the Tenth Circuit’s adoption of the Registration Approach in *La Resolana Architects*.¹⁶⁹ Had the Ninth Circuit conducted a more thorough analysis of the circuit split, it might have been persuaded to endorse the Registration Approach in *Cosmetic Ideas*.¹⁷⁰

2. Ignoring the Copyright Office’s Own Interpretation

In deciding *Cosmetic Ideas*, the Ninth Circuit completely ignored the Copyright Office’s own interpretation of when registration is complete.¹⁷¹ Although a legislative office’s interpretation of a statute is not binding on a court, the Copyright Office’s reading of § 411(a) should hold at least some persuasive value.

The Copyright Office is a service unit of the Library of Congress, which in turn is an agency of the legislative branch of the government.¹⁷² At least one of the Copyright Office’s own publications plainly adopts the Registration Approach. Copyright Circular 10 reads, “the Copyright Office must have acted on your application before you

165. *Id.*

166. *Id.* (emphasis added).

167. Although Judge Posner dismissed the alleged infringer’s argument as “frivolous,” his reasoning on this point did not rest on when a copyright registration is effective. Instead, he found that any test questions that the plaintiff did not directly author would likely be considered “works made for hire” so that “the school board would have owned the copyright anyway.” *Id.*

168. *See id.* (“Although a copyright no longer need be registered with the Copyright Office to be valid, an application for registration must be filed before the copyright can be sued upon. . . . Had the claim been false, the registration should not have issued . . .”).

169. *La Resolana Architects, PA v. Clay Realty Angel Fire*, 416 F.3d 1195 (10th Cir. 2005), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

170. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612 (9th Cir. 2010), *cert. denied*, *IAC/InterActiveCorp, v. Cosmetic Ideas, Inc.*, 131 S. Ct. 686 (2010).

171. *Id.*

172. U.S. COPYRIGHT OFFICE, CIRCULAR 1A, A BRIEF INTRODUCTION AND HISTORY (2010), *available at* <http://www.copyright.gov/circs/circ1a.html>.

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can file a suit for copyright infringement."¹⁷³ As the sentence discusses the precondition required to file an infringement lawsuit, it seems to be directly addressing § 411(a). The phrase "must have acted on" indicates that mere receipt of an application by the Copyright Office is not sufficient to effect a "registration" under the preconditions of § 411(a). Instead, an affirmative act by the Office is required, such as examination followed by approval or rejection.¹⁷⁴

The Copyright Office is directly under Congress's control. If Congress were unhappy with the Copyright Office's adoption of the Registration Approach, Congress could have instructed the Copyright Office to change its approach, amended the statute to add clarity, or done both. By taking no action, Congress has tacitly approved of the Registration Approach, indicating that the approach is in line with its intent in passing § 411(a).

3. Copyright Commentators

Throughout its decision to adopt the Application Approach, the Ninth Circuit leans on the persuasive authority of "the leading treatise on copyright," *Nimmer on Copyright*.¹⁷⁵ Other commentators, however, flatly reject Nimmer's reasoning and advocate the Registration Approach.¹⁷⁶

William F. Patry, author of *Patry on Copyright*, writes that the courts that have adopted the Application Approach "were led astray by Nimmer."¹⁷⁷ Patry continues, "Nimmer's view is not an interpretation of the statute: it is a flagrant disregard of the statute, its legislative history, its statutory history, in short, every evidence of Congress's intent."¹⁷⁸ He goes on to criticize Nimmer's disregard of the plain

173. U.S. COPYRIGHT OFFICE, CIRCULAR 10, SPECIAL HANDLING (2010), available at <http://www.copyright.gov/circs/circ10.pdf>.

174. It may also be noted that Circular 10 was revised in the same month (May, 2010) as the Ninth Circuit's decision in *Cosmetic Ideas* (May 25, 2010), indicating that this is the Office's most current thinking, even in light of the circuit split that existed prior to *Cosmetic Ideas*.

175. *Cosmetic Ideas*, 606 F.3d 612, 620 (9th Cir. 2010) (citing NIMMER & NIMMER, *supra* note 34). The court found Nimmer's reasoning persuasive on several points: (1) Because a plaintiff will ultimately be allowed to proceed with a suit regardless of the Copyright Office's approval or rejection, "it makes little sense to create a period of 'legal limbo' in which suit is barred." *Id.* at 620 (quotation and citation omitted). (2) Delay by the Copyright Office may lead to the expiration of the statute of limitations, "occasion[ing] complete inability to recover damages." *Id.* (3) "[T]he pace of litigation entails that the Copyright Office will typically have granted or refused registration during [an infringement suit's] pendency," enabling the Register to join a suit should it choose to do so following the rejection of an application. *Id.* at 621 (quotation and citation omitted).

176. See PATRY, *supra* note 146, § 17:78.

177. *Id.*

178. *Id.* In the same section, Patry also points out, "Tellingly, the Solicitor General of the United

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language and structure of § 411(a), Nimmer's misplaced reliance on and misreading of § 410,¹⁷⁹ and Nimmer's purported inversion of the registration process.¹⁸⁰ Patry clearly feels that the Registration Approach is both the better approach and the one required both by the plain text of the statute and by Congress's intent.

While Nimmer is admittedly the leading commentator on copyright law, wise men may be wrong.¹⁸¹ Patry makes a compelling argument both for his case and against Nimmer's regarding the correct interpretation of § 411. Because the Ninth Circuit cited Nimmer without examining his argument,¹⁸² the court may be lumped in with others who "were led astray by Nimmer."¹⁸³

D. The Registration Approach Best Meets Policy Concerns

The Ninth Circuit adopted the Application Approach in part because the court believed that the Application Approach better fulfilled desirable policy goals such as broad copyright protection, a robust federal register, fairness, and conservation of judicial resources.¹⁸⁴ The court, however, failed to recognize that the Registration Approach fulfilled these policy goals as well as or better than the Application Approach. The following four sections address the Registration

States rejected Nimmer's theory in her amicus brief to the Supreme Court in the *Reed Elsevier* case." *Id.* (referencing *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010)).

179. *Id.* § 17:78 ("Nimmer's reading of section 410 was undertaken . . . not to illuminate the meaning and purpose of section 411(a), but to subvert it.").

180. *Id.* ("[W]hile the Copyright Office does not grant copyrights, only the Copyright Office 'makes' registration of a claim to copyright within the meaning of section 411(a). Nimmer inverts the state by having the applicant effectively 'make' the registration.").

181. For example, before the U.S. Supreme Court decided *Reed Elsevier v. Muchnick*, Nimmer wrote, "registration is a condition precedent for a court to exercise jurisdiction in an infringement case," NIMMER & NIMMER, *supra* note 34, § 7.16[B][1][a] (Rel. 78-5/2009), while noting in a footnote that "a minority view treats these matters [of registrations] are [*sic*] prerequisites for claim-processing, not as strictly jurisdictional." *Id.* § 7.16[B][1][a], n.38.3a. The U.S. Supreme Court agreed with the "minority view." *Reed Elsevier*, 130 S. Ct. 1237, 1247 (2010) ("Section 411(a) thus imposes a type of precondition to suit that supports nonjurisdictional treatment."). Nimmer's treatise has since been revised. See NIMMER & NIMMER, *supra* note 34, § 7.16[B][1][a] (Rel. 82-8/2010) ("Registration is a condition precedent for an infringement case to move forward in federal court.").

182. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 620, 621 (9th Cir. 2010), *cert. denied*, *IAC/InterActiveCorp. v. Cosmetic Ideas, Inc.*, 131 S. Ct. 686 (2010).

183. PATRY, *supra* note 146, § 17:78; see also Ann Bartow, *The Hegemony of the Copyright Treatise*, 73 U. CIN. L. REV. 581, 583 (2004) (noting that while *Nimmer on Copyright* and treatises in general "can be quite valuable, their impact on the law can actually be negative if they are too heavily and unquestioningly relied on").

184. *Cosmetic Ideas*, 606 F.3d at 621 ("This interpretation ensures the broad copyright protection that the 1976 Act provided[,] . . . accomplishes the central purpose of registration—the compilation of a robust national register of existing copyrights—and at the same time avoids unfairness and waste of judicial resources.").

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Approach in relation to the policy goals of (1) a robust federal register, (2) fairness, (3) judicial economy, and (4) the relaxation of formalities.

1. Robust Register

Congress incentivized copyright registration with the goal of maintaining a robust federal register, finding such a register "useful and important to users and the public at large."¹⁸⁵ The Ninth Circuit found that this goal "is accomplished equally by the registration and application approaches."¹⁸⁶ In reality, however, this is likely not correct, as the Registration Approach may encourage more copyright holders to register their works, leading to a more robust register than one under an Application Approach regime. As the *Cosmetic Ideas* court noted, "copyright holders frequently register specifically for the purpose of being able to bring suit."¹⁸⁷ Presumably, copyright holders whose works are being infringed would like to bring suit as soon as possible in order to stop the infringement. By requiring the issuance of a certificate as a precondition of an infringement suit, the Registration Approach, in effect, incentivizes early registration by disincentivizing registration at the time of infringement.

The Application Approach gives little incentive for early registration in general and no incentive at all for the registration of non-infringed works. Considering the minimal time, effort, and money required to apply for a copyright registration, copyright holders suffer little if they wait until infringement occurs before applying for a registration under the Application Approach; they will be able to bring suit as soon as the Register receives the materials.¹⁸⁸ Consequently, if the Application Approach gains widespread acceptance among the federal circuits, it is conceivable that the future bulk of the federal register will consist only of infringed works. In sum, the Application Approach gives little reason to register non-infringed works and imposes little penalty for delaying registration until they are in fact infringed, doing little to achieve Congress's goal of a robust register.

On the other hand, under the Registration Approach the copyright holder will suffer an inevitable delay between the time of registration application and approval while the Register receives and examines the

185. *Id.* at 619 n.10 (quoting H.R. REP. NO. 94-1476 (1976)).

186. *Id.* at 620.

187. *Id.* at 619.

188. This process will usually be complete within just a few days—while the application, deposit, and fees are in the mail (or fewer, using the online submission process).

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copyright application.¹⁸⁹ Should infringing activity occur during this time, the infringer can continue to profit from the wrongful activity while the copyright holder awaits approval of his or her registration. While this by itself seems unjust, a copyright holder can avoid this frustration by applying for registration soon after the copyrightable work is created and before infringement occurs.¹⁹⁰ Doing so will increase his likelihood of holding a registration certificate at the time of infringement, enabling the copyright holder to sue immediately. Of course, it is inevitable that infringement of only some of these works will occur, resulting in the registration of both infringed and non-infringed works as well as a more robust federal register.

2. Fairness

The Ninth Circuit felt as though the Application Approach “avoid[ed] unfairness”¹⁹¹ by allowing a litigant to bring suit almost immediately rather than being forced to endure a prolonged period of infringement.¹⁹² The court also feared that the Registration Approach could lead to the expiration of the statute of limitations while the copyright holder awaits a decision by the Register of Copyrights.¹⁹³ It found that “[o]nly the application approach fully protects litigants from any disadvantage caused by this timelag.”¹⁹⁴ The court’s fears, however, were unfounded and overstated, and they can be fully addressed and resolved by the Registration Approach.

First of all, given that the plain language and legislative history of § 411(a) contemplate affirmative action by the Register before an infringement suit may be instituted,¹⁹⁵ it is unclear how requiring a

189. As discussed below, the copyright holder will not ultimately be harmed by this time lag, as the effective date of registration (and therefore the date from which statutory damages may be recovered) is the date that the application was received by the Copyright Office. See 17 U.S.C.A. §§ 410(d), 412 (West 2010).

190. As an additional incentive to register a work early in its lifecycle, a registration certificate constitutes prima facie evidence of the copyright’s validity only if registration was made before or within five years of the first publication of the work. 17 U.S.C. § 410(c) (2006). If registration occurs outside this window (for example, in response to infringement occurring six years after publication), then the certificate will be awarded evidentiary weight according to the discretion of the court. *Id.*

191. *Cosmetic Ideas*, 606 F.3d at 621.

192. *Id.* at 620 (“The application approach avoids this legal limbo—and avoids prolonging the period of infringement—by allowing a litigant to proceed with an infringement suit as soon as he has taken all of the necessary steps to register the copyright at issue.”).

193. *Id.* at 620–21.

194. *Id.*

195. See 17 U.S.C.A. § 411(a) (West 2010); see also *supra* Part IV.A.3 regarding “effective date” and remedies.

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litigant to fulfill a precondition to filing a lawsuit is in any way "unfair." Copyright protection and enforcement are the results of legislative grace.¹⁹⁶ Registration is a statutory requirement of an infringement action, no different than the filing of a complaint or the service of process.

The court is also unclear on why forcing a litigant to endure a period of alleged infringement is necessarily unfair. The Registration Approach penalizes a copyright holder's inaction in terms of time and mental frustration, but not in terms of the ultimate damages that the copyright holder will be entitled to receive. Section 410(d)'s backdating provision makes the effective date of registration the date on which the Copyright Office receives the application, deposit, and fee,¹⁹⁷ and statutory damages and attorney's fees can be awarded for any infringement occurring after this effective date.¹⁹⁸ Therefore, the copyright holder will be able to recover for any damages incurred while the Register processes the application.

Finally, when proposing the "worst-case scenario" in which a copyright holder loses the ability to sue due to the running of the statute of limitations,¹⁹⁹ the court neglected to acknowledge the Copyright Office's "Special Handling" option. While a registration certificate may normally take up to several months to issue, an applicant may elect to pay an extra fee for "Special Handling," which is "the expedited processing of an online or paper application for registration of a claim to copyright."²⁰⁰ It is available in limited circumstances or for compelling reasons, one of which is "pending or prospective litigation."²⁰¹ This

196. In general, the United States does not recognize "moral rights" of authors and treats copyrights purely as personal property that may be freely transferred. *See, e.g.,* Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1, 2-3 (1985) ("The 1976 Act does not purport to protect the creator, but rather the copyright owner. Nevertheless, a creator, regardless of whether he holds the copyright in his work, has a personal interest in preserving the artistic integrity of his work and compelling recognition for his authorship. In many European and Third World nations personal rights are protected by a legal doctrine commonly known as the moral right."). Visual artists, however, are offered some protection regarding their reputation and distortions of their work, even if the artist does not own the work's copyright. *See* 17 U.S.C. § 106A(a) (2006); Edward J. Damich, *The Visual Artists Rights Act of 1990: Toward a Federal System of Moral Rights Protection for Visual Art*, 39 CATH. U. L. REV. 945 (1990).

197. 17 U.S.C. § 410(d) (2006).

198. 17 U.S.C.A. § 412 (West 2010). Additionally, a copyright holder remains entitled to recover actual damages for any infringement that occurred before the effective date of registration. 17 U.S.C.A. § 504 (West 2010).

199. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 620 (9th Cir. 2010), *cert. denied*, *IAC/InterActiveCorp, v. Cosmetic Ideas, Inc.*, 131 S. Ct. 686 (2010).

200. U.S. COPYRIGHT OFFICE, CIRCULAR 10, SPECIAL HANDLING 1 (2010), *available at* <http://www.copyright.gov/circs/circ10.pdf>.

201. *Id.* Other circumstances include "customs matters, or contract or publishing deadlines that necessitate the expedited issuance of a certificate." *Id.*

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request can be quickly made online, and “[o]nce a request for special handling is received and approved, every attempt is made to process the claim . . . within five working days.”²⁰²

Therefore, a copyright holder who is nearing the end of the statute of limitations may expedite registration through the “Special Handling” procedure. As the Copyright Office aims roughly for a one-week turnaround time,²⁰³ the applicant should suffer little delay in being able to file an infringement suit. Additionally, the large “Special Handling” fee²⁰⁴ further incentivizes early application so that the fee can be avoided, which should in turn bolster the number of works registered with the Copyright Office. While it is true that the Application Approach might allow the copyright holder to file an infringement action perhaps a week or two earlier, this small benefit to the copyright holder is offset and overshadowed by the furtherance of Congress’s goal of maintaining a robust federal register.²⁰⁵

3. Judicial Efficiency

The Ninth Circuit found that the Application Approach “‘best effectuate[s] the interest of justice and promote[s] judicial economy.’”²⁰⁶ However, in its desire to “avoi[d] . . . waste of judicial resources,”²⁰⁷ the court did not properly consider the ways in which the Registration Approach also promotes as much or more judicial economy.

According to the Ninth Circuit, the Application Approach avoids unnecessary delays that put the copyright holder in a “period of ‘legal limbo’ in which suit is barred,”²⁰⁸ but a copyright holder need not endure a prolonged period of infringement before bringing suit. As

202. *Id.*

203. *Id.* (“within five working days”).

204. Copyright Fees, <http://www.copyright.gov/docs/fees.html> (last visited June 13, 2011) (fee currently \$760 per expedited claim).

205. Courts should also discourage copyright holders who have notice of infringement from sleeping on their rights. A copyright holder who waits until the end of the three year period to register would be similarly disadvantaged as one who waits two years and 364 days to talk to his or her lawyer, as it will take time for the lawyer to draft and file a complaint. The statute of limitations exists to encourage prompt action by a litigant and fairness to the opposition.

206. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 621 (9th Cir. 2010) (quoting *Int’l Kitchen Exhaust Cleaning Ass’n v. Power Washers of N. Am.*, 81 F. Supp. 2d 70, 72 (D.D.C. 2000), *cert. denied*, *IAC/InterActiveCorp, v. Cosmetic Ideas, Inc.*, 131 S. Ct. 686 (2010)).

207. *Id.* (“‘Nothing is better settled than that statutes should receive a sensible construction, such as will effectuate the legislative intention, and, if possible, so as to avoid an unjust or an absurd conclusion.’” (quoting *Lau Ow Bew v. United States*, 144 U.S. 47, 59 (1892))).

208. *Id.* at 619–20 (“[G]iven that the claimant . . . will ultimately be allowed to proceed regardless of how the Copyright Office treats the application, it makes little sense to create a period of ‘legal limbo’ in which suit is barred.” (quoting *NIMMER & NIMMER*, *supra* note 34, § 7.16[B][1][a][i])).

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described in the previous section,²⁰⁹ pre-infringement registration or the “Special Handling” option will minimize any period of “legal limbo.”²¹⁰ Given these options, a copyright holder should be able to sue immediately or, upon receiving notice of infringement and exercising the “Special Handling” registration option, after only a short time.

The Ninth Circuit also thought that the requirement of waiting for approval or rejection of a copyright registration was a “needless formality”²¹¹ that led to an “inefficient and peculiar result.”²¹² A court that adopts the Registration Approach, however, will ultimately save judicial resources as it will have to entertain fewer motions, amendments, and arguments.²¹³ A clear adoption of the Registration Approach will result in litigants whose copyright registrations have been either affirmatively approved or rejected by the Copyright Office, resulting in a clear litigation strategy. The Application Approach, on the other hand, may lead to several inefficiencies during the course of litigation.

For example, assume that a jurisdiction follows the Application Approach and allows suit to be filed before a registration certificate has actually been issued. Even if the registration is eventually approved, the plaintiff will not have a registration certificate to use as prima facie evidence of a valid copyright,²¹⁴ resulting in more arguments, more

209. See *supra* Part IV.D.2.

210. *Cosmetic Ideas*, 606 F.3d at 620 (citing *NIMMER & NIMMER*, *supra* note 34, § 7.16[B][1][a][i]).

211. *Id.*

212. *Id.* (quoting *Brush Creek Media, Inc. v. Boujaklian*, No. C-02-3491, 2002 WL 1906620, at *4 (N.D. Cal. Aug. 19, 2002)). The *Cosmetic Ideas* court found that it “makes little sense to dismiss a case (which will likely be refiled in a matter of weeks or months) simply because the Copyright Office has not made a prompt decision that will have no substantive impact on whether or not a litigant can ultimately proceed.” *Id.* at 620.

213. Inefficiencies arise when the approach to copyright registration in a given court or jurisdiction is not known, especially in jurisdictions that adopt the Registration Approach. For example, in *M.G.B Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990), a copyright holder brought suit after applying for a copyright registration but before receiving it. *Id.* The trial court, applying the Registration Approach, dismissed the case for failure to satisfy the registration precondition. *Id.* at 1489. M.G.B. then filed an amended copyright registration application with the Copyright Office, and upon being issued a certificate of registration, M.G.B. filed a motion to amend its original complaint, which the court granted over jurisdictional objections of the defendant. *Id.* The circuit court noted that the more appropriate course of action would have been for the plaintiff to file a new complaint once it received the certificate, it found that allowing the case to proceed was within the spirit of the Federal Rules of Civil Procedure and supported by case law. *Id.* at 1488–89. Had the jurisdiction clearly adopted the Registration Approach, M.G.B. would have waited to file suit until the registration certificate had been received, avoiding the unnecessary motions, amendments, and confusion.

214. 17 U.S.C. § 410(c) (2006) (“In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded

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motions, and more time of the court's consumed.²¹⁵ Furthermore, if the Copyright Office issues the certificate after litigation is begun, the plaintiff will likely amend the complaint to reflect this fact, which, depending on the stage of the proceeding, may change the evidentiary burdens of the parties.²¹⁶

On the other hand, suppose that in the same Application Approach jurisdiction the Copyright Office rejects an application for copyright registration after litigation has already begun. The plaintiff must then notify the Register of the intention to proceed with the infringement action, and the Register will then have the option of joining regarding the issue of registrability of the copyright claim.²¹⁷ Therefore, the action has now added parties (potentially the Register), added issues (copyright validity in addition to the copyright infringement), and added time (the Register may appear within sixty days of service).²¹⁸ Alternatively, upon learning that the registration was refused, the plaintiff may find the infringement battle to be too onerous and decide to drop suit altogether, resulting in a needlessly-filed-and-dropped lawsuit. Either way, judicial resources are unnecessarily consumed.

In effect, because various burdens and litigation strategies ultimately hang on the Register's decision to approve or deny the registration, the Application Approach itself creates a period of "legal limbo"²¹⁹ that affects not just the plaintiff but all parties, the Register, and the court. This "waste of judicial resources"²²⁰ can easily be avoided by the clear adoption of the Registration Approach. When a plaintiff is forced under the Registration Approach to wait until a copyright is either approved or rejected by the Copyright Office, the course of litigation is more obvious and more efficient.

the certificate of a registration made thereafter shall be within the discretion of the court.").

215. The Ninth Circuit noted that the absence of prima facie evidence may actually be a boon to the defendant, as the plaintiff will bear a higher evidentiary burden of proving the validity of its copyright. *Cosmetic Ideas*, 606 F.3d at 621 n.14. It did not note the extra time and resources consumed by this higher burden, however.

216. See *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1205 (10th Cir. 2005) ("[T]he Application approach allows for shifting entitlements" that "would generate uncertainty in copyright litigation that the Act was designed to moderate."), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

217. 17 U.S.C.A. § 411(a) (West 2010).

218. *Id.*

219. This period of "legal limbo" continues between the institution of a suit following the submission of an application to the Copyright Office and the affirmative action of the Register.

220. *Cosmetic Ideas*, 606 F.3d at 621.

4. Formalities and Accordance with the Berne Convention

Section 411(a) imposes the formality of registration on copyright holders of U.S. works who wish to bring an infringement suit, regardless of whether a court adopts the Registration Approach or the Application Approach. According to the Ninth Circuit, "[t]he registration approach's added requirement of affirmative approval or rejection before suit thus amounts to little more than just the type of needless formality Congress generally worked to eliminate in the 1976 Act."²²¹ Congress, however, did not "eliminate" formalities with the 1976 Act; it merely reduced them.²²² Since the passage of the 1976 Act, it has reduced them even further to make the United States a party to the Berne Convention, and in doing so it has expressly considered and retained the registration requirements of § 411(a).

In 1988, Congress amended § 411(a) of the Copyright Act and created a two-tier system in which registration is a precondition to infringement suits for United States works but not for foreign works.²²³ In seeking to reduce the formalities associated with registration and infringement actions, Congress expressly considered dispatching with the registration requirement altogether out of concern that "'section 411(a) . . . is incompatible with Article 5(2) [of the] Berne [Convention].'"²²⁴ The House of Representatives rejected the Senate's proposed modification that the registration precondition be eliminated completely,²²⁵ and the ultimate amendment of § 411(a) retained the registration formality for U.S. works but not for foreign works.²²⁶ In 1993, Congress again considered a proposal that eliminated the registration requirement; the proposal did not pass.²²⁷

As Congress has considered and rejected several proposals that would eliminate the formality of copyright registration altogether, Congress clearly intends for some level of formality to remain intact. Both the

221. *Id.* at 620.

222. For example, registration is a precondition to an infringement suit, and a deposit must be made with the Library of Congress in order to effect such registration.

223. 17 U.S.C.A. § 411(a) (noting that copyright registration is a precondition for a "civil action for infringement of the copyright in any *United States* work") (emphasis added).

224. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1205 (10th Cir. 2005) (quoting S. REP. NO. 100-352, 14, *reprinted in* 1988 U.S.C.A.A.N. 3706, 3719), *abrogated in part by* *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

225. *Id.* at 1205 ("The House passed bill left current law intact, finding that current recordation and registration are not formalities prohibited by Berne." (quoting 134 CONG. REC. 10091, 10095 (1988))).

226. 17 U.S.C.A. § 411(a).

227. *La Resolana Architects*, 416 F.3d at 1206 (citing Copyright Reform Act of 1993, H.R. 897, 103d Congress (1993) (rewriting §§ 410 and 411 to eliminate the registration precondition)).

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Application and Registration Approaches require the formalities of an application, a deposit, and a fee before the institution of an infringement action. While the Registration Approach adds the additional formality of the Register's approval, nothing indicates that Congress finds the first three formalities acceptable but rejects the fourth. Congress has had multiple opportunities to amend the statute with the express intention of reducing formalities, but has instead chosen to leave the substantive language of § 411(a) intact.

The Registration Approach is consistent with the intention of the 1976 Act, its subsequent amendments, and the Berne Convention. The two-tiered system for U.S. and foreign works may be a bit unwieldy and arguably undesirable, but it is what Congress has created. If Congress found affirmative action by the Copyright Register prior to the institution of an infringement suit to be a "needless formality,"²²⁸ Congress could have eliminated it by amending the statute; however, it has not. Instead, Congress has decided that in order for a U.S. copyright holder to gain the incentivized benefits of copyright registrations, the holder must also suffer some formalities, one of which is—or at least should be—the Register's approval or rejection of a registration application.

V. CONCLUSION

In *Cosmetic Ideas v. IAC/Interactivecorp*, the Ninth Circuit erred in adopting the Application Approach to copyright registration within the meaning of § 411(a) of the Copyright Act.²²⁹ In doing so, the court disregarded Congress's language and intent and substituted its own judgment for what American copyright law should be.

The Registration Approach, which requires affirmative action by the Register of Copyrights before an infringement action may be instituted, is better supported by the plain language of the statute and its legislative history. Furthermore, the Ninth Circuit's reliance on persuasive authority was suspect. Finally, the Registration Approach supports policy goals such as a robust federal register, fairness, judicial efficiency, and accordance with international treaties as well as or better than the Application Approach.

Nimmer wrote, "In some sense, the dispute between the registration and application approaches is a tempest in a teapot."²³⁰ In practice, a

228. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 620 (9th Cir. 2010), *cert. denied*, *IAC/InterActiveCorp, v. Cosmetic Ideas, Inc.*, 131 S. Ct. 686 (2010).

229. *Id.*

230. NIMMER & NIMMER, *supra* note 34, § 7.16[B][3][b][v].

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jurisdiction's approach may have little effect on the overall impact on the outcome of an infringement suit. A suit filed prematurely (that is, before a registration certificate has been issued) in a jurisdiction that follows the Registration Approach will likely be merely dismissed; the copyright holder can probably refile in a matter of weeks or months. The Copyright Office's Special Handling procedure can expedite registrations that are filed near the end of the statute of limitations. Due process, however, mandates that citizens have notice of the laws that govern them. While no one has apparently argued that § 411(a) is unconstitutionally vague, the statute has eluded a consistent interpretation.

Clarity can come in one of two ways. First, the U.S. Supreme Court could grant certiorari to an appeal regarding the proper interpretation of § 411(a). The Court, however, seems to have little interest in doing so; it recently denied certiorari to IAC/Interactivecorp's petition despite the widening circuit split.²³¹

Second, Congress could amend the Copyright Act to give clarity to the meaning of "registration." For example, it might change the text of § 101 to indicate that "registration" requires the Register's affirmative approval.²³² Congress could also amend the text of § 411(a) to show (even more clearly than it already does) that registration as a precondition to an infringement suit requires more than the Copyright Office's mere receipt of the applicable materials.²³³

Whatever the source of the change, the Registration Approach is better supported by the history and current language of § 411(a). It also better serves the overall policy goals of the Copyright Act of 1976, which was adopted to bring consistency to copyright actions, rights, and remedies nationwide. With the text, history, and policy goals in mind, the Supreme Court or Congress should adopt the Registration Approach and give guidance to copyright holders and courts contemplating copyright infringement actions.

231. IAC/Interactivecorp v. Cosmetic Ideas, Inc., 131 S. Ct. 686 (2010).

232. It might read that registration "means a registration of the claim *affirmatively granted by the Register of Copyrights* in the original or the renewed and extended term of the copyright" (emphasized text added to original text of 17 U.S.C. § 101).

233. Part of 17 U.S.C. § 411(a) could be amended to read "no civil action for infringement of the copyright in any United States work shall be instituted until *an application for preregistration or registration of the copyright claim has been made in accordance with this title and has been approved by the Register of Copyrights*" (emphasized text added to original text of § 411(a)). Alternatively, to parallel the structure of the next sentence of § 411(a), it might read, "where the deposit, application and fee required for preregistration or registration of a United States work have been delivered to the Copyright Office in proper form and registration has been approved, the applicant is entitled to institute a civil action for infringement."