

The logo for Astrachan Gunst Thomas features a stylized, swirling blue graphic to the left of the firm's name. The name "astrachan gunst thomas" is written in a lowercase, sans-serif font, with "astrachan" and "thomas" in a darker blue and "gunst" in a lighter blue.

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CAN YOU HEAR THE DRUMS FERNANDO?

By: Jim Astrachan

Sometimes it's the smallest of details that trip us up. Little things we overlook, like dead batteries in a smoke alarm. Fernando Torres-Negrón learned this lesson, taught by a United States Court of Appeals, the hard way. And it cost him dearly.

In 1993 Fernando was asked by his amigo, Rubén Cañuelas, to write a song for the friend's merengue band. Fernando listened to a tape of the band's music to pick up its style, and the result was music and lyrics for a merengue bomba rhythm song he named *Noche de Fiesta*. He wrote the song on a sheet of paper and made a taped recording of him singing the song. Fernando handed over the paper and the tape and didn't look back. That is, until 2001 when he learned that the song had been included on 3 CD's that were distributed in Puerto Rico and the continental United States without his blessing.

Seeking to enforce his rights in the copyright to the song he wrote, he registered his work with the Registrar of Copyrights in Washington, D.C. Apparently, Fernando was a heck of a song writer, but not much of a businessman for he had failed to make and keep a copy of the paper and cassette he gave to friend Rubén. And since the Copyright Act requires that an application for registration be accompanied by a copy of the work, Fernando created from memory a new typed version of the lyrics and a cassette on which he sang the song and clapped the rhythm. What's a guy to do?

The registration issued in due course and Fernando sued a number of persons he thought responsible for copyright infringement. Eventually, claims against some defendants were dismissed, and claims against others went to the jury which returned a verdict of infringement.

Up to this point the case had been pretty much a garden-variety copyright case, but a defendant's renewed motion for judgment as a matter of law changed that and the case was elevated to a higher level as a case of almost first impression. The basis for the motion was that the court lacked subject matter jurisdiction to hear Fernando's

copyright case because the deposit copies of *Noche de Fiesta* were not bona fide copies of the work, but instead, were “reconstructions” and as such were invalid. The defendant asserted that if the deposit copy was invalid, then it had to follow that the resulting registration was invalid because registration of a published work requires a deposit copy. And without a registration, the district court lacked subject matter jurisdiction.

The same judge who first heard and denied defendant’s motion to dismiss considered the renewed motion, and low and behold granted the motion, holding “a copy that is simply created or reconstructed from memory without directly referring to the original, known as a ‘reconstruction’, does not comply with the deposit requirements of the Copyright Act.”

Fernando filed his appeal with the First Circuit in an effort to restore the jury verdict that he asserted had been wrongfully snatched from him. The appellate court reviewed the dismissal for lack of subject matter jurisdiction. Critical to its ultimate decision was §411(a) of the Copyright Act that 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 in accordance with this Title.” In plainer words, registration of the copyright is a prerequisite to suit for infringement in a United States district court – the only court where a copyright suit can be brought. Thus, the registration requirement is jurisdictional.

The appellate court focused on the fact that the written lyrics and the cassette tape sent to the Registrar with the application were not the originals, and were not the “exact tape or piece of paper on which he first recorded the music or wrote the lyrics of the song.” At issue was whether copies of the work, reconstructed from memory, qualified as “copies”, and the court held that the reconstructions created by poor Fernando who was without access to the originals he had created years earlier could not be “copies”. To support its conclusion, the court referred to Black’s Law Dictionary that defines a copy as an “imitation or reproduction of an original”, and to Webster’s Dictionary that defines reconstruction as “to construct again; rebuild; make over”; or to “recreate in the mind from some available information.” It added to these sources of support similar decisions of the Ninth and Sixth Circuits.

Just because the Ninth and Sixth Circuits took this approach does not mean that the First Circuit couldn’t do the right thing for Fernando. The fundamental purpose of requiring an applicant seeking registration to deposit copies is to provide the Library of Congress, through the Copyright Office, with copies of all works published in the United States! And get this - Section 407 of the Act allows a deposit to be made within 3 months following publication of the work, which requirement becomes mandatory only if the Registrar makes a written demand. Failure to comply may result in a fine, but the copyright will not be forfeited, although under the earlier Copyright Act, that’s exactly what would have happened on failure to deposit. So even the Act or the Registrar recognizes that there are circumstances where failure to deposit does not invalidate a copyright. Most importantly there was no factual dispute over whether Fernando wrote

the lyrics and music; there was a jury trial and every party had an opportunity to testify. What happened was that the court, having the power to act equitably did not even though it was clear to all that Fernando's work was taken without his authorization. In ruling this way the court left Fernando without any remedy whatsoever merely because he delivered his only copy of his original work to Rubén. Although the ruling can be defended, it's just plain wrong.

James B. Astrachan is the author of The Law of Advertising, published by Matthew Bender-Lexis/Nexis.