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## **ADMINISTRATIVE ADJUDICATIONS AND THE VARIOUS BASES FOR COURT REVIEW IN COPYRIGHT REGISTRATION**

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### **I. INTRODUCTION**

The Copyright Office (Office) of the United States is an interesting example of an agency whose limited powers have expanded through judicial decisions. One of the primary responsibilities of the Office is to examine works for their registerability. The scope of the examination process is limited by statute and further narrowed by the Office's internal rules. However, on appeal, the circuit courts have given great deference to Office decisions. This paper will examine the mechanisms in place for administrative adjudications and court review in copyright registration matters.

### **II. EVOLUTION OF U.S. COPYRIGHT LAW**

#### Generally

There has always been literary protection of one form or another in the United States. [n.1] Dating back to England's Statute of Anne [n.2] and embodied explicitly in Article I, Section 8, Clause 8 of the U.S. Constitution [n.3], \*130 there is a strong tradition of protecting the intellectual property rights of authors in this country.

Under the first U.S. Copyright Act, copyright registration was truly ministerial. An applicant was required simply: (1) to record the title, before publication, in the register book of the clerk's office of the district court where the author or proprietor lived; (2) publish a copy of the record for four weeks in at least one newspaper; and (3) deposit a copy of the work in the Office of the U.S. Secretary of State within six months of publication. [n.4] In the U.S., the law of copyright slowly but steadily developed between the first copyright act and the Copyright Act of 1909 (1909 Act). [n.5]

1909 Act

The 1909 Act, with few modifications, survived for 68 years. The 1909 Act created only three explicit formalities to copyright protection. First, each work had to be published with the proper notice inscribed on it. [n.6] Second, one or more copies of the work had to be deposited in the Office. [n.7] Third, each work had to be registered in the Office. [n.8]

The 1909 Act has been described as causing "no little perplexity in the practical administration of the Act, not to speak of disturbance in the minds of the interested public." [n.9] For example, one problem that arose under the 1909 Act was whether the Register of the Copyright Office (Register) had discretionary power or was merely a ministerial officer. One commentator concluded that the Register had limited discretion: "[s]uch exercise of discretion by the Copyright Office is more necessary because there is no provision in the copyright law, as there is in the patent law, for scrutiny of applications or copies, to determine questions of originality or authorship." [n.10]

### \*131 Current Copyright Law

Today, the Copyright Office is part of the Library of Congress and under the supervision of the Librarian of Congress (Librarian). The Librarian is appointed with the advice and consent of the Senate. [n.11] The Librarian is authorized to appoint a Register of Copyright (Register) as director of the Office. [n.12] The Register also functions as the Assistant Librarian of Congress for Copyright Services. [n.13] Finally, in addition to administrative responsibilities [n.14], the Register registers (or refuses to register) claims for copyright and issues certificates of registration of copyright. [n.15]

## III. INITIAL ADJUDICATIONS

### Registration: Why is it Important?

Under the Copyright Act of 1976, registration, or at least an attempt at registration, is a prerequisite to an infringement action. [n.16] In addition, by registering a claim for copyright prior to infringement, or within three months of publication, the copyright holder becomes eligible for two important remedies: statutory damages and attorney \*132 fees. [n.17] Finally, registration within five years of publication is prima facie evidence of the validity of the registration [n.18] which is procedurally valuable. In court, this burden shifting mechanism requires an alleged infringer to prove copyright invalidity. [n.19]

Because a copyright registration can be a valuable procedure and provide the basis for a wider array of alternative remedies, it is important to understand the examination procedure. Examination is initiated by filing an application to register a claim and is

concluded with either issuance of the requested registration or a letter from the Office explaining why the application was denied.

### The Scope of Examination: A Two-Prong Analysis

Unlike the examination procedure for other intellectual property, [n.20] the scope of inquiry for copyright is very narrow. Specifically, the Office uses a two-prong analysis to determine whether the subject matter of the application is registerable. The examination determines (1) whether or not the submitted work constitutes copyrightable matter; and (2) whether or not the other legal and formal requirements have been met, including those contained in the Copyright Office Regulations (embodied in the Code of Federal Regulations) and in the Compendium of Copyright Office Practices (Compendium II). [n.21]

The Office does not compare works to determine if the material has already been registered [n.22]; nor does the Office make findings of fact with respect to information outside the Office. [n.23] However, the Office will take notice of matters of common knowledge. [n.24] Finally, unlike the Patent and Trademark Office (PTO), the Copyright Office does not conduct opposition or interference proceedings. [n.25]

\*133 The Office's discretion is further limited by the rule of doubt. Under this rule, a claim is registered even though there is reasonable doubt about what action a court of law would take in determining compliance with 17 U.S.C. § 410(a). [n.26]

The last limitation on the Office's ability to refuse registration is referred to as a variance. A variance occurs when contradictory information is contained in the registration materials. [n.27] If the variance is immaterial, the Office will disregard it. [n.28] When a variance is more than immaterial, but can be resolved for purposes of registration, the Office will annotate [n.29] the application to show the varying material. [n.30] Finally, where the variance is substantial, the Office will contact the applicant and request an explanation for the discrepancy. [n.31]

The limited scope of review, the rule of doubt, and the use of variances increase the efficiency of the Office and shifts the ultimate authority for resolving registration disputes to the courts. As a consequence of the Office's limited ability to review registrations, 96.4% of copyright applications are approved. [n.32] Thus, over 100,000 registrations are issued each year. [n.33]

Except for the Register's power to refuse to register applications, the Office functions much like a registry of deeds. It receives applications, reviews them to ensure the material is copyrightable subject \*134 matter and that certain legal and formal requirements have been met. [n.34] Then, the Office registers the material and issues a certificate of registration.

## Educational and Experience Requirements of the Examining Corps

One reason for the Office's narrow scope of review may be the lack of specialized educational and experience requirements for the examining corps. A bachelor's degree is required for a Copyright Examiner (Examiner). [n.35] Also, an Examiner must have two years of specialized experience in copyright law and procedures. However, the Office will accept three years of general experience as a substitute for the educational requirement. The Office accepts a law degree or a master's degree in the liberal arts, humanities, or fine arts as a substitute for both the educational and experience requirements.

The Head of an Examining Division (Section Head) only needs a bachelor's degree. [n.36] Also, a Section Head must have three years of specialized experience, strong substantive knowledge of copyright law, and the ability to analyze copyright problems. However, the Office will accept six years of experience (three years of general and three years of specific experience) in lieu of the educational requirements. A master's degree and one year of specialized experience may substitute for the above-stated educational and experience requirements. Finally, a law degree may substitute for two of the three years of specialized experience requirements.

The Office requires that the Chief of an Examining Division (Division Head) possess a law degree and be a member of a state bar or the D.C. bar. [n.37] In addition, a Division Head must have one year of specialized experience demonstrating a knowledge of copyright law as well as a legal understanding of the problems, policies, and trends related to copyright registration process.

## \*135 IV. INTRAMURAL APPEALS

### Refusal to Register

If the subject matter of the application for copyright registration fails to meet the two-prong test found in § 410(a), registration is refused and the applicant is notified in writing as to the reasons for refusal. Specifically, under prong one of the § 410(a) analysis, if the material is unregistrable, registration will be refused. Examples of unregistrable material include: works of the U.S. Government (17 U.S.C. § § 101, 105); works not fixed in a tangible medium of expression (17 U.S.C. § 102(a)); and works that are not original works of authorship (17 U.S.C. § 102(a)). [n.38]

The Office will also refuse to register material if "certain legal requirements" have not been met. For example, a work that went into the public domain before 1978, as determined by the 1909 Act, will be refused registration. In certain cases, works published under the current act without the required notice which were not registered within five years after publication will be refused registration. [n.39] Also, if the Office has knowledge that the applicant is not authorized to submit the claim, the Office will

refuse to register the material. [n.40] Finally, if essential information has not been given, registration will be refused.

Once the Office has determined that a work is not registerable, the Office must notify the applicant in writing of the reasons for such refusal. [n.41] The refusal notice from the Office should be more substantial than simply the word "rejection." The United States Court of Appeals for the District of Columbia in *Atari v. Oman (Atari I)*, required that the Register clearly and in reasonable detail defend his ruling. [n.42]

#### \*136 Requests for Reexamination

A claimant who has been denied registration may have two options: request reconsideration [n.43] or file an infringement suit and collaterally attack the Office's refusal. [n.44] This section will address the intramural appeals route of requesting reconsideration. After the Office issues a refusal, the applicant may request reconsideration by setting forth in writing all of his or her objections. [n.45] Specifically, a claimant has 120 days to respond to the Office's notification of refusal to register. [n.46] If the claimant fails to respond in time, the file will be closed and the claimant will have to refile a new application. [n.47]

The initial refusal is generally written by the Copyright Examiner. If reconsideration is requested and again refused, the Section Head will notify the claimant in writing of the reasons for refusing to register the application. [n.48] Finally, the claimant may request reconsideration of the Section Head's decision. If the claimant is again denied registration, the Division Head will notify the claimant in writing of the reasons for refusing registration. [n.49] The decision of the Division Head is considered final agency action. [n.50]

#### \*137 V. COURT REVIEW

##### Appeals Under the 1909 Act: Writ of Mandamus

Under the 1909 Act, claimants who were refused registration sought relief through a writ of mandamus under 28 U.S.C. § 1361 to compel the Register to register the material. [n.51] For example, in *Bouve v. Twentieth Century-Fox Film Corp.* a mandamus action was brought after the Office refused to register material submitted as a "book" by Twentieth Century-Fox (Fox). The dispute was really over money (e.g., whether the Office would collect 20 separate registration fees or just 1). The Office refused to register the material on the grounds that the "book" was really 20 separate works under § 12 of the 1909 Act. Fox petitioned in the District Court for the District of Columbia for a writ of mandamus to compel the Register to register the book. The District court granted Fox's writ and ordered the Office to register the book. The Office appealed.

The issue before the United States Court of Appeals for the District of Columbia was whether the Register has "[a]ny discretionary power in connection with the registering of works subject to copyright." [n.52] In affirming the District Court, the Court of Appeals held that although the Register was not simply a ministerial officer, his discretion was limited and did not include the power to alter provisions of § 5 of the 1909 Copyright Act. Therefore, under the 1909 Act, the register's powers, though not ministerial, were limited.

## APA Review

Since the 1988 Amendments [n.53] to the 1976 Act, claimants refused registration by the Register may appeal under the Administrative Procedure Act (APA). [n.54] Specifically, § 701(d) states that ". . . all actions taken by the Register of Copyrights under this title [17 U.S.C. § § 101 et seq.] are subject to the provisions of the Administrative Procedure Act. . . ." [n.55] Although not explicitly addressed in the statute, case law demonstrates that a claimant must exhaust all of his administrative remedies prior to filing suit. [n.56] Therefore, a claimant must follow the procedures outlined in diagram A [n.57] and discussed supra in section IV before judicial review is possible.

## Abuse of Discretion Standard and Judicial Deference to Register

Review under the APA may be sought in any United States District Court. The standard of review used by the courts is "arbitrary, capricious, and abuse of discretion or otherwise not in accordance with the law." [n.58] As a practical matter, most appeals are met with motions for summary judgment. Therefore, the claimant must be ready to meet his burden of proof and production.

For example, in *The Homer Laughlin China Co. v. Oman*, the Homer Laughlin China Co. (HLC) appealed to the United States District Court for the District of Columbia because the Office refused to register HLC's Gothic chinaware pattern. The Office moved for summary judgment arguing that HLC's chinaware pattern was not copyrightable subject matter. The issue before the district court was whether the Register abused his discretion in refusing to register the pattern. Concluding that the Register did not abuse his discretion, the court stated that, "[t]he register is entitled to a significant degree of deference and its decision may be overturned only upon an abuse of discretion." [n.59]

The Homer Laughlin Court seems to justify its deferential treatment of the Register's decision based on the Office's expertise in determining creativity and originality. Specifically, the district court said, \*139 "[i]n determining creativity, such a decision necessarily requires the exercise of informed discretion, and the Register, in part due to having to make such determinations on a daily basis, is generally recognized to possess considerable expertise over such matters." [n.60]

Given the Office's limited inspection powers and the examining corps' minimal educational and experience requirements, the question arises why have the courts been so deferential to the Office in reviewing its decisions to refuse to register works? [n.61] The Homer Laughlin Court concluded that "since the applicant can gain full judicial review of copyrightability in an infringement action, the costs of forcing too fine an analysis and too extensive an explanation of a denial of registration are not worth the benefits . . . ." [n.62] The HLC Court explicitly recognizes that there are two different standards for reviewing Office decisions: (1) "arbitrary and capricious" under the APA and (2) de novo review for copyrightability under § 411(a). However, the HLC decision provides little solace for an applicant who cannot bring a § 411(a) action. Therefore, the judicial deference paid to the Office under the APA creates formidable proof and production burdens for the refused claimant. [n.63]

\*140 However, a claimant who chooses to appeal a decision of the Office under the APA is not without hope. [n.64] In the Atari I and II decisions, the United States Court of Appeals for the District of Columbia seems to have retreated from the traditional deference given to the Office. The Atari decisions mark the first time an appeals court has not deferred to the Office's interpretation of what constitutes original authorship. [n.65]

In two separate decisions involving a video game, the Court refused to accept the Office's definition of what constituted original authorship. The Atari I Court chastised the Office for confusing registerability with the extent of copyright protection. The Atari I Court said that registerability involves the question of whether a work constitutes copyrightable subject matter and that the extent of protection, strong or thin, is a matter of scope of protection. [n.66] In addition, the Atari II court said, "[i]t is not the Register's task to shape the protection threshold or ratchet it up beyond the 'minimal creative spark' required by the Copyright Act and the Constitution." [n.67] Therefore, a claimant litigating a refusal to register decision by the Office may have more luck than in the past, at least in the Court of Appeals for the District of Columbia, on issues relating to original authorship.

#### Collateral Review Under the 1909 Act

As discussed supra, prior to the 1976 Act, the only judicial remedy available to a party who was denied registration was a writ of mandamus. [n.68] For example, the United States Court of Appeals for the Second \*141 Circuit in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Company*, addressed the issue of whether the Register's refusal to register a claim can be litigated in the context of an infringement suit. [n.69] *Vacheron* was a case decided under the 1909 Act, in which *Vacheron* sued *Benrus* for copyright and design patent infringement of a wrist watch. However, prior to instituting the infringement suit, *Vacheron's* watch had been denied copyright registration.

District Court Judge Dimock ruled on the merits of the copyrightability of the watch. Specifically, Judge Dimock upheld the Office's refusal to register the watch because he found that under 17 U.S.C. § 5(g) [n.70], the watch was not copyrightable. However, on appeal, Judge Hand, writing for the Second Circuit, said, "[w]e do not think it necessary to decide whether the plaintiff's watch was copyrightable . . . ." [n.71] Rather, the Second Circuit held that 17 U.S.C. § 13 (1909) "[f]orbade any action for infringement of the copyright when the Register of Copyrights had refused, as he did, to accept the watch as copyrightable under § 5(g)." [n.72]

The Second Circuit argued that an infringement action could not be brought unless the infringed work had been registered by the Office. In support of its holding, the Second Circuit cited the Bouve decision which granted a writ of mandamus in favor of a copyright applicant and forced the Office to register the application. The Second Circuit reasoned that compelling the Register to register a claim through a writ of mandamus presupposed that no action for infringement could be brought. [n.73] The decision rests upon the theory that a writ of mandamus is an extraordinary remedy which is granted only if there is no other adequate alternative remedy. [n.74]

#### \*142 Collateral Review Under § 411(a): The Death of Mandamus

Under 17 U.S.C. § 411(a) of the 1976 Act, a claimant may now litigate a refusal to register decision by the Office in the context of an infringement suit before any U.S. District Court in the venue in which the infringement occurred. However, there are several prerequisites to collateral review of the Office's decision not to register a claim.

First, the claimant must have properly applied for registration and have been denied. Proper application means that the claimant must submit the proper fee, application, and deposit (if required) to the Office.

Second, notice and a copy of the complaint must be served on the Register. If the claimant fails to serve the Register with notice and a copy of the complaint, the infringement action must be dismissed. [n.75] The Register may, at his discretion, intervene as a defendant in the infringement suit to litigate the registerability issue. The Register has 60 days from the time he is served with notice of the infringement action to make an appearance before the court. Failure of the Register to make an appearance will not deprive the court of jurisdiction to hear either the infringement or registerability issues. [n.76]

Finally, because of the changes in the 1976 Act reflected in §§ 411(a) and 701(d), the United States Court of Appeals for the Ninth Circuit removed mandamus as an avenue to review registration decisions. [n.77] *Nova Stylings v. Ladd* was a mandamus action brought under 28 U.S.C. § 1361 to compel the Register to register several jewelry designs. The Office refused to register *Nova Stylings'* jewelry designs because the Register did not think they were original works of authorship as required by § 102(a) of the 1976 Act. The Register moved for summary judgment arguing lack of subject matter



jurisdiction under 28 U.S.C. § 12(b)(6); the district court agreed and dismissed the case. Nova Styling appealed to the Ninth Circuit.

The issue before the Ninth Circuit was whether the district court had jurisdiction under 28 U.S.C. § 1361 to compel the Office to register the jewelry designs. According to the Ninth Circuit, "[t]he 1976 Copyright Act obviates the need for a mandamus remedy." [n.78] Citing 17 U.S.C. § 411(a), the Ninth Circuit said that the only precondition for bringing an infringement suit is that notice be served on the Register. [n.79] The Ninth Circuit concluded that "[o]nce that has occurred [fulfilling the preconditions set forth in § 411(a)], the district court can determine both the validity of the copyright, which in turn determines its registerability, as well as whether an infringement has occurred." [n.80]

In dicta, the Ninth Circuit also addressed the availability of a mandamus action when a claimant who has been denied a registration cannot use § 411(a) for collateral review of the Office's decision because no infringing activity has occurred. Arguing that § 701(d) made the provisions of the APA available to denied applicants, the Ninth Circuit said that "mandamus is no longer available as a basis for review in this area." [n.81]

There is a split among the Circuits as to whether a claimant must exhaust his administrative remedies prior to instituting an infringement action. Section § 411(a) does not expressly require final agency action prior to filing an infringement suit. However, several circuits in infringement suits have reviewed the Office's refusal to register under an abuse of discretion standard implying that exhaustion of the claimant's administrative remedies was required. [n.82] However, the abuse of discretion standard used by some circuits is rejected by Judge Silberman's concurring opinion in *Atari I*: "If the Register has adopted such an interpretation [a categorical distinction between classes of works] to govern his office's decisions on registration, that does not mean that the judiciary would be obliged to afford deference to that position in an infringement action, which of course, is not a direct review of agency action governed by the Administrative Procedure Act." [n.83]

\*144 In summary, the Copyright Act of 1976 and the 1988 Amendments substantially changed the 1909 Act in several ways: (1) by allowing judicial review through the APA; (2) by allowing collateral review of refusals to register; and (3) by prohibiting denied claimants from filing writs of mandamus to compel the Register to register their applications. [n.84] However, there is no definitive answer to whether exhaustion of one's administrative remedies is required prior to litigating the Office's registration decision in an infringement action.

#### Judicial Deference: Abuse of Discretion or De novo Review?

The 11th Circuit has addressed the issue of why and under what circumstances Office decisions are entitled to deference in *Norris Industries, Inc. v. I.T.& T. Corp.* [n.85] *Norris* involved an infringement action in which the registration of a wire-spoked wheel cover design became an issue. *Norris* was issued a registration under the rule of doubt for

its design in 1976. In 1977, Norris applied for four additional copyright registrations in a second wire-spoked wheel cover design. The Office denied all four registrations.

In 1980, Norris instituted an infringement action against IT&T, in the District Court for the Northern District of Florida, alleging copyright and patent infringement of its designs. The Register intervened pursuant to 17 U.S.C. § 411(a) as a defendant to contest the registerability of the unregistered designs. Both IT&T and the Register moved for summary judgment on the copyright counts. The district court granted summary judgment and Norris appealed.

The 11th Circuit analyzed several cases dating from *Mazer v. Stein* [n.86] and found that there is a tradition of giving deference to decisions of the Office. In answering the question of why the Office is owed such deference given that the examining corps do not have technical expertise, the 11th Circuit said, "[t]he expertise relied on is not technical expertise in the use of the article submitted for registration but expertise in the interpretation of the law and its application to the facts presented by the copyright application." [n.87] The 11th Circuit may be placing too much emphasis on the Office's expertise considering \*145 that an Examiner or Section Head is only required to have a bachelor's degree. [n.88]

In contrast, under § 411(a) a court first examines a work to determine whether it is copyrightable subject matter. If the work is copyrightable subject matter, the court determines the scope of copyright protection. The issue of copyrightability is a question of law and is reviewed using a *de novo* standard. [n.89]

One would expect courts who implicitly review registerability by determining copyrightability to give less deference to Office refusals to register. Therefore, a claimant who has properly applied for registration and been denied by the Office may be wise to litigate the issue of registerability through an infringement action under § 411(a). [n.90] Such a claimant would save time and money by-passing the intramural review procedures of the Office. In addition, by choosing the right forum, the claimant would have her registration claim decided in the context of copyrightability under the less deferential *de novo* standard of review.

## VI. CONCLUSION

Since the enactment of the 1909 Act, the Copyright Office has grown from a largely ministerial agency to one that has assumed much substantive power through court decisions. Except for Compendium II § 604.04, there are no written guidelines for intramural appeals to the Office. In addition, § 411(a) is silent as to the proper discretion courts must give Office registration decisions in infringement suits.

The largely unchecked power of the Office is manifest in the fact that the Atari decision is the only case where a court explicitly rejected the Register's interpretation of original authorship. Given the Office's limited scope of review and the minimal educational and

experience requirements of the examining corps, it is hard to explain the great amount of discretion courts have given to Office registration decisions.

It is clear that refused claimants have two levels of recourse when they are denied a registration. Specifically, the applicant may seek judicial review through the provisions of the APA under 17 U.S.C. § 701(d). Alternatively, a disappointed claimant may file an infringement action if several conditions are met: (1) the claimant has \*146 complied with § 411(a); (2) infringing activity has occurred; and (3) the claimant serves notice and a copy of the complaint on the Register.

It is also clear that prior to seeking APA review, the claimant must exhaust all of his administrative remedies by requesting reexamination. However, the claimant is in a catch-22 because the courts have cited the three levels of administrative review the application has gone through as a reason for deferring to the decision of the Office. [n.91] It does not make sense to require a claimant to exhaust his administrative remedies prior to seeking judicial review and then penalize him in court for following the rules by multiplying the amount of deference given to Office decisions by the number of times the application was reviewed.

Three recent cases [n.92] may give denied claimants hope that APA review may be more successful than in the past. However, all three cases are out of the same circuit (D.C. Circuit). Therefore, unless the claimant brings suit in the United States District Court for the District of Columbia, the claimant may have a better chance of succeeding by litigating the issue of registerability under § 411(a).

However, there is a discrepancy among the Circuits as to the proper standard of review Office decisions deserve in the context of infringement litigation. Judge Silberman's concurring opinion in *Atari I* is most persuasive. When registration is decided in an infringement suit, *de novo* review should be the proper standard because the real issue is the copyrightability of the work which is a question of law. However, not all denied claimants may be in a position to bring an infringement suit (i.e., no infringing activity may have occurred) and even if they can, they may be in a jurisdiction that uses the abuse of discretion standard.

[n.a1]. Kevin Hopper is a third year Juris Doctor/Master of Intellectual Property Law candidate at Franklin Pierce Law Center, May 1995. The author wishes to thank Professor Thomas G. Field for his comments and criticism. This article tied for first place at Franklin Pierce Law Center in The Nathan Burkan Memorial Competition.

[n.1]. Prior to the enactment of the U.S. Constitution, literary rights were protected by state law.

[n.2]. 8 Anne c. 19, 1710. "An act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein mentioned." The Statute of Anne contained two registration requirements: (1) the applicant had to register the title at the Stationers' Hall and (2) the applicant had to deposit nine copies of the work at official libraries.

[n.3]. Congress is expressly empowered "[t]o promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

[n.4]. Copyright Act of May 31, 1790, ch. 15, 1 Stat. 124. See also, Richard C. Dewolf, *An Outline of Copyright Law*, 16-17 (1925).

[n.5]. For example, in 1802 protection was extended to "historical prints"; in 1819 the Circuit Courts of the U.S. were given original jurisdiction in copyright cases; and in 1891 U.S. copyright protection was extended to foreigners.

[n.6]. 17 U.S.C. § 9 (1909).

[n.7]. *Id.* at § 12.

[n.8]. *Id.* at § 10.

[n.9]. Robert A. Gorman and Jane C. Ginsburg, *Copyright for the Nineties*, 9 (1993).

[n.10]. Richard C. Dewolf, *An Outline of Copyright Law*, 59-60 (1925).

[n.11]. 2 U.S.C. § 136 (1988).

[n.12]. 17 U.S.C. § 701(a). However, there is some movement in Congress to have the President, with the advice and consent of the Senate, appoint the Register of the Copyright Office. See e.g., Hearings on H.R. 897 held by the House Judiciary Subcommittee on Intellectual Property and Judicial Administration on March 3-4, 1993. See also, 20,724 *Copyright Law Review* 11,938 Vol. 2, CCH (1993).

[n.13]. Compendium II of Copyright Office Practices § 104 (1984). (Hereinafter, Compendium II).

[n.14]. The Register's administrative powers recently increased when President Clinton signed into law the Copyright Act of 1993 (Act of 1993). The Act of 1993 abolished the Copyright Royalty Tribunal (CRT) and transferred its responsibilities to the Register and the Librarian. The CRT was an independent agency in the "legislative" branch created to administer the compulsory royalty fees generated by certain sections of the Act of 1976. The Librarian and Register now oversee the administration of the royalty fees through ad hoc three-member Copyright Arbitration Royalty Panels (CARPs). See e.g., 103 P.L. 198, 1993 H.R. 2840, 107 Stat 2304.

[n.15]. 17 U.S.C. § § 410(a), 701(a)-(c) (1988). Notes of the Committee on the Judiciary, House Report No. 94-1476.

[n.16]. 17 U.S.C. § 411(a). However, the precursor to the Act of 1993, HR 897, contained provisions that would eliminate the registration requirement as a prerequisite to instituting a copyright infringement suit and to recover statutory damages and attorney's fees. Ultimately, only the abolishment of the CRT became law under the Act of 1993. See e.g., 20,724 Copyright Law Review 11,938 Vol. 2, CCH (1993).

[n.17]. 17 U.S.C. § 504 (c). In lieu of actual damages, the copyright owner may elect at any time prior to final judgment, to recover statutory damages (the amount of which is determined by the judge at her discretion) of not less than \$500.00 or more than \$20,000.00. § 504(c)(1). In addition, where the copyright owner elects statutory damages and proves willful infringement, the court may award up to \$100,000.00. § 504(c)(2).

[n.18]. However, certificates of registration do not create an irrebutable presumption of validity. An opposing party may present evidence that the items are not copyrightable. See e.g., *Ronald Litoff, LTD. v. American Express Co.*, 621 F. Supp. 981, 984 (S.D.N.Y. 1985).

[n.19]. 17 U.S.C. § 410.

[n.20]. E.g., patents and trademarks.

[n.21]. See e.g., 17 U.S.C. § 410, Compendium II § 108.01 (1984), 37 C.F.R. § 201 et. seq.

[n.22]. Compendium II § 108.03.

[n.23]. Id. at § 108.04.

[n.24]. Id. at § 108.05(b).

[n.25]. Id. at § 108.06.

[n.26]. Id. at § 108.07. 17 U.S.C. § 410(a) states: "When, after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application, together with the number and effective date of the registration.

[n.27]. Id. at § 605.02 (Feb. 1988).

[n.28]. Id. at § 605.02(a).

[n.29]. An annotation is defined as "a statement added to the application by the Copyright Office to amplify the record of facts affecting the copyright claim." Annotations are commonly used to note variances, add missing information, add comments to the application, or where authorized by the applicant. See Compendium II at § 605.03.

[n.30]. Id. at § 605.02(b). For example, when a deposited phonorecord states the title of the work to be "The Quick Brown Fox" but the application material gives the title as "The Brown Quick Fox" the Office will annotate the application to reflect the title appearing on the phonorecord. Presumably the Office does this annotating without contacting the applicant although it is not specifically addressed in Compendium II.

[n.31]. Id. at § 605.02(c).

[n.32]. Laurie A. Haynie, *So the Copyright Office has Refused to Register Your Claim to Copyright - What Does it Mean and What Can You Do About it?*, 21 A.I.P.L.A. Q.J. 70 (1993). The statistic was obtained from a copyright examiner in May of 1992.

[n.33]. Howard B. Abrams, *The Law of Copyright*, § 7.21[B], Vol. 1 (1993).

[n.34]. E.g., The Register ensures that the fee is paid and the proper registration form is used and completely filled out. See 17 U.S.C. § § 407- 409.

[n.35]. See e.g., Vacancy Announcement Numbers 21106 and 21116 (June 2 and July 6, 1992). The exact major may vary depending upon the section. The salary range for an Examiner begins at \$26,798.00 to \$34,835.00.

[n.36]. See e.g., Vacancy Announcement Number 21141 (August 5, 1992). The exact major may vary depending upon the section. The salary range for a Section Head begins at \$54,607.00 to \$70,987.00.

[n.37]. See e.g., Vacancy Announcement Number 30919 (January 4, 1984). The salary range for a Division Head begins at \$48,553.00 to \$63,115.00 (10 years ago).

[n.38]. For more examples of unregistrable works see Compendium II § 606.01 (1988).

[n.39]. *Id.* at § 606.02. See also, 17 U.S.C. § 405 (a).

[n.40]. Compendium II at § 606.03. An application for registration can only be submitted by one entitled to do so. See e.g., 37 C.F.R. 202.3(c)(1).

[n.41]. 17 U.S.C. § 410(b), Compendium II § 606.

[n.42]. *Atari Games Corp. v. Oman*, 888 F.2d 878, (D.C. Cir. 1989). The Atari Court held that "[t]he Copyright Office did not intelligibly account for its ruling." 888 F.2d at 879.

[n.43]. The only codification of the claimant's right to reconsideration is in Compendium II § 604.04 (1988). Reconsideration is not explicitly found in either Title 17 or 37 C.F.R. The only case under the 1976 Act that addresses the Office's intramural appeals process

is *Nova Stylings, Inc. v. Ladd*, 695 F.2d 1179 (9th Cir. 1983), which tells a claimant who has been refused registration that a mandamus action is not available but that appeal under the Administrative Procedure Act (APA) is available under 17 U.S.C. § 701(d). However, Congress is aware of the lack of codification of the Copyright Office's intramural appeals process. In part of the Copyright Act of 1993 which was not passed last session, version 4 of H.R. 897 would have required the Register to establish and publish in the Federal Register a formal procedure by which appeals may be taken from refusals to register. See 1993 H.R. 897 amending 17 U.S.C. § 410(b).

[n.44]. 17 U.S.C. § 411(a) (1988).

[n.45]. Compendium II § 606.04.

[n.46]. See James E. Hawes, *Copyright Registration Practice*, § 22.01 [[5] (1992).

[n.47]. Several consequences result from failing to respond within the 120- day time limit: The applicant will lose his filing date (the effective date of registration will be the later registration); the claimant will have to submit a new deposit; and the claimant will have to pay another filing fee.

[n.48]. Compendium II § 606.04.

[n.49]. *Id.*

[n.50]. *Id.*

[n.51]. See e.g., *Bouve v. Twentieth Century-Fox Film Corp.*, 122 F.2d 51 (D.C. Cir. 1941), *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co., Inc.*, 260 F.2d 637 (2nd Cir. 1958), and *Eltra Corp. v. Ringer*, 579 F.2d 294 (4th Cir. 1978).

[n.52]. 122 F.2d at 52.

[n.53]. The Berne Convention Implementation Act of 1988 (1988 Amendments). The 1988 Amendments modified the 1976 Act by limiting the formalities necessary to obtain copyright protection in the United States. As the title of the Act suggests, the amendments paved the way for the U.S. to join the Berne Convention.



[n.54]. 17 U.S.C. § 701(d).

[n.55]. § 701(d) explicitly exempts copies or reproductions of deposited material retained by the Office. See 17 U.S.C. § 706(b). To obtain review of decisions of the Office on the disposition of material covered by § 706(b) one must rely on the Freedom of Information Act.

[n.56]. See e.g., *Atari I*, where court observed that the "Copyright Office reported its final action . . . "; *Oddzon Products, Inc. v. Oman*, 16 U.S.P.Q.2d 1225 (D.C. D.C. 1989) aff'd, 924 F.2d 346, 350 (D.C. Cir. 1991), where the court cited three unsuccessful attempts at registration of the KOOSH ball before suit was brought under the APA; *The Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q.2d 1074 (D.C. D.C. 1991), where the court discussed in detail the three refusal-to-register notifications sent by the Office to Homer Laughlin describing why its Gothic chinaware design was not copyrightable.

[n.57]. See Appendix A.

[n.58]. 5 U.S.C. § 706(2)(A). See also, *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986).

[n.59]. 22 U.S.P.Q.2d at 1075.

[n.60]. *Id.* See also, 16 U.S.P.Q.2d at 1228, where the court said, "[i]n making this determination [refusing to register], the Register is entitled to a significant degree of deference and its decision may be overturned only upon an abuse of discretion." In addition, the Court of Appeals for D.C. in *Atari I* said, "[w]e accord due respect, however, to decisions made by the Copyright Office pursuant to authority vested in the Register." 888 F.2d at 880.

[n.61]. Although the scope of the Register's inquiry into whether material is registerable is limited, there is a tradition of recognizing broad discretionary powers vested in the Office of the Register of Copyrights. Specifically, under the 1909 Act, § 207 provided that "[t]he Register of Copyrights shall be authorized to make rules and regulations for the registration of claims to copyright as provided by this statute." The current copyright statute explicitly vests in the Register the power to determine whether registration is permissible under § 410(a) or prohibited under § 410(b). See e.g., *Abrams*, supra note 33, at § 7.21[A].

[n.62]. 22 U.S.P.Q.2d at 1074.

[n.63]. Case law is full of examples of judicial deference to Office decisions. For example, in *Norris Industries, Inc. v. International Telephone and Telegraph Corp.*, 696 F.2d 918, 922 (11th Cir. 1983), 217 U.S.P.Q. 226, the 11th Circuit was interpreting the 1909 Act when it stated that "[t]he district court properly gave some deference to the expertise of the Register in its decision." See also, *Eltra Corp. v. Ringer*, 579 F.2d 294, 299 (4th Cir. 1978), where the Fourth Circuit opinion in footnote 12 quotes a George Washington (G.W.) Law Review article stating, "[t]hree Supreme Court opinions have apparently acknowledged that interpretations by the Copyright Office, particularly if long-continued, are entitled to weight." Finally in *Mazer v. Stein*, 347 U.S. 201 (1954), (which was one of the cases cited in the G.W. article), the Supreme Court of the United States showed great deference to the Copyright Office's distinction between ornamental and useful articles in a case involving statuettes used as lamps.

[n.64]. See e.g., Homer Laughlin discussed in the text above and *Oddzon Products*. In *Oddzon Products*, the D.C. Circuit, although deferring to the Register's decision concerning the registerability of a toy ball in a suit brought under the APA, explicitly distinguished the standard of review it would use in a similar case brought under § 411(a). Specifically, Judge Ginsburg, writing for the court said, "[w]e again emphasize that we decide simply and only that the refusal of the Copyright Office to register the KOOSH ball, in the circumstances here presented, does not constitute an abuse of discretion. We do not decide on the copyrightability of the item, and we intimate no opinion on the decision we would reach if the matter came before us in an infringement action." *Oddzon Products, Inc. v. Oman*, 924 F.2d 346, 350 (D.C. Cir. 1991).

[n.65]. Haynie, *supra* note 32, at 81.

[n.66]. 888 F.2d at 882.

[n.67]. *Atari Games, Corp. v. Oman*, 979 F.2d 242, 247 (D.C. Cir. 1992), (*Atari II*). On remand, after *Atari I*, the Register again refused to register *BREAKOUT*. The district court again granted summary judgment to the Register, and Atari appealed. The *Atari II* Court reversed the summary judgment of the lower court and remanded the case to the district court with instructions to return the matter of Atari's application back to the Office for renewed consideration consistent with the court's decision.

[n.68]. See e.g., *supra* note 51.

[n.69]. 260 F.2d 637.

[n.70]. 17 U.S.C. § 5(g) (1909) is similar to the current list of categories of copyrightable subject matter found in § 102 of the 1976 Act. Specifically § 5(g) refers to "works of art; models or designs for works of art."

[n.71]. 260 F.2d at 639.

[n.72]. *Id.*

[n.73]. *Id.* at 640. But see, Judge Clark's dissenting opinion that quotes a First Circuit opinion: "[a]nd, although registration was refused, yet it [[complainant] fully complied with the requirements of law, and is entitled to maintain this suit if it had any statutory right to the extension [of the copyright]." *Id.* at 645 quoting, *White-Smith Music Pub. Co. v. Goff*, 187 F. 247 (1st Cir. 1911).

[n.74]. *Save the Dunes Council v. Alexander*, 584 F.2d 158, 162 (7th Cir. 1978).

[n.75]. 17 U.S.C. § 411(a).

[n.76]. *Id.*

[n.77]. 695 F.2d 1181.

[n.78]. *Id.*

[n.79]. This is not entirely correct. As stated *supra*, an attempted registration is necessary, except for Berne works whose country of origin is not the United States (see the Berne Convention Implementation Act of 1988, Pub. L. 100-568, 102 Stat. 2853 (1988)), as well as the serving of notice and a copy of the complaint.

[n.80]. 695 F.2d at 1181.

[n.81]. *Id.*

[n.82]. See e.g., 802 F.2d at 990, where the court said, "[t]he Register's decisions are subject to judicial review, but only on an abuse of discretion standard." In addition, the claimant, John Muller & Company, had in fact exhausted its administrative remedies prior to instituting an infringement suit against the New York Arrows Soccer Team. See also, *Gemveto Jewelry Co. v. Jeff Cooper, Inc.*, 568 F. Supp. 319 (S.D.N.Y. 1983) 219 U.S.P.Q. 806, vacated and remanded on other grounds 613 F. Supp. 1052 (S.D.N.Y. 1985), 227 U.S.P.Q. 623. *Gemveto I* presented the court with, among other issues, the registerability of a watch design by Gemveto within the context of an infringement suit. The *Gemveto* Court said that "the decision to register an article rests in the sound discretion of the Register of Copyrights, and the scope of judicial review is limited to whether the decision was 'arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.'" 568 F. Supp. at 329.

[n.83]. 888 F.2d at 887.

[n.84]. See e.g., H.R. Rep. 1476, 94th Cong. 2d Sess. 157 where the House Judiciary Committee report stated that the purpose of enacting § 411(a) was to "alter the present law as interpreted in *Vacheron*."

[n.85]. 696 F.2d 918.

[n.86]. See e.g., *supra* note 63.

[n.87]. *Id.* at 922.

[n.88]. See e.g., *supra* notes 35, 36.

[n.89]. *Durham Industries, Inc. v. Tomy Corp.* 630 F.2d 905, 908 (2d Cir. 1980).

[n.90]. Assuming there is infringing activity.

[n.91]. 16 U.S.P.Q.2d at 1227. In ruling against the claimant the court said, "[t]hat object [claimant's KOOSH ball] was carefully examined on three different occasions at different

levels in the Copyright Office. In each instance, the examiners concluded that there was insufficient creative authorship to merit copyright protection."

[n.92]. See e.g., Atari I and II, Homer Laughlin, and Oddzon Products.

\*147 Appendix A Diagram A: The Copyright Office Review and Appeals Process  
TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT  
DISPLAYABLE

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All sections refer to Title 17 of the United States Code.

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