A (Brief) Overview of *Fourth Estate Public Benefit Corporation v. Wall-Street.com, LLC*

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On June 28, 2018 the Supreme Court granted a petition for *certiorari* to determine when "registration of [a] copyright claim has been made" within the meaning of 17 U.S.C. § 411(a).[2] Lower courts are split in deciding whether "registration" means when the copyright holder delivers the required application, deposit, and fee to the Copyright Office or only once the Copyright Office acts on that application.

Fourth Estate Public Benefits Corporation is a news organization that produces online journalism, often licensing articles to websites and retaining the copyright to the articles.[3] Wall-Street.com is a news website that obtains licenses to a number of articles produced by Fourth Estate.[4] The license agreement in question required Wall-Street to remove all of the content produced by Fourth Estate from its website before Wall-Street cancelled its account.[5] When Wall-Street cancelled its account with Fourth Estate, it continued to display Fourth Estate articles.[6]

Fourth Estate filed a complaint for copyright infringement pursuant to 17 U.S.C. § 501 against Wall-Street.com, alleging that Fourth Estate had filed "applications to register [the] articles with the Register of Copyrights."[7] However, the complaint did not specify if the Register of Copyrights had yet to act on the application. Wall-Street.com moved to dismiss the complaint, arguing that the Copyright Act permits a suit for copyright infringement only after the Register of Copyrights approves or denies an application to register a copyright.

The lower court, the Court of Appeals for the Eleventh Circuit, held the requirements of § 411(a) to be met only once the Copyright Office acts on that application. Other circuits have concluded that registration occurs when the owner files the application with the Copyright Office.[8] The United States Copyright Office joined a CVSG brief[9] filed by the U.S. solicitor general, which argued that based on the text, structure, and history of the Copyright Act, a copyright infringement suit may not be filed until the Register of Copyrights has either approved or refused registration of the work.

The brief argues that the plain text of § 411(a) "imposes a precondition to filing a claim"[10] of infringement, which can be satisfied via registration "only when the Register has approved an application"[11] or when the registration has been rejected. Further, the brief notes that Petitioner's

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interpretation of the Copyright Act is either mistaken,[12] or "subverts the Congressional purpose" of the third sentence of § 411(a), which permits the Register, after refusing registration, to become a party to civil actions with respect to the issue of registerability. Finally, it points out that other provisions of the Copyright Act[13] reinforce the court of appeals' interpretation, as well as the history of the Copyright Act.

The Copyright Act of 1909 stated that "[n]o 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."[14] Courts subsequently interpreted that language as "requiring dismissal of any infringement suit that was filed before the owner had obtained a certificate of registration, even if the proper deposit had been made."[15] Even after registration had been refused, a copyright owner was previously required to obtain a writ of mandamus compelling the Register to grant registration of its copyright before instituting an infringement suit. This rule was the backdrop for § 411(a) of the 1976 Act.[16]

Fourth Estate argues that the 11th Circuit misreads the word "registration" alone to refer to the action of the Copyright Office.[17] They argue that a correct reading refers to the action of the copyright holder, rather than that of the Register.[18] Fourth Estate also argues that a copyright holder's rights do not depend on any affirmative government action, therefore registration with the Copyright Office should not be a necessary precondition to enforce rights.[19] Finally, Fourth Estate argues that the "application" approach does not limit the Register's power to refuse registration because the "copyright owner still has the right to sue and enforce those rights."[20]

There are practical consequences of the Supreme Court's decision. If the "application" approach is adopted, the Copyright Office will no longer play a mandatory role in the road to litigation. While a plain reading of the Copyright Act may indicate registration is not required, it should be. The Copyright Office provides invaluable guidance to the courts regarding copyrightable subject matter due to years of experience.[21]

A further investigation into *Fourth Estate*, as well as its effect on the registration process and the Copyright Office, may be found in a forthcoming article written by University of Kentucky College of Law Professor Brian L. Frye and student Nicole E. Pottinger.

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[2] Section 411(a) allows a copyright holder who filed an application for registration to file an infringement suit if "registration has been refused." 17 U.S.C. § 411(a).

[3] *Fourth Estate Pub. Ben. Corp. v. Wall-Street.com, LLC.*, 856 F.3d 1338, 1339 (2017).

[4] *Id.*

[5] *Id.*

[6] *Id.*

[7] *Id.*

[8] *See Cosmetic Ideas, Inc. v. IAC/InteractiveCorp*, 606 F.3d 612 (9th Cir. 2010) (following the "application" approach, which requires a copyright owner to plead that he has filed the appropriate documents before filing a suit for infringement); *see also Positive Black Talk Inc. v. Cash Money Records Inc.*, 394 F.3d 357, 365 (5th Cir. 2004), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) *and Action Tapes, Inc. v. Mattson*, 462 F.3d 1010 (8th Cir. 2006).

[9] The Supreme Court, when deciding whether it should grant *certiorari* in a case, thinks the view of the federal government would be relevant or useful, will call for the views of the Solicitor General ("CVSG"). The U.S. solicitor general will then file a brief in the case expressing the views of the government.

Glossary of Supreme Court Terms, ScotusBlog, http://www.scotusblog.com/reference/educational-resources/glossary-of-legal-terms/.

[10] Brief for the United States as *Amicus Curie* at 13, *Fourth Estate Pub. Ben. Corp. v. Wall-Street.com, LLC*, 138 S. Ct. 720 (2018) (No. 17-571) (citing *Reed Elsevier, Inc.*, 559 U.S. at 166).

[11] *Id.*

[12] "But if Congress had intended [for the copyright owner to notify the Register of litigation if the Register refuses registration while the litigation is ongoing], it could have required the copyright owner to provide notice to the Register in order to 'maintain' or 'continue with' the suit," rather than "institute." *Id.* at 15.

[13] *See generally* 17 U.S.C. §§ 408(f)(2)–(3), 410(d), 411(a).

[14] Act of Mar. 4, 1909, ch. 320, § 12, 35 Stat. 1078.

[15] *Lumiere v. Pathe Exch. Inc.*, 275 F. 428, 430 (2d Cir. 1921).

[16] Brief for the United States as *Amicus Curie* at 6, *Fourth Estate Pub. Ben. Corp. v. Wall-Street.com, LLC*, 138 S. Ct. 720 (2018) (No. 17-571).

[17] Reply Brief for Petitioner at 6, *Fourth Estate Pub. Ben. Corp. v. Wall-Street.com, LLC*, 138 S. Ct. 720 (No. 17-571).

[18] *Id.*

[19] *Id.* at 8.

[20] *Id.*

[21] The Copyright Office has 121 years of experience in granting and rejecting applications for federal copyright protection. *See U.S. Copyright Office, A Brief Introduction and History*, Circular 1a, *available at* https://www.copyright.gov/circs/circ1a.html

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