

US Supreme Court Holds That Copyrights Must Be Registered in Order to Sue for Infringement

by Andrew L. Goldstein

A FREEBORN & PETERS LLP CLIENT ALERT



ABOUT THIS CLIENT ALERT:

On March 4, 2019, the U.S. Supreme Court ruled that you must have registered your copyright in the US Copyright Office before you can sue for infringement of the copyright. The Supreme Court rejected the rule adopted by several lower courts which allowed one to sue for infringement if an application has been submitted to the Copyright Office. This ruling makes it important for you to review your intellectual property assets and make sure that you have registered any important copyrights you may own.

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Under U.S. law, a copyright exists the moment an author creates an original work and “fixes” it in a tangible medium. However, while you may have an enforceable copyright, the U.S. Copyright Act states that: “no civil action for infringement of the copyright in any United States work shall be instituted until ... registration of the copyright claim has been made.”

There was a split among the federal courts as to whether this meant that the Copyright Office must issue a registration before you can sue for infringement, or whether you can sue if you have submitted an application with the U.S. Copyright Office to register the copyright.

In *Fourth Estate Public Benefit Corp. v. Wall-Street.com LLC et al.*, a unanimous Supreme Court decided that you must have a registration from the Copyright Office, or have been refused a registration, in order to sue for copyright infringement. Justice Ruth Bader Ginsberg, who wrote the opinion, noted that once a registration has issued for a copyright, a copyright owner can recover for infringement that occurred both before and after registration.

Justice Ginsberg also noted that the Copyright Act allows for “preregistration” in certain circumstances which allows the copyright owner to file an infringement suit before a registration has issued. Preregistration is allowed if a copyright owner is preparing to distribute a work of a type vulnerable to pre-distribution infringement, such as a movie or musical composition. The Supreme Court further noted that a copyright owner may also sue for infringement of a live broadcast before the copyright is registered.



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In addition, the Supreme Court recognized that copyright owners facing prospective infringement litigation can seek expedited processing of a registration for an additional \$800 fee. For expedited processing, the Copyright Office “makes every attempt to examine the application ... within five working days.”

The Supreme Court addressed the fears that a copyright owner may lose the ability to enforce the owner’s copyrights if the three-year statute of limitations for copyright infringement runs out before the Copyright Office processes the copyright application. Justice Ginsburg admitted that the copyright registration “scheme has not worked as Congress likely envisioned [because] processing times have increased from one or 2 weeks in 1956 to many months today.” However, Justice Ginsburg said that this “fear is overstated as the average processing time for registration applications is currently seven months, leaving ample time to sue after the [Copyright Office’s] decision, even for infringement that began before submission of an application.”

Aside from the Supreme Court’s decision, you should know that there are other benefits to registering your copyright with the Copyright Office. If you register your copyright prior to an infringement, or within three months of the date of first publication, you can recover your attorney’s fees and costs and, as opposed to having to prove your actual damages, you can recover statutory damages of between \$750 and \$30,000 per work per infringement, which can be increased to \$150,000 per work if the infringement is willful.

This Supreme Court’s decision has made it more important for you to review your intellectual property portfolio to determine whether you own any valuable copyrights which may be susceptible to infringement. If so, you should consider filing applications to register these copyrights with the Copyright Office. If you require assistance in registering your copyrights with the Copyright Office, contact Andrew L. Goldstein at agoldstein@freeborn.com.

ABOUT THE AUTHOR



Andrew L. Goldstein
Partner

Chicago Office
(312) 360-6438

agoldstein@freeborn.com

Andy Goldstein is a Partner in the Corporate Practice Group and a member of the Emerging Technologies Industry Team. He focuses his practice in the area of Intellectual Property and Information Technology. He has extensive experience in the areas of intellectual property law, including trademark, copyright, trade dress; internet, website, cloud computing, technology, outsourcing, IoT and computer law in general; advertising, marketing, and promotion law; and entertainment law, including video production, theater and dance-related matters. The Chambers-USA Guide to America's Leading Lawyers, calls Andy a "business law expert," and adds that "He is smart and versatile, with broad expertise and an extremely fast turnaround time."

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CHICAGO

311 South Wacker Drive
Suite 3000
Chicago, IL 60606
(312) 360-6000
(312) 360-6520 fax

NEW YORK

230 Park Avenue
Suite 630
New York, NY 10169
(212) 218-8760
(212) 218-8761 fax

SPRINGFIELD

217 East Monroe Street
Suite 202
Springfield, IL 62701
(217) 535-1060
(217) 535-1069 fax

RICHMOND

411 East Franklin Street
Suite 200
Richmond, VA 23219
(804) 644-1300
(804) 644-1354 fax

TAMPA

1 Tampa City Center
201 North Franklin Street
Suite 3550
Tampa, FL 33602
(813) 488-2920

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