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Cases of Note--Register Your Copyright Without Delay

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Now it's Your Turn to Talk ...

It is important to hear from librarians about Google Books, because in the end, the essential question to be answered is whether the Google Books project has been worth all the effort to create it (and to fight about it). So, I would like to know what you have to say on the following questions:

Is Google Books being used by libraries and library patrons in a productive (and proper way)?

Is the world (at least the library world) a better place for its creation?

Share your answers with the author at <whannay@schiffhardin.com>. 🌱

Endnotes

1. **Mr. Hannay** is a partner in the Chicago-based law firm **Schiff Hardin LLP** and an Adjunct Professor at **IIT/Chicago-Kent** law school. He is a regular speaker at the **Charleston Conference** and a contributor to *Against the Grain*.
2. *Authors Guild et al. v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015).
3. On October 4, 2012, the **Association of American Publishers** and **Google** announced that they had settled the publishers' part of the Google Books litigation. See <http://www.publishers.org/press85/>. The settlement provides access to publishers' in-copyright books and journals digitized by **Google** for its Google Library Project. Other terms — including monetary payments, if any — were not disclosed.
4. 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994).
5. *Authors Guild v. HathiTrust*, 755 F.3d 87, 95 (2d Cir. 2014).

Cases of Note — Register Your Copyright Without Delay

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LA RESOLANA ARCHITECTS, PA. V. CLAY REALTORS ANGEL FIRE AND ANGEL FIRE HOME DESIGN. UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT. 416 F.3d 1195; 2005 U.S. App. LEXIS 15319.

This is about that oddity of the author having copyright when the work is fixed in a tangible medium but having to register before suit can be brought.

La Resolana Architects met with **Clay Realtors** to discuss building townhouses at the famous Angel Fire, New Mexico ski resort. Architectural drawings were shown that were done specifically for the site, but no agreement was reached. This was in 1996-97.

In 2003, an architect from **La Resolana** was at the site and noticed a very similar set of townhouses being sold by **Clay**. Teeing up for a lawsuit, **La Res** applied to register their copyright, sent in apps, fees, etc. Before confirmation of the registration, **La Res** filed suit.

Clay moved for dismissal because **La Res** lacked a certificate of copyright registration. **La Res** replied all the stuff had been received, and copyright was approved for registration on Jan. 22, 2004.

Why do lawyers do these kind of delaying things? Do they imagine the other side will get bored and go away?

The district court held for **Clay**. And up we go to the Tenth Circuit.

So which is it?

Subject matter jurisdiction gives a court power to adjudicate a case. The **1976 Copyright Act** merged a confusing mix of state and federal law into a single and exclusive Federal system. All state law was preempted.

Protection was made easier by granting it the moment an original idea “leaves the mind” and is put into a tangible medium. See 17 U.S.C. § 102(a) (“Copyright protection subsists ... in original works of authorship fixed in a tangible medium”).

Registration

Registration is simple. Provide a copy of the work, an application and a fee. The Register of Copyrights then checks the work to determine if it is copyrightable. If it is, then “the Register shall register the claim and issue to the applicant a certificate of registration.” 17 U.S.C. § 410(a).

But the protection is always there from that moment of tangible medium. “[R]egistration is not a condition of copyright infringement.” 17 U.S.C. § 408(a). In fact, registering is entirely voluntary.

But if you want to sue ...?

The big benefit of registering is you are allowed to sue in federal court for infringement. 17 U.S.C. § 411(a). And the certificate of registration serves as prima facie evidence of the copyright's validity.

Now, about our case ...

“[N]o action for infringement of the copyright ... shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.”

And even if the registration has been refused, you may still sue with a copy of the complaint served on the Register of Copyrights. *Id.* 411(a).

The word “preregistration” was added in 2005. But this was not part of the statute when this action was filed.

Nothing in the language even suggests that receipt by the Copyright Office is sufficient. Registration is not automatic. It can be refused. You must have registration or refusal before filing suit. And you're trying to establish your prima facie case for copyright.

But despite the plain language ...

Gosh darn it, the courts are divided between the “Registration approach” and the

“Application approach.” The Registration approach can be found in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 640-41 (2d Cir. 1958). And there's the nice “the examination would be meaningless if filing and registration were synonymous.” *Robinson v. Princeton Review, Inc.*, 1996 U.S. Dist. LEXIS 16932.

But **Mel Nimmer** and various courts think application is sufficient. After all, the owner can sue whether the application is rejected or not. See **Melville B. Nimmer, Nimmer on Copyright**, Vol. 2 § 7.16[B][1][a], p. 7-154-56. See also, *Lakedreams v. Taylor*, 932 F.2d 1103, 1108 (5th Cir. 1991).

They note that an infringer can run amok while the Copyright Office sifts through piles of applications. The owner can sue and move towards a court date while waiting for the certificate.

And yet ...

Do you really need a paper certificate to sue? The fact of registration can exist before the certificate goes out. And it's the fact of registration that gives the court jurisdiction.

Nonetheless ...

The Tenth Circuit sticks with the registration requirement. The creative soul ought to get busy and register without waiting for someone to infringe.

Plus you could have the odd circumstance of presumption of validity upon application, then have the

certificate refused, and the presumption flips back.

And they affirm the dismissal of the complaint.

And the billable hours go up for lawyers. 🌱

