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## The US Experience with Copyright Formalities: A Love/Hate Relationship

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## **THE US EXPERIENCE WITH COPYRIGHT FORMALITIES: A LOVE/HATE RELATIONSHIP**

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**The US Experience with Copyright Formalities:  
A Love/Hate Relationship**

Jane C. Ginsburg \*

*Abstract*

Copyright formalities – conditions precedent to the existence or enforcement of copyright, such as provision of information about works of authorship that will put the public on notice as to a work’s protected status and its copyright ownership, or deposit of copies of the work for the national library or other central authority, or local manufacture of copies of works of foreign origin – have performed a variety of functions in US copyright history. Perhaps of most practical importance today, formalities predicate to the existence or enforcement of copyright can serve to shield large copyright owners who routinely comply with formalities from the infringement claims of smaller copyright owners, particularly individual authors, who may lack the information or resources systematically to register and deposit their works.

This article will first define “formalities,” and then will consider their conceptual foundations. Next, it will examine the U.S. experience with formalities, from the first copyright statute of 1790 to the present. Finally, it will consider whether and how the beneficial, information-providing role of formalities might be achieved, without engendering forfeitures of protection or posing practical impediments to meaningful enforcement of copyright.

**Introduction**

Given calls, such as those expressed in some recent copyright scholarship, for a return of copyright formalities,<sup>1</sup> a reality check might be in order. The United States has

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\* Morton L. Janklow Professor of literary and artistic property law, Columbia University School of Law. This article is based in part on a report to the Association Littéraire et Artistique Internationale (ALAI) at its June 17, 2009 Congress; the report was in turn based in part on a lecture given April 20, 2009 at the University of Rome 1 La Sapienza, “Protezione del pubblico o trappola per gli autori, le formalità nella concezione e nella pratica del diritto d’autore.” I am grateful to Professors Laura Moscati and Paolo Spada for their comments. Thanks also to David Carson, Esq. and to Professors Lionel Bently, Jessica Litman, R. Anthony Reese, and to Professors Joanna Manning and David Williams and the participants in the University of Auckland Faculty of Law faculty workshop. Many thanks for research assistance to Mark Musico, Columbia Law School Class of 2011.

had *de jure* or *de facto* mandatory copyright formalities for over 200 years: Does our experience serve as an inspiration or as a cautionary tale?

Copyright formalities – conditions precedent to the existence or enforcement of copyright, such as provision of information about works of authorship that will put the public on notice as to a work’s protected status and its copyright ownership, or deposit of copies of the work for the national library or other central authority, or local manufacture of copies of works of foreign origin – have performed (or are thought to have performed) a variety of functions in US copyright history. First, formalities that condition the existence or enforcement of copyright on supplying information about works of authorship should enable effective title searching, thus furthering the economic interests both of copyright owners and of potential exploiters.<sup>2</sup> Second, copyright-constitutive formalities, principally notice of copyright, but also at various times deposit, registration and renewal, erect a barrier to the existence of protection, concomitantly casting into the public domain published works that fail to comply. These formalities thus (at least in theory) have divided works of perceived economic significance worth the effort of compliance from the mass of other creations, leaving the latter free for others to exploit. Third, formalities with whose compliance protection depends entail additional results, probably intended, and in any event certainly foreseeable. US manufacturing requirements, introduced when the US at last extended copyright to works of foreign origin,<sup>3</sup> served not only local labor interests, but also consigned to the public domain foreign works whose authors were unaware that US protection for works of foreign creators required the employment of local printers and artisans. Thus, the international copyright protection that Congress belatedly gave with one hand, it may have placed substantially out of reach with the other.<sup>4</sup> Finally, and perhaps of most practical importance today, formalities predicate to the existence or enforcement of copyright can serve to shield large copyright owners who routinely comply with formalities from the infringement claims of smaller copyright owners, particularly individual authors, who may lack the information or resources systematically to register and deposit their works.

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<sup>1</sup> See Stef van Gompel, *Formalities in the digital era: an obstacle or opportunity?* (proceedings of the ALAI Annual Congress, London, England, June 14-17, 2009), available at <https://www.alai2009.org/programme.aspx>; see also sources cited, *infra* note 9.

<sup>2</sup> Formalities thus can serve to alleviate the transaction costs of what Prof. Molly van Houweling has called “atomistic copyright.” See Molly Shaffer van Houweling, *Author Autonomy and Atomism in Copyright Law* 55-56 (August 12, 2009) (unpublished manuscript), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1422016](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1422016).

<sup>3</sup> An act to amend title sixty, chapter three, of the Revised Statutes of the United States, relating to copyrights, 26 Stat. 1106 (1891), sec. 3 (“Provided That in the case of a book, photograph, chromo or lithograph, the two copies of the same required to be delivered or deposited as above shall be printed from type set within the limits of the United States, or from plates made therefrom, or from negatives, or from drawings on stone made within the limits of the United States, or from transfers made therefrom”).

<sup>4</sup> The manufacturing clause applied to all books, periodicals, lithographs and photo-engravings, including those by US authors. See 17 U.S.C. § 15 (1909 Act, repealed). For a summary of the complexities of the 1891 and 1909 Act manufacturing clauses, starkly illustrating the many pitfalls for foreign, and even some domestic, authors, see R.R. BOWKER, *COPYRIGHT, ITS HISTORY AND LAW* 153-61 (1912). See also Elizabeth K. Dunne, *Study No. 20, Deposit of Copyrighted Works* (1960), reprinted in 1 *STUDIES ON COPYRIGHT* 409, 425 (Arthur Fisher Mem. Ed., 1960) (“It was found almost impossible for foreign authors, writing in a foreign language, to complete negotiations for the publication of an American edition of their work (as required by the manufacturing clause) prior to publication abroad.”)

Confiscatory formalities, long lamented in US copyright commentary,<sup>5</sup> have now garnered favor in some quarters, particularly with respect to exploitations on the Internet. One hundred years after the 1908 Berlin Act of the Berne Convention confirmed the automatic vesting of international copyright by forbidding the imposition of copyright-constitutive or enforcement-predicate formalities on foreign Berne member works, most countries have also ceased to require compliance by local authors as well. With formality-free initial protection, any work created, no matter how trivial (so long as minimally “original”), automatically enjoys enforceable exclusive rights in every country of the Berne Union. Protection thus “subsists”<sup>6</sup> even for casual communications, and even though the author may not be a professional creator, and hence may be unaware of or indifferent to any copyright in her work.<sup>7</sup> On the other hand, the Internet has put vast amounts of formal and informal copyrighted content at the *de facto* (if not *de jure*) disposal of countless users. A clash between users disinclined, or practically unable, to clear rights, and the subsisting rights of authors may seem inevitable. The relaxation of formalities is also evoked as a cause of “orphanage” of works: were registration required, then right holders might more easily be found.<sup>8</sup>

Hence the current vogue for “reformatizing copyright,”<sup>9</sup> to return to the author or right holder the burden of asserting claims to copyright, and thereby to enlarge the public domain with works whose authors do not “care” sufficiently about to mark off their ownership.<sup>10</sup> In other words, the draconian features of U.S. formalities, once seen as deplorable, now in some respects are celebrated. Whether or not a return to the copyright-confiscatory function of formalities is desirable, the United States’ Berne obligations would forbid it from imposing a reformatized regime on foreign works. Berne’s reservation of domestic protection in the country of origin<sup>11</sup> would, however, permit the United States to reinstate formalities with respect to U.S. works. While, as we will see, the US has applied a “two-tier” approach to certain enforcement-predicate

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<sup>5</sup> See, e.g., Shira Perlmutter, *Freeing Copyright From Formalities*, 13 CARDOZO ARTS & ENT. L.J. 565 (1995); Irwin Karp, *A Future Without Formalities*, 13 CARDOZO ARTS & ENT. L.J. 521 (1995). Arthur Levine, *The End of Formalities: No More Second-Class Copyright Owners*, 13 CARDOZO ARTS & ENT. L.J. 553 (1995).

<sup>6</sup> See 17 U.S.C. § 102(a) (“Copyright protection subsists in original works of authorship fixed . . .”).

<sup>7</sup> One may, however, dispute the indifference of non professional authors to the subsistence of copyright in their works. To the extent that the use of Creative Commons icons serves as a guide, most users affix icons denoting a reservation of copyright control over their works, for example, with over 3/4 of persons posting photographs to Flickr adopting the “non commercial” and/or “no derivative works” directions. See Flickr, at <http://www.flickr.com/creativecommons/>.

<sup>8</sup> Lawrence Lessig, Op-Ed., *Little Orphan Artworks*, N.Y. TIMES, May 20, 2008, at A23; David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139 (2009). See also, WORLD INTELLECTUAL PROPERTY ORGANIZATION, STANDING COMMITTEE ON COPYRIGHT AND RELATED RIGHTS, THIRTEENTH SESSION, SURVEY OF NATIONAL LEGISLATION ON VOLUNTARY REGISTRATION SYSTEMS FOR COPYRIGHT AND RELATED RIGHTS, DOC. SCCR/13/2 4-6 (Nov 9, 2005) (discussing relationship of formalities to orphan works).

<sup>9</sup> See, e.g., Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STANFORD L. REV. 484 (2004); James Gibson, *Once and Future Copyright*, 81 NOTRE DAME L. REV. 167 (2005), David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139 (2009).

<sup>10</sup> *But see supra* note 7.

<sup>11</sup> Berne Conv. art. 5(3) (“Protection in the country of origin is governed by domestic law.”).

formalities, a return to conditioning the existence or persistence of copyright on compliance with formalities so significantly increases the discrimination against local creators as to be politically problematic. Moreover, given the ease in the digital era with which the country of origin can be manipulated,<sup>12</sup> it is not even clear that a two-tier regime will in fact burden any but the least informed and least affluent local creators.

This article will first further define “formalities,” and then will consider their conceptual foundations. Next, it will examine the U.S. experience with formalities, from the first copyright statute of 1790 to the present. Finally, it will consider whether and how the beneficial, information-providing role of formalities might be achieved, without engendering forfeitures of protection or posing practical impediments to meaningful enforcement of copyright.

## **I. Formalities in Theory and in Practice: Theory**

### **A. What are, and are not, “formalities”?**<sup>13</sup>

In the sense of the Berne Convention, the formalities that art. 5(2) prohibits member States from imposing on foreign authors include “everything which must be complied with in order to ensure that the rights of the author with regard to his work may come into existence.”<sup>14</sup> Thus requirements such as registration, the deposit or filing of copies, the payment of fees, or the making of declarations or affixing notices to copies of the work, may not be made mandatory preconditions to protection. But State-imposed preconditions on the coming-into-being of the author’s rights represent only part of the Berne-targeted formalities. An author may be *vested* with copyright, but unable to *enforce* her rights unless she complies with a variety of prerequisites to suit. Hence the addition by the 1908 Berlin Act of the word ‘exercise’, so that then-article 4(2) (now art. 5(2)) read: “The enjoyment and exercise of these rights shall not be subject to any formality.”<sup>15</sup> This wording was designed to cover any provision in Member-state law that, as distinct from making the recognition of an author’s rights contingent upon compliance with some formality, made the bringing of proceedings to enforce these rights subject to a formality (perhaps even the same ones as required for the existence of protection). For example, the obligation the US Copyright Act imposed on authors to register their works with the Copyright Office as a prerequisite to initiating an infringement action was deemed inconsistent with the article 5(2) prohibition on subjecting the exercise of rights to compliance with formalities.<sup>16</sup>

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<sup>12</sup> See 17 U.S.C. § 101 (definition of “United States work” for purposes of § 411 – pre-suit registration requirement; if the work is first published outside the US in another Berne member State and not simultaneously published in the US, it is not a “US work”); Berne Conv. art. 3(4). (definition of country of origin; “simultaneous” publication occurs within 30 days of first publication)

<sup>13</sup> Portions of this section have been adapted from SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND, ¶¶ 6.102-6.105 (2006).

<sup>14</sup> See *Actes de la Conférence internationale pour la protection des droits d’auteur réunie à Berne du 8 au 19 Septembre 1884* 43 (1884), discussed in RICKETSON & GINSBURG, *supra* note 13, ¶ 6.102 (2006).

<sup>15</sup> Berne Conv. art. 5(2).

<sup>16</sup> See *Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, reprinted in 10 COLUM.-VLA J.L. & ARTS 513, 569-574 (1986). The 1988 Berne Convention Implementation Act

Nonetheless, not every record-keeping or even litigation-related obligation a State imposes should be considered a Berne-banned “formality.” For example, Berne does not require the suspension of local rules of evidence or procedure applicable to all judicial proceedings; it targets only copyright-specific measures.<sup>17</sup> Thus, a foreign copyright holder cannot assert that art. 5(2) dispenses her from paying court fees that attach to the filing of any kind of claim, but she may object to payment of a fee imposed only on the bringing of a copyright action.

It is also necessary to distinguish between local rules that condition the validity or scope of a grant of rights on the formalization of an agreement to transfer rights under copyright and rules that limit the exercise of those rights independently of their ownership. The first class of rules – which may include such requirements as that the transfer be in writing, that it be signed by the author, and that the scope of the grant be clearly articulated – are generally designed to protect authors from ignorant or improvident transfers.<sup>18</sup> The rationale and the effect of this kind of author-protective formalism are profoundly different from public-protective formalities, such as notice or registration, or copyright-specific litigation hurdles, which seek to shield the public from authors’ claims. In the former instance, the formal rules tell us *who* is entitled to enforce a copyright whose existence the rules do not call into question. In the latter instance, the formalities limit *any* copyright claimant’s enforcement, and may destroy the copyright altogether. The difference between *who* owns rights under a copyright, and *whether* a copyright exists or can be enforced, is crucial to determining whether the obligation under scrutiny is a Berne-barred “formality.” Immediately below, and in Part III, we will address the consequences of the distinction for the achievement of some of the public-regarding goals of formalities, through the development of a reliable means of title-searching.

The characterization as “formalities” of three other copyright-pertinent obligations – recordation of transfers, deposit of copies for the Library of Congress, and

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accordingly lifted the requirement for non-US Berne works, but retained it for US works. See Jane C. Ginsburg & John M. Kernochan, *102 Years Later: The US Joins the Berne Convention*, 13 COLUMBIA-VLA JOURNAL OF LAW & THE ARTS 1, 13 (1988). The Act did not, however, alter the “incentives” to register, such as according prima facie evidentiary value to registrations made within five years of publication, and conditioning the availability of statutory damages and attorneys fees on registration before the occurrence of the infringement, or within three months of publication, 17 USC secs. 410(c), 412. See S. Rep. No. 100-352, 100<sup>th</sup> Cong. 2d sess. at 14 (1988) (“while these provisions substantially enhance the relief available to the proprietor of a registered work, they do not condition the availability of all meaningful relief on registration, and therefore are not inconsistent with Berne”).

<sup>17</sup> See, e.g., CLAUDE MASOUYÉ, WIPO GUIDE TO THE BERNE CONVENTION, ¶ 5.5 (1978); *U.S. Adherence to the Berne Convention: Hearings Before the Subcomm. on Patents, Copyrights, and Trademarks of the Senate Comm. on the Judiciary*, 99<sup>th</sup> Cong. 72 (1987) (statement of Donald C. Curran, the Assoc. Librarian of Congress and Acting Register of Copyrights, Copyright Office).

<sup>18</sup> See, e.g., 17 U.S.C. § 204(a) (transfers of exclusive rights require a writing signed by the grantor); Code de la propriété intellectuelle art. L131-2 (Fr.) (“The performance, publishing and audiovisual production contracts defined in this Title shall be in writing.”); Code de la propriété intellectuelle art. L131-3 (Fr.) (“Transfer of authors’ rights shall be subject to each of the assigned rights being separately mentioned in the instrument of assignment and the field of exploitation of the assigned rights being defined as to its scope and purpose, as to place and as to duration.”).

conditioning certain remedies on registration - warrants examination. The U.S. has since 1802 required that transfers of copyright ownership be recorded. Most enactments of this requirement have not made it a condition to enforcement of the copyright; rather, the penalty for failure to record has been invalidity of the transfer in the event of a subsequent bona fide purchase, which the later transferee does record.<sup>19</sup> Because this obligation addresses who may assert copyright ownership, rather than whether the copyright exists or may be enforced, a general recordation requirement, carrying the same sanctions as those accompanying duties to record other kinds of property, for example, title to land,<sup>20</sup> would not seem inconsistent with Berne art. 5(2).

By contrast, making recordation a prerequisite to suit, as the US briefly did between the implementation of the 1976 Copyright Act and the enactment in 1988 of amendments to conform to Berne Convention minima,<sup>21</sup> presents a more difficult question. Such a prerequisite does condition the exercise of copyright on compliance with an obligation to supply information to a government authority. But, as indicated earlier, a “formality” is copyright-specific. If recordation of transfers of title were a prerequisite to assertion of property rights in general, then one might contend that a recordation requirement should be viewed no differently than, for example, general court costs (as opposed to special copyright litigation fees), which we have already posited are Berne-permissible. If, however, recordation of title is not generally mandated, a copyright recordation prerequisite might still survive Berne scrutiny, on the ground that the requirement concerns who may exercise the rights, rather than whether they may be enforced at all.

The obligation to deposit copies for the national library does not violate the Berne prohibition so long as the penalty for failure to deposit is not tied to the existence or enforcement of copyright. Berne does not prevent member States from requiring authors to subsidize a member State’s national library by in effect taxing the local publication of foreign authors’ works; thus, a member State may demand deposit and may impose fines for failure to comply, so long as any sanctions do not compromise the existence or enforceability of the copyright.

Finally, conditioning certain remedies on registration of the work<sup>22</sup> may be problematic. Arguably, so long as a Berne Member State leaves basic claims for injunctive relief and statutory damages unencumbered by formalities, it may limit the availability of enhanced remedies, such as statutory damages, to compliance with

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<sup>19</sup> See Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075 (repealed 1976); Act of Feb. 3, 1831, ch. 16, 4 Stat. 436 (amended 1870); Act of July 8, 1870, ch. 230, 16 Stat. 198 (repealed 1909).

<sup>20</sup> See, e.g., N.Y. REAL PROP. LAW § 291 (McKinney 2006) (“Every such conveyance [of real property] not so recorded is void as against any person who subsequently purchases . . . the same real property . . . in good faith and for a valuable consideration, from the same vendor or assignor, his distributees or devisees, and whose conveyance, contract or assignment is first duly recorded . . .”); *Miller v. Hennen*, 438 N.W.2d 366 (Minn. 1989) (purchaser who first recorded the sale of real property prevails against previous purchaser who did not record).

<sup>21</sup> See 17 U.S.C. § 205(d) (repealed).

<sup>22</sup> See 17 U.S.C. § 412 (pre-infringement registration of work a prerequisite to obtaining statutory damages and attorneys fees), discussed *infra* Part II.C.2.



registration or other obligations.<sup>23</sup> However, “the difference between a permissible conditioning of an *enhanced* remedy, and an impermissible conditioning of an *effective* remedy may not always be apparent, thus making the distinction a delicate one in practice.”<sup>24</sup>

## B. Conceptual and historical underpinnings

This section will set the question of copyright formalities on the broader stage of copyright theory, if only to overturn that platform by examining the history of copyright formalities. Since at least the mid 19<sup>th</sup> century, commentators have articulated two general concepts of copyright, one founded in natural property rights, the other based on a State grant of monopoly. For example, in 1838 Charles-Augustin Renouard, author of one of the first French copyright treatises, articulated two opposing philosophies of copyright. According to one, grounded in natural rights conceptions of property, authors are the absolute owners of their work, both before and after publication. Their property right is, like all other property rights, transmissible, perpetual, and inviolable. According to the other, social contract-based, system of copyright thought, authors are

[W]orkers and not property owners; if the laws ensure them exclusive exploitation of their works, it is by virtue of a positive grant of civil law and of a tacit contract which, at the moment of publication, intervenes between the public and the author. It is by the establishment of a privilege, created as a legitimate and fair compensation, that the full and free exploitation of a published work is forbidden to all persons composing the public.<sup>25</sup>

From these opposing bases for copyright different attitudes towards formalities might follow. If copyright is essentially a government grant, it might well come with conditions. For example, requiring the author to affix a notice of copyright, or to register and deposit copies of the work with a government agency before the right will be recognized or enforced, is fully consistent with a social-contractual view of copyright. Imposition of formalities thus would reflect the premise that creating the work does not alone justify protection: copyright is a *quid pro quo*, and it is the author's burden properly to assert her rights; should she fail to keep her end of the bargain, the innocent public should not be liable for unauthorized exploitations. Formalities thus make free copying

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<sup>23</sup> See, e.g., REPORT OF AD HOC WORKING GROUP ON US ADHERENCE TO THE BERNE CONVENTION, reprinted in 10 COLUM.-VLA J. L. & THE ARTS 513, 572-74 (1986). See also *Football Ass'n. Premier League Ltd. v. You Tube*, 2009 U.S. Dist. LEXIS 57438, \*10 (S.D.N.Y. July 3, 2009) (exemption of foreign works from pre-suit registration obligation does not extend to prerequisites to obtaining statutory damages; the latter registration obligation does not violate the Berne Convention or the TRIPs Accord: “The Senate Judiciary Committee concluded that Section 412 and other provisions of the Copyright Act ‘do not condition the availability of all meaningful relief on registration, and therefore are not inconsistent with Berne.’ S. Rep. No. 100-352, at 14-15.”; in any event, the Berne Convention and TRIPs are not self-executing in the US); *Elsevier BV v. Unitedhealth Group Inc.*, No 09 Civ. 2124 (WHP) (S.D.N.Y. Jan. 14, 2010) (.dismissing challenge to sec. 412 because Berne Conv. not self-executing).

<sup>24</sup> RICKETSON AND GINSBURG, *supra* note 13, at ¶ 6.108.

<sup>25</sup> CH.-A. RENOARD, DES DROITS DES AUTEURS SUR LES PRODUITS DE LEUR INTELLIGENCE 242 (1838); see also AUGUSTINE BIRRELL, SEVEN LECTURES ON COPYRIGHT 10-15 (1899) (distinguishing between concepts of copyright as a property right, and as a “privilege.”)

the default position; that initial stance should not vary unless the author undertakes to warn the world of her claims. So characterized, formalities clash with a conception of copyright as springing from the creative act. If copyright is a natural property right in the fruits of the author's intellectual labor, then copyright is born with the work, and no further action should be necessary to confer or confirm the right. Hence, a natural property rights conception of copyright should in theory eschew formalities.<sup>26</sup>

Such tidy coherence may be theoretically satisfying, but it is also substantially anachronistic. In historical context, the opposition of natural rights and social contract (State-granted monopoly) concepts was much less sharp. By the same token, the role of formalities as exemplifying one or another concept reflects subsequent rationalizations more than contemporary experience. Neither at the beginning of the eighteenth century, with the Statute of Anne, nor towards its end, with the US constitution's copyright clause or the first US copyright statute, did lawmakers set out to conceptualize copyright exclusively as a natural right, or only as a conditional State grant, or for that matter to adopt any overriding theory of copyright. In the case of the Statute of Anne, the vesting of rights in authors rewarded their intellectual labor,<sup>27</sup> and the conditioning of an additional term of protection on the author's remaining alive,<sup>28</sup> further demonstrates the Act's focus on the rights of authorship. But the statute also adopted the regulatory framework, including registration with the Stationers Company and deposit of copies of books with designated libraries, established under the 1662 Licensing Act.<sup>29</sup> Arguably, Parliament retained the bureaucratic aspects of the pre-copyright printing privileges not because its Members carefully conceptualized the nature of copyright, but because the prior system was known and had worked.<sup>30</sup> In the case of the early US enactments, many pre-Constitutional State copyright statutes included preambles with ringing declarations of natural property rights,<sup>31</sup> but then copied the Statute of Anne almost verbatim,

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<sup>26</sup> Benjamin Kaplan, *Study No. 17, The Registration of Copyright* (1958), in 1 STUDIES ON COPYRIGHT, *supra* note 4, at 325, 366 (Arthur Fisher Mem. Ed., 1960) ("Those for whom copyright is a 'natural' right have regarded formalities as repugnant to such a right and therefore offensive in their nature; while those who think of copyright as a State-granted, limited 'monopoly' have tended to look upon formalities as somehow the proper or even the necessary accompaniment of the grant."); see also SILKE VON LEWINSKI, INTERNATIONAL COPYRIGHT LAW AND POLICY, ¶¶ 3.25-3.26 (2008).

<sup>27</sup> Laura Moscati, *Un "Memorandum" di John Locke tra Censorship e Copyright*, LXXVI RIVISTA DI STORIA DEL DIRITTO ITALIANO 69 (2003), has demonstrated a link between Locke's general theory of property rights and his expression of literary property rights, subsequently captured in the Statute of Anne.

<sup>28</sup> The last sentence of the Statute of Anne (§ 11) provides: "Provided always that after the expiration of the said term of fourteen years the sole right of printing or disposing of copies shall return to the Authors thereof if they are then living for another Term of fourteen years." 8 Anne, ch. 19 (1710).

<sup>29</sup> *Id.* (providing for pre-publication registration of the book's title with the Stationers Company, "in such manner as hath been usual"). On registration with the Stationers Company under the 1662 Licensing Act, see, e.g., Michael Treadwell, *The stationers and the printing acts at the end of the seventeenth century*, in 4 THE HISTORY OF THE BOOK IN BRITAIN 1557-1695 755 (John Barnard & D.F. McKenzie eds., 2002).

<sup>30</sup> See, e.g., JOHN FEATHER, PUBLISHING, PIRACY AND POLITICS: AN HISTORICAL STUDY OF COPYRIGHT IN BRITAIN 63 (1994) (the Statute of Anne was generally consistent with past business practice: "For the trade, the 1710 Act represented a simple continuation of legal and commercial practices which had developed since the middle of the sixteenth century, but which had been under challenge in the absence of any statutory authority since 1695.")

<sup>31</sup> See, e.g., Massachusetts Copyright Statute (1783), in PRIMARY SOURCES ON COPYRIGHT (1450-1900), (L. Bently & M. Kretschmer eds.), at www.copyrighthistory.org ("... as such security [of the fruits of authors']

including its requirements of registration and deposit of copies,<sup>32</sup> and even including language almost certainly irrelevant to the situation of the ex-Colonies.<sup>33</sup> The cut-and-paste character of these statutes belies any consistent reflection on the nature of copyright.

Indeed, in the US, authorities throughout the 19<sup>th</sup> century conveyed highly mixed messages regarding the nature of copyright and the role of formalities. While courts (including the Supreme Court) often articulated a rigidly positivistic concept of copyright, for which strict adherence to formalities formed a cornerstone,<sup>34</sup> treatise writers eloquently insisted on the natural rights of authorship, generally treating formalities as an administrative afterthought.<sup>35</sup> Similarly, the Judiciary Committee report accompanying the bill that ultimately became the 1831 copyright amendments, making registration of the work before its publication an unambiguous prerequisite to the obtaining of federal copyright protection, nonetheless extolled the author's natural entitlement to a property right: "If labor and effort in producing what before was not possessed or known will give title, then the literary man has title, perfect and absolute, and should have his reward . . ."<sup>36</sup>

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study and industry] is one of the natural rights of all men, there being no property more peculiarly a man's own than that which is produced by the labour of his mind"); North Carolina Copyright Statute (1785), *id.* ("Whereas nothing is more strictly a man's own than the fruit of his study . . ."); see generally Francine Crawford, *Pre-Constitutional Copyright Statutes*, 23 BULL. COPYRIGHT SOC'Y 11 (1975).

<sup>32</sup> Crawford, *supra* note 31, at 23-24, states that the registration requirement was for evidentiary purposes – to prove that the claimant was the author or held rights from the author – rather than constitutive of copyright protection.

<sup>33</sup> *Id.* at 15-16 & n.15<sup>a</sup>.

<sup>34</sup> See *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834) (strict compliance with all statutory formalities held a prerequisite to the vesting of federal copyright protection for published works); *Osgood v. AS Aloe Instrument Co*, 83 Fed. 470 (C.C..E.D. Mo. 1897) (despite judge's "disposition much in favor of upholding copyrights, and thus securing to authors what seems to be a natural right to the rewards of their own literary labors," holding that author "never acquired a valid copyright" because she failed to fulfill statutory obligations to deposit copies of her book with Library of Congress before publication and to insert proper notice of copyright on the title-page); see also *Clayton v. Stone*, 5 F. Cas. 999 (C.C.S.D.N.Y. 1829) (inferring that a "daily price quote" could not be the subject matter of federal copyright protection because its publication was too evanescent to permit compliance with full range of statutory formalities).

<sup>35</sup> See GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF COPYRIGHT 1-25 (Introduction –Theory of the Rights of Authors; copyright founded in "general principles of justice and right"), 193-98 (Chapter VI: Of the Statute Requisites for a Valid Copyright) (1847); EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 1-20 (Origin and nature of Literary Property, especially p. 13, challenging argument that author's natural rights cease upon publication: "It is a ridiculous doctrine which recognizes a species of property, and yet pronounces its only use unlawful and self-destructive"), 262-300 (Statutory Requisites for Securing Copyright) (1879); Stef van Gompel, 'Les formalités sont mortes, vive les formalités! Copyright formalities and the reasons for their decline in nineteenth-century Europe', in PRIVILEGE AND PROPERTY: ESSAYS ON THE HISTORY OF COPYRIGHT, (Ronan Deazley, Martin Kretschmer & Lionel Bently, eds., forthcoming 2009) has observed a similar pairing of natural rights rhetoric and formalities in 19<sup>th</sup>-century Continental European copyright systems.

<sup>36</sup> H.R. REP. NO. 3 (1830), in PRIMARY SOURCES ON COPYRIGHT, *supra* note 31, at [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/showThumb/%22us\\_1831%22/start/%22yes%22](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/showThumb/%22us_1831%22/start/%22yes%22). Professor Oren Bracha, in his commentary on this Committee Report, suggests that the Committee's fulsome endorsement of authorial property rights reflected the influence of Noah Webster, a tireless advocate of copyright protection, whose

But formalities, and the highly restricted view of copyright they ultimately symbolized, came to dominate the US landscape, particularly following the Supreme Court's 1834 decision in *Wheaton v Peters*.<sup>37</sup> The first State and then Federal copyright statutes had included formalities modeled on Statute of Anne, but it was not inevitable that they be interpreted as constitutive of copyright, as opposed to predicate to special statutory remedies. Indeed, British authorities since the 18<sup>th</sup> century had confined the sanction for non compliance with registration and deposit requirements to restricting the author's or rightholder's remedies for copyright infringement to those available at common law.<sup>38</sup> Non compliance did not endanger the existence of the author's copyright. By contrast, the Supreme Court in *Wheaton v. Peters* imposed punctilious compliance, making post-publication copyright a tributary of the many statutory prerequisites.<sup>39</sup>

Different explanations for the centrality of formalities to *Wheaton v Peters*' delimitation of US copyright might be ventured. Given the Framers' suspicion of restraints on competition, statutory formalities could have been perceived as a necessary counterweight to the prospect of excessive market power that even a monopoly limited in time might engender.<sup>40</sup> The statutory institution and judicial requirement of strict observance of statutory formalities would suggest that Congress and the courts were far more fearful of establishing monopolies than concerned to foster authorship. The more stringent the formalities, the more works freely available in the public domain, and the smaller the universe of works over which exclusive rights could be enforced.<sup>41</sup> An alternative account suggests that the *Wheaton* court's embrace of a highly positivistic, formality-defined approach to copyright was a necessary corollary of the Court's federalism jurisprudence; after all, Henry Wheaton's assertion that non compliance with federal formalities did not bar his common law copyright claims clashed with the Court's

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son-on-law, Oliver Ellsworth, wrote the Committee Report. Oren Bracha, *Commentary on the U.S. Copyright Act 1831* (2008), in PRIMARY SOURCES ON COPYRIGHT, *supra* note 31, at [http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabeCom/%22us\\_1831%22](http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/ausgabeCom/%22us_1831%22)

<sup>37</sup> 33 U.S. (8 Pet.) 591 (1834); *see also* Shaffer van Houweling, *supra* note 2, at 27 (citing ZORINA KAHN, *THE DEMOCRITIZATION OF INNOVATION* 245 (2005) (18% of copyright cases from 1790-1909 concerned abandonment or forfeiture of copyright for – often minor - failures to comply with formalities)).

<sup>38</sup> *See Beckford v. Hood*, [1798] 7 TR 620, 101 Eng. Rep. 1164 (K.B.); *see also* Kaplan, *supra* note 26, at 327-35 (providing general survey of English caselaw on formalities).

<sup>39</sup> *See* 33 U.S. (8 PET.) at 663-64, “No one can deny that when the legislature are about to vest an exclusive right in an author or inventor, they have the power to prescribe the conditions on which such right shall be enjoyed; and that no one can avail himself of such right who does not substantially comply with the requisitions of the law.”

<sup>40</sup> *See, e.g.,* L. Ray Patterson and Craig Joyce, *Copyright in 1791: An Essay Concerning the Founders' View of the Copyright Power Granted to Congress in Article I, Section 8, Clause 8 of the U.S. Constitution*, 52 EMORY L. J. 909, 941 (2003).

<sup>41</sup> The extent to which the Framers and their immediate successors were in fact as monopoly-phobic as the above account implies is subject to some debate. *See, e.g.,* Thomas Nachbar, *Constructing Copyright's Mythology* 6 GREEN BAG 2D 37, 45 (2002) (modern scholars' attribution of anti-monopoly animus to the framing of early US copyright laws is overstated); Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution* 2 J. INTELL. PROP. L. 1, 55-6 (1994) (“very few actually gave much thought to” Congress' power to grant copyright monopolies).

previous rejection of residual State common law intellectual property rights whose assertion undermined Federal control of interstate commerce.<sup>42</sup> Formality-free copyright was thus a casualty of the Marshall Court's determination to eliminate barriers to interstate trade and to consolidate Federal power.<sup>43</sup> In the light of the Court's federalism jurisprudence, Justice Joseph Story's perhaps otherwise surprising alignment with the *Wheaton* majority becomes more readily understandable. Although Justice Story was an advocate of broad copyright protection,<sup>44</sup> and may have been sympathetic to *Wheaton*'s common law copyright claims, he was also "greatly concerned with the development of [the Court's] jurisprudence as a tool of national power,"<sup>45</sup> and had joined or authored the Court's principal federalism decisions.<sup>46</sup>

## II. US Formalities in Practice

Whatever their conceptual foundation, formalities in practice dominated 19<sup>th</sup> and 20<sup>th</sup> century US copyright law, their extent and complexity often proving a trap for the unwary.<sup>47</sup> It is important to emphasize, however, that those "ensnared" could as well (if perhaps not as often) be exploiters as authors, at least when incompletely or incorrectly fulfilled formalities misled the user into believing the work unprotected.<sup>48</sup> Users might draw unreliable conclusions regarding a work's status because, notwithstanding the legacy of *Wheaton v Peters*, some courts, endeavoring to avoid forfeitures of copyright (particularly following enactment of the 1909 Act), interpreted (or interpolated into) the statute some tolerance for substantial, albeit imperfect, compliance.<sup>49</sup>

But not all courts were equally forgiving, as others persisted in requiring strict fulfillment of all statutory conditions. As a result, the legal norm became increasingly incoherent and unpredictable. The doctrine of "limited publication" further complicated the situation. Formalities were required for works which had been, or were about to be, published. Until the 1976 Copyright Act, an unpublished work, as a chattel, remained the

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<sup>42</sup> See Jane C. Ginsburg, *Une Chose Publique?: The Author's Domain and the Public Domain in Early British, French and US Copyright Law*, 65 CAMBRIDGE L.J. 636, 662-66 (2006).

<sup>43</sup> See *Gibbons v. Ogden*, 22 U.S. 1 (1824) (holding commerce clause prevailed over any residual State power to grant patent monopolies on steamboat traffic).

<sup>44</sup> See, e.g., JOSEPH STORY, COMMENTARIES ON EQUITY JURISPRUDENCE, ¶¶ 930-44 (1839); see generally, R. Anthony Reese, *The Story of Folsom v. Marsh*, in INTELLECTUAL PROPERTY STORIES 259 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006).

<sup>45</sup> See Craig Joyce, *The Story of Wheaton v. Peters: "A Curious Chapter in the History of Judicature"*, in INTELLECTUAL PROPERTY STORIES, *supra* note 44, at 36, 41.

<sup>46</sup> In addition to *Gibbons v. Ogden*, 22 U.S. 1, see, e.g., *Martin v. Hunter's Lessee*, 14 U.S. 304 (1816).

<sup>47</sup> See generally Vincent A. Doyle, George D. Cary, Marjorie McCannon & Barbara Ringer, *Study No. 7, Notice of Copyright* (1957), reprinted in STUDIES ON COPYRIGHT, *supra* note 4, at 229; Kaplan, *supra* note 26.

<sup>48</sup> See *Washingtonian Pub. v. Pearson*, 98 F.2d 245, 249 (D.C. Cir. 1938), *rev'd*, 306 U.S. 30 (1939) (if failure "promptly" to deposit work following publication does not invalidate copyright, then the formality becomes "a mere snare for the unwary, who were foolish enough to rely upon absence of registration as showing absence of copyright." Nonetheless the Court held the deposit, which occurred more than two years [published Dec 1931, deposited 21 Feb 1933] after publication, met the statutory standard of promptness).

<sup>49</sup> See generally Doyle et al., *supra* note 47, at 237-49; Kaplan, *supra* note 26, at 346-51.

object of formality-free common law rights<sup>50</sup> “Unpublished,” however, did not mean unexploited or undivulged. Public performance of a work did not “publish” it, and therefore did not subject it to formalities, even if the performed work had been widely seen.<sup>51</sup> Borrowing from old English decisions holding that a public performance was not a “publication,”<sup>52</sup> US courts elaborated a parallel universe of “unpublished” works. The rather strained notion of publication was motivated in large part by courts’ awareness that, were the work to be deemed “published,” and had the author not complied with all applicable federal statutory formalities, the work would go into the public domain, and all protection, state or federal, would be lost.<sup>53</sup>

The following chart summarizes the formalities in force under various copyright laws, from the Statute of Anne and the first Copyright Act to the present.

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<sup>50</sup> The 1976 copyright act abolished the publication threshold for entitlement to federal copyright, which now “subsists” as of the creation and fixation of the work, see 17 U.S.C. § 102(a).

<sup>51</sup> See, e.g., *Estate of Martin Luther King v. CBS*, 194 F.3d 1211 (11th Cir. 1999) (“I Have a Dream” speech technically “unpublished” despite delivery before live audience of thousands, and television and radio broadcast to millions); see generally William S. Strauss, *Study No. 29, Protection of Unpublished Works*, in *STUDIES ON COPYRIGHT*, *supra* note 4, at 189.

<sup>52</sup> See *Macklin v. Richardson*, [1770] Amb 694, 27 Eng. Rep. 451 (Ch.); *Coleman v. Walthen*, [1793] 5 TR 245, 101 Eng. Rep. 137 (K.B.); *Morris v Kelly*, [1820] 1 Jac. & W. 481, 37 Eng. Rep. 451 (Ch.).

<sup>53</sup> Courts’ efforts to avoid forfeitures may also explain the somewhat tortured US caselaw relating to sound recordings, see Strauss, *supra* note 51, at 202-04. In this instance, two different forfeitures loom, first of the recorded musical composition, and second of the recorded performance. Under the 1909 Act regime, if sale of phonograms constituted “publication,” and the recorded composition had not previously been published with notice or registered, then the sale of the recording would cast the composition into the public domain. With regard to the recorded performance, sound recordings were not included within federal copyright subject matter until 1972. Pub. L. No. 92-140, 85 Stat. 391 (1971), as amended by Pub. L. No. 93-573, 88 Stat. 1873 (1974) (federal protection for sound recordings fixed and published with notice on and after Feb. 15, 1972). As a result, were pre-1972 recordings deemed “published,” they would have immediately gone into the public domain. Hence the judicial rulings that the sale and distribution of phonograms did not “publish” the performances, which, accordingly, remained subject to common law copyright. See *Capitol Records v. Naxos of America*, 4 N.Y.3d 540 (2005); *Capitol Records v. Mercury Records Corp.*, 221 F.2d 657 (2d Cir. 1955).

## Evolution of US Formalities

Formality	(Brit.) Statute of Anne 1710	1790 Act	1802 Act	1831-1905 Acts	1909 Act	1976 Act	1989 (Berne) Amendments
<b>registration</b>	Registry of title of book in Stationers Co. register “in such manner as hath been usual” required pre-publication	Registry of title of book in clerk’s office of local federal district court required pre-publication and for renewal term	Registry of title of book in clerk’s office of local federal district court required pre-publication and for renewal term	Until 1870: with district court; 1870 Act: With Librarian of Congress before publication; renewal term within 6 months before expiration of initial term	With Copyright Office, accompanying deposit	With Copyright Office, accompanying deposit; now optional (but see below on deposit noncompliance)	With Copyright Office, accompanying deposit; now optional (but see below on deposit noncompliance)
-- sanction for non-compliance	Statutory penalties unavailable, but copyright still enforceable for remedies in equity	“no person shall be entitled to the benefit of this act”; maybe ambiguous whether non statutory remedies available without registration	Not entitled to “benefit of [1790] Act”; construed in <i>Wheaton v Peters</i> (U S. 1834) to mean no copyright protection at all without total compliance	Precondition to protection; failure to register before publication cast work into public domain	Prerequisite to infringement action (prima facie evidence of facts stated); registration within 1 year prior to expiration of first term required for renewal term	Prerequisite to infringement action (prima facie evidence of facts stated); registration pre-infringement requisite to statutory damages and attorneys’ fees	Prerequisite to infringement action - <b>US works only</b> ; registration pre-infringement requisite to statutory damages and attorneys’ fees – <b>all works</b>
<b>deposit</b>	9 copies to designated libraries	One copy to secretary of State within six months of publication	One copy within six months of publication to secretary of State	2 copies to Library of Congress w/in 1 month (1846 Act)/10 days of pub. (1870 Act)	2 copies to Copyright Office “promptly” following publication	2 copies to Copyright Office within 3 months of publication	2 copies to Copyright Office within 3 months of publication
-- sanction for non-compliance	finest for non deposit; (1775 Act) Statutory penalties unavailable	Not stated	Not entitled to “benefit of [1790] Act”(see above on registration noncompliance)	Forfeiture of copyright (1846 Act); then precondition to copyright (1870 Act)	Prerequisite to infringement suit; if after demand, no deposit, fines, forfeiture of copyright	Prerequisite to infringement suit; if after demand, no deposit, fines imposed	Prerequisite to infringement suit <b>for US works</b> ; if after demand, no deposit, fines imposed

Formality	(Brit.) Statute of Anne 1710	1790 Act	1802 Act	1831-1905 Acts	1909 Act	1976 Act	1989 (Berne) Amendments
<b>notice</b>	[implicit in registration and provision for public inspection of Stationers Company registry]	Publication of record of registration in one or more newspapers for 4 weeks within 2 months of publication, and, for renewal term, during last 6 months of first term	Same newspaper publication requirements, <b>plus:</b> publication of full record of registration in title page of book or page immediately following	On title page of book or page immediately following; newspaper notice now required only for renewal term, to be made within 2 months of renewal date	On title page or page immediately following; newspaper notice no longer required for renewal term	Must be affixed to published copies, but omission can be cured within five years of publication	optional
-- sanction for non-compliance	[no explicit provision]	“no person shall be entitled to the benefit of this act”	Not entitled to “benefit of [1790] Act”; see above	Precondition to protection; publication without notice cast work into public domain	Same, unless notice omitted from “a particular copy or copies”; but no damages v. innocent infringer	Forfeiture of copyright, if omission of notice not cured by registration of work with Copyright Office	No forfeiture, but innocent infringer defense in theory possible
<b>recordation</b>	Entry of permission to print in Stationers Co register	[no provision]	“Transfer or assignment of copyrights” to be recorded in clerk’s office	Same, with recordation in Library of Congress; Stat. 1, June 30, 1834 (recordation of transfer)	Assignments to be recorded within 3 or 6 months of execution	Any transfer of copyright or document pertaining to copyright	Any transfer of copyright or document pertaining to copyright
-- sanction for non-compliance	Statutory penalties unavailable	[no provision]	If not recorded within 60 days of execution, void against subsequent good faith purchaser	If not recorded within 60 days of execution, void against subsequent good faith purchaser	Transfer void against subsequent good faith purchaser who recorded assignment	Prerequisite to suit; if not filed within a month, void against later recording good faith purchasers who record first	Same, re later purchasers, but no longer prerequisite to suit



## A. Formalities in Practice: 1909 Act<sup>54</sup>

### 1. Threshold Criterion: Publication.

As indicated earlier, the pivot of the 1909 law was the concept of "publication." This event was generally the dividing line between common law protection on the one hand and either statutory or no protection on the other. Thus publication with the prescribed copyright notice obtained statutory copyright, while publication without such notice placed a work in the public domain. This rule was anchored in the text of section 9 of the 1909 Act, which provided: "any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this Act."<sup>55</sup> The concept of "publication" as utilized in section 9 developed into a rather technical construct; it was not always coterminous with the general notion of "making public," nor even with the act that divests the author of common law rights.

The 1909 Act did not expressly define "publication." This omission was apparently based on the assumption that a general definition of this concept was too difficult.<sup>56</sup> Section 62, however, provided that in the case of a work "of which copies are reproduced for sale or distribution," "the 'date of publication' shall . . . be held to be the earliest date when copies of the first authorized edition were placed on sale, sold or publicly distributed by the proprietor of the copyright or under his authority."<sup>57</sup>

Without a coherent concept of "publication" under the 1909 Act, a number of rather arbitrary distinctions emerged. Among the most well known – and most important – was the generally accepted rule that the public performance of a spoken drama did not constitute publication. This rule was established under the pre-1909 law,<sup>58</sup> and was applied by analogy to the exhibition of a motion picture,<sup>59</sup> the public performance of a musical composition, whether for profit or not,<sup>60</sup> and the oral delivery of a lecture or address,<sup>61</sup> all irrespective of the methods employed, including radio broadcasting.<sup>62</sup>

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<sup>54</sup> Subsections A and C are in part adapted from ROBERT A. GORMAN & JANE C. GINSBURG, COPYRIGHT: CASES AND MATERIALS, chs. 4 & 5 (7th ed. 2006).

<sup>55</sup> Act of Mar. 4, 1909, ch. 320, § 9, 35 Stat. 1075, 1077 (repealed 1976).

<sup>56</sup> *Hearings on S. 6330 and H.R. 19853 Before Committee on Patents*, 59th Cong., 1st Sess. 71 (June 1906).

<sup>57</sup> Act of Mar. 4, 1909, ch. 320, § 62, 35 Stat. 1075, 1087 (repealed 1976). As noted by the court in *Cardinal Film Corp. v. Beck*, 248 F. 368 (S.D.N.Y. 1918), the section was evidently intended to fix the date from which the term of copyright should begin to run for such a work, rather than to provide a general definition of what should constitute publication in all cases.

<sup>58</sup> *Ferris v. Frohman*, 223 U.S. 424 (1912).

<sup>59</sup> *See, e.g., De Mille v. Casey*, 121 Misc. 78 (N.Y. Sup. Ct. 1923).

<sup>60</sup> *See, e.g., McCarthy v. White*, 259 F. 364 (S.D.N.Y. 1919).

<sup>61</sup> *See, e.g., Nutt v. National Institute, Inc.*, 31 F.2d 236 (2d Cir. 1929).

<sup>62</sup> *See, e.g., Uproar Co. v. National Broadcasting Co.*, 81 F.2d 373 (1st Cir. 1936).

Under the 1909 Act, considerable uncertainty was also created as to the effect of publication of a derivative work – such as a reproduction of a work of art, or the motion picture based on a novel – on the status of the underlying work on which it is based. *Compare Rushton v. Vitale*, 218 F.2d 434 (2d Cir. 1955), with *Leigh v. Gerber*, 86 F. Supp. 320 (S.D.N.Y. 1949). In *Batjac Prods. v. GoodTimes Home Video Corp.*, 160 F.3d 1223 (9th Cir. 1998), the Ninth Circuit held that "a common law copyright in the underlying screenplay does not survive the motion picture's loss of copyright and falls into the public domain due to a

Because disclosure or communication of a work to another person did not always amount to "publication" under the 1909 copyright law, restricted communication of the contents of a work was generally held not to be a publication of the work. Distribution with limitation by the proprietor of the persons to whom the work was communicated and of the purpose of the disclosure was long known as "limited," "restricted," or "private" publication, but was, more accurately, no "publication" at all.<sup>63</sup> The distinction between limited and general publication under the 1909 Act was complicated even further by the distinction between "divestive" and "investive" publication. The former described dissemination that lost common law copyright; the latter described dissemination, with copyright notice, that triggered statutory copyright – and, out of concern for forfeitures, courts more readily found the latter than the former.<sup>64</sup>

In sum, although publication triggered statutory formalities, the statutorily-undefined concept of "publication" remained elusive, thus compromising the prospect of a clear dividing line between works still entitled to common law protection or qualifying for federal protection on the one hand, and works dedicated to the public on the other hand. Judicial reluctance to avoid forfeitures, while inconsistently acted-upon, undermined the efficacy of copyright-constitutive formalities in consigning to the public domain publicly-disclosed works which had not properly complied with the various statutory formalities. At the outset, then, one of the signal goals of the US system of formalities was, to say the least, imperfectly realized.

## 2. The Notice Requirement.

Once a work was deemed "published," the 1909 Act – as did all of its forebears from 1802 – required the placement of a copyright notice in a specified location.<sup>65</sup> The required form of notice was set forth in section 18, which (with some minor exceptions) provided for the word "copyright" (or abbreviation) or the familiar copyright symbol, the name of the copyright proprietor and the year of publication. Section 19 mandated the location of the notice – for a book, "upon its title-page or the page immediately following"; for a periodical, "either upon the title-page or upon the first page of text of each separate number or under the title heading"; and for a musical work "either upon its title-page or the first page of music."<sup>66</sup>

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failure to renew the movie's copyright." *Bajtak*, 160 F.3d at 1225; *accord Shoptalk, Ltd. v. Concorde-New Horizons Corp.*, 168 F.3d 586 (2d Cir.1999) (publication of motion picture "The Little Shop of Horrors" published as much of the film's screenplay as was disclosed in the film); *Harris Custom Builders, Inc. v. Hoffmeyer*, 92 F.3d 517, 520 (7th Cir.1996), *cert. denied*, 519 U.S. 1114 (1997) (publication of architectural drawings publishes underlying plans); *Classic Film Museum, Inc. v. Warner Bros., Inc.*, 597 F.2d 13 (1st Cir. 1979) (publication of motion picture publishes underlying screenplay to the extent the movie incorporates the screenplay).

<sup>63</sup> See *White v. Kimmell*, 193 F.2d 744 (9th Cir.), *cert. denied*, 343 U.S. 957 (1952).

<sup>64</sup> See, e.g., *Atlantic Monthly Co. v. Post Pub'g Co.*, 27 F.2d 556, 558 (D. Mass. 1928) (sale of proof copy of magazine to publisher's treasurer held investive publication "in so far as the statutory formalities are concerned").

<sup>65</sup> Act of Mar. 4, 1909, ch. 320, § 19, 35 Stat. 1075, 1079 (repealed 1976). On the history of the notice requirement, see generally R. Anthony Reese, *Innocent Infringement in US Copyright Law: A History*, 30 COLUM J. L. & THE ARTS 133, 148-54 (2007).

<sup>66</sup> Act of Mar. 4, 1909, ch. 320, § 19, 35 Stat. 1075, 1079 (repealed 1976).

Some courts were prepared to overlook minor departures from the form and location requirements of the 1909 Act, provided there was substantial compliance. This was particularly true if a technically inaccurate corporate or partnership name was used, but was close enough to the name of the true copyright proprietor (e.g., a company with identical officers) such that no one could reasonably claim to have been misled. But other courts were more punctilious, operating on the theory that the copyright was a special legislative privilege that could be secured only through full compliance with formalities. Although a notice accompanying the masthead of a periodical (typically on the editorial page of a newspaper) was commonly regarded as satisfactory, it was, for example, held that it was improper to place the copyright notice on the back cover of a 28-page pamphlet; such a defect was regarded as fatal, and the work was thrust into the public domain.<sup>67</sup> Similarly, courts could be strict about the placement of the notice on a journal or other collective work, holding that such notice would not protect included works that were authored by others and that did not carry a separate copyright notice.<sup>68</sup>

Inaccuracies in the year date placed in the notice could also be fatal to the copyright. The general rule that developed, through judicial decisions and Copyright Office regulations, was that an inaccurately *early* date was not fatal, but the beginning of the statutory term would be reckoned from that year (so as to shorten the term of protection, for the benefit of the public). Notice that was *postdated* by more than one year (thus allowing for end-of-the-year slippage in publication schedules), however, was regarded as fatally defective. Of course, if the required notice was altogether omitted, that too was fatal. The statute itself, however, in section 20, allowed of one exception: when the copyright owner had "sought to comply" with the notice provisions but "by accident or mistake" had omitted the notice "from a particular copy or copies."<sup>69</sup> That oversight would not invalidate the copyright, but would "prevent the recovery of damages against an innocent infringer who has been misled by the omission of the notice."<sup>70</sup> Another issue that divided the courts was whether U.S. copyright was lost, under the 1909 Act, when a work was first published without a notice of copyright outside of the U.S. The Court of Appeals for the Ninth Circuit has consistently since 1996 answered that question in the negative.<sup>71</sup>

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<sup>67</sup> See *J.A. Richards, Inc. v. New York Post*, 23 F.Supp. 619 (S.D.N.Y. 1938).

<sup>68</sup> See e.g., *Sanga Music Inc. v. EMI Blackwood Music, Inc.*, 55 F.3d 756 (2d Cir.1995).

<sup>69</sup> Act of Mar. 4, 1909, ch. 320, § 20, 35 Stat. 1075, 1080 (repealed 1976).

<sup>70</sup> This statutory exception, however, was held not to apply if the omission of notice was through "neglect or oversight," *Sieff v. Continental Auto Supply*, 39 F. Supp. 683 (D. Minn.1941), or through a mistake of law, *Wildman v. New York Times Co.*, 42 F. Supp. 412 (S.D.N.Y. 1941).

<sup>71</sup> See, e.g., *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162 (9th Cir. 1996). In *Twin Books*, the literary work, "Bambi, A Life in the Woods," was first published without notice in Germany in 1923, and then republished with notice in 1926 (and registered for U.S. copyright). The copyright owner renewed the copyright in 1954, which would have been too late had the work's first publication been in 1923. The court noted some early decisions which indicated that publication abroad without notice forfeits the possibility of securing copyright through a later U.S. publication, but the court concluded that such a view conflicted with the prevailing doctrine of "territoriality" of the copyright law. The Ninth Circuit relied upon *Heim v. Universal Pictures Co.*, 154 F.2d 480 (2d Cir. 1946), for the proposition that publication abroad without notice – in a nation that does not place the work in the public domain for that reason – will not prevent subsequently obtaining a valid U.S. copyright. The Ninth Circuit has recently reasserted its adherence to

In sum, while the notice formality marked the dividing line between protected and public domain works, inconsistencies in its application blurred the boundary. Moreover, the willingness of some courts to accept “substantial compliance” may have achieved individually just results at the cost of systemic unpredictability.

### 3. Deposit and Registration

Under the 1909 Act, registration was not a prerequisite to federal protection during the initial 28-year term of copyright, although it was necessary to have registered the work and deposited copies before bringing an infringement action.<sup>72</sup> On the other hand, section 13 of the Act required that copies of the work be deposited “promptly” following publication, thus posing the question whether failure to deposit copies shortly after publication would strip the author or rightowner of the copyright that would have vested upon publication with notice. It was ultimately held, however, that failure promptly to deposit copies did not divest the copyright but would bar the rightholder from bringing suit until deposit was made.<sup>73</sup>

While not initially constitutive of copyright, registration was a prerequisite to obtaining a second statutory term of 28 years. The renewal term could be claimed by the author if he or she survived the initial term (or at least until the date in the 28th year when renewal was sought). If the author had died, then the right to claim the renewal passed successively to three other statutory beneficiaries – the surviving spouse or children, or for lack of those the author's executor, or in the absence of a will the author's next of kin. The renewal term came into being only if an initial application for registration, and then an application for renewal registration, were filed with the Copyright Office. The registration prerequisite to renewal had the effect of limiting the duration of most copyrights to 28 years.<sup>74</sup> Most non renewals probably reflected the rights owners' determinations that the works no longer had commercial value justifying the effort and expense of renewal, but some non renewals likely resulted from failure to keep track of when renewal was due, or from other inadvertence or ignorance.<sup>75</sup> Thus, the renewal formality ensured early entry into the public domain of the bulk of works initially protected for 28 years, but at the cost of divesting those authors (most likely, individual and foreign authors) who may have wished protection but failed correctly to fulfill statutory requirements.

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*Twin Books*, see *Succession Guino v. Renoir*, 549 F.3d 1182 (9th Cir. 2008) (sculptures published in France without copyright notice in 1917 and 1974).

<sup>72</sup> Act of Mar. 4, 1909, ch. 320, § 12, 35 Stat. 1075, 1078 (repealed 1976).

<sup>73</sup> *Washingtonian Pub. v. Pearson*, 98 F.2d 245, 249 (D.C. Cir. 1938), *rev'd*, 306 U.S. 30 (1939).

<sup>74</sup> See Barbara Ringer, *Study No. 31, Renewal of Copyright*, in *STUDIES ON COPYRIGHT*, *supra* note 4.

<sup>75</sup> See, e.g., Statement on the floor of the House of Representatives in connection with Pub. L. 102-307, 106 Stat. 264 (substituting the equivalent of a single 75-year term for the prior dual terms, by making the second term – 28 plus 19 years – vest without filing for renewal): “The renewal requirements are highly technical and have resulted in the unintended loss of valuable copyrights. In addition to countless individuals who do not have knowledge of the requirements, even famous directors such as Frank Capra have fallen victim. Capra's 'It's a Wonderful Life,' starring Jimmy Stewart and Donna Reed, went into the public domain when the film production company that owned the copyright went bankrupt and no one was around to file the renewal application.” Reprinted in GORMAN & GINSBURG, *supra* note 54, at 423-24.

## B. Interlude: 1925 Bill to Amend the US Copyright Act to Join the Berne Convention

The US stance on formalities long precluded its membership in the Berne Convention. During the 1920s, the efforts of the then-Register of Copyrights Thorvald Solberg and of the Authors League and the American Society of Composers Authors and Publishers, led to a 1925 bill “to amend and consolidate the acts respecting copyright and to permit the United States to enter the International Copyright Union.”<sup>76</sup> The cornerstone of this bill was the automatic, formality-free vesting of copyright upon creation of the work. Its advocates characterized the then-current law’s obligation to comply exactly with technical requirements as a “rather primitive situation,”<sup>77</sup> and as “restrictions on the fundamental rights and privileges of the author and composer which should come away.”<sup>78</sup>

The concept of automatic copyright, however, encountered considerable skepticism from some lawmakers and fierce opposition from copyright-exploiting industries, particularly the league of motion picture theaters and the producers of phonograph records and piano rolls,<sup>79</sup> for whom formalities combated expansive assertions of authors’ rights and formed a bulwark against unanticipated liability. Some of the objections voiced against formality free copyright seem dreadfully prescient of the claims of today’s “Copyleft.” For example, Representative William Hammer, Democrat of North Carolina, exclaimed, “Do you mean to chain human thought so that in the Free America, just by signing the author’s name, an article can not be printed in a newspaper without infringing upon a copyright? Is that the kind of law you are asking us to enact?”<sup>80</sup> Similarly, the entrepreneurs of new technological modes of exploitation then, as now, sanctimoniously strained to equate their profits with the public interest. Thus the president of the association of Motion Picture Theater Owners declared, “Congress should grant no copyright privilege which would have any tendency to inhibit the activities or interfere with the progress of great agencies like the motion-picture screen and the newspaper that are of such consequence to the general welfare of the people of the United States.”<sup>81</sup>

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<sup>76</sup> Perkins Bill, H.R. 11258, 68th Cong., (2d sess. 1925). The 1924 Dallinger Bill proposed similar reforms.

<sup>77</sup> *Hearings Part I on H.R. 11258*, 68th Cong. 14 (Jan. 22, 1925) (statement of Thorvald Solberg, Register of Copyrights).

<sup>78</sup> *Id.* at 19.

<sup>79</sup> *Id.* at 136 *et seq.* (Victor Talking Machine Co.) (bill would “create an undisclosed monopoly”); *Hearings Part II on H.R. 11258*, 68th Cong. 227 *et seq.* (Feb. 3, 1925) (Music Industries Chamber of Commerce) (“The sponsors of the proposed legislation apparently have no concern for those members of the American public who would thereby be subjected to great and unavoidable danger of infringement claims by foreigners.”)

<sup>80</sup> See *Hearings Part I on H.R. 11258*, *supra* note 77, at 68.

<sup>81</sup> *Id.* at 113. Some Members of Congress seemed particularly unmoved by pretensions of this kind, as in this colloquy between Mr. Paine of the Victor Talking Machine Company and Rep. Hammer of North Carolina:

Mr. Paine. The position that we take is to come down here and urge this committee not to put copyright users at the peril of making infringements of copyrighted works when they know nothing about the copyrights.

It would take the US another fifty years to adopt and (partially) implement the Berne principle that exclusive and enforceable authors' rights arise with the creation of the work. The toll of the earlier debates is apparent. Later reformers recognized that Solberg's natural rights advocacy could not prevail in the intense debates that defined copyright reform in the 1920s.<sup>82</sup> The Report of the Register of Copyrights on the general revision of the US Copyright Law that led to the 1976 Act did not endorse "automatic copyright." Proceeding from the general premise that "where [the author's and the public's interests] conflict, the public interest must prevail,"<sup>83</sup> the Register concluded that the notice requirement served the public interest by "keeping free of copyright restrictions the great bulk of published material in which the authors do not wish to secure copyright."<sup>84</sup> The Report instead recommended retention of the notice requirement, but with a five-year grace period for curing inadvertent omissions of notice from published copies of works.

### C. Formalities in Practice: The 1976 Act

The principal conceptual and practical innovation of the 1976 Act was to bring published and unpublished works under a single federal regime, thus making creation of a fixed copy of the work – rather than publication with notice – the starting point for federal protection. But, while the 1976 Act was intended to bring the US closer to the Berne Convention,<sup>85</sup> it did not at first fully adopt the post-Berlin system of automatic, formality-free copyright. Rather, if copyright attached upon creation and fixation of the work, it could detach – and the work fall into the public domain – if the author upon publication failed to affix a notice of copyright, and failed to cure that omission within the time period allowed by the statute.

#### 1. Publication and Notice

Thus publication remained a key concept in US copyright law, but the 1976 Act, unlike its predecessors, included a definition of publication. Section 101 defined publication as:

The distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not itself constitute publication.

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Mr. Hammer. From a purely humanitarian standpoint of the public good, not your own private interest?

*Id.* at 296.

<sup>82</sup> See Abe A. Goldman, *Study No. 1, The History of U.S.A. Copyright Law Revision from 1901 to 1954*, in STUDIES ON COPYRIGHT, *supra* note 4, at 1113.

<sup>83</sup> See REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW, ch. 1, in STUDIES ON COPYRIGHT, *supra* note 4, at 1206.

<sup>84</sup> *Id.* at 1263-64.

<sup>85</sup> See, e.g., H.R. REP. NO. 94-1476, at 135-36 (1976).

This definition resolved many of the problems that arose by virtue of the definitional vacuum in the 1909 Act, particularly by providing that a public performance or display of a work is not a "publication" that entails a copyright notice, but that the public distribution of phonograph records does constitute publication of the recorded work (as well as of the sound recording).<sup>86</sup> A definition of publication clarified what acts triggered the notice obligation. For despite the US' drawing closer to Berne, the 1976 Act retained a modified version of the notice requirement. Among the issues most hotly debated during the comprehensive revision of the 1909 Copyright Act leading up to the 1976 Act was the continued imposition of a requirement to place copyright notice on "published" works and the sanction for a failure to do so. Congress initially decided to retain the notice requirement but to make less draconian the consequences of an error or omission, in particular allowing for a five-year grace period for registration of the work with the Copyright Office, and efforts to add notice to copies after the omission was discovered, as a cure for omission of notice. This sort of splitting the difference between the Berne system of automatic formality-free copyright, and the conditional copyright of prior US enactments arguably served the goals of neither regime. A system of defeasible copyright could not reliably alert potential users as to a work's public domain status because absence of the notice from published copies no longer cast the work immediately into the public domain; a user would have to wait five years and interrogate registration records before being able to conclude that the work was no longer under copyright. But the system could still penalize authors who neglected the notice and then failed to make timely registration by divesting them of their copyrights after five years.

The notice requirements were set forth in Sections 401 and 402 of the 1976 Act. Section 401 applied to "copies" of published works, and Section 402 to "phonorecords." In 1988, in order to permit United States adherence to the Berne Convention, Congress eliminated the copyright notice as a precondition to copyright protection. Nonetheless, in part because it was difficult to break with such a longstanding practice as the use of copyright notice – and in part because Congress and the Copyright Office continued to believe that notice served useful purposes in warning unauthorized users and in conveying information – the Berne Implementation amendments to the 1976 Act continued to provide incentives to copyright owners to avail themselves of what has, since March 1, 1989, become merely a discretionary option to use the notice on published works.

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<sup>86</sup> Nonetheless, the 1976 Act did not succeed in dispelling all confusion or uncertainty regarding use of the notice. For example, almost 70 years after *White-Smith Music Pub'g Co. v. Apollo Co.*, 209 U.S. 1 (1908), Congress still declined to equate recordings with copies. Thus, in this definition and throughout the statute, one notes the refrain "copies or phonorecords." And, as will be noted below, there is no provision for use of a © copyright notice on phonorecords pertaining to the underlying recorded work. (There *is* a provision for a P notice pertaining to the recorded *performance* under § 402.) And, while the statute uses "copies" and "phonorecords" in the plural, the committee reports state that under this definition "a work is 'published' if *one or more* copies or phonorecords embodying it are distributed to the public." S. REP. NO. 94-473, at 121 (1976); H.R. REP. NO. 94-1476, at 138 (1976) (emphasis added). But Chairman Kastenmeier of the House subcommittee stated on the House Floor that "in the case of a work of art, such as a painting or statue, that exists in only one copy ... [i]t is not the committee's intention that such a work should be regarded as 'published' when the single existing copy is sold or offered for sale in the traditional way – for example, through an art dealer, gallery, or auction house." 122 CONG. REC. 31,980 (1976).

After Berne adherence, the amended 1976 Act provided that, for works first published on or after March 1, 1989 – and also for copies or phonorecords distributed after that date of works that had been published previously – Sections 401(a) and 402(a) no longer require placement of notice on publicly distributed copies and phonorecords, but instead provide that the © notice "may" be placed on copies and the P-in-a-circle notice "may" be placed on phonorecords of sound recordings.<sup>87</sup> The form and placement of the optional notice are as they were previously when the notice was mandated.<sup>88</sup> The incentive provided for use of the notice was set forth in a new subsection (d) to Sections 401 and 402, which disallow an innocent infringement defense if the requisite notice "appears on the published copy or copies to which a defendant in a copyright infringement suit had access."<sup>89</sup> The incentive is rather weak, however, because the innocent infringer defense applies only to the calculus of statutory damages; it affects neither actual damages nor the existence of liability.<sup>90</sup>

The question has arisen whether the copy "to which a defendant . . . had access" means the source copy for the infringing act, or generally available copies, whether or not such a copy was the one from which the defendant copied. In *BMG v Gonzales*,<sup>91</sup> the defendant downloaded numerous recorded songs from the Internet. She sought a diminution of statutory damages on the ground that the copies from which she copied did not bear a copyright notice. Recognizing that unauthorized source copies may often lack copyright notice or other copyright owner-identifying indicia, the court rejected defendant's contention:

It is undisputed that BMG Music gave copyright notice as required – "on the surface of the phonorecord, or on the phonorecord label or container" (§ 402(c)). It is likewise undisputed that Gonzalez had "access" to records and compact disks bearing the proper notice. She downloaded data rather than discs, and the data lacked copyright notices, but the statutory question is whether "access" to legitimate works was available rather than whether infringers earlier in the chain attached copyright notices to the pirated works. Gonzalez readily could have learned, had she inquired, that the music was under copyright.<sup>92</sup>

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<sup>87</sup> 17 U.S.C. §§ 401(a), 402(a).

<sup>88</sup> Under § 404(a), a notice of copyright applicable to a collective work as a whole suffices as notice for the separately-owned contents of the collective work, although the authors or copyright owners of these contributions may also affix separate notices. Section 404 carries over the practice of "blanket notice" which courts held preserved the copyrights in contributions to collective works published under the 1909 Copyright Act. See, e.g., *Abend v. MCA, Inc.*, 863 F.2d 1465, 1469 (9th Cir. 1988) (holding that blanket notice "is sufficient to obtain a valid copyright on behalf of the beneficial owner, the author or proprietor" under 1909 Act (quoting *Goodis v. United Artists Television, Inc.*, 425 F.2d 397, 399 (2d Cir. 1970))), *aff'd sub nom. Stewart v. Abend*, 495 U.S. 207 (1990)..

<sup>89</sup> As to whether continued use of the notice may be expected once no meaningful sanctions attach to its omission, see H.R. REP. NO. 100-609, at 26 (1988) ("It is entirely possible that elimination of the notice formality may not in the end curtail its use. Old habits die hard; it remains useful under the Universal Copyright Convention; and, it is, in all probability, the cheapest deterrent to infringement which a copyright holder may take.").

<sup>90</sup> See 17 U.S.C. §§ 401(d), 504(c)(2).

<sup>91</sup> 430 F.3d 888 (7th Cir. 2005).

<sup>92</sup> *BMG*, 430 F.3d at 892.



It is important to remember that the Berne Implementation amendments concerning notice do not apply retroactively. Thus, as to copies or phonorecords first distributed before the amendments' effective date of March 1, 1989, one must still ascertain whether notice was properly affixed. With respect to copies distributed without notice between 1978 and February 1989 (inclusive), it is necessary to determine whether the omission was discovered and cured within five years of initial publication, and whether the copyright owner made reasonable efforts to add notice to after-distributed copies.<sup>93</sup>

## 2. Deposit and Registration

Sections 407 through 412 of the 1976 Act enact a modernized administrative scheme with the dual purpose of enriching the resources of the Library of Congress and providing a comprehensive record of copyright claims. The former is achieved in section 407, which prescribes a mandatory system of deposit as to published works for Library purposes with administrative flexibility as to implementation and realistic sanctions for noncompliance under section 407(d) (not including forfeiture of copyright). The latter is embodied in a "permissive" registration provision, section 408. The Library deposit under section 407 may do double duty as the deposit required for registration under section 408. Moreover, the incentives for registration are quite strong. Accordingly, the dichotomy between these two deposit provisions may not be quite as sharp as initially thought.

### a. Deposit for Library of Congress

The section 407 deposit, which "shall" be made by "the owner of copyright or of the exclusive right of publication" within three months after publication in the United States, is to consist of "two complete copies of the best edition" or, if the work is a sound recording, two complete phonorecords of the best edition, together with all accompanying printed material.<sup>94</sup> The term "best edition" is defined in section 101 as "the edition, published in the United States at any time before the date of deposit, that the Library of Congress determines to be most suitable for its purposes."<sup>95</sup> The Library has issued a policy statement on what constitutes such a "best edition," and this is now referred to in the implementing Copyright Office regulations.<sup>96</sup>

The material for use or disposition of the Library of Congress under section 407(b) of the 1976 Act is to be deposited in the Copyright Office. Section 407(c) gives the Register of Copyrights authority to issue regulations exempting categories of material from the deposit requirements of this section, reducing the required copies or phonorecords to one, or, in the case of certain pictorial, graphic, or sculptural works,

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<sup>93</sup> See, e.g., *Garnier v. Andin Int'l, Inc.*, 36 F.3d 1214 (1st Cir. 1994). By virtue of section 104A, however, the copyrights in foreign works published without notice before 1989 were restored, effective January 1, 1995.

<sup>94</sup> 17 U.S.C. § 407.

<sup>95</sup> *Id.* § 101.

<sup>96</sup> See 37 C.F.R. 02.19(b)(1), & app. B. The deposit requirement was sustained against a variety of constitutional attacks in *Ladd v. Law & Technology Press*, 762 F.2d 809 (9th Cir.1985).

providing for exemptions or alternative forms of deposit. The Register is also empowered, under section 408(c), to specify classes of works for purposes of deposit and to permit the deposit of "identifying material instead of copies or phonorecords."

## b. Registration

### i. Procedure

Registration under section 408 contrasts with the Library deposit provision under section 407 in the following respects: (1) it may be made not only by the owner of copyright but also the owner of any exclusive right thereunder rather than by the owner of the exclusive right of publication; (2) it applies to unpublished as well as published works; (3) it includes works published abroad; and (4) it may be made "at any time" during the subsistence of copyright. If the Library deposit under section 407 is accompanied by a prescribed application for registration along with a fee (currently \$35 for an electronic filing and \$65 for a paper filing for most works),<sup>97</sup> it may be used to satisfy the deposit requirements of registration. The deposit copy must in most cases be a copy of the work in which copyright is claimed.<sup>98</sup>

The application for registration includes various items of information potentially required for computation of duration (e.g., year of death, year of creation, and year of publication if any), as well as the basis of ownership for persons other than authors and a brief, general statement of preexisting and added material used in any derivative work or compilation.<sup>99</sup>

### ii. Effect of Registration

Although the Berne Convention Implementation Act of 1988<sup>100</sup> had as one of its objectives the elimination of the need to comply with statutory formalities, its principal focus was upon the elimination of the *notice* requirement for published works; it made few changes in the sections on *deposit and registration* as they were written in the 1976 Act. The major change in this respect is that registration of copyright is no longer a prerequisite to an action for infringement of copyright "in Berne Convention works whose country of origin is not the United States." Most pertinently, this means that registration remains a prerequisite for an infringement action when the copyrighted work is first published in the United States or when the work, if unpublished, is by a United

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<sup>97</sup> See U.S. COPYRIGHT OFFICE, ANALYSIS AND PROPOSED COPYRIGHT FEE ADJUSTMENTS TO GO INTO EFFECT ON OR ABOUT AUGUST 1, 2009 (2009), available at <http://www.copyright.gov/reports/fees2009.pdf>.

<sup>98</sup> See *Coles v. Wonder*, 283 F.3d 798 (6th Cir. 2002) (1990 registration of 1982 song was invalid when the deposited copy was a "reconstruction" of the song from memory and without direct reference to the original; defendant is therefore awarded summary judgment, for lack of subject matter jurisdiction).

For certain types of works, it is permissible to deposit "identifying material" in lieu of a copy of the work, see 37 C.F.R. 202.20 and 202.21.

<sup>99</sup> See 17 U.S.C. § 409.

<sup>100</sup> Pub. L. No. 100-568, 102 Stat. 2853 (codified as amended in scattered sections of 17 U.S.C.).

States author.<sup>101</sup> The 1988 Act thus creates what is known as a two-tier registration system, with works of U.S. origin being on the "lower" tier for purposes of litigation.<sup>102</sup> The requirement of pre-suit registration has been criticized, both because of the inferior position in which it places U.S. authors compared to foreign authors and because it is not clear that the requirement in fact induces a substantial number of incremental registrations.<sup>103</sup>

In addition to seeking to encourage registration through the pre-suit requirement, the 1976 Act provided the following further incentives for timely registration: (1) registration within five years of first publication will ensure prima facie proof of validity of the copyright;<sup>104</sup> (2) statutory damages and attorney's fees may be awarded only if registration is made prior to the commencement of the infringement.<sup>105</sup> Given the high costs of litigation, the last-mentioned incentive is particularly important and indeed, for smaller litigants, may determine whether bringing an infringement action is financially viable. It is important to emphasize that these incentives apply to all works regardless of their countries of origin. As a practical matter, then, copyright registration promptly upon publication remains key to effective enforcement of copyright, even for non-U.S. works for which registration is not a prerequisite to suit.<sup>106</sup>

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<sup>101</sup> Id. § 411(a) ("no civil action for infringement shall be instituted until . . . registration of the copyright claim has been made in accordance with this title"). The Second Circuit has rejected an attempt to devise a "blanket registration" doctrine akin to the "blanket notice" of § 404(a) (see *supra* note 88), under which the registration of a copyright claim in a collective work would have covered the separate contents of the collective work as well. See *Morris v. Business Concepts, Inc.*, 283 F.3d 502 (2d Cir.2002).

<sup>102</sup> For an unsuccessful attempt to extend the pre-suit registration requirement to foreign works first published on a non-US website, on the ground that publication on the Internet occurs simultaneously in every country in which the work is accessible, thus rendering the work a "United States work" subject to sec. 411, see *Moberg v. Leygues*, 2009 U.S. Dist. LEXIS 93402 (D. Del. 2009) (rejecting simultaneous publication theory as contrary to the Berne Convention and US copyright law).

<sup>103</sup> See Robert Wedgeworth and Barbara Ringer, *The Library of Congress Advisory Committee on Copyright Registration and Deposit – Letter and Report of the Co-Chairs*, 17 Colum.-VLA J. L. & the Arts 271, 310 (1993) ("one thing on which all of the Members of ACCORD appeared to agree was the lack of hard evidence concerning the effect of sections 411(a) and 412(a) as inducements to registration."); id at 273 ("no empirical proof that these three sections induce registration").

<sup>104</sup> 17 U.S.C. § 410(c).

<sup>105</sup> Id. § 412, which makes these remedies available even as to post publication infringements that commence before registration if the latter is made within three months after first publication.

<sup>106</sup> A related question, receiving sparse but contradictory treatment from courts, is how closely the work registered must correspond to the work allegedly infringed. Compare *Streetwise Maps v. VanDam, Inc.*, 159 F.3d 739, 746-47 (2d Cir. 1998) (copyright registration of derivative work sufficient for copyright infringement action based on pre-existing work where plaintiff owned the copyrights for both the derivative and pre-existing work); *RW Beck, Inc. v. E3 Consulting LLC*, 577 F.3d 1133, 1143 (10th Cir. 2009) (citing *Streetwise* for same proposition), and *Christopher Phelps & Assoc. LLC v. Galloway*, 492 F.3d 532, 539 (4th Cir. 2007) (emphasizing that registration of architectural design sufficient to provide standing for suit for "entire design," including underlying, pre-existing, unregistered aspects of design), with *Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp.*, 354 F.3d 112, 116 (2d Cir. 2003) (registration of a claim on a pre-existing work confers jurisdiction over infringement claims regarding its derivative works). But see *Scholz Design v. Zimmerman*, 2009 WL 2226048, \*3--\*4 (D. Md. 2009) (registration of underlying architectural design does not cover claim alleging infringement of derivative work design). See also *Newton v. Diamond*, 349 F.3d 591 (9th Cir. 2003) (musical composition defined by deposit copy of musical score, rather than by recorded performance of the work which, if set in musical notation, would have included more notes); *Oravec v. Sunny Isles Luxury Ventures LC*, 527 F.3d 1218 (11th Cir. 2008) (claim of violation of

Whether or not they in fact increase the numbers of works registered, the registration incentives thus achieve a gatekeeper function, forestalling the claims of litigants, many of whom are likely to be individual authors. As Pamela Samuelson and Tara Wheatley have observed: “The prompt registration requirement for statutory damages has not become a meaningful inducement to registration for all authors who value copyright protection, but rather a substantial boon to major copyright industry players—the commercial exploiters of copyrighted works whose rights largely derive from the Act’s work for hire rules or assignments from authors . . . . ‘Little guy’ authors thus, in theory, have the same strong legal rights as major copyright industry players, but effectively no way to get relief when their rights are infringed.”<sup>107</sup>

Nonetheless, this filtering of small claimants may not always prove a boon to the larger economic actors who may perceive the pre-suit requirement and limitations on statutory damages and attorneys fees as desirable means of screening out frivolous claims.<sup>108</sup> For example, in a case involving the unauthorized digitization of the works of freelance journalists by the periodicals in which they had published their work, the Second Circuit held that the section 411 requirement that “registration of the copyright claim ha[ve] been made” before instituting an infringement action is “jurisdictional,” and that the court therefore did not have authority to approve a class action settlement which included compensation to authors of works whose authors had not registered them with the Copyright Office.<sup>109</sup> As a result, the large newspaper and magazine publisher defendants in that case face the prospect of additional liability for copyright infringement should the excluded class members subsequently register their works and resume the litigation. The US Supreme Court has heard an appeal from the decision.<sup>110</sup>

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architectural work rejected when registration was made in category of pictorial, graphic and sculptural works); *supra* note 98 (discussing *Coles v. Wonder*).

<sup>107</sup> Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright: A Remedy in Need of Reform* 51 WM. & MARY L. REV. (forthcoming 2009), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1375604](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1375604).

<sup>108</sup> See, e.g., Wedgeworth & Ringer, *supra* note 100, at 293 (fear that elimination of registration prerequisite to statutory damages and attorneys fees will engender a “flood of infringement claims”). See also Amicus Br. for the United States, *Reed Elsevier v. Muchnick*, No. 08-103 (June 2009) (registration requirement may filter out bad claims: “[T]he registration requirement may sometimes obviate the need for the court to rule on infringement claims at all, since a potential plaintiff whose registration application is denied by the Copyright Office may forgo suit rather than challenge the Register’s determination.”)]

<sup>109</sup> 17 U.S.C. § 411.

<sup>110</sup> See *In re Literary Works in Electronic Databases Copyright Litigation*, 509 F.3d 116 (2d Cir. 2007), cert. granted, 129 S. Ct. 1523 (2009). The Second Circuit’s decision appears to have inspired a particularly perverse interpretation of section 411 as barring an action for a declaration of *non* infringement if the work at issue has not been registered for copyright, see *Stuart Weitzman, LLC v. Microcomputer Res., Inc.*, 542 F.3d 859 (11th Cir. 2008).

While registration is a prerequisite to a suit for copyright infringement of a U.S. work, non-registration or improper registration does not prevent an action alleging violation of the § 1201 provisions prohibiting circumvention of technological measures that protect access to or prevent copying of a copyrighted work. See, e.g., *I.M.S. Inquiry Mgmt. v. Berkshire Info. Sys.*, 307 F. Supp. 2d 521 (S.D.N.Y. 2004).

The statutory language requiring pre-suit registration, or its literal interpretation, produces other undesirable results as well. For example, some courts have held that an author may not bring an infringement action until the registration in fact issues or is definitively refused by the Copyright Office.<sup>111</sup> As a result, an author who promptly *filed* an application for registration, but the determination of whose application falls prey to backlogs in the Copyright Office, may not have her claims adjudicated until the Copyright Office acts on the application.<sup>112</sup> Where the author has in fact sought to make the requisite public record of her claim, it is unclear what public policy such a wooden approach, whether it be Congress' or the courts', to registration advances.

### iii. Registration and Renewal of Copyright

While works created as of the January 1, 1978 effective date of the 1976 Copyright Act enjoy a unitary term of the life of the author plus (since 1998) seventy years (or, for works made for hire, anonymous or pseudonymous works, now 95 years from first publication), works first published under the 1909 Act come within a transitional regime. The 1976 Act initially preserved the renewal requirement for all works then in their first term of copyright. Thus the author of a work first published in 1960 would have had to register the work and renew its registration in order to obtain the second term of protection. In 1992, Congress provided for the "automatic renewal" of any work still in its first term; thus, for works first published between 1964 and 1977, the author's failure to renew would no longer cast the work into the public domain.<sup>113</sup>

## 3. Recordation of Transfers

The principal purpose of the registration formality is to facilitate ascertaining the copyright status and ownership of a work of authorship. Registration will aid title-searching, however, only to the extent it also accounts for subsequent transfers of

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<sup>111</sup> See, e.g., *La Resolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005); *Corbis Corp. v. Amazon.com*, 351 F. Supp. 2d 1090 (W.D. Wash. 2004); *Strategy Source, Inc. v. Lee*, 233 F. Supp. 2d 1 (D.D.C. 2002); *Do Denim v. Fried Denim*, 2009 U.S. Dist. LEXIS 51512 (S.D.N.Y. 2009). But see *Tri Marketing v. Mainstream Marketing*, 2009 US Dist. LEXIS 42694 (D. Minn. 2009) (holding jurisdictional requirement met upon submission of application).

<sup>112</sup> In 2005, Congress amended the registration provisions to add § 408(f), Pub. L. No. 109-9, 119 Stat. 218, 221, allowing for "preregistration of works being prepared for commercial distribution." The provision assists enforcement of copyright in a "class of works that the Register determines has had a history of infringement prior to authorized commercial distribution." This class consists of motion pictures, sound recordings, musical compositions, literary works being prepared for publication in book form, computer programs (including videogames), or advertising or marketing photographs, see 37 C.F.R. § 202.16(b). The fee is \$100 per work. *Id.* § 201.3(c)(10).

While it is possible to obtain rapid resolution of an application for registration, the expedited procedure involves substantial additional expense: where the standard fee is \$65 (or \$35 for an online filing), the fee for "special handling" is \$760. 37 C.F.R. § 201.3(d) (2009). Where the registration claim has been pending for at least six months, however, the Copyright Office will waive the additional fee for "special handling." See Fees for Special Handling of Registration Claims, 74 Fed. Reg. 39900-01 (August 10, 2009).

<sup>113</sup> See 17 U.S.C. § 304(a)(2). In *Kahle v. Gonzales*, 487 F.3d 697 (9th Cir. 2007), the Ninth Circuit upheld the automatic renewal amendment against a challenge that Congress' abandonment of that copyright-confiscatory formality altered the "traditional contours" of copyright in violation of the first amendment.

ownership. Section 205 of the Copyright Act permits recordation of properly executed documents, and accords constructive notice to the recorded facts if:

- (c)(1) the document, or material attached to it, specifically identifies the work to which it pertains so that, after the document is indexed by the Register of Copyrights, it would be revealed by a reasonable search under the title or registration number of the work; and
- (2) registration has been made for the work.<sup>114</sup>

Section 205 offers a further encouragement to take measures enhancing the utility of the Copyright Office's records: in the event of a conflict of transfers, the first to record prevails. Section 205, however, no longer accompanies these carrots with a stick. In its original guise, section 205(d) of the 1976 Act made recordation a prerequisite to suit, but in the Berne-adherence amendments Congress deleted that requirement. The Berne-adherence amendments may in this instance have undermined one of the beneficial functions of formalities in a context in which the requirement may not in fact have been Berne-incompatible.<sup>115</sup>

### **III. Author-Friendly Formal Requirements?**

Formalities have benefits. If all works are protected, whether or not their authors have asserted rights in them, then an untold number of works whose authors neither maintain nor exploit them remain off limits to others' exploitation, without profit to their creators. Arguably, if the creator cannot take care enough to mark off her claims, then perhaps the public should be entitled to rely on the absence of notice to treat the work as unclaimed and free. Law and economics reasoning might reinforce this conclusion: The creator is better able to assume the costs of notification than the public is to incur the costs of tracing right holders. And those search costs can be high, particularly if the work is old, or if rights have been divided up among a variety of grantees (and their heirs). A system that requires authors first to assert rights, through notice in distributed copies, or registration in a publicly accessible record, alerts the world to the author's claims. A system that obliges all transfers of rights to be recorded on the publicly accessible record facilitates tracing right holders.

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<sup>114</sup> 17 U.S.C. § 205.

<sup>115</sup> See discussion, *supra* Part I.A. Congress nevertheless was convinced that pre-suit recordation was Berne-incompatible. S. REP. NO.100-352 (1988) ("The committee concludes that the recordation requirement of section 205(d) , at least as applied to foreign works originating in Berne countries, is incompatible with the Berne prohibition against formalities as preconditions for the 'enjoyment and exercise' of copyright."). The conclusion, however, was a main point of contention in consideration of the Act. Cf. The Berne Convention: Hearings on S. 1301 and S. 1971 Before the Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary, 100th Cong. 156 (1988) (statement of Ralph Oman, Register of Copyrights) (advocating for S. 1971, which did not eliminate pre-suit registration or recordation); H.R. REP. NO. 100-609 (1988) ("The [pre-suit recordation requirement] is Berne compatible because the failure to record does not lead to loss of the copyright---it merely regulates who may sue.").

Notice, registration, and recordation of transfers thus are unquestionably beneficial and desirable; the problem, and the historical difference between the US and much of the rest of the world, lies in the consequences of failure to affix notice, register, or record a transfer of ownership. Confiscating the copyrights of the non compliant, or barring their way to the courthouse door, may encourage adherence to formalities.<sup>116</sup> But not all those who fail to fulfill these obligations do so because they do not care about their works. Some lose track; some are ignorant of the obligation, particularly if they reside in foreign countries which do not impose formalities; some may find the fees prohibitive. The last point is not trivial, particularly for individual creators. Fees of \$35 (for electronic filings) to \$65 (for paper filings) per work may not impose a significant financial burden if the author creates relatively few works. For example, if the author produces one novel every year or two, the registration fee would seem unproblematic (and will in any event likely be paid by the publisher). But if the author creates a large volume of works, for example, in the visual arts, the fees per work quickly add up. The author who cannot afford to register all her works might wait to see which of her works attracts an audience before selecting which to register, but this strategy may prove perilous. Not only does the cost of registration increase to \$760 for an eve-of-litigation registration,<sup>117</sup> but because statutory damages and attorneys fees are available only with respect to works that were registered within three months of publication, or before the infringement occurred, the author who waits to see what succeeds (and infringement can be evidence of success) will have lost the opportunity to obtain statutory damages and attorneys fees, and therefore may find she cannot afford to bring the suit.<sup>118</sup>

Former Register of Copyrights Barbara Ringer, whose understanding of US copyright formalities was second to none,<sup>119</sup> proclaimed, regarding the registration

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<sup>116</sup> *But see supra* note 102.

<sup>117</sup> *See supra* note 111.

<sup>118</sup> *See* 17 USC § 412. The Copyright Office regulations allow registration of certain works, for example, photographs published within 12 months of each other, as a group, for which one fee will apply. 37 C.F.R. § 202.3(b)(10). But waiting till twelve months have elapsed before registering the group may disqualify from statutory damages any photographs not registered before the infringement occurred. It is, however, possible to register the photographs in three-month batches, *see id.* § 202.3(b)(10)(vi) (thereby also quadrupling the registration fees), thus taking advantage of the three-month grace period if the infringement occurs soon after publication.

It also is not clear whether, when a work is registered as part of a group, the “work” for purposes of calculating statutory damages, is the group or its individual components. If two works within a group are infringed, then the characterization of “the work” will either double or halve the basis for calculation of damages. For examples of courts grappling to sort out the relevant work(s) from a group registration *see Gamma Audio & Video, Inc. v. Ean-Chea*, 11 F.3d 1106, 1117 & n.8 (1st Cir. 1993) (“We are unable to find any language in either the statute or the corresponding regulations that precludes a copyright owner from registering the copyrights in multiple works on a single registration form while still collecting an award of statutory damages for the infringement of each work’s copyright . . . the number of copyright registrations is not the unit of reference for determining the number of awards of statutory damages.”); *Walt Disney Co. v. Powell*, 897 F.2d 565, 569 (D.C. Cir. 1990) (assessing status as individual work by asking whether work could “live its own copyright life” (quoting *Robert Stigwood Group, Ltd. v. O’Reilly*, 530 F.2d 1096, 1105 (2d Cir. 1976))).

<sup>119</sup> *See, e.g.*, Barbara Ringer, *First Thoughts on the Copyright Act of 1976*, 22 N. Y. L. SCH. L. REV. 477 (1977); Ringer, *supra* note 31; *see also* Wedgeworth & Ringer, *supra* note 103; Doyle, Cary, McCannon & Ringer, *supra* note 47.

formality, “My philosophy has always been to reward authors for what they do, not to punish them for what they don’t do.”<sup>120</sup> To obtain the social benefits of formalities without disadvantaging authors, it may be desirable to look beyond the current copyright law and the Copyright Office to alternatives to demarcating the public domain status of a work, and to establishing a traceable public record of copyright claims. With respect to the former, under the default position of the copyright law (and of the Berne Convention) an original work of authorship is automatically protected; absence of notice or of registration does not entitle members of the public to conclude that the work is freely appropriable. But if it is no longer necessary to assert rights through notice or other formalities in order to vest copyright, perhaps a formal *relinquishment* of rights might suffice to place a work in the public domain (or at least to enable a court to conclude that the author is estopped from enforcing her rights). Thus, an unambiguous notice, such as the Creative Commons PD icon, might shift the default as to given works away from protected status. The burden thus would not be on the author to acquire rights, but rather to *disclaim* them.

With respect to rights clearance, the records of collective licensing societies, if open to the public, offer another source of information. For works in digital formats, rightholders may embed “copyright management information” identifying the author and subsequent rightholders and setting out terms and conditions for licenses or permissions. Section 1202 of the Copyright Act protects this information against removal or tampering, although the statutory scope of protection has proved inadequate in several instances.<sup>121</sup> The Creative Commons icons standardize certain kinds of copyright management information, marking off the scope of rights granted or withheld. These markers perform a very useful notice function, identifying both the author and, within a limited set of choices, the nature of the uses permitted (commercial or non commercial; whether or not derivative works are authorized). The omnibus nature of a CC license, however, makes it inappropriate for authors who wish to differentiate among licensees. Nor do the licenses directly assist authors who would seek to be paid for the works they distribute using the icons, because Creative Commons does not currently incorporate a payment mechanism. On the other hand, an author’s selection of the “non commercial” license could be understood as an invitation to bargain with the author for the right to exploit the work commercially.<sup>122</sup>

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<sup>120</sup> Judith Nierman, *Barbara Ringer: 1925-1909*, COPYRIGHT NOTICES, April 2009 (Special Edition), at 1, 5.

<sup>121</sup> See, e.g., *Kelly v. Arriba Soft Corp.*, 77 F. Supp. 2d 1116 (C.D. Cal. 1999), *aff’d.*, 336 F.3d 811 (9th Cir. 2003) (declining to protect information about authorship, terms and conditions for exploiting work because plaintiff had not embedded the copyright management information in the images themselves, but had included it elsewhere on his webpages); *Gordon v. Nextel Comms.*, 345 F.3d 922 (6th Cir. 2003) (failure to prove that removal of copyright notice was intentional and intended to facilitate infringement); *Jacobsen v Katzer*, 2009 U.S. Dist. LEXIS 115204, (ND Cal 2009) (defendants’ removal of names of the authors and copyright holder, title, reference to license, where to find the license and the copyright notices, renaming the files and referring to their own copyright notice and naming themselves as author and copyright owner: while the information was protectible under section 1202, facts alleged did not suffice to prove defendants’ knowledge and intent).

<sup>122</sup> Thanks to Prof. Jessica Litman for this observation.



Real improvements in title searching may well require amending the copyright act (with all the perils that entails) in at least three respects. First, the author's name should normally furnish the best starting point for ascertaining copyright ownership,<sup>123</sup> particularly if no publicly-accessible registry includes a given work's first or subsequent copyright owner. Effective title searching then depends on the work's disclosure of the author's name. This may seem an obvious point, but appearances mislead: the point's obviousness is premised on the expectation that the author's name will in fact appear in connection with her work. Or put another way, that the author enjoys an enforceable right of attribution. In fact, outside the narrow realm of certain works of visual art,<sup>124</sup> the U.S. copyright act does not give authors the right to name recognition. And it seems that other federal or state sources (other than contracts) afford authors no recourse either.<sup>125</sup> Thus, Congress should include a general right of authorship attribution in the copyright act.<sup>126</sup>

Second, we need a reliable record of transfers of copyright interests. Congress might consider enacting a variety of incentives. Were Congress to reimpose a pre-suit recordation requirement, that amendment should not violate the Berne Convention, because, as discussed earlier,<sup>127</sup> a filing obligation that addresses *who* owns a copyright, rather than *whether* a copyright exists or may be enforced is not a prohibited "formality" in the sense of that treaty. Arguably, barring the courthouse door to the copyright grantee does make the right unenforceable because anyone else is a stranger to the right, and therefore no one else can enforce it. But the copyright act already provides one solution to that impasse: a "beneficial" copyright owner, for example, an author who transferred rights in return for royalties, has standing to bring an infringement action.<sup>128</sup> On the other hand, an author who does not retain a continuing royalty interest may not be a "beneficial owner," and therefore may lack standing.<sup>129</sup> Congress could provide a more

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<sup>123</sup> Cf. Berne Conv. art. 15(1) ("In order that the author of a literary or artistic work protected by this Convention shall, in the absence of proof to the contrary, be regarded as such, and consequently be entitled to institute infringement proceedings in the countries of the Union, it shall be sufficient for his name to appear on the work in the usual manner. This paragraph shall be applicable even if this name is a pseudonym, where the pseudonym adopted by the author leaves no doubt as to his identity."). See also Jessica Litman, *Real Copyright Reform*, [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1474929](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1474929) (9/15/09 draft), ("In a world of media conglomerates who purchase each other's divisions, spin off product lines, and liquidate in bankruptcy at a dizzying rate, an author is now far easier to track down than her assorted assignees, their successors and their respective assignees. It also seems more likely that an author will have kept track of what publisher bought her publisher than that a publisher will know how to find all of the authors whose contracts it assumed when it purchased the company that purchased the company that initially held the author's contracts.")

<sup>124</sup> See 17 USC § 106A (attribution rights in narrowly-defined "works of visual art").

<sup>125</sup> See generally, Jane C. Ginsburg, *The Right to Claim Authorship in US Trademarks and Copyright Law*, 41 Hous. L. Rev. 263 (2004) (surveying sources of attribution rights and proposing amendment to the copyright act).

<sup>126</sup> For details of a proposed attribution right, see, e.g., id; Justin Hughes, *American Moral Rights and Fixing the Dastar "Gap"*, 2007 Utah L. Rev. 659, 699-703. Contra, Rebecca Tushnet, *Naming Rights: Attribution and Law*, 2007 Utah L. Rev. 781.

<sup>127</sup> See supra, part IA.

<sup>128</sup> 17 USC § 501(b).

<sup>129</sup> See, e.g., *Cortner v. Israel*, 732 F.2d 267, 271 (1984) (considering basic example of beneficial owner as "an author who had parted with legal title to the copyright in exchange for percentage royalties based on

radical and recordation-incentivizing solution: any exclusive rights that are transferred but not recorded within a stated period will revert to their grantors. Requiring recordation as a prerequisite to suit, or indeed, as a condition of the validity of the grant,<sup>130</sup> will, however, only assist title-searching to the extent that the recordation documents clearly define the scope of the grant of rights granted. Thus, as a corollary to a reinforced recordation obligation, Congress might further provide that any ambiguities in the scope of the recorded grant will be interpreted against the grantee.

Third, returning to the Copyright Office, while a central public register ideally should be the best, most complete source of information about the existence and ownership of copyrights, problems of practical implementation and of fairness to individual authors and smaller copyright owners caution against tying meaningful copyright enforcement to copyright registration.<sup>131</sup> On the other hand, while pre-suit or pre-infringement registration requirements should therefore be eliminated, registration should be encouraged, notably because the recordation system here advocated depends on initial registration of the work in which rights are assigned or licensed. For individual creators of large volumes of works for whom separate registrations become cumulatively prohibitive, one might consider establishment of annual registration accounts into which authors would prepay a substantially discounted blanket fee covering the year's production so that each individual work upon publication could be registered without further payment. The accounts would work like employee "flexible spending accounts": at the start of the year, the author would pay in a sum which she believes will, at the discounted rate, cover the number of works she expects to register in the course of the year. If she exhausts the deposited sum, she would pay additional fees for additional works; in order to avoid discouraging the registration of the additional works, the fees should still reflect the discount. If she in fact registers fewer works than anticipated, the Copyright Office would keep the difference.

An efficiently-working registration system may provide its own best incentive, but we are not likely to enjoy such a centralized system unless it is adequately staffed and supported by government funding. Congressional intent to encourage registration must be implemented through efficient and low cost procedures that will enable the Copyright Office in fact to process promptly all the applications whose registration US public policy purports to favor. At the moment, when the waiting time between filing for and issuance

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sales or license fees" (quoting H.R. Rep. No. 1476, 94th Cong., 2d Sess. 159, *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5775). *But see* *Warren v. Fox Family Worldwide, Inc.*, 328 F.3d 1136, 1145 (2003) (holding that grant of royalties to creator of work-for-hire does not create beneficial ownership). Perhaps, however, the author's inalienable termination right under sec. 203 might constitute sufficient continuing economic interest to qualify the author as a beneficial owner. *But cf. Hearn v. Meyer*, 664 F. Supp. 832, 844 (1987) (finding merely possible reversion of royalty interest insufficient to create beneficial ownership).

<sup>130</sup> Cf. 17 USC § 204(a)(transfer of copyright ownership must be in writing and signed by the grantor).

<sup>131</sup> Arguably one person's "fairness to individual authors" is another's "encouragement of strike suits", but there should be means, other than making lawsuits unaffordable for valid claimants, to discourage frivolous claims, such as the award of attorneys fees against the losing plaintiff, see 17 U.S.C. sec. 505 (court may award costs and attorneys fees to prevailing party).

of a registration exceeds 18 months for a paper filing,<sup>132</sup> and averages 6 months for an electronic filing,<sup>133</sup> if substantially more creators of works of authorship in fact sought to register them than do now, the already backlogged Copyright Office might well be incapable of handling them.

Changing the registration system from one based on examination to an automatic repository of claims might reduce backlog, but it is not clear that this kind of streamlining would in fact improve the system. Because the originality threshold for copyrightability is very low,<sup>134</sup> and the Copyright Office in fact registers the overwhelming majority of claims,<sup>135</sup> one might contend that little would be lost, and time would be gained, were Congress to discard the examination. If in fact the backlog were attributable to time copyright examiners spend ascertaining the originality of the works for which registration is sought, the proposal might be compelling, especially if in most cases minimal originality is apparent. But it appears that examiners spend the bulk of their time addressing other aspects of the applications, particularly the internal consistency of the information the applicant supplied and its conformity with the information requested by the form.<sup>136</sup> In other words, examiners devote most of their time to verifying that the applications establish a reliable public record of the claim and claimants.<sup>137</sup>

The examination justifies the provision of the copyright act which makes registration within five years of first publication “constitute prima facie evidence of the validity of the copyright.”<sup>138</sup> Prima facie validity serves at least two functions. First, it places the burden on the defendant to disprove the work’s originality or the accuracy of the other information, such as the date of the work’s creation. The practical significance

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<sup>132</sup> See Lindsey Layton, © 2009? *Wishful Thinking, Perhaps, as Backlog Mounts*, WASHINGTON POST, May 19, 2009, available at <http://www.washingtonpost.com/wp-dyn/content/article/2009/05/18/AR2009051803171.html>. If electronic filings displace paper filings, the paper filing backlog may diminish.

<sup>133</sup> Copyright Office, eCO Online System (updated Aug. 5, 2009), at <http://www.copyright.gov/register/>. But see Copyright Office, Frequently Asked Questions (updated Nov. 5, 2009), at <http://www.copyright.gov/help/faq/faq-what.html#certificate> (estimating closer to 9 month waiting time).

<sup>134</sup> A “modicum of creativity” will suffice. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 346 (1991). The standard of creativity for obtaining a patent is much higher, and requires substantive expertise on the part of the examiners. See 35 U.S.C. § 102 (2006) (novelty); § 103 (non obviousness).

<sup>135</sup> See, e.g., Copyright Office Annual report, 2007 at 11 (“During fiscal year 2007, the Copyright Office received 541,212 claims to copyright covering well over a million works and registered 526,378 claims . . .”), <http://www.copyright.gov/reports/annual/2007/ar2007.pdf>.

<sup>136</sup> DONALD W. KING, ET AL., COST-BENEFIT ANALYSIS OF U.S. COPYRIGHT FORMALITIES 34-35 (1987) [hereinafter “COST-BENEFIT ANALYSIS”] (distinguishing a thorough examination that delves deeply into originality and novelty from a “ cursory examination to determine only that all technical requirements are carried out” and implying that the Copyright Office system tends toward the latter, in that it “does not generally examine works for artistic merit or newness, nor . . . does it ‘examine’ works to determine if the work is in fact an ‘original’ work”).

<sup>137</sup> COST-BENEFIT ANALYSIS, *supra* note 136, at 30 (1987) (emphasizing registration as means of providing “useful information to the public” and noting the Copyright Office’s “complete historical file, dating back to the first registration made at the office in 1870”).

<sup>138</sup> See 17 U.S.C. § 410(c); § 401(a) makes clear that the registration’s prima facie value as to the copyrightability of the subject matter and validity of the information contained in the registration results from the examination process.

of this function depends on whether the allocation of the burden to the defendant in fact changes the outcome when originality is in dispute.<sup>139</sup> If courts in effect address originality *de novo*, the evidentiary advantages of registration would lie principally with respect to proof of dates of creation and publication; in cases where the dates of creation or dissemination of plaintiff's and defendant's works are at issue,<sup>140</sup> assignment of the burden of proof can make a difference.<sup>141</sup>

The second function of presumptive validity may carry even more practical consequences. A Cease and Desist letter to which a copy of a registration is appended may be far more effective than an unaccompanied demand.<sup>142</sup> The registration represents a government determination that the work in question crosses the threshold of copyrightability and that the author is the initial copyright owner. If the registration were simply an unverified record of the author's assertions, it is not clear that it would provide admonitory benefits. Thus, even were registration no longer a prerequisite to statutory damages and attorneys fees, authors (as well as the general public) still would be better served by a credible public record of their works than without one. Voluntary compliance with formalities accordingly promotes the interests of both authors and their audiences. But, without a smoothly-functioning registration system, the current US system of de facto mandatory formalities simply penalizes authors without sufficiently advancing the public record.

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<sup>139</sup> *Compare., Sapon v. DC Comics*, 2002 WL 485730 (S.D.N.Y. 2002) (despite plaintiff's registration for his "Black Bat" allegedly infringed by DC Comics' Batman, defendant had little difficulty establishing lack of originality); *Past Pluto Productions Corp. v. Dana*, 627 F. Supp. 1435 (S.D.N.Y. 1986) (despite plaintiff's registration for his foam hat of Statue of Liberty Crown allegedly infringed by defendant's foam hat of Statute of Liberty Crown, defendant had little difficulty establishing lack of originality), *with, Maljack Productions, Inc. v. UAV Corp.*, 964 F. Supp. 1416, 1428 n.9 (C.D. Cal. 1997) (finding "UAV's mere supposition, unsupported by evidence, is insufficient to rebut the presumption of validity of the certificate of copyright"); *Stanislawski v. Jordan*, 337 F. Supp. 2d 1103, 1109 (E.D. Wis. 2004) (appearing to give significant weight to registration as evidence that plaintiff's works were not derivative).

<sup>140</sup> *See, e.g., Repp v Webber*, 132 F.3d 882 (2d. Cir. 1997) (counterclaimant Andrew Lloyd Webber asserted that plaintiff's song was copied from earlier song by Webber).

<sup>141</sup> *See COST-BENEFIT ANALYSIS, supra* note 136, at 105 (in 1987 study, in 80% of lawsuits, *prima facie* evidentiary value of registration was found to be "very important" (59%) or "somewhat important" (21%) in settling or terminating the lawsuit. "When *prima facie* evidence supplied by the copyright registration was challenged, the challenge was not successful 83 percent of the time.")

<sup>142</sup> *Id.* (in 71% of non litigated disputes, *prima facie* evidentiary value of registration was found to be "very important" (46%) or "somewhat important" (25%) in resolving the dispute).