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Copyright Publication on the Internet

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COPYRIGHT PUBLICATION ON THE INTERNET

DEBORAH R. GERHARDT*

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I. INTRODUCTION

This Article tackles the question of when a work distributed over the Internet is published as a matter of copyright law. Copyright publication doctrine retains significant practical importance and can have a dispositive impact on the economic value of a work. Publication can also determine whether a court has jurisdiction over a

* Associate Professor of Law, University of North Carolina School of Law. I am grateful to Ann Bartow, Jim Gibson, Rebecca Tushnet, Alfred Chueh-Chin Yen, and participants at the 2019 University of New Hampshire Redux Conference and the 2019 Intellectual Property Scholars Conference. I am also grateful to Chandler Martin and R. Taylor Townes for excellent research assistance.

copyright claim. For many twentieth century works, publication with observance of formalities was required if copyrights were to attach to creative works at all.¹ Publication remains relevant in determining the length of copyright protection, but duration is far from the only copyright issue that turns on this concept. The federal Copyright Act repeatedly references publication for many other purposes. Year by year, works dependent on the publication doctrine for their duration are entering the public domain. As the works of the twentieth century enter the public domain, the issue of copyright publication will fade from importance for purposes of duration analysis, and the relative impact of the doctrine will be experienced more forcefully with respect to other issues. Therefore, it is time for research on the copyright publication doctrine to shift its focus from duration to other copyright issues.

¹ For those seeking clarity on this question, I conducted an empirical study to identify the variables that lead courts to determine whether a work is published. Both focus primarily on duration. The first of two articles, *Copyright Publication: An Empirical Study*, reviews over a century of copyright publication decisions decided between 1849 and 2009 and provides an overview of how publication doctrine affects many significant issues in copyright law. Deborah R. Gerhardt, *Copyright Publication: An Empirical Study*, 87 NOTRE DAME L. REV. 135 (2011). It explains how the meaning of copyright publication affects a variety of different copyright issues including the citizenship of the author, the duration of the copyright term, the availability of statutory damages, infringement, and fair use. The second piece, *Copyright at the Museum: Using the Publication Doctrine to Free Art and History*, focuses on how copyright publication determines whether original art, documents, photographs, and other cultural treasures are in the public domain. Deborah R. Gerhardt, *Copyright at the Museum: Using the Publication Doctrine to Free Art and History*, 61 J. COPYRIGHT SOC'Y U.S.A. 393 (2014). Both studies provide clarity on how courts analyze the publication doctrine and how practitioners should apply it to determine whether works have entered the public domain.

A precise understanding of copyright publication is critical to optimizing the value of a work through the copyright registration process. Practical decisions about copyright publication must be decided by everyone trying to optimize creative rights. When authors, musicians, comedians, advertising professionals, artists, software engineers, and corporations apply to register their copyrights, they must specify if and when each work was published.² Correctly pinpointing the moment of copyright publication and applying to register within three months of that date trigger the availability of statutory damages and attorney's fees.³ Failure to register a United States work eliminates the possibility of obtaining statutory damages, but if a work is first published abroad, that rule does not apply. The place of first publication triggers whether timely registration is required. Consequently, the issue of publication impacts the economic value of every copyrighted work as dictated by U.S. law.

Because so many works are distributed on the Internet, it is important to understand when such distribution constitutes publication. Unfortunately, copyright law can appear hopelessly unclear on this basic issue. The federal statutory definition of publication was enacted in 1976, before the Internet existed, and therefore does not address online distribution. The Copyright Office guidelines raise the question without answering it.⁴

² 17 U.S.C. § 409(8) (2012).

³ *See id.* § 412.

⁴ *See also* U.S. COPYRIGHT OFFICE, *COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES*, §§ 900–01 (2d ed. 1984); Copyright Office, *Circular 66: Copyright Registration for Online Works*, p. 4 (Mar. 2019) (“Merely displaying or performing a work online generally does not constitute publication. . . . However, a work is considered published when the copyright owner offers to distribute copies of the work to a group of people for the purpose of further distributing the copies or publicly performing or displaying the work.”)

Judicial efforts to clarify the issue are a mixed bag of conflicting interpretations. This piece provides needed clarity on the issue of when Internet distribution constitutes publication.

Part I begins by summarizing the copyright publication doctrine and explaining the roots of the doctrine's ambiguities. Part II seeks to reframe perception of the doctrine as one related primarily to the duration of twentieth century works. As publication fades from importance for duration purposes, its import is increasing for other purposes, such as the availability of statutory damages and attorney's fees, the validity of registrations, country of origin, and fair use. Part III focuses on the question of copyright publication on the Internet and explains why this issue creates repeated daily challenges for applicants seeking to register their works. Recent decisions reach conflicting results on whether online sharing constitutes publication. This Part reviews those decisions, and critically examines the extent to which copyright precedent supports their findings and analysis. Part IV sets forth a standard for determining whether an online distribution constitutes publication for copyright

The key element of publication for an online work is that the copyright owner must authorize distribution. Just because an end user can technically reproduce a work does not necessarily mean that the work has been published. A copyright owner must have expressly or implicitly authorized users to make retainable copies of a work by downloading, printing, or other means for the work to be considered published.

The concepts of authorization and publication can be complicated and may have serious consequences for the author or copyright owner. For this reason, the Office generally lets the applicant decide whether a particular work is published or unpublished. In making this determination, you may wish to consider the following general guidelines.”).

purposes. While the proposed standard does not answer this fact-based question for all scenarios, it gives a much-needed framework for determining whether the publication question can be answered as a question of law, and if not, where the factual inquiry should focus. The Article concludes with an appeal to the U.S. Copyright Office, treatise writers, and other leading copyright voices to apply the proposed standard and share it with those seeking to register copyrights in creative works in order to clarify the recurrent issue of whether online distribution amounts to copyright publication.

II. AMBIGUITIES LATENT IN COPYRIGHT PUBLICATION DOCTRINE

Copyright laws were originally designed for textual works sold in hard-printed copies.⁵ The first U.S. copyright statute applied only to books, maps, and charts.⁶ It was then extended to visual works of fine art and sheet music.⁷ Later, protection was expanded to sound recordings and architectural works.⁸ Before passage of the 1976 Act, publication marked the beginning of protection.⁹ Even

⁵ Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124 (repealed 1831) (“An Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies”).

⁶ *Id.*

⁷ Act of Feb. 3, 1831, ch. 16, § 2, 4 Stat. 436 (repealed 1870).

⁸ Act of Oct. 15, 1971, Pub. L. No. 92-140, 85 Stat. 391 (adding copyrights “[t]o reproduce and distribute to the public by sale or other transfer of ownership, or by rental, lease, or lending, reproductions of the copyrighted work if it be a sound recording”); Act of Dec. 1, 1990, Pub. L. No. 101-650, 104 Stat. 5089, 5133 (adding “architectural works” to copyright subject matter under section 102(a) of title 17, United States Code).

⁹ See 17 U.S.C. § 302(a) (“Copyright in a work created on or after January 1, 1978, subsists from its creation”); *Acad. of Motion Picture Arts & Scis. v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1452

before the Internet further complicated publication issues, the definition created all kinds of doctrinal ambiguity.¹⁰ In deciding whether Martin Luther King Jr.’s widely publicized “I Have a Dream” speech was published and in the public domain, the Court of Appeals for the Eleventh Circuit observed that “‘publication’ is a ‘legal word of art, denoting a process much more esoteric than is suggested by the lay definition of the term.’”¹¹ There were, however, two points of clarity. Multiple sales of authorized copies were clearly deemed publication.¹² Mere display or performance, with no distribution of any hard-copy version of the work, did not amount to publication.¹³ Any factual scenario that did not fit neatly into one of those two extremes was not easily resolved.¹⁴ Mark Twain once

(9th Cir. 1991); *Letter Edged in Black Press, Inc. v. Pub. Bldg. Comm’n of Chicago*, 320 F. Supp. 1303, 1308 (N.D. Ill. 1970).

¹⁰ See *Werckmeister v. Am. Lithographic Co.*, 134 F. 321, 324 (2d Cir. 1904) (“Publication of a subject of copyright is effected by its communication of dedication to the public. Such a publication is what is known as a ‘general publication.’ There may be also a ‘limited publication.’ The use of the word ‘publication’ in these two senses is unfortunate and has led to much confusion.”); Thomas F. Cotter, *Toward a Functional Definition of Publication in Copyright Law*, 92 MINN. L. REV. 1724, 1770 (2008) (“[T]he meaning of publication remains, in many circumstances, fuzzy.”).

¹¹ *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 194 F.3d 1211, 1214 n.3 (11th Cir. 1999). For a more in-depth discussion of the other two decisions deciding whether this speech was in the public domain as well as the underlying facts, see Deborah R. Gerhardt, *Copyright Publication: An Empirical Study*, 87 NOTRE DAME L. REV. 135, 143–45 (2011).

¹² 17 U.S.C. § 101 (2012); 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 4.03[A] at 4–24 (2011).

¹³ 17 U.S.C. § 101 (2012) (defining “copies,” “phonorecords,” “public display,” “public performance,” “transfer of ownership,” and “works.”).

¹⁴ *McLaren v. Chico’s FAS, Inc.*, No. 10 CIV. 2481 JSR, 2010 WL 4615772, at *4 (S.D.N.Y. Nov. 9, 2010) (holding that the “claim that images composing [Plaintiff’s] Collection were posted on her website

wrote that, “[o]nly one thing is impossible for God: to find any sense in any copyright law on the planet.”¹⁵ The publication doctrine reflects the frustration many experience in trying to make practical sense of copyright law.

In the 1976 Copyright Act, Congress attempted to clarify the doctrine developed by courts, defining publication as:

[T]he *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 of itself constitute publication.¹⁶

One complexity inherent in this definition is that many of its terms also have defined meanings particular to

would not in any event suffice to plead ‘publication’ as a matter of law); *Rogers v. Better Bus. Bureau of Metro. Houston, Inc.*, 887 F. Supp. 2d 722, 733 (S.D. Tex. 2012) (“[T]he court cannot hold, as a matter of law, that the webpages were published unless public distribution occurred. The court’s finding with regard to Defendant’s failure to prove as a matter of law that posting the webpages on [a] . . . website constituted a distribution at all, rendering the issue of selling or licensing immaterial.”); *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 197 (S.D.N.Y. 2006) (“Making the work available [by posting it on the Internet], even assuming it constituted ‘distribution,’ did not involve ‘sale or other transfer of ownership, or by rental, lease or lending.’”).

¹⁵ MARK TWAIN, MARK TWAIN’S NOTEBOOK 381 (Albert Bigelow Paine, ed., 1st ed. 1935).

¹⁶ 17 U.S.C. § 101 (2012) (emphasis added).

copyright law. All of the italicized terms in the definition reprinted above are specifically defined in the 1976 Copyright Act and further interpreted by federal courts and the U.S. Copyright Office.¹⁷ As if this mesh of overlapping defined terms weren't enough, judicial interpretations of the definition created additional complexities.

The publication definition had some gaping holes that courts had to fill. For example, section 101 did not clarify whether distribution by someone other than the copyright owner would result in publication. That gap left open the questions of whether (and if so, under what circumstances) an unauthorized use or distribution can result in publication of a copyrighted work. Such questions resulted in complex balancing of many variables.

Even where the statute is crystal clear, judicial interpretations muddied its impact. The statutory definition states that publication occurs when one merely “offers to distribute” copies.¹⁸ Literal application of this portion of the definition might have resulted in publication of all works made available to the public if the work was deposited in any kind of public archive. The plain meaning suggested by the statute was ignored by many federal courts, who were reticent to find that copyright was lost because someone deposited a copy of the work in a government file in compliance with another federal or state law. For example, courts have been reticent to divest architectural copyrights when architectural plans were filed in a public repository for zoning purposes.¹⁹ Such judicial decisions conflicted with the literal text of the statute.

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ Deborah R. Gerhardt, *Copyright at the Museum: Using the Publication Doctrine to Free Art and History*, 61 J. COPYRIGHT SOC'Y U.S.A. 393, 432–33 (2014).

This conflict resulted from a statutory omission that could have been foreseen. If Congress intended to hold a mirror to the judicially-created publication doctrine in the 1976 Act,²⁰ it did so only in part, as the statutory definition failed to address whether “limited publication” to particular persons for a specific purpose, without the right of distribution to the public, amounted to publication. The statute suggests that all such distributions are publications because even a “rental, lease, or loan” is expressly deemed a publication.²¹ If courts had applied the plain language of the definition in this way, there would have been a clear rule. All temporary transfers of ownership, in the form of rental, lease, lending, or licensing, would amount to publication. Instead, courts doubled down on the limited publication doctrine, creating a conflict with the plain meaning of the statute.

Before 1976, all authors who published their works without affixing a copyright notice lost their copyrights upon publication.²² The harsh consequences of the statute fed the public domain, but also trapped unwary authors into

²⁰ See 17 U.S.C. § 405(a); Cotter, *supra* note 10, at 1771 (“[The 1976 Act’s] definition [of publication] is said to largely track the meaning of the term as developed in the pre-1976 case law.”); W. Russel Taber, *Copyright Déjà Vu: A New Definition of “Publication” Under the Copyright Act of 1909*, 58 VAND. L. REV. 857, 875 (2005) (“[The 1976 Act’s] definition [of publication] is generally considered a codification of the common law.”); 1 Nimmer & Nimmer, *supra* note 12, § 4.03 (“[T]he 1976 Act definition [of publication] has been held to constitute a codification of the definition evolved by case law prior to adoption of the current Act.”).

²¹ 17 U.S.C. § 101.

²² In the 1976 Act, Congress softened the consequences, created the ability to cure a deficient notice, and did away with the notice requirement completely when the copyright statute was revised to comply with the Berne treaty in 1989.

unintentionally losing their copyrights.²³ In an effort to minimize the harsh consequences of the formality requirements, courts developed the doctrine of limited publication.²⁴ If a work was distributed only to a discrete

²³ See Act of Mar. 4, 1909, ch. 320, § 9, 35 Stat. 1075, 1077 (repealed 1976) (providing that “[a]ny person entitled thereto by this Act may secure copyright for his work by publication thereof with the notice of copyright required by this Act; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor”); see 17 U.S.C. § 102 (2012) (expanding copyright protection to “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated”); see 17 U.S.C. § 106 (bestowing unto the copyright owner the exclusive rights to “reproduce the copyrighted work,” “prepare derivative works based upon the copyrighted work,” “distribute copies . . . to the public,” “perform the copyrighted work publicly,” “display the copyrighted work publicly,” and “perform the copyrighted work publicly by means of a digital audio transmission” in the case of a sound recording); see 17 U.S.C. § 302(a) (extending copyright term to the “life of the author and 70 years after the author’s death”); see *The Law: Righting Copyright*, TIME, Nov. 1, 1976, at 82 (“‘All in all,’ says Barbara Ringer, the U.S. Register of Copyrights, ‘[the Copyright Act of 1976] is a balanced compromise that comes down on the authors’ and creators’ side in almost every instance.’”).

²⁴ See *Ladd v. Oxnard*, 75 F. 703, 731 (C.C.D. Mass. 1896) (“The determinations of various courts that, under some circumstances, the delivery of lectures, or the representation of plays, to such of the public as may attend, do not constitute publication, must be regarded as rather of an incidental character, arising undoubtedly to some extent from tenderness for authors, and not establishing any general rule.”); *Keene v. Wheatley*, 14 F. Cas. 180, 199 (C.C.E.D. Pa. 1861) (No. 7664) (“A limited publication of it is an act which communicates a knowledge of the contents to a select few, upon conditions expressly or impliedly precluding its rightful ulterior communication, except in restricted private intercourse.”); see Jane C. Ginsburg, *The U.S. Experience with Mandatory Copyright Formalities: A Love/Hate Relationship*, 33 COLUM. J.L. & ARTS 311, 323 (“‘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. Borrowing from old English

group of people for a limited purpose by means that did not permit further distribution to the public, such a “limited publication” did not divest a claimant of his or her copyright.²⁵ Broader distributions to the public, deemed “general publication,” were still equated with publication, but a work distributed in a “limited publication” was treated as though it had not been published at all.²⁶ Development of this paternalistic doctrine was designed to protect authors and artists from the harsh consequences of the formality requirements, which it did.²⁷ But it further complicated the publication doctrine, defanging some portions of the statute and pulling many works back from falling into the public domain.

decisions holding that a public performance was not a ‘publication,’ U.S. 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.” (citations omitted)).

²⁵ *White v. Kimmell*, 193 F.2d 744, 746–47 (9th Cir. 1952) (explaining that a limited publication “communicates the contents of a [work] . . . to a definitely selected group and for a limited purpose, and without the right of diffusion, reproduction, distribution or sale . . . [and] does not result in loss of the author’s common-law right to his [work]. . . . [T]he circulation must be restricted both as to persons and purpose, or it cannot be called a private or limited publication.”).

²⁶ *Id.*

²⁷ *See Am. Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1026–27 (9th Cir. 1981) (“Case law has created a distinction between general and limited publication, holding that only the former operates to divest common law copyright and subject a work to the federal statutory scheme.”); Theresa Gue, *Triggering Infection: Distribution and Derivative Works Under the Gnu General Public License*, 110 U. ILL. J.L. TECH. & POL’Y 95 (2012) (“If [an author] . . . published a work without proper notice, he lost both common law and federal copyright protection, and the work was placed into the public domain. Courts differentiated between limited publication and general publication in order to mitigate the harshness of this rule.”).

Judicial treatment of the distribution of feature films illustrates how the limited publication doctrine was employed to justify results that contradict the plain language of the statute. Before digital distribution, studios would send theaters a hard copy of a film with the requirement that the work be returned after the run.²⁸ According to the statute, this distribution should amount to publication. This result would not be due to the public showing of the film because the statute unambiguously states that public performance is not publication.²⁹ However, the statutory definition also states that a “rental, lease or loan” amounts to publication.³⁰ Based on this language, the studio’s temporary transfer of film reels to movie houses would constitute publication of the film. And if the studio failed to affix a copyright notice, those films would be part of the public domain. Given the clear statutory implications of this fact pattern and those similar to it, courts devised the “limited publication” doctrine to soften the effects of the statute and save these works from the consequences of inadvertent publication.³¹ The contradictory signals from the statute and the case law, not

²⁸ See *Am. Vitagraph*, 659 F.2d at 1025 (“In December of 1975 Vitagraph delivered to Levy a print of their initial version of the film . . . That print was screened to the public for one week . . . and subsequently returned to Vitagraph for additional editing.”).

²⁹ 17 U.S.C. § 101 (2012).

³⁰ *Id.*

³¹ *Soc’y of the Holy Transfiguration Monastery, Inc. v. Gregory*, 689 F.3d 29, 44–46 (1st Cir. 2012) (holding that distribution of translations of religious texts to other parishes for use in worship and for editorial feedback was limited publication); *Am. Vitagraph*, 659 F.2d at 1027–28 (holding that a temporary screening of a film reel for the purposes of audience feedback followed by the theater returning the reel was limited publication); *Swatch Grp. Mgmt. Servs., Ltd. v. Bloomberg L.P.*, 756 F.3d 73, 87–89 (2d Cir. 2014) (holding that a recording of a conference call between a corporation’s management and 132 invited analysts was statutorily unpublished).

uncommon in copyright law, added to the publication doctrine's lack of clarity.

The complexities only worsen in the age of the Internet. If distribution in cyberspace merely constitutes a public performance or display, it will not be considered publication. Under this portion of the definition, works distributed over the Internet may still be unpublished. However, if the Internet permits anyone to access copies or phonorecords of the work, the copyright owner who posts a work online is providing the public with access to copies, and therefore, the statutory definition indicates that the work has been published.

III. THE ENDURING SIGNIFICANCE OF COPYRIGHT PUBLICATION

Some may question whether publication remains worthy of attention for contemporary works. Any work created after 1989 is not vulnerable to losing its copyright protection through publication without a properly constructed copyright notice.³² Nonetheless, copyright publication remains critically significant at multiple moments in the life of a copyrighted work. As more distributions occur in cyberspace, determining whether Internet dissemination amounts to publication retains practical significance for many issues tied to the economic value of creative works.

Pinpointing the moment of copyright publication is a practical necessity for everyone seeking to secure the benefits of copyright registration in the United States. Hundreds of thousands of copyright registration applications are filed in the U.S. Copyright Office each

³² 17 U.S.C. § 405(a) (1988).

year. Although the Copyright Office does not provide access to bulk data as the U.S. Patent and Trademark Office does, Dotan Oliar, Nathaniel Pattison, and K. Ross Powell collected five years of data, and found that 2.3 million copyright registrations were granted between 2008 and 2012.³³ For U.S. authors, registration is required before a federal court has jurisdiction to decide an infringement claim.³⁴

An understanding of publication is necessary to register a work because publication is one of the questions of fact that must be entered on each application.³⁵ For example, a photographer may save on filing fees by registering a group of works for fifty-five dollars instead of paying thirty-five dollars to register each work.³⁶ In order to do so, all photos in the group must have identical publication data. They must all be either published or unpublished—and if published, they all must have been published in the same calendar year.³⁷

Given the importance of publication to the registration process, one might expect the Copyright Office to give applicants meaningful guidance on whether Internet distribution constitutes publication. Unfortunately, the

³³ Dotan Oliar, Nathaniel Pattison & K. Ross Powell, *Copyright Registrations: Who, What, When, Where, and Why*, 92 TEX. L. REV. 2211, 2213 (2014).

³⁴ *See* 17 U.S.C. § 411(b) (1990); *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 157 (2010); *PRC Realty, Sys., Inc. v. Nat'l. Ass'n of Realtors, Inc.*, 766 F. Supp. 453, 461 (E.D. Va. 1991) (“The registration is, after all, merely the plaintiff’s ‘ticket’ to court; the protection of the copyright arises at the time of the creation of the work.”).

³⁵ *See* 17 U.S.C. § 409(8) (1992).

³⁶ 37 C.F.R. § 202.4(i)(6) (2018); U.S. COPYRIGHT OFFICE, <https://www.copyright.gov/about/fees.html> [<https://perma.cc/D3UZUSRB>] (last visited Sep. 26, 2019).

³⁷ 37 C.F.R. § 202.4(h)–(i).

Copyright Office does not currently provide this service. Instead, it continues its “long-standing practice” of leaving it up to “the applicant, who knows the facts surrounding distribution of copies of a work, to determine whether the work is published or not.”³⁸ If anything in the statement of facts contradicts a publication conclusion in the Application, the Copyright Office will not register the work.³⁹ Mistakes often pass through the ministerial copyright registration process and can come back to haunt authors later.

This practice would not be problematic if the publication doctrine tracked the lay understanding of the word “publication.” Unfortunately, it does not. The copyright meaning of publication is counterintuitive in many respects. Copyright publication does not occur each time the public gains access to a work. Public performance and display are expressly excluded from amounting to publication. Conversely, relatively private conduct such as the unconditional sale of a single copy, the offering to sell copies to the public, or the temporary loan of a copy may amount to publication.⁴⁰ Given these anomalies, more guidance is necessary. The standard set forth in Part IV begins to fill this gap and assist applicants in making correct publication conclusions about Internet distribution.

Copyright registration applications may be completed without the assistance of counsel. Given the counterintuitive meaning of publication in copyright law, it would be most helpful if the Copyright Office provided

³⁸ Copyright Office, *Circular 66: Copyright Registration for Online Works*, p. 3; see also U.S. COPYRIGHT OFFICE, *COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES*, § 904(1) (2d ed. 1984).

³⁹ U.S. COPYRIGHT OFFICE, *COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES*, § 904(5) (2d ed. 1984).

⁴⁰ 17 U.S.C. § 101 (2012).

user-friendly FAQ’s or instructional videos on this issue. At a minimum, the Office could identify examples of sales and common Internet distributions that would or would not constitute publication.

Federal copyright registration, when done correctly, can confer substantial benefits at minimal cost. A valid federal copyright registration constitutes *prima facie* evidence of the validity of all the facts found in the certificate, including the validity of the copyright, the date of first publication, and ownership.⁴¹

Getting the publication date wrong can ruin an otherwise strong copyright claim. In *JMAS Enterprises, Inc. v. Kassir Import-Export Co.*,⁴² the plaintiffs claimed a first publication date of 2009. That date was wrong. Plaintiffs had no evidence to support publication in 2009.⁴³ They admitted they did not create their website until 2010 and did not begin marketing the work until January 2011, well after the 2009 publication date claimed in their copyright application.⁴⁴ Even though their substantive infringement claim was strong, the court denied their claim for a preliminary injunction—all because they were not able to substantiate their claimed publication date.⁴⁵ Had they used a correct date or filed for copyright for their design as an unpublished work, the outcome may have been different. This decision provides an important cautionary lesson. Getting the publication date or status wrong can be fatal to an otherwise strong copyright claim.

⁴¹ *Id.* § 410.

⁴² *JMAS Enterprises, Inc. v. Kassir Imp.-Exp. Co.*, No. CV 11-06258 SVW (PJW), 2011 WL 13221007, at *2 (C.D. Cal. Aug. 24, 2011).

⁴³ *Id.* at *4.

⁴⁴ *Id.*

⁴⁵ *Id.* at *5 (“Assuming that Plaintiffs are able to establish a valid copyright, they likely could establish infringement.”).

Another important mistake to avoid in the registration process is grouping works that were published in different years. The Copyright Office regulations sometimes permit authors or photographers to register a group of works and avoid paying multiple registration fees but only if the entirety falls within industry-specific definitions of an acceptable group or constitutes “a single unit of publication.”⁴⁶ In either case, all works in the group must have been published in the same calendar year.⁴⁷ In *McLaren v. Chico’s FAS, Inc.*, a designer attempted to benefit from this provision by registering a group of twenty-four drawings.⁴⁸ Two years before the claimed publication date, she sold some of the drawings.⁴⁹ The court determined that this prior sale amounted to publication. Because some of the drawings were not published in the same year as claimed in the application, the registration for the group was invalidated, and an otherwise viable copyright claim was dismissed.⁵⁰ Getting the publication dates right and paying the additional modest registration fees are a small price to pay to preserve the economic value of such copyrightable works. Both *JMAS Enterprises, Inc. v. Kassir Import-Export Co.* and *McLaren v. Chico’s FAS, Inc.* illustrate how important it is to fill in the publication information correctly when applying to register a copyright. Completing the application correctly requires understanding the particular meaning of copyright publication.

⁴⁶ U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES §§ 1107–1107.1 (3d ed. 2017).

⁴⁷ *Id.* at § 1107.1.

⁴⁸ *McLaren v. Chico’s FAS, Inc.*, No. 10-cv-2481 (JSR), 2010 WL 4615772, at *1 (S.D.N.Y. Nov. 9, 2010).

⁴⁹ *Id.*

⁵⁰ *Id.* at *3–4.

The timing of publication and registration may also dramatically impact the economic value of a copyrighted work. A copyright owner who gets the timing right can obtain statutory damages and attorney’s fees in an infringement suit.⁵¹ Statutory damages can be as high as \$150,000 per act of infringement.⁵² In addition to heightening the potential economic recovery of winning an infringement claim, the settlement value of a copyright claim may significantly increase if heightened damages are available. Registration before infringement, or within three months of first publication, dictates whether such extraordinary remedies are available.⁵³ A copyright owner who understands these remedies will see that there is a powerful economic incentive to register within three months of publication. Even if actual damages exceed the statutory damages amount, the litigation costs of proving the economic value of damages combined with the possibility of obtaining attorney’s fees may make it more cost efficient to claim the statutory remedies.

Copyright registration data suggests that many applicants are unaware of the significant benefits that result from timely copyright registration. Hundreds of thousands

⁵¹ 17 U.S.C. § 412 (2008).

⁵² 17 U.S.C. § 504(c)(2) (2010) (“In any action under this title . . . no award of statutory damages or of attorney’s fees, as provided by sections 504 and 505, shall be made for—

(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or

(2) any infringement of copyright commenced after first *publication* of the work and before the effective date of its registration, unless such registration is made within three months after the first *publication* of the work.”) (emphasis added).

⁵³ *Alaska Stock, LLC v. Houghton Mifflin Harcourt Pub. Co.*, 747 F.3d 673, 678 (9th Cir. 2014) (citing 17 U.S.C. § 412 to explain that “registration prior to infringement or, if the work is published, within three months of publication, is necessary for an owner to obtain statutory damages and attorneys’ fees.”).

of works are registered each year, many for groups of works.⁵⁴ From 2008 to 2012, 54.6% of applicants filed to register their copyrights within three months of publication, and only .02% of works were registered as unpublished. These two groups optimized the economic value of their registrations. The remaining 45% of applications were filed more than three months after publication.⁵⁵ That delay cost them the opportunity to recover statutory damages and attorney's fees. These applicants could have substantially increased the economic value of their copyrights by registering within three months of first publication.

In order to successfully plead a claim for statutory damages and attorney's fees, a copyright plaintiff must identify the dates of (1) first publication; (2) copyright registration; and (3) the alleged infringement. The registration must also precede publication or be effective⁵⁶ within three months of first publication.⁵⁷ If the dates are not properly pled, or if the timing does not fit the requirements of the statute, a defendant may obtain dismissal of the claim for statutory damages and attorney's fees, defanging the economic threat of the suit and

⁵⁴ See 2018 U.S. Copyright Office Ann. Rep. Reg. Copyright, 21 (showing an average of 527,380 registrations per year dating back to 2008. However, Oliar, Patteson, and Powell note that it is important to remember "that there is no simple one-to-one relationship between the number of registrations and the number of works registered therein."). Oliar, Patteson & Powell, *supra* note 33, at 2243.

⁵⁵ Oliar, Patteson & Powell, *supra* note 33, at 2230 (explaining that 54.6% are registered within three months of publication, while only .02% are registered while still unpublished).

⁵⁶ 17 U.S.C. § 410(d) (1976) ("The effective date of registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.").

⁵⁷ 17 U.S.C. § 412(2) (2008).

substantially increasing the cost of litigation for the plaintiff.⁵⁸

Publication is also important in identifying a work's nation of origin, and whether compliance with U.S. formalities is necessary. For example, registration with the U.S. Copyright Office is required for federal jurisdiction over claims asserting copyright infringement of a "United States work."⁵⁹ Pursuant to one of the copyright provisions that favors international applicants, owners of foreign works need not comply with this provision.⁶⁰ While a "United States work" must be registered before a copyright infringement suit is filed, the registration requirement is waived for foreign works. "Thus, to proceed with a

⁵⁸ *Olivares v. Univ. of Chicago*, 213 F. Supp. 3d 757, 772–73 (M.D.N.C. 2016) (granting Defendants' motion to strike and dismissing Plaintiff's requests for statutory damages and attorney's fees for failure to state a claim upon which relief can be granted because the infringement occurred before registration); *Hoffman v. 0 Three Media, LLC*, No. CV 12-60-GW(JEMX), 2012 WL 12886181, at *3 (C.D. Cal. Nov. 27, 2012) (granting summary judgment on unavailability of statutory damages or attorney's fees for this copyright claim "because the photograph was unpublished at the time the alleged infringement occurred, and the alleged infringement occurred prior to the copyright registration.").

⁵⁹ See 17 U.S.C. § 101 (2010) ("For purposes of section 411, a work is a 'United States work' only if— (1) in the case of a published work, the work is first published— (A) in the United States . . . "); 17 U.S.C. § 411(a) (2017) ("[N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title."); *Moberg v. 33T LLC*, 666 F. Supp. 2d 415, 420 (D. Del. 2009) (holding that "because plaintiff's photographs did not originate in the United States, they are not subject to the registration requirement, and such a formality is not a prerequisite to suit").

⁶⁰ *Moberg*, 666 F. Supp. 2d at 420 ("The effect of the United States' accession to the [Berne] Convention 'is to exempt works the country of origin of which is not the United States from the registration requirement.'") (quoting *Cotter*, *supra* note 10, at 1743).

copyright infringement action, a plaintiff that claims his published work is exempt from the registration requirement must prove that the first publication occurred abroad.”⁶¹ The timing and place of first publication must be determined before a work can be classified as a “United States work” or foreign work.⁶² As the creative world becomes increasingly international, the publication doctrine will trigger whether a creative piece is considered a “United States work,” which may be subject to different copyright formality requirements.

Similarly, while a “United States work” permanently enters the public domain for failure to observe formalities, certain foreign works can recover their copyright protections.⁶³ Pursuant to this provision, many

⁶¹ *Kernel Records Oy v. Mosley*, 694 F.3d 1294, 1304–05 (11th Cir. 2012) (citing 17 U.S.C. §§ 101, 411(a)); *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1233 (11th Cir. 2010); *BUC Int’l Corp. v. Int’l Yacht Council, Ltd.*, 489 F.3d 1129, 1141–42 (11th Cir. 2007).

⁶² *Kernel Records Oy*, 694 F.3d at 1304 (“Determining whether a work was first published domestically or abroad adds an additional level of complexity. Because the statutory definition of ‘United States work’ contains strict temporal and geographic requirements (e.g., ‘first,’ ‘simultaneously,’ ‘in the United States,’ ‘foreign nation,’ and ‘treaty party’) a determination that a work was first published abroad requires both: (1) an examination of the method, extent, and purpose of the alleged distribution to determine whether that distribution was sufficient for publication, and (2) an examination of both the timing and geographic extent of the first publication to determine whether the work was published abroad.” (citations omitted)).

⁶³ 17 U.S.C. § 104A(h)(6) (2002).

The term “restored work” means an original work of authorship that--

(A) is protected under subsection (a);

(B) is not in the public domain in its source country through expiration of term of protection;

(C) is in the public domain in the United States due to--

(i) noncompliance with formalities imposed at any time by United States copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements;

popular musical works such as Prokofiev’s *Peter and the Wolf* (which was in the public domain prior to the enactment of 17 U.S.C. § 104(A)) can no longer be played by orchestras without seeking a license or risking infringement. The time and place of first publication triggers whether the work is considered a “United States work” or a work from another source country.⁶⁴

Authors who want to optimize their creative rights must promptly register copyrights in works first published in the United States. If an author incorrectly enters the date of publication in its copyright application, the entire registration may be later invalidated.⁶⁵ Such a result can be fatal to an otherwise strong copyright infringement claim because registration is a prerequisite for federal jurisdiction if the work was first published in the United States.⁶⁶

For all of these reasons, the importance of understanding copyright publication should not be underestimated. Publication triggers many important moments in the life of a creative work. Because so many

(D) has at least one author or rightholder who was, at the time the work was created, a national or domiciliary of an eligible country, and if published, was first published in an eligible country and not published in the United States during the 30-day period following publication in such eligible country;

(E) If the source country for the work is an eligible country solely by virtue of its adherence to the WIPO Performances and Phonograms Treaty, is a sound recording.

⁶⁴ *See id.* § 101.

⁶⁵ *KEMA, Inc. v. Koperwhats*, No. C-09-1587 MMC, 2010 WL 3464737, at *3 (N.D. Cal. Sept. 1, 2010) (“A copyright plaintiff will not satisfy the registration requirement where the allegedly infringed work was published before the date of first publication identified in the registration, unless such registration identifies the registered work as derivative of, or a compilation containing, the allegedly infringed work.”)

⁶⁶ 17 U.S.C. § 411.

works are shared online, the following section explains how these ambiguities may be resolved for online distributions.

IV. INTERNET PUBLICATION

Once one appreciates the significance of publication, it becomes apparent why it is so important to confront whether online distribution amounts to publication. If posting a work on the Internet is considered the distribution of copies, it is publication, but if posting is mere display or performance, it is not publication. The Copyright Office dodges the question. Its Compendium suggests that online works may be published or unpublished and leaves it to the applicant to make that distinction, without helpful guidance.⁶⁷ In short, it raises the question of whether distribution on the Internet constitutes publication but does not answer it.

After hunting through the Compendium's labyrinth for help, applicants may ultimately think they've found the answer when they arrive at a subsection on "websites and website content" titled, "What Constitutes Publication?" When they begin reading that section, they will be told that "while technological developments have blurred this traditional concept, the U.S. Copyright Office interprets publication in a manner consistent with congressional intent and with appreciation for the current factual and legal distinctions that may inform the assessment of this issue."⁶⁸

In some sections, the Compendium may lead one to wonder whether dissemination of mere digital copies can amount to publication. For example, one section states that

⁶⁷ COMPENDIUM (THIRD) § 1008.6(A)-(B).

⁶⁸ *Id.* at § 1008.3(A).

“any form or dissemination in which a material object does not change hands . . . is not a publication no matter how many people are exposed to the work.”⁶⁹ This passage reflects legislative history that was articulated at a time before the Internet existed. For decades, it has been well-settled that digital duplicates of a work constitute “copies” within the meaning of copyright law.⁷⁰ A physical material object need not exist for publication to occur. This outdated statement should be removed from the Compendium because it is misleading to suggest that digital copies cannot result in publication.

Other sections of the Compendium confirm that it is not necessary for the public to actually put hands on physical copies. It offers the following examples of digital distribution that constitute publication:

[A] book is published when copies of the work are distributed online or in bookstores. A newspaper is distributed when copies are sold at newsstands or delivered to subscribers’ doorsteps. A song is distributed when print copies or phonorecords are sold (e.g., on sheet music or in mp3 format). Software is distributed when copies are distributed by purchase or license, whether in CD-ROM format or online (provided that

⁶⁹ *Id.* at § 1905.2 (quoting H.R. Rep. No. 94-1476, at 138 (1976), reprinted in 1976 U.S.C.C.A.N. at 5754.)

⁷⁰ See *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 928–29 (2005) (basing its decision on the factual foundation that digital sharing is tantamount to infringement); *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 519 (9th Cir. 1993) (holding that “it is generally accepted that the loading of software into a computer constitutes the creation of a copy under the Copyright Act.”).

the copies are actually downloaded and not merely accessed online).⁷¹

From this passage, a reader may conclude that all online distributions constitute publication. But the Compendium leaves room for the possibility that distribution on the Internet may not amount to copyright publication. For example, it tracks the publication definition by stating that if “the content was placed online solely for the purpose of public display or public performance, the work may be deemed unpublished.”⁷² In this way, the Compendium gives its readers reasons to believe both that online distribution may be either publication or mere display or performance (which does not amount to publication) and leaves its readers with no guidance on how to tell the difference.

To further complicate the issue, the Copyright Office guidelines also incorporate the doctrine of limited publication, indicating in one example that “a draft dissertation or other manuscript that is sent [presumably by email or some other electronic method] to a dozen people for peer review with a note stating that the copy should not be shared with other parties is not considered publication.”⁷³ This example may raise questions about how to treat works when online distribution provides access to a work even if the work is not sold. Is such content merely displayed and performed, but not published? The statute indicates that any transfer—even a loan—may constitute publication.⁷⁴ Therefore, the price tag alone cannot dictate the answer. And what about content that is made available only if one first becomes a member of a

⁷¹ COMPENDIUM (THIRD) § 612.2.

⁷² *Id.* at § 1108.6(B).

⁷³ *Id.* at § 612.2.

⁷⁴ 17 U.S.C. § 101.

password-protected website? Should limited access make a difference? After wading through the Compendium and statutory publication definition, one is left frustrated as neither adequately explain how to determine if a work was published if it was distributed, but not sold, on the Internet. Greater clarity is needed so that authors know how to apply to register works they distribute online such as photographs uploaded to Instagram, videos one can view on YouTube, or articles shared for no charge on Facebook.

The ambiguity of whether such works are published has confounded courts as well.⁷⁵ In 2002, the Southern District of New York was the first to confront this issue directly in *Getaped.com, Inc. v. Cangemi*.⁷⁶ Getaped created a website to sell motorized scooters.⁷⁷ The site went live in July 2000, and a month later, the company registered its copyright in the code for the site.⁷⁸ The defendants, who were competitors in the scooter market, copied the code for their own site.⁷⁹ The defendants did not show up to defend themselves on liability, and default judgment was entered for Getaped.⁸⁰ However, Cangemi did hire counsel to dispute the issue of damages.⁸¹ A magistrate judge held that the source code was merely displayed on the site, and not published.⁸² Therefore, the judge recommended that the district court enter only \$1,050

⁷⁵ See *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002); *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 197 n.5 (S.D.N.Y. 2006).

⁷⁶ 188 F. Supp. 2d at 402.

⁷⁷ *Id.* at 399.

⁷⁸ *Id.* at 400.

⁷⁹ *Id.*

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² *Id.* at 401.

in actual damages based on a theory of lost licensing revenue.⁸³

The district court thoughtfully considered whether the code was merely displayed and identified a critical distinction in separating published from unpublished works. The court indicated that when one can view a work but not make a copy, it is merely displayed and not published, but when one can obtain a copy, it is published.⁸⁴ The court reasoned:

By accessing a webpage, the user not only views the page but can also view—and copy—the code used to create it. In other words, merely by accessing a webpage, an Internet user acquires the ability to make a copy of that webpage, a copy that is, in fact, indistinguishable in every part from the original. Consequently, when a website goes live, the creator loses the ability to control either duplication or further distribution of his or her work. A webpage in this respect is indistinguishable from photographs, music files or software posted on the web—all can be freely copied. Thus, when a webpage goes live on the Internet, it is distributed and “published” in the same way the music files in *Napster* or the photographs in the various *Playboy* decisions were distributed and “published.”⁸⁵

⁸³ *Id.* at 400.

⁸⁴ *Id.* at 401–02.

⁸⁵ *Id.*

More than a century of publication precedent is consistent with the conclusion in *Getaped*. Digital files have been deemed to be copies.⁸⁶ My empirical study indicates that the existence of copies authorized by the copyright owner is a significant variable that often leads to a conclusion of publication.⁸⁷ Accordingly, one might conclude that public digital distribution by the copyright owner will generally lead to a conclusion that the work has been published. Other courts have questioned whether distribution on the Internet constitutes publication,⁸⁸ but a close look at the facts of each of them indicates that their reasoning does not undermine the basic conclusion of *Getaped*.⁸⁹

The decision in *McLaren v. Chico's FAS, Inc.*,⁹⁰ has been cited repeatedly in footnotes as an example of a court

⁸⁶ 17 U.S.C. § 1001; *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153, 171 (D. Mass. 2008) (“[A]ny object in which a sound recording can be fixed is a ‘material object.’ That includes . . . electronic files.”); Sara Steetle, *UMG Recordings, Inc. v. MP3.com, Inc.: Signaling the Need for a Deeper Analysis of Copyright Infringement of Digital Recordings*, 21 LOY. OF L.A. ENT. L. REV. 31, 40 (2000) (“Works in digital form are considered ‘copies’ under the Copyright Act.”).

⁸⁷ Deborah R. Gerhardt, *Copyright Publication: An Empirical Study*, 87 NOTRE DAME L. REV. 135, 184–92 (2011) (“The principal factor driving the publication determination turns out to be whether copies are authorized for distribution. Whatever impact the public availability of copies may appear to have on its own, that influence is subsumed by the presence of authorized copies. In short, district court judges are relying principally upon the copyright owner’s consent, not the availability of copies to the general public, when rendering their judgments.”).

⁸⁸ See generally *Kernel Records Oy v. Mosley*, 694 F.3d 1294, 1308 (11th Cir. 2012); *Rogers v. Better Bus. Bureau of Metro. Houston, Inc.*, 887 F. Supp. 2d 722, 730 (S.D. Tex. 2012); *Moberg v. 33T LLC*, 666 F. Supp. 2d 415, 422 (D. Del. 2009).

⁸⁹ See *McLaren v. Chico's FAS, Inc.*, No. 10-cv-2481 (JSR), 2010 WL 4615772, at *4 (S.D.N.Y. Nov. 9, 2010).

⁹⁰ *Id.*

that reached a conclusion contrary to *Getaped*. Although the court questioned in dicta whether Internet distribution always amounts to publication, the decision is based on a different issue. Chesley McLaren sued Chico's, claiming the retailer of women's clothing displayed mannequins that infringed her copyrighted designs.⁹¹ Prior to filing the complaint, she applied for copyright registration in a collection of her drawings.⁹² Her registrations did not reflect a clear understanding of publication rules. Normally, each work must be registered separately.⁹³ Some exceptions permit publication of a group of certain works (such as photographs and serials) published in the same calendar year.⁹⁴ Drawings do not fit neatly into any of those exceptions, and therefore, they can only be registered as a group if they were published as one "unit of publication" on the same day.⁹⁵ In *McLaren*, although the group of drawings was distributed online at the same time, some of the drawings had been licensed prior to the alleged publication date.⁹⁶ Based on these facts, the court correctly concluded that the license amounted to publication, and therefore, the entire group was not first published on the same day as claimed in the registration.⁹⁷ On that basis, the court invalidated the registration. The designer's counsel argued that before the sale, she had published the whole collection by posting it online, but no date or documentation were provided to substantiate this conclusory allegation.⁹⁸ Accordingly, the court explained:

⁹¹ *Id.* at *1.

⁹² *Id.*

⁹³ U.S. COPYRIGHT OFFICE, *COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES*, § 1101.

⁹⁴ *Id.* at § 1104.

⁹⁵ *Id.* at § 1103.

⁹⁶ *McLaren*, 2010 WL 4615772, at *2.

⁹⁷ *Id.*

⁹⁸ *Id.*

[T]he amended complaint provides no indication of when that website was posted and gives no details regarding how the images from the Collection were displayed, thus rendering this allegation little more than conclusory. Moreover, even if the factual aspect of this allegation were credited, this claim that images composing the Collection were posted on her website would not in any event suffice to plead “publication.” Furthermore, even assuming *arguendo* that website posting can amount to publication, there is no basis to conclude that this alleged publication represented the first time that any of the illustrations in the Collection was published, and for that reason, this new allegation fails to alter the conclusion that the Collection does not qualify for a “single work” registration.⁹⁹

Before citing this precedent for the principle that Internet distribution does not constitute publication, litigants should be mindful of the fact that the court stated it did not have the factual predicate to decide the case on this issue. Instead, the court based its conclusion on the facts it had and found that the entire group did not have the same publication date because some of the drawings were sold, and therefore published, before the claimed publication date for the entire set.¹⁰⁰

⁹⁹ *Id.* at *4 (citing *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 197 n.5 (S.D.N.Y. 2006) for the proposition that “‘merely posting a digital file’ on the Internet does not amount to ‘publication’ under the Copyright Act.”).

¹⁰⁰ *Id.*

When analyzing the issue of Internet publication, the *McLaren* court cites *Einhorn v. Mergatroyd Productions*, which does address the issue of when Internet distribution may constitute publication. In *Einhorn*, the director of an “Off Off Broadway” show entitled *Tam Lin* claimed to have created copyrightable “blocking and choreography” for the production of a play that was performed eight times.¹⁰¹ The director was fired before the show opened, and did not get paid, so he sued the production company claiming he was promised \$1,000 for his work.¹⁰² He attempted to register a copyright in his contributions, using an edited copy of the playwright’s script, but he failed to identify exactly what his original contributions were.¹⁰³ Before addressing the motion to dismiss, Judge Kaplan began the opinion with his overall impression of the matter. He wrote, “We speak of ‘making a federal case’ out of something to express the sentiment that someone is blowing something out of proportion. Plaintiff Edward Einhorn, represented by his attorney brother, has made this federal case out of a dispute over \$1,000.”¹⁰⁴ Plaintiff sought statutory damages claiming that publication of his work occurred when the Defendants performed the play and posted images of the show on their website.¹⁰⁵ The court easily disposed of the first claim based on the statutory definition of publication that expressly excludes public performance.¹⁰⁶ That portion of the conclusion is indisputably correct.

The court then proceeded to determine whether the Defendant published the play when it posted a performance

¹⁰¹ *Einhorn*, 426 F. Supp. 2d at 191–93.

¹⁰² *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 196.

¹⁰⁶ 17 U.S.C. § 101 (2010).

on the Internet. The court determined that it did not. It reasoned:

The same definition dooms Einhorn’s claim that the posting of performances of the show on the Internet constituted publication, even assuming *arguendo* that Einhorn may rely upon defendants’ actions, some of which are said to have infringed his alleged rights, to establish publication. Making the work available in that way, even assuming it constituted “distribution,” did not involve “sale or other transfer of ownership, or by rental, lease or lending.” Indeed, this result follows directly from the principle that “the projection or exhibition of a motion picture in theaters or elsewhere does not in itself constitute a publication.”¹⁰⁷

The court in *Einhorn* arrived at the correct conclusion, but its reasoning is flawed. The court should have clarified that distribution by the *Defendants* could not amount to publication because, generally, only distributions authorized by the copyright owner constitute publication, and this distribution was clearly not authorized.¹⁰⁸

The question of authorization was a significant factor leading to the determination that the song “Happy Birthday” belongs in the public domain.¹⁰⁹ The district court correctly noted that “[i]f the publication was

¹⁰⁷ *Einhorn*, 426 F. Supp. 2d at 197 (quoting 1 Nimmer & Nimmer, *supra* note 12, § 4.11[A]).

¹⁰⁸ Deborah R. Gerhardt, *Copyright Publication: An Empirical Study*, 87 NOTRE DAME L. REV. 135, 200 (2011).

¹⁰⁹ *Marya v. Warner/Chappell Music, Inc.*, 131 F. Supp. 3d 975, 990–91 (C.D. Cal. 2015).

authorized, that could make it a general publication . . . divesting the Hill sisters of their common law copyright” due to the lack of notice required at the time of publication.¹¹⁰ When a public distribution has not been authorized, it will not weigh as heavily in favor of publication.¹¹¹ A defendant cannot prove publication based solely on an act of infringement.¹¹² However, if a copyright owner permits obvious public distribution without doing anything to control it, a general publication may occur notwithstanding a lack of express permission.¹¹³ Had the *Einhorn* court emphasized that unauthorized distributions do not amount to publication, the conclusion would have been based on a sound foundation of copyright publication precedent.

To the extent that the court suggests that Internet distribution does not amount to transfer of ownership of a copy, the decision contradicts *Getaped*. The *Einhorn* court suggested that for publication purposes, Internet distribution of a film was equivalent to the screening of a film in a theater,¹¹⁴ but that is a false equivalency. When a

¹¹⁰ *Id.* at 991.

¹¹¹ *Id.* at 990.

¹¹² *Neri v. Monroe*, No. 11-cv-429-slc, 2014 WL 793336, at *10 (W.D. Wis. Feb. 26, 2014), *aff'd*, 567 F. App'x 465 (7th Cir. 2014) (“For purposes of statutory damages and attorney fees under the Copyright Act, ‘publication’ refers to the *copyright owner’s* actions, not those of the alleged infringer. Stated another way, ‘an act that commences infringement does not publish an otherwise unpublished work.’ *Zito v. Steeplechase Films, Inc.*, 267 F. Supp. 2d 1022, 1026 (N.D. Cal. 2003). *See also* 1 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 4.04 at 4–22 to 4–23 (2002) (‘Congress could not have intended that the various legal consequences of publication under the current Act would be triggered by an unauthorized act of an infringer or other stranger to the copyright.’)”).

¹¹³ *Letter Edged in Black Press, Inc. v. Pub. Bldg. Comm’n of Chi.*, 320 F. Supp. 1303, 1311–13 (N.D. Ill. 1970).

¹¹⁴ *Id.*

film is merely shown, it falls under the public performance exception to publication. When copies of the film are distributed—in hard copies or digitally—such distribution amounts to publication.¹¹⁵ Perhaps the court was not directed to the settled precedent indicating that digital versions of copyrightable works are “copies” as defined by federal copyright law.¹¹⁶ Posting digital copies online does result in a “transfer of ownership” as defined under the Act.¹¹⁷ Contrary to the *Einhorn* court’s suggestion, no sale is required for publication to occur.¹¹⁸

To the extent that *Einhorn* contradicts *Getaped*, it is the *Getaped* decision that is consistent with decades of publication precedent, demonstrating that when a copyright owner authorizes unrestricted distribution of copies to the public, the work will be deemed published. Therefore, unless something in the factual history of a work shows that distribution was restricted or unauthorized, Internet distribution will generally be deemed to constitute publication.

Given the divergent conclusions about digital distribution regarding publication, it remains critically

¹¹⁵ *Am. Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1027 (9th Cir. 1981) (“An oft quoted modern definition of general publication is that ‘publication occurs when by consent of the copyright owner, the original or tangible copies of a work are sold, leased, loaned, given away, or otherwise made available to the general public, or when an authorized offer is made to dispose of the work in any such manner even if a sale or other such disposition does not in fact occur.’”) (quoting 1 NIMMER & NIMMER, *supra* note 12, § 4.04 at 4-18, 4-19).

¹¹⁶ *See* 17 U.S.C. § 1001 (1992); *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153, 171 (D. Mass. 2008).

¹¹⁷ *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 401 (S.D.N.Y. 2002) (“[T]he ability of the Internet user to download a file containing a copyrighted work and thereby gain control of it, that is, gain a proprietary or possessory interest in the copyrighted work.”).

¹¹⁸ *See* 17 U.S.C. § 101 (2010).

important to identify and plead facts to support the publication status of a work. A plaintiff claiming publication online should identify the date on which the work was first placed on a *publicly* accessible site. Without the explicit claim that the site was public, the publication allegation may be deemed insufficient.

One court found that an allegation of online distribution is an insufficient claim of publication unless the claimant specifies that the site was visible to the general public.¹¹⁹ In *Kernal Records Oy v. Mosley*, a Norwegian citizen composed a musical arrangement entitled “Acidjazzed Evening.”¹²⁰ Plaintiff claimed the work was first published in Australia, and therefore fit the definition of a foreign work that did not require the plaintiff to register its copyright under U.S. law.¹²¹ The defendant alleged that Internet publication constituted simultaneous publication in the U.S., and therefore, the work did not qualify for the registration exemption.¹²² The court’s jurisdiction to hear the case turned on whether the online distribution of the composition amounted to publication in the United States.

Because the work was posted on the Internet, the district court presumed simultaneous, worldwide publication and dismissed the case finding it lacked jurisdiction given that there had been no registration.¹²³ On

¹¹⁹ *Kernal Records Oy v. Mosley*, 794 F. Supp. 2d 1355, 1368 (S.D. Fla. 2011).

¹²⁰ *Id.*

¹²¹ *Id.* at 1362–63.

¹²² *Id.* at 1364–68.

¹²³ *Id.* at 1368 (“We hold that publishing AJE on a website in Australia was an act tantamount to global and simultaneous publication of the work, bringing AJE within the definition of a ‘United States work’ under § 101(1)(C) and subject to § 411(a)’s registration requirement. Gallefoss elected to publish AJE on the Internet and the legal

appeal, the Eleventh Circuit indicated that the presumption that Internet distribution amounts to publication was erroneous.¹²⁴ The court explained: “[T]he terms ‘Internet’ and ‘online’ include alternatives to the use of a public website, including a restricted website, e-mail, or a peer-to-peer network. Such general and ambiguous deposition testimony, without the inclusion of specific facts, is insufficiently probative to demonstrate that there was no dispute of material fact.”¹²⁵ Despite this fundamental criticism of the district court’s reasoning, its summary judgment decision was affirmed because Plaintiff “failed to produce sufficiently probative evidence of *Acidjazzed Evening* being a foreign work exempt from registration.”¹²⁶ An important lesson can be drawn from this decision: future litigants should expressly indicate whether their online distribution was publicly accessible. Although the defendant offered evidence that the work was posted online, the evidence did not clarify whether the site was open to the public.

consequences of that decision must apply. Plaintiff was therefore required to register AJE prior to seeking judicial enforcement of its copyright rights.”)

¹²⁴ *Id.* at 1305–06 (“Although it may be possible to presume simultaneous worldwide availability of a public website, . . . such a presumption could not apply to restricted websites, peer-to-peer networks, and e-mail. A restricted website is only available to those willing to pay a fee or who meet specified criteria; a peer-to-peer network is only available to those who have downloaded the required software; and an e-mail only goes to the addresses input by the sender. Thus, unlike public websites on the World Wide Web, each of these other methods of online distribution would be inconsistent with a presumption of simultaneous worldwide availability. . . . The district court then erroneously assumed all ‘Internet publication’ results in simultaneous, worldwide distribution. As outlined below, a proper separation of the terms yields a very different analysis.”) (citations omitted).

¹²⁵ *Id.* at 1308.

¹²⁶ *Id.* at 1311.

As illustrated above in *Einhorn*, authorization by the copyright owner is another important piece of the publication puzzle.¹²⁷ When a copyright owner distributes a work or authorizes a distribution, that authorization is an important factor leading to a conclusion of publication. When a copyright owner posts a work on a publicly available Internet site, the posting constitutes copyright publication because the general public has unrestricted access to digital copies. Judges should no longer have to throw up their hands in frustration or avoid the publication issue by deferring to the ministerial decision of registration made without access to all the relevant facts.¹²⁸

When a work has been posted by the copyright owner on a publicly available site, both the statutory definition and the overwhelming weight of copyright precedent support a finding that the work has been published. Therefore, the moment a work is posted on social media or a public website, it has been published as a matter of copyright law. Some courts have seen through the ambiguity in publication doctrine to set helpful precedent regarding Internet publication. For example, the court in *Wright v. BuzzFeed* correctly concluded that a copyright owner's posting of her work on Instagram constitutes publication.¹²⁹ Courts and the U.S. Copyright Office should not hesitate to draw this conclusion that is compelled by decades of precedent. Whether the

¹²⁷ *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 191–93 (S.D.N.Y. 2006).

¹²⁸ *Rogers v. Better Bus. Bureau of Metro. Houston, Inc.*, 887 F. Supp. 2d 722, 732–33 (S.D. Tex. 2012).

¹²⁹ *Wright v. BuzzFeed, Inc.*, No. 2:18-cv-02187-CAS (AFMx), 2018 WL 2670642, at *3 (C.D. Cal. June 4, 2018) (concluding that plaintiff is not entitled to statutory damages or attorney's fees on two of her claims because (1) the alleged infringement pre-dated her copyright registration; and (2) the copyright was not registered within three months of first publication).

distribution constitutes limited publication or no publication at all raises a legitimate question of fact only if (1) someone other than the copyright owner posted the work; (2) the site was not publicly available and the content was not authorized for further distribution; or (3) members of the public could view the content but not download digital copies.¹³⁰ The following section provides a standard to help future copyright registrants and litigants decide when online distribution does and does not amount to copyright publication.

V. INTERNET PUBLICATION INDICATORS

The following standard should be used to determine whether a work has been published through distribution on the Internet and, specifically for copyright purposes, a work placed on the Internet should be considered published if the facts reflect the following three factors: (1) the work was posted by the copyright owner or with the owner’s permission; (2) the site was publicly accessible; and (3) the public could download copies of the work.

Use of this standard will make it clear that Internet posts on many websites will constitute publication if the work was posted by the copyright owner or with the owner’s consent. When a copyright owner posts content on a website or social media site such as Facebook or Instagram that permit users to create or download copies, the work should be deemed published.

¹³⁰ NIMMER & NIMMER, *supra* note 12, § 4.07[B]; Palmer/Kane LLC v. Gareth Stevens Publ’g, No. 1:15-CV-7404-GHW, 2017 WL 3973957, at *12 (S.D.N.Y. Sept. 7, 2017) (“At the very least, the question of whether the appearance of the Images on stockmarketphoto.com prior to May 28, 1999 constituted ‘publication’ of the Images requires resolution of factual disputes regarding the extent to which the website was available to the general public and the purpose for which the Images were posted.”).

It is also important to remember that none of these elements will independently establish that a work is published. Take, for example, the first element involving permission from the copyright owner. Such authorization is important and generally leads to a finding of publication, but it does not always do so.¹³¹ If a work is posted on a site that is password-protected, encrypted, or otherwise closed to the public, the second element cannot be established. Although publication of the work may still be proven based on other facts, the technological protection measures will weigh against such a finding. If the distribution was restricted to a select group who were not authorized to distribute copies, the authorized distribution may be only a limited publication, which is equivalent to no publication at all. Such an authorized posting of a work on a site that is not publicly accessible will likely amount to only limited publication as such a distribution would be made to a limited group for a limited purpose.

Similarly, posting a work on a publicly accessible site is not by itself sufficient to constitute publication, especially if the first element is not proven. If the post was made without copyright owner authorization, the facts may not support a finding of publication, especially if the distribution was made by the defendant in the case being decided.¹³² Nonetheless, a series of unauthorized distributions may amount to publication especially when the copyright owner does nothing to stop them.¹³³ Therefore, authorization alone is insufficient to drive the publication conclusion.

¹³¹ Deborah R. Gerhardt, *Copyright Publication: An Empirical Study*, 87 NOTRE DAME L. REV. 135, 199–200 (2011).

¹³² *Neri v. Monroe*, No. 11-cv-429-slc, 2014 WL 793336, at *10 (W.D. Wis. Feb. 26, 2014), *aff'd*, 567 F. App'x 465 (7th Cir. 2014).

¹³³ *Letter Edged in Black Press v. Public Building Comm'n of Chi.*, 320 F. Supp. 1303, 1309 (N.D. Ill. 1970).