

## **Copyright from Inside the Box: A View from the U.S. Copyright Office\***

### *Keynote Address*

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Good morning. I want to thank Professors Ginsburg and Besek for inviting me to speak today and introducing me. I also want to thank everyone at the Kernochan Center and the *Journal of Law and the Arts* for their assistance. It's always a pleasure to be here—a block from where I grew up. And an entire event about copyrightability, what a wonderful thing. This topic is usually covered in just a couple minutes in a panel, but I really want to welcome you to my world at the U.S. Copyright Office. I'd also like to take a moment for a pitch for a twenty-first century Copyright Office as well. This is a picture of the Office as it appeared in the 1920s, so we are actually not still using typewriters. This is a more current view of my office that, on a daily basis, examines more claims than the federal courts review in any given year. The issues that come up are enormously varied and complex. But where we start our assessment of copyrightability in the Office is where we start when we first begin studying copyright law, and where we start when we're teaching copyright with our students—back to the basic principles of copyright, and some of the seminal cases on creativity.

As you'll recall looking at some of these classic bedrock cases, *Alfred Bell v. Catalda* dealt with issue of mezzotints of public domain oil paintings by classic masters, and a question for the Second Circuit was whether these reproductions were copyrightable as derivative works.<sup>1</sup> These cases are an important foundation for first principles in copyright law, because Congress did not define many of the critical terms or standards for copyrightability. We don't have a definition of what is a "work," of who is an "author," or of how much or what kind of authorship is necessary for a work to be copyrightable. So this critical information comes from these early court decisions. But if we look at some of these classic cases, we must

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1. 191 F.2d 99 (2d Cir. 1951).

do so with a critical eye and with the knowledge that Congress and subsequent Supreme Court decisions have provided additional information since these decisions. For instance, in *Catalda*, the court wrote that “a copyist’s bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the ‘author’ may adopt it as his and copyright it.”<sup>2</sup>

This raises the question: “Really? A clap of thunder? Is that all that we need to establish sufficient creative authorship in a work?” A sudden inadvertent movement may address some issues with respect to copyrightability, such as whether intent is necessary. As a general rule, there is mostly agreement that an author need not have intended a particular result in order to be the creator of a work. But that conclusion does not really address the question about the sufficiency of the creative contribution or what it is that is copyrightable, or the scope of the copyright. *Catalda* may address originality with respect to independent creation, but it does not address the sufficiency of the creative contribution to justify federal copyright protection. We see in some of the court’s statements that something more than a merely trivial variation is recognized as the touchstone. But originality in this context does little to distinguish between sufficient creative authorship and the requirement of independent creation, or inadequacy of merely copying. So again, does this decision tell us more about independent creation than it does about explaining how to determine what is sufficient creativity?

So we look back to other Supreme Court decisions. In *Bleistein* we find a classic opinion by Justice Holmes dealing with the question of whether circus posters are copyrightable at a time when the statute included the term “fine art” as the subject matter of copyright. Thus, the broader question addressed was whether something that was a mere advertisement could be copyrightable.<sup>3</sup> And this is an essential case for the concept of aesthetic nondiscrimination—the warning that we should not look to a subjective view of aesthetic merit to determine copyrightability. From this decision, we obtain Justice Holmes’s classic quote that it would be a “dangerous undertaking” for judges to be involved in determinations of what qualifies as art.<sup>4</sup> But when we’re thinking about this in the context of originality, again, we see that originality in this context means little more than a prohibition on actual copying. No matter how poor artistically the author’s addition, it is enough if it be its own. Again, that contribution doesn’t really help us with understanding the necessary amount of creative authorship that must be contributed to a work. The decision instructs courts (and the Office) not to impose subjective or objective views of aesthetic merit, but rather to evaluate the independently created contributions of the author. These courts are looking at cases based on the particular facts before them, and often have a particular goal in mind. But these decisions do not provide us with all the information we need to

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2. *Id.* at 105.

3. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

4. *Id.* at 251.

examine the full panoply of questions that arise with respect to copyrightable subject matter and copyrightability. These cases offer guidance, but few answers, for how to define the line between sufficient and insufficient contributions.

If we go back a little further in time to the Supreme Court's decision in *Sarony*, involving the classic photograph of Oscar Wilde, we obtain more information about the requisite contributions of an author.<sup>5</sup> The question before the court was whether a photograph was copyrightable subject matter. The defendant argued, among other things, that the work was not copyrightable because it was a mere mechanical process and was therefore not creative.<sup>6</sup> It's interesting that although this is the first case that recognized that photography and photographs could be within the scope of the copyrightable subject matter, the Court was expressly considering the specifics of *this* photograph and *this* photographer's contributions in assessing sufficient authorship.<sup>7</sup> In this decision, we find the Court assessing not only independent creation, but see more development and discussion of what facts are considered in determining whether a work is sufficiently creative. But we only obtain this information with respect to the *Sarony* work. We are provided with little information about how to evaluate the sufficiency of creativity involved in photographs generally. With respect to the argument that photography was merely a mechanical process reproducing the real world, the Court stated: "This may be true in regard to the ordinary production of a photograph, and, further, that in such case a copyright is no protection. On the question as thus stated we decide nothing."<sup>8</sup>

There was no judgment made about whether an "ordinary" photograph is copyrightable or what the characteristics of such an "ordinary production of a photograph" might be. But the Court did discuss what the aspects of sufficient creativity are in the context of *Sarony*'s photograph. And we see in this paragraph the discussion of all of the creative aspects that the photographer contributed in terms of arranging the subject, the drapery, the selection and arrangement of the angles, and everything else.<sup>9</sup> This listing of the creative contributions provides some real substance as to what qualifies as the contribution of creativity to a particular work. It does not articulate where the line is with respect to insufficient creativity. That is the difficult statutory duty of line-drawing that the U.S. Copyright Office's Examiners face every day for all works of authorship in every conceivable category and class of copyrightable subject matter.

Certainly, the amount of creativity added by the author in the *Sarony* case is

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5. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

6. *Id.* at 59.

7. *Id.* at 59–61.

8. *Id.* at 59.

9. *Id.* at 60 (describing *Sarony*'s photograph as a "useful, new, harmonious, characteristic, and graceful picture . . . entirely from [Plaintiff's] own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff").

more than you would expect to find from an animal. This question, however, was raised in a recent lawsuit by PETA seeking to extend federal copyright protection to animals.<sup>10</sup> The fact that the monkey selfie controversy was the most important questions answered by our recently published revision of the *Compendium of U.S. Copyright Office Practices, Third Edition*,<sup>11</sup> from the public perspective, or at least the press perspective, was a bit depressing, given that this was a reference to one example in a 1,288 page work that took over two years to complete. It should be noted that the Office was not weighing in on the particular facts of this case, but rather, the Office was merely stating the longstanding principle that we will not register works produced by nature, animals, or plants, including a photograph taken by a monkey.<sup>12</sup> We did not, in fact, say anything about this particular photograph and have no judgment as to who the author is or whether it's copyrightable, but human authorship is required in our view.<sup>13</sup>

We read and teach these classic cases to learn from them. However, we must also recognize that the cases mentioned were all dealing with prior copyright acts. The *Feist* decision is the only post-1976 Act Supreme Court decision focusing on originality and sufficient creativity, and is really the critical decision for the U.S. Copyright Office and its administration of a national registration system. *Feist* gave us a lot more information about the level of creativity that is required. It also went further to specifically state for the first time that originality is a constitutional requirement.<sup>14</sup> The discussion and analysis in the *Feist* decision is extremely instructive. It is a case with personal significance for me. It was decided while I was studying copyright law in law school. Moreover, when I was interviewing for a position at the U.S. Copyright Office in 1999, I was asked what I thought was the most important development in copyright law in the last decade. I answered that the *Feist* decision was the most important development for a number of reasons. It was a critical decision for the U.S. Copyright Office in a number of ways, including that all works must meet the two-fold elements of originality, (1) independent creation and (2) sufficient creativity, and also that while the vast majority will satisfy this requirement quite easily, some works will not. After placing this decision in such high esteem, when I was admitted to the Supreme Court bar many years ago, I had the opportunity to briefly meet Justice O'Connor at a reception

10. See *'Monkey Selfie' Case Brings Animal Rights Into Focus*, PETA (Jan. 6, 2016), <http://www.peta.org/blog/monkey-selfie-case-animal-rights-focus/> [<https://perma.cc/P3DB-YKPJ>]; Complaint for Copyright Infringement, *Naruto v. Slater*, No. 3:15 Civ. 04324, 2016 WL 362231 (N.D. Cal. Sept. 21, 2015).

11. U.S. COPYRIGHT OFFICE, *COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES (THIRD)* (3d ed. 2014), [copyright.gov/comp3/](http://copyright.gov/comp3/) [<https://perma.cc/C2XZ-8FQ7>].

12. See *COMPENDIUM (THIRD)* § 313.2 (“The Office will not register works produced by nature, animals, or plants.” Examples include: “A photograph taken by a monkey.”).

13. Recently, the court in *Naruto v. Slater* adopted the Office's view. See *Naruto v. Slater*, No. 3:15 Civ. 04324, 2016 WL 362231, at \*4 (N.D. Cal. Jan. 28, 2016) (relying on *COMPENDIUM (THIRD)* § 313.2 to conclude that “[i]n light of the plain language of the Copyright Act, past judicial interpretations of the Act's authorship requirement, and guidance from the Copyright Office” that “Naruto [the monkey] is not an ‘author’ within the meaning of the Copyright Act”).

14. *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

after the admission. I mentioned that I was a copyright law professor and that I always enjoyed teaching the *Feist* decision more than any other part of the class. Justice O'Connor responded, "Ah, copyright, what an interesting area. I always wished that I had taken it in law school."

But the *Feist* decision provided us a lot of the critical information and foundational principles that we need to think about on both sides of the copyrightability equation. It showed that there is an originality level that all works must meet as a constitutional requirement. In every case we have to look at whether there is not only independent creation, but also a sufficiency of creative authorship in the work. And while the Court reiterated that the amount of creativity required is not high, and that most works make the grade quite easily, some do not.<sup>15</sup> The Copyright Office seeks to administer the *Feist* decision's teachings in conjunction with a faithful administration of the Copyright Act's text. I would say about ninety-five percent probably an even a slightly higher percentage, of the applications that we receive are registered, and certificates of registration are issued to the claimant. But for every claim, we have to look closely, and identify whether this constitutional and statutory requirement of originality has been met. Even if all of the elements are uncopyrightable, we also endeavor to assess whether creative selection, coordination, and/or arrangement of those elements is sufficient to support a claim in copyright. Identifying a sufficient level of creativity that is required for all works is the primary role of the Examiner in every particular case. That creativity must be perceptible or demonstrated in the deposit submitted with the application and fee rather than in a creative explanation of the work's creativity by the applicant.

The *Feist* decision also made clear that just because certain types of works are mentioned in the statute, that does not tell us anything in particular about those works.<sup>16</sup> Compilations were listed in the Act and led some courts to believe that since Congress listed it, they need not look at the level of creativity involved, but rather that those works were per se copyrightable. The same is true of all categories and classes of works listed in the statute. For each class, while it may be true that a vast majority of those works can demonstrate a sufficient level of creativity, not all will. The Office must separate the wheat from the chaff, as it were, and question or refuse that small percentage of claims for which sufficient creativity is lacking. We have to carefully scrutinize works in all listed categories and classes of authorship and engage in appropriate line-drawing that is faithful to the Copyright Act and the teachings of the *Feist* decision. We must also faithfully apply *Feist*'s teachings on the "sweat of the brow" doctrine and those other contributions of time and effort that are not relevant to the sufficiency of creativity or copyrightability.<sup>17</sup> And the *Feist* decision is also important for its recognition of the U.S. Copyright Office's role in clarifying some of these issues. In the revision process leading up to the 1976 Act, the Register of Copyrights had identified past

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15. *Id.* at 345.

16. *Id.* at 357.

17. *Id.* at 353.

problems that had occurred in the courts' interpretation of copyrightability, and the Court noted that Congress followed the advice of the Register in the creation of the new Copyright Act.<sup>18</sup>

The Court stated that not every selection, coordination, or arrangement will pass muster; there is a line that all works must pass, and that some works will fail.<sup>19</sup> And we have some specific language which, despite being discussed in the context of the relatively easy case dealing with alphabetical listings in "white page" phone directories, provides some basis for evaluating other types of works and thinking about what is copyrightable for the vast array of copyrightable subject matter that the Office must examine. This includes phrases and terms like: "[t]here remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent";<sup>20</sup> "could not be more obvious";<sup>21</sup> "[t]he end product is . . . garden-variety";<sup>22</sup> and "there is nothing remotely creative about arranging names alphabetically."<sup>23</sup> From this guidance from the Court, the Office must decide: how do we translate the concept of alphabetical ordering into other types of works, for instance, into visual arts works, musical works, sound recordings, choreography and other categories and class of authorship? But we try to be faithful to this decision and do what the Court instructed in this case. Moreover, we try to learn from the reasoning of the decision by carefully examining the words in the statute—and I think one of the most important lessons of the case is the Court's demonstration of careful reading of all of the words in the statutory language, its clauses, and a consistent reading with other sections of the statute.

We also learned from the *Feist* decision the importance of looking at a work as a whole, rather than examining and dissecting individual components of works. In the case of *Atari v. Oman*, which was an action brought against the Copyright Office for refusing to register the *Breakout* game, Judge (now Justice) Ginsburg sent this refusal back to the Copyright Office two times, instructing the Office to consider the requirements of *Feist* and to look at all of the elements of the work as a whole and not just breaking it apart into component parts.<sup>24</sup>

That was an important lesson for the Office in conforming to the teachings of *Feist*. One of the biggest concerns that the Court of Appeals for the D.C. Circuit had with the Office's refusal was its lack of adequate explanation for the refusal.<sup>25</sup> As we move forward, I have made a dedicated effort to ensure that Examiners and attorneys in the Office of Registration Policy and Practice explain their reasoning clearly and as specifically as possible. Just as your math teacher probably told you, don't just provide the answer or conclusion, but rather, "show your work." That is a guiding principle that the Registration Program is working towards every day.

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18. *Id.* at 358.

19. *Id.* at 364.

20. *Id.* at 359.

21. *Id.* at 362.

22. *Id.*

23. *Id.* at 363.

24. 888 F.2d 878, 883 (D.C. Cir. 1989).

25. *Id.* at 881.

Many other questions arise, though, questions beyond the issues of sufficient creativity. For instance, there are issues of subject matter. Are all dances copyrightable as choreography? Are all movements copyrightable as choreography, such as in the case of yoga poses? Is an actor or actress's performance copyrightable as a dramatic work or pantomime? Are the section 102 categories a limit on copyrightable subject matter? For the Office's assessment of this latter question, I would refer you to the 2012 policy statement on compilations which, I believe, followed and expanded on *Feist's* reasoning and the relevant legislative history to faithfully resolve that question as Congress intended: Congress reserved unto itself the ability to add to the categories of copyrightable authorship (as it did with architectural works, for example), but delegated to courts to discern the proper scope of those listed categories.<sup>26</sup> Many of you have seen cases questioning the proper subject matter of copyright, for instance, the recent claim for copyright protection of a chicken sandwich. The court found this not to be the proper subject matter of copyright, and that the Plaintiff didn't really even make a specific claim for copyright protection.<sup>27</sup> In any event, there was not enough creative authorship in terms of the recipe or the end result for it to be copyrightable.<sup>28</sup> The courts and the Office often rely heavily on sufficiency of creativity to justify a denial of copyrightability or refusal of registration. However, the courts and the Office are increasingly looking at other important principles, including subject matter, fixation, and the section 102(b) categories of uncopyrightable subject matter.

While sufficient creativity is an important part of the examination process, we also have to consider other questions that the Copyright Act compels in determining whether a claim meets the legal and formal requirements for copyrightability. Questions of fixation sometimes arise and are often tied closely with the question of what is the subject matter being claimed. So later today, you'll be hearing about the copyrightability of gardens or parks—one well-known case resulted in a court decision that the work claimed, a garden, was not fixed.<sup>29</sup> But it is fair to question whether that is the best analysis, when fixation is such a very easy standard to achieve under the statutory definition of a work being capable of being "perceived, reproduced, or otherwise communicated."<sup>30</sup> Clearly, we could reproduce this work, as you can see from this photograph shown on this screen, but the question is, what is the subject matter of the work? Is it the photograph, or is it the subject that is depicted in the photograph?

There are other kinds of works that raise these same issues, for instance, fireworks. Fireworks are capable of being fixed on film or video, but again the question is—what is the subject matter of the claim? Is it the photograph that's taken of the fireworks, or the subject matter of the photograph that clearly does not

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26. Registration of Claims to Copyright, 77 Fed. Reg. 37,605, 37,606-37,608 (June 22, 2012).

27. *Lorenzana v. S. Am. Rest. Corp.*, 799 F.3d 31, 34 (3d Cir. 2015).

28. *Id.*

29. *See Kelley v. Chi. Park Dist.*, 635 F.3d 290, 304 (7th Cir. 2011).

30. 17 U.S.C. § 101 (definition of "fixed").

appear to fit within the categories of copyrightable authorship under section 102(a)?

In addition, we have to look at other doctrines that are important under section 102. For instance, in *Nichols*, Judge Learned Hand expressed the classic statement of the abstractions test and how courts must consider questions of the idea/expression dichotomy.<sup>31</sup> This often comes up more often in the context of infringement than copyrightability, but it's something that is very important to consider with, for instance, descriptions, photographs, illustrations, or models. Is the claimed work the description or the system, method, or principle that it describes? Is the illustration the work and does that extend to the subject depicted?

The courts are considering these issues and so is the Office. There are many cases where we have to assess a useful article and decide whether there is physically or conceptually separable authorship from useful article. While the Office applies its longstanding test for conceptual separability that some courts defer to,<sup>32</sup> other courts create their own test to fit the question before them.<sup>33</sup> However, it's important to consider that the Office does not have the luxury of creating a new test for every factual question that arises. We have to administer a national copyright registration system for all categories of authorship that is applicable to all creators nationwide. Unlike courts, we are not adjudicating an infringement suit between two parties. We strive to apply statutory principles in a consistent manner across the nation with respect to registration. The statute affords courts the option of disagreeing with our conclusion and/or reasoning. But it's important for courts to remember that we don't have the benefit of factual arguments, cross-examination, discovery, market effects, expert witnesses, or other evidence that may affect a court's determination. The registration process simply examines the claim and the deposit and seeks to ensure that the legal and formal requirements of a claim in copyright are met in accordance with our longstanding institutional expertise in these questions. As Congress conceived it, a final determination by the registration system as a prerequisite to filing an infringement suit is intended to benefit the courts and serve as an important filter for the courts. Moreover, there is a function of the system that many do not appreciate—we serve to mediate and limit claims even when we ultimately issue a certificate of registration rather than a refusal. While less than five percent of claims are refused, many claims result in correspondence that require a limitation of the claim, identification of the copyrightable contribution, a proper deposit, resubmission on proper form, payment of a correct fee, et cetera. This mediation of the claim may be very useful to a court and a party when the case goes to trial. Furthermore, when applicants do not respond to our correspondence, which occurs quite frequently, the application is closed and no further action will be taken on the claim

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31. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

32. COMPENDIUM (THIRD) § 924.2(B).

33. See *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484–85, 487 (6th Cir. 2015) *petition for cert. filed*, No. 15-866,—U.S.—(Jan. 16, 2016) (outlining nine distinct tests for determining conceptual separability before continuing on to adopt a “hybrid approach”).

unless a new application is submitted.

One enhancement of the current system that I have advocated for and that many agree would be useful is a registry of refusals. The Office currently has a registry of registrations for which certificates have issued, but there is nothing in our online record addressing refusals, cases closed as “no-replies,” or withdrawals of claims. We intend to explore the public benefit of this enhancement as we move toward the Register of Copyrights’s goal of a twenty-first century U.S. Copyright Office.<sup>34</sup>

In that vein, I would also like to mention an area of enormous concern to the Office and the Register’s statutory authority. As I said, under the congressional design of the statute, the Office is placed in an intermediary position to the courts. As a prerequisite to bringing a copyright infringement suit, sections 410 and 411(a) require the Register to determine whether to register or refuse a claim in copyright of a work. Some courts have interpreted this to mean that a creator or owner must simply have filed an application for registration with the Office, the so-called “Application Rule.” However, under any interpretation of the Act, an application for registration is not the same thing as the issuance of a certificate of registration or a refusal by the Office. The evidentiary presumption that the issuance of a certificate within five years of publication entails is limited to the facts stated in the certificate of registration, not the application.<sup>35</sup> Not only does the statute withhold the evidentiary presumption until a certificate of registration issues, but it provides the Register of Copyrights with specific statutory rights if the Register refuses registration.<sup>36</sup> In particular, the statute allows the plaintiff who files an infringement suit based on a refused application to file, only upon notice, on the Register (and under the Rules of Civil Procedure, the Department of Justice) of the initiation of the action for infringement and a copy of the complaint, and provides the Register with a statutory right to intervene in the action for infringement.<sup>37</sup>

Given that the majority of applications result in the issuance of a certificate of registration, some courts have found that requiring a plaintiff to wait for a decision by the Office could result in judicial delay.<sup>38</sup> Notwithstanding the fact that the statute requires this result, there are other reasons why the Application Rule is inappropriate. First, any applicant in litigation can request, for a fee, “special handling,” which expedites the examination of a claim in litigation to five business days. Second, if the court moves forward with a case in which the Register has not made a decision, not only does the court lose the benefit of the Office’s findings with respect to the legal and formal requirements of the Copyright Act (including copyrightability, the appropriateness of the claim or facts stated in conjunction with the examination of the deposit, the sufficiency of the deposit, or many other statutory or regulatory nuances of registration), but the court deprives the Register

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34. U.S. Copyright Office, *Strategic Plan 2016-2020: Positioning the United States Copyright Office for the Future* (2015), <http://copyright.gov/reports/strategic-plan/sp2016-2020.html> [https://perma.cc/RBU7-S4LA].

35. 17 U.S.C. § 410(c).

36. 17 U.S.C. § 411(a).

37. *Id.*

38. See generally 2 NIMMER ON COPYRIGHT § 7.16[B][3][b][ii] (2016).

of a clear statutory right in cases that result in refusal. Congress clearly intended this mediation as an important benefit to the courts by making it a prerequisite to filing an action for infringement. What was not clearly anticipated was the fact that even where the issuance of a certificate or refusal has not been achieved, the Office may issue correspondence requiring additional information, a limitation of the claim, a statutorily-required deposit, or some other legal or formal requirement of the Act, that may result in an altered claim, a refused claim, or a closed claim for failure to reply. Thus, the Application Rule not only violates the congressional scheme, but does a disservice to the legal process and the intended benefit that the Office was intended to provide to the courts.

Although some ambiguity was found by one court in section 410(d) that has led courts to believe that the Application Rule was embraced by Congress, this interpretation is misplaced.<sup>39</sup> The ability of courts to determine the “effective date of registration” by a “court of competent jurisdiction [later determined] to be acceptable for registration” must be read in context.<sup>40</sup> In context, this allows a court that disagrees with the Register’s refusal to find a work copyrightable for purposes of the infringement action and for purposes of section 412 and the award of statutory damages and attorney’s fees.<sup>41</sup> If a court disagrees with a refusal in the context of a particular infringement action, the court may set the “effective date of registration” as the date in which the U.S. Copyright Office received the application for registration that the court believes should have been registered.<sup>42</sup>

As I’ll discuss further below, the 1976 Act made a significant change from the 1909 Act. Under the 1909 Act, no infringement suit could be instituted without the Office issuing a certificate of registration.<sup>43</sup> At most, a refused applicant could seek a writ of mandamus. The 1976 Act altered this result and allowed an applicant to bring a suit based on a refusal under specific procedural circumstances. Congress wanted the courts to be able to revisit the determination of copyrightability. I, as the Associate Register of Copyrights and Director of

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39. See *Cosmetic Ideas, Inc. v. IAC/InteractiveCorp*, 606 F.3d 612, 619 (9th Cir. 2010) (concluding “that the application approach better fulfills Congress’s purpose of providing broad copyright protection while maintaining a robust federal register”).

40. 17 U.S.C. § 410(d).

41. 17 U.S.C. § 412.

42. See 17 U.S.C. § 410(b) (providing the statutory authority for the Register to refuse a claim); § 410(d) (detailing the criteria required to establish the effective date of a registration); § 411(a) (establishing registration, preregistration, or refusal as a prerequisite to bringing an infringement suit); and § 412 (establishing registration, preregistration, or refusal as a prerequisite to an award of attorney’s fees or statutory damages). It should also be noted that when Congress enacted the PRO IP Act in 2008 and amended § 411(b), they made it clear that “[a] *certificate of registration* satisfies the requirements of this section and section 412, regardless of whether the *certificate* contains any inaccurate information.” Prioritizing Resources and Organization for Intellectual Property Act of 2008 (PRO IP Act) Pub. L. No. 110-401, 122 Stat. 4256 (2008) (emphasis added). It is clear that Congress intended that a *completed* registration, for which a certificate has been issued, meets the prerequisite requirements of §§ 411 and 412, not the mere act of applying for registration.

43. Copyright Act of 1909, § 12 (repealed 1976) (“No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with.”).

Registration Policy and Practice, want the courts to be able to revisit the issue of copyrightability when my Examiners refuse a work. This is the enhancement that Congress made in the 1976 Act and the Office fully embraces it. That said, the courts may only reach a different conclusion with respect to the work involved in a particular infringement action. While courts may find a work copyrightable for purposes of the infringement action before them, they do not have authority to order the Register to issue a certificate of registration,<sup>44</sup> nor do they have the authority to order the Register to cancel an existing registration.<sup>45</sup> In many instances, a refusal may ensure that courts do not give the Office deference in a situation where the Office is not convinced that a work is copyrightable. In my view, this is precisely the mediation function that Congress intended for the Office and the reconsideration envisioned for the federal judiciary.

So this raises the question of what deference the courts should give to the Office. The Office has received deference in a number of cases, or at least the courts have found the Office's views persuasive.<sup>46</sup> But I think one of the important questions in terms of copyrightability from an institutional perspective is what should the Office's default be? In the past, the Copyright Office had a culture that we give the benefit of the doubt to the applicant, thereby defaulting to registration rather than refusal. Looking at this more, there is a persuasive case to be made to default in the opposite direction. If the Office has doubts about copyrightability, it may make more sense to refuse the claim given the statutory scheme. Given the evidentiary presumption, albeit rebuttable, that goes along with the registration of a work, where copyrightability has not been demonstrated as being more likely than not, why should the Office afford an applicant an evidentiary presumption pursuant to the statute? Since there is no evidentiary presumption that is afforded to a refusal, it may make more sense to ensure that a court carefully examines claims that are questionable.<sup>47</sup> As I mentioned, under the 1909 Act, there was no way to bring a copyright infringement case unless someone received a certificate of registration. The 1976 Act changed that, and now there is the ability to bring an action for copyright infringement based on the refusal of a work, as long as the Plaintiff provides proper notice to the Office and courts respect the Register's statutory right to intervene at her discretion.<sup>48</sup> Also, there is the availability of

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44. See *Atari Games Corp. v. Oman*, 979 F.2d 242, 243 (D.C. Cir. 1992) (merely remanding the case for further consideration by the Office, rather than ordering registration, despite finding, on two separate occasions, that the Register of Copyrights did not properly apply the standards for originality outlined by the Supreme Court in *Feist*).

45. See *Brownstein v. Lindsay*, 742 F.3d 55 (3d Cir. 2014) (holding that courts have no inherent or statutory authority to cancel copyright registrations).

46. See, e.g., *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038 (9th Cir. 2014) (holding that *Skidmore* deference was appropriate for the Copyright Office's Compendium and opinion letters).

47. See 17 U.S.C. § 410(c) (providing that "[i]n any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.").

48. 17 U.S.C. § 411(a).

Administrative Procedures Act (“APA”) actions against the Office, and administrative requests for reconsideration within the Office when the Office refuses registration of a work.<sup>49</sup> There are in fact two administrative appeals or requests for reconsideration within the Office, but it is important to understand that those administrative appeals do not alter the statutory design—an administrative appeal does not obviate the statutory requirement to serve notice on the Register when an application has been refused for registration. It simply affords an opportunity for the applicant to have the claim reviewed, first the Office of Registration Policy and Practice, and if a second request for reconsideration is filed based on an affirmance of the first appeal, an opportunity to have the decision reviewed by the Review Board of the U.S. Copyright Office.<sup>50</sup>

But from my informal review of cases over the last twenty-five years, it appears to me that courts tend to give more deference to the Office for the issuance of certificates of registration than they do for refusals of works,<sup>51</sup> and that makes sense given the evidentiary presumption that the statute requires for registrations submitted within five years of publication. Courts appear to be quite willing on occasion to disagree with the Office when the Office refuses a work, particularly given that they are looking at those works in the context of a particular claim. Courts are often in a position to consider facts beyond those available to the Office at the time of registration. But where the Office refuses registration of a work based on a determination of questionable copyrightability, this forces courts to scrutinize the claim much more closely than they might where an evidentiary presumption applies or where the court may defer to the Office’s substantive expertise. As a practical matter, I really don’t want deference or an evidentiary presumption to be afforded to claims in works that we are not confident about. In fact, if the Office had adequate resources, it may be more important for there to be internal review when the Office issues a certificate of registration in close-calls as opposed to when the Office issues a refusal. At present with the existing level of staffing of Copyright Examiners, it would be impossible to have peer review or supervisor review of all approved claims. However, we are looking into whether we can provide increased review of borderline cases under existing staffing levels. The bottom line is that we could do more to ensure higher quality with sufficient staffing—at least staffing that matched or exceeded the 120 Examiners we used to

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49. See COMPENDIUM (THIRD) §§ 1701–08 (detailing the Office’s administrative review process), [copyright.gov/comp3/](https://copyright.gov/comp3/) [<https://perma.cc/C2XZ-8FQ7>].

50. The Office has become aware of some parties who have claimed that the Office has not rendered a decision when an administrative appeal is still pending. Where an initial application has been refused, § 411(a) requires a party initiating a copyright infringement suit to serve notice on the Register that a suit is being brought based on a refusal. An administrative appeal does not affect this statutory requirement in any way, except where an appeal overturns a refusal prior to the initiation of a copyright infringement action.

51. See, e.g., *Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp. 2d 482 (E.D. Pa. 2002) (granting “some deference” to the Copyright Office’s refusal to register a work, and also noting that “since the statute permits a party whose application was denied to sue for copyright infringement, Congress did not intend, in our view, narrowly to constrain a jury or a court from finding a rejected work to be copyrightable and infringed”).

have in 2010. By the end of this Fiscal Year, we anticipate having approximately 104 Copyright Examiners to examine approximately a half-million claims a year.

I should point out that in the past year, all of the existing and newly hired Examiners, as well as supervisors, have received the equivalent of a complete law school copyright course as a refresher to ensure that everyone understands the concepts of copyright law. In addition, there is ongoing training on the ways in which the *Compendium* revision has been harmonized with the Copyright Act. The emphasis in the Registration Program is firmly rooted in quality, and if we need more staff to fulfill our commitment to quality, that is what we will ensure happens. We can never sacrifice quality in order to meet workload pressure. Fortunately, in addition to our qualified veteran Examiners, our new Examiners have demonstrated enormous enthusiasm and dedication. We are very excited about our role in the national copyright system and committed to continually improving our services to applicants, the public, practitioners, and the courts.

Finally, in terms of the deference to the Office, courts generally provide the Office with *Skidmore* deference for registration decisions, meaning generally, the Office receives deference to the extent that the Office is able to persuade a fact-finder.<sup>52</sup> And this is an important with respect to registrability. When we do issue a certificate, there is no reasoning that goes along with that issuance, although there is an evidentiary presumption in many cases. It's only in the case of a refusal that the Office provides some articulation of the reasons why that work was refused.<sup>53</sup> And the Office typically articulates more of its reasoning the further that the claim goes in the process—including the initial correspondence and any follow-up correspondence, the refusal letter, the first and second request for reconsideration, and the Office's response to those administrative appeals.<sup>54</sup> Since the Office receives *Skidmore* deference only to the extent that its reasoning is persuasive, logical, statutorily sound, and reasonable, it is all the more important for us to "show our work," so that courts can understand why we reached the decision to refuse. What some applicants are seeing is that we are beginning to correspond more frequently, to insist on greater clarity in claims more often, and in appropriate circumstances, annotating certificates in more cases, in order to explain and clarify the basis or reasoning on which we registered a work, or refused registration. And when courts disagree with us, we welcome the information that we get from them through their well-reasoned decisions. In some cases where there are questions and doubts about these issues, it is our sincere hope that the Office can focus the courts' attention to issues, stimulating judicial reasoning on difficult or unsettled issues, and encouraging that reasoning if courts do disagree.

In conclusion, for many of the specific issues that come up with respect to

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52. See *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944) (holding that agency's interpretive rules deserve deference to the extent that they are persuasive).

53. See COMPENDIUM (THIRD) § 210 ("If the Office finds that an applicant has not met the requirements for copyright registration, the Office will refuse to register the claim and will specify the reasons for its decision.").

54. See COMPENDIUM (THIRD) § 1703.2 ("If the Office upholds the refusal to register, it will notify the applicant in writing and will explain the reasons for its decision.").

registrability and copyrightability from a U.S. Copyright Office perspective, our recently published *Compendium of U.S. Copyright Office Practices, Third Edition*, which we published in final form in December of 2014, provides a wealth of information about the Office's practices, procedures, and views of copyright law, particularly as they relate to registration and copyrightability.<sup>55</sup> This revised *Compendium* has gotten many positive reviews from practitioners, academics, and the public, and has been cited nearly a dozen times by the courts.<sup>56</sup> It is a living document that we are committed to keeping current, and we hope will answer or provide insight into many of the questions that will be raised by the panelists who will speak on various issues throughout the day at this wonderful conference. Thank you very much.

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55. COMPENDIUM (THIRD) is available at [copyright.gov/comp3/](http://copyright.gov/comp3/) [<https://perma.cc/C2XZ-8FQ7>].

56. See *Varsity Brands, Inc. v. Star Athletic, LLC*, 799 F.3d 468 (6th Cir. 2015); *Ray Charles Found. v. Robinson*, 795 F.3d 1109 (9th Cir. 2015); *Naruto v. Slater*, No. 15 Civ. 04324, 2016 WL 362231 (N.D. Cal. Jan. 28, 2016); *Media.net Advertising FZ-LLC v. Netseer, Inc.*, No. 14 Civ. 03883, 2016 WL 141707 (N.D. Cal. Jan. 12, 2016); *Asche & Spencer Music, Inc. v. Principato-Young Entertainment, Inc.*, No. 15 3305, 2015 WL 7573884 (D. Minn. Nov. 24, 2015); *Marya v. Warner/Chappell Music, Inc.*, No. Civ. 13-4460, 2015 WL 5568497 (C.D. Cal. Sept. 22, 2015); *Schenck v. Orosz*, 105 F.Supp.3d 812 (M.D. Tenn. 2015); *Ward v. Barnes & Noble, Inc.*, 93 F.Supp.3d 193 (S.D.N.Y. 2015); *Oracle America, Inc. v. Terix Computer Co.*, No. 5-13 Civ. 03385, 2014 WL 31344 (N.D. Cal. Jan. 3, 2015); *Jane Envy, LLC v. Best Imports & Wholesale, LLC*, No. 5-14 Civ. 81, 2014 WL 7338879, at \*4 (W.D. Tex. Dec. 22, 2014); *Jane Envy, LLC v. Infinite Classic Inc.*, No 5-14 Civ. 83, 2014 WL 7338884 (W.D. Tex. Dec. 22, 2014).