



The Inevitable Registration or Refusal Approach

By: Jim Astrachan

No one who knows will dispute that registration of a work is not a prerequisite to copyright. Folks just seem to know that copyright inheres from the moment an original work is fixed in a tangible medium of expression. Type a short story into the memory of your computer and you have a copyright; slop some oil paint on a canvas and you have a copyright. No filing with the Registrar of Copyrights is required.

Nor does anyone in the know dispute that registration of a work with the Registrar, or the Registrar's refusal to register, is a prerequisite to a suit for copyright infringement. The copyright statute reads, "no action for infringement of the copyright in any United States work shall be instituted until registration of the copyright claim has been made." It matters not whether the suit seeks monetary damages or injunctive relief. If you want to sue for infringement, you have to register or attempt to register and be rejected. But, there is a significant dispute among different courts as to what constitutes registration and not knowing which courts take what positions can create big problems and lead to dismissed lawsuits, sometimes after limitations have run. Some courts have held that mailing the application with the necessary fee and deposit copy qualifies as registration. Other courts say no; action on the registration by the Registrar of Copyrights is needed, and they will dismiss suits if the Registrar has not acted by the time suit was filed.

There are two kinds of authors of copyright works: Those who register their works as soon as, or before, they publish, and those who do not register their works until they are forced to do so to protect their rights. The first group has no problem meeting the statutory requirement of registration in order to file suit. The second group, however, learn of infringement, demand an immediate redress and implore counsel to move quickly to stop the harm. From experience, quick action may include filing suit at the same time the registration application hits the mailbox. The early registrants in the first group possess a certificate evidencing registration, or a denial of registration, in hand when they file; the procrastinators do not. Do they need to?

Recently, a District Court judge in Maryland dismissed an action on the basis that registration had not actually occurred although the application for registration had been mailed. Last month, the U.S. Court of Appeals for the Tenth Circuit held that the actual registration, or refusal of the Registrar to register, is a prerequisite to an infringement action, affirming dismissal of a suit prematurely brought. The Tenth Circuit joined with the Eleventh Circuit in adopting what has been called the "registration approach", rejecting the "application approach." Strictly construing the Copyright Act the court concluded that the statutory requirement of registration, or refusal, means more than merely placing the application, fee and deposit copy in the mail. It requires action by the Registrar – registration or denial.

The U.S. Court of Appeals for the Fifth, Second and Third Circuits, however, have adopted the "application approach" as have some District Courts in the Ninth Circuit and in D.C. Treatise author, David Nimmer, asserts that the "application approach" is the more common, and preferred approach. But, Nimmer of course, is not a federal judge. He can only suggest. I have to agree with Mr. Nimmer and those circuits that follow the "application approach" and I have followed the "application approach" many times without problem.

There are many good reasons to favor the application over registration approach. For one, scrutiny of the application by the Registrar is inevitable if the application is completed and mailed or delivered to the right address. The Registrar will either register the work or reject it. Why, then, should the applicant have to go through the expense and effort of expediting the registration? Why must the Registrar say "yes" or "no" before allowing the suit to proceed when the Registrar's yes or no decision is a certainty if the application reaches the Registrar? If it is inevitable that the application will be acted upon in one way or the other, either decision meeting the stuffy prerequisite to filing, why shouldn't the applicant be allowed to sue as soon as the application is mailed? It's not as though the presumption of validity created by registration is critical to a court inasmuch as ; refusal to register creates no presumption of invalidity.

The simple answer is that a copyright owner should be allowed to file suit when the completed application hits the mailbox or is at least able to prove that his application was received by the Registrars, whose own regulations provide that registration is effective as of the date of receipt and not the date of review. As the United States District Court for the District of Columbia held a few years ago, doing so, "best effectuates the interests of justice and promotes judicial economy." Some courts have even allowed a plaintiff who filed a copyright infringement action without having mailed an application for registration to amend his complaint once the application is made.

Maybe it's an issue of strict statutory construction versus practicality and Congressional intent. I have never been a judge so I never had to decide, but if I was,

in this case, I would adopt a new approach: The “Inevitable Registration or Refusal Approach,” and I would be very hesitant to dismiss a suit where it is shown that when the suit was filed, the application was really in the mail.

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