

**In The  
Supreme Court of the United States**

—◆—  
REED ELSEVIER, INC., ET AL.,

*Petitioners,*

v.

IRVIN MUCHNICK, ET AL.,

*Respondents.*

—◆—  
**On Writ Of Certiorari To The  
United States Court Of Appeals  
For The Second Circuit**

—◆—  
**BRIEF OF COURT-APPOINTED AMICUS CURIAE  
IN SUPPORT OF THE JUDGMENT BELOW**

—◆—  
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**QUESTION PRESENTED**

Does 17 U.S.C. § 411(a) restrict the subject matter jurisdiction of the federal courts over copyright infringement actions?

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## INTEREST OF AMICUS CURIAE

This Court invited Deborah Jones Merritt to brief and argue the case as amicus curiae in support of the judgment below. 129 S. Ct. 1693 (Apr. 2, 2009). This brief responds to that invitation.<sup>1</sup>



## JURISDICTION

The district court had jurisdiction under 28 U.S.C. § 1331, 28 U.S.C. § 1338, and 17 U.S.C. § 411(a) to adjudicate copyright infringement claims based on (1) registered U.S. works; (2) U.S. works denied registration; and (3) works first published in foreign countries participating in the Berne Convention. The district court lacked jurisdiction over other infringement claims asserted by the class representatives.

28 U.S.C. § 1291 conferred jurisdiction on the court of appeals, and 28 U.S.C. § 1254(1) confers jurisdiction on this Court.



## STATEMENT OF THE CASE

This case is about boundaries: the borders that protect intellectual property; the limits of class-action

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<sup>1</sup> No counsel for a party authored any portion of this brief. The Ohio State University Moritz College of Law provided incidental financial support for preparing the brief.

representation; and, most important, the lines that mark the subject-matter jurisdiction of the lower federal courts.

1. During the 1980s, the database defendants (petitioners here) began marketing electronic versions of newspaper, magazine, and journal articles. The defendants purchased articles from periodical publishers, assembled the articles into electronic files, and sold access to libraries and other consumers. A group of freelance writers complained that these commercial databases overstepped the bounds of copyright law: The authors protested that neither the publishers nor database defendants obtained the writers' consent for the new uses of their works.

In 2000-01, two dozen writers filed the class actions yielding this consolidated suit. The class action plaintiffs, who appear here as the Pogrebin-respondents, described themselves as “published, professional authors who created literary works . . . for which the copyrights have been registered under United States law.” JA 82.<sup>2</sup> Their consolidated complaint repeatedly referred to registered copyrights, JA 81, 82, 85-86, 93-94, and attached a 66-page chart

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<sup>2</sup> A few of the plaintiffs alleged that they wrote works that were “protected by copyright in a nation of origin that is party to a copyright treaty to which the United States is a signatory.” *Id.* These foreign works support infringement suits without registration. 17 U.S.C. § 411(a). The bulk of the claims at issue in this case, however, rests on U.S. works as defined by 17 U.S.C. § 101.

listing registration numbers for the plaintiffs' works. JA 105.

Despite their distinct status as professional freelancers holding registered copyrights, the plaintiffs defined their class very broadly. They sought to represent "all persons who own a copyright in a literary work created and first published on or after January 1, 1978 and electronically reproduced, displayed, sold, and/or distributed by one or more of defendants . . . without the owners' permission on or after August 15, 1997." JA 94. This class included tens of thousands of writers who had never registered any copyrights.

2. The United States District Court for the Southern District of New York stayed the class action while this Court considered *New York Times Co. v. Tasini*, 533 U.S. 483 (2001). The *Tasini* decision confirmed the validity of the writers' core claim. Databases like the ones contested here, the Court ruled, are not revisions of collective works privileged by 17 U.S.C. § 201(c). The database defendants' reproduction of freelance works, therefore, required the freelancers' consent.

*Tasini* was not a class action, and the Court nowhere suggested that publishers and databases could remedy their ongoing infringements through a "court-enforceable global settlement." Pet. Br. 2. Indeed, as the petitioners observed in February 2002, "virtually no precedent for copyright infringement class actions" existed when *Tasini* was decided. App.



49a.<sup>3</sup> The Court, therefore, could not have “expressly contemplated” a class-action resolution of the defendants’ infringements. Pet. Br. 2.

Instead, *Tasini* noted numerous options for retaining freelance works in electronic databases. The publishing industry, the Court observed, could negotiate electronic access to copyrighted works through individual “agreement[s] allowing continued electronic reproduction of the Authors’ works.” 533 U.S. at 505. The Court also highlighted the usefulness of copyright registries and licensing schemes “for distributing copyrighted works and remunerating authors.” *Id.*

3. By the time the Court issued *Tasini*, publishers had already altered their contracts to accommodate electronic databases. During the mid 1990s, publishers began requiring all freelancers to assign electronic reproduction rights. App. 41a. According to the publishers, these changes greatly reduced potential infringement claims. By November 2001, for example, the *New York Daily News* possessed “secure electronic rights” for more than 99% of the articles it had posted in LexisNexis. App. 43a. Since many of the defendants’ electronic files focus on post-1990 articles, and few date back before 1980, these contractual changes narrowed the window of

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<sup>3</sup> For the Court’s convenience, this brief’s appendix reproduces excerpts from the parties’ lower-court submissions. These documents are cited as “App. \_\_\_\_.”

potential *Tasini* claims. *See, e.g.*, App. 7a-8a (Declaration of Robin Bierstedt, Deputy General Counsel of Time, Inc.).

The publishers, however, refused to seek licenses for the works falling within this window. Although these media companies regularly purchased freelance articles to enrich their publications, they kept few records of their content suppliers. Time, Inc., the nation's largest magazine publisher, told the district court that it maintained no "internal database or other electronic or paper list of freelance writers" for any of its widely distributed magazines. *Id.* at 7a. The companies kept so few records of their content suppliers that Time's Deputy General Counsel advised the district court that the company could not "distinguish a pizza deliverer from a freelance writer." *Id.* Because of these gaps in their own records, the publishers concluded that it would be an "insuperable task" to identify freelance authors and negotiate the licenses required by copyright law. Pet. Br. 4.

The publishers and database defendants also rejected copyright registries as a tool for reimbursing freelance writers. By 2001, the companies involved in this litigation relied heavily on registries to collect royalties on their own copyrighted material. The Copyright Clearance Center has gathered royalties since 1978 from universities, libraries, laboratories, and other organizations that reproduce copyrighted work. During the last fifteen years alone, CCC has channeled to publishers more than one billion dollars

of copyright fees from college students purchasing course packs, teachers creating electronic reserves, and other sources. Judith Rosen, *Copyright Clearance Center Piles Up the Numbers*, Publishers Weekly, May 18, 2009, at 11. As Elsevier Science and other publishers successfully argued in 1992, CCC's registry offers such a "convenient, reasonable licensing system" that it trumps fair-use defenses to infringement. *American Geophysical Union v. Texaco, Inc.*, 802 F. Supp. 1, 25 (S.D.N.Y. 1992), *aff'd*, 60 F.3d 913 (2d Cir. 1994).

Rather than adopt any of these remedies, the publishers and database defendants pursued years of "often heated" mediation with the class-action representatives. Pet. App. 7a.<sup>4</sup> While the parties attempted to resolve their dispute, the defendants dropped the contested articles from their databases. These removals had little impact. By 2001, consumers had little interest in freelance articles written between 1980 and 1995, and scholars had turned to other sources.<sup>5</sup> The databases maintained the same

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<sup>4</sup> Most of the publishers were not formal parties to the class action, but they participated in the mediation as members of an expanded "defense group." For the remainder of this brief, references to the "defendants" or "defense group" include both publishers and database companies.

<sup>5</sup> Scholars now rely upon a wide range of resources that reproduce original sources in their entirety. Users can page through these sources as they would hard copy; they can also conduct full-text searches. For examples of these sources, see HeinOnline, <http://heinonline.org/> (last visited Aug. 11, 2009) (law-related books and periodicals); Chronicling America,

(Continued on following page)

subscription fees, despite the deleted content, and subscribers did not complain. App. 41a-42a, 44a (Defendants' Joint Memorandum).

4. At the very start of mediation, more than seven years ago, the defendants asserted an impassable bar to litigating most of the class-action claims: Citing “[e]xtensive authority,” they advised the mediator that Section 411(a) imposes a jurisdictional limit that “precludes the certification of any class respecting works in which copyright has not been registered.” *Id.* at 47a. This jurisdictional line, the defendants asserted, “could hardly be clearer.” *Id.*

The defendants pressed the same jurisdictional boundary in discussions with the plaintiffs; they “made these arguments directly to class counsel, repeatedly, in every mediation session over three years.” App. 23a (Defense Group’s Response in the District Court); *see also* App. 37a (Declaration of Charles S. Sims). As the defendants later explained to the Second Circuit, this jurisdictional representation “was intended to, and did, play a key role in tempering plaintiffs’ expectations.” App. 56a (Second Circuit Brief for Defendants-Appellees).

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<http://chroniclingamerica.loc.gov/> (last visited Aug. 11, 2009) (Library of Congress database of historic newspapers). *Cf. Greenberg v. National Geographic Society*, 533 F.3d 1244 (11th Cir.) (en banc) (17 U.S.C. § 201(c) privileges reproductions of this type), *cert. denied*, 129 S. Ct. 727 (2008).

5. After negotiating under these constraints, the parties finally struck a deal. Their proposed settlement closely tracks the jurisdictional line urged by the defendants: The agreement includes both registered and unregistered works, but distinguishes sharply between them. Works registered before stipulated dates generate substantial payments as “Category A” or “Category B” claims. Unregistered works earn very low “Category C” payments.

The plaintiffs presented the settlement to the district court, urging that it represented “an exceptional result for the Class” precisely because of Section 411(a)’s barrier. App. 1a. “Generally,” the plaintiffs explained, “registration is a requirement for standing to bring infringement actions under the Copyright Act.” *Id.* at 1a-2a (citing 17 U.S.C. § 411). “[I]f forced to litigate the infringement claims in this proceeding,” plaintiffs continued, “absent class members could be found to lack standing and, as a result, would be unable to receive any legal redress for the copyright infringement on which these actions are based.” *Id.* at 2a.

6. Several class members, including a professor emeritus of Harvard Business School and a distinguished physicist, objected to the settlement. The objectors raised two principal concerns: (a) The settlement treated unregistered claimants unfairly, and (b) those claimants, who comprised most of the class, lacked an adequate representative.

To parry these objections, both the plaintiffs and defendants appealed to Section 411(a). The plaintiffs once again justified low payments for unregistered works by noting that those authors “lacked standing to bring an infringement action,” App. 14a, and “would have no available avenue for relief in the courts.” *Id.* at 20a. The plaintiffs also derided the objectors as “outlandish” for suggesting that a separate representative should have advocated for the unregistered authors. *Id.* at 19a. A separate representative was impossible, the plaintiffs scolded, because “no author *without* a registered work could have sued. *See* 17 U.S.C. § 411(a).” *Id.* (emphasis original).

The defendants even more aggressively trumpeted Section 411(a)’s jurisdictional bar to justify the settlement to the district court. “Because the Copyright Act confers jurisdiction only for claims concerning registered works and precludes any infringement action for an unregistered work,” the defendants reminded the court, “the Court would lack subject matter jurisdiction over any person whose ‘claims’ all involve unregistered works.” App. 26a (citing § 411(a)). The settlement’s “adequacy, fairness, and reasonableness,” they stressed, all rested on the fact that “a huge proportion of the claims were for works in which copyright had never been registered, and which were not, therefore, within the court’s subject matter jurisdiction.” *Id.* at 23a.

While boosting Section 411(a)’s jurisdictional barrier to defend the settlement, the parties buried

any concerns that the provision might limit the court's authority to enforce the agreement. Plaintiffs did not address the issue directly, although they observed in a different context that courts sometimes release "claims that could never have been sued upon." App. 17a n.10. The defendants relegated the jurisdictional conundrum to a footnote, equating Section 411(a)'s jurisdictional bar with non-jurisdictional issues that complicate litigation of class action claims. App. 24a-25a n.1. Quoting this Court's decision in *Amchem Products, Inc. v. Windsor*, 521 U.S. 591, 620 (1997), the defendants maintained that "when a class is certified for settlement purposes only, . . . 'a district court need not inquire whether the case, if tried, would present intractable management problems.'" *Id.*

The district court adopted the parties' proposed final order, approving the settlement without commenting on the jurisdictional issues. The court's final order broadly "reserves jurisdiction over the subject matter," requiring the court to resolve ongoing disputes over enforcement of this wide-ranging, hotly contested settlement. JA 156.

7. The objectors appealed, pressing their challenges to the low payments for unregistered works and the lack of representation for those authors. The plaintiffs and defendants responded once again by championing Section 411(a)'s jurisdictional bar. "[T]he Copyright Act confers jurisdiction over suits for infringement of United States works only if those works are registered," the defendants

declared to the Second Circuit. App. 61a. Under Section 411(a), they advised the court of appeals, “the district court would have lacked subject matter jurisdiction over any complaint for infringement of articles in U.S. newspapers and periodicals filed by a person whose ‘claims’ all involved unregistered works.” *Id.*

The plaintiffs concurred: “Unregistered works,” they counseled the Second Circuit, “arguably would not even confer standing to bring a lawsuit at all.” App. 69a. Defending the settlement’s fairness, the plaintiffs reminded the court that: “The vast majority of works at issue were never registered with the U.S. Copyright Office, and thus the authors of those works arguably lacked standing to sue for copyright infringement.” *Id.* at 68a.

After reading these representations, which invoked jurisdictional defects to justify the settlement’s process and outcome, the Second Circuit ordered the parties to submit letter briefs further addressing the jurisdictional issues they had raised. Pet. App. 46a. Informed by those letters, the initial briefs, and the parties’ oral argument, the Second Circuit endorsed the jurisdictional boundary that the defendants had pressed throughout five years of mediation and trial court proceedings: Congress limited the federal courts’ subject-matter jurisdiction in Section 411(a) of the Copyright Act. The majority, however, rejected the parties’ claim that the district court possessed power to settle controversies falling outside its subject-matter jurisdiction. The court



vacated the district court’s decision and remanded for proceedings consistent with its opinion. Pet. App. 28a.

Judge Walker dissented from the court’s jurisdictional ruling, but signaled a different flaw in the settlement. Judge Walker warned that the parties’ “failure to create a sub-class consisting of those members holding primarily [unregistered] claims, and separate representation for those members,” was “a serious problem” on the merits. *Id.* at 45a n.5 (Walker, J., dissenting). Thus, while the majority concluded that the parties exceeded the bounds of subject-matter jurisdiction, Judge Walker perceived that they likely transgressed the limits of class-action representation.

8. This Court granted certiorari, limiting review to whether Section 411(a) restricts subject-matter jurisdiction over copyright infringement actions. Abandoning their positions in the lower courts, the petitioners and Pogrebin-respondents now deny Section 411(a)’s jurisdictionality; the objectors (Muchnick-respondents) endorse that new position. Because all parties urge reversal of the Second Circuit’s decision, the Court invited this amicus to brief and argue the case in support of the judgment below.



## **SUMMARY OF ARGUMENT**

I. Congress drew an emphatic jurisdictional line in Section 411(a) of the Copyright Act. 17 U.S.C.

§ 411(a). The provision refers explicitly to “jurisdiction,” and it precisely defines the copyright infringement claims subject to federal adjudication. A companion section of the Act supports this limit by directing the district court’s attention to the jurisdictional fact of registration “[w]ithin one month after the filing” of any infringement action. *Id.* § 508(a).

For a full century, Congress, the courts, and copyright experts have viewed Section 411(a)’s registration requirement as an unwaivable constraint on federal jurisdiction. Overturning that “century’s worth of precedent,” *Bowles v. Russell*, 551 U.S. 205, 209 n.2 (2007), would defy congressional intent and undermine a complex statutory scheme.

Repudiating Section 411(a)’s jurisdictional status, moreover, would defeat “system-related goal[s],” *John R. Sand & Gravel Co. v. United States*, 128 S. Ct. 750, 753 (2008), at the heart of copyright law. Congress designed Section 411(a)’s jurisdictional bar to further free trade in copyrighted works; shield the courts from ill-defined infringement claims; protect defendants from frivolous suits penalizing expression; and maintain the world’s largest library.

Congress did not trust any of these public goals to the caprice of private litigants. It imposed an unwaivable mandate requiring authors of United States works to register their copyrights publicly before invoking federal judicial power to enforce their claims. Disregarding the boundary marked by

Congress would propel the Court “beyond the bounds of authorized judicial action” and upset “fundamental principles of separation of powers.” *Steel Co. v. Citizens for a Better Environment*, 523 U.S. 83, 94 (1998).

II. Even if the Court interprets Section 411(a) as a waivable condition, the petitioners and Pogrebin-respondents cannot purport to waive that mandate now. Those parties relied explicitly on Section 411(a)’s jurisdictional limits to justify their settlement before the lower courts. The settlement’s compensation schedule and procedural fairness both rest on Section 411(a)’s strict mandate. The parties cannot re-bake the cake they have already eaten.

III. The parties’ remaining arguments fall outside the Court’s limited grant of certiorari. None of them, moreover, remedy the jurisdictional flaw in this settlement. The parties confuse claims with controversies, and private releases with class action judgments. The federal courts lack power to extinguish controversies falling outside their subject-matter jurisdiction. The Second Circuit properly concluded that the district court lacked jurisdiction to enforce a settlement that the parties themselves knew exceeded the boundaries laid by Congress.



## ARGUMENT

### I. Section 411(a) Limits the Federal Courts' Subject-Matter Jurisdiction

Within broad constitutional constraints, Congress chooses the “classes of cases” appropriate for federal adjudication. *Kontrick v. Ryan*, 540 U.S. 443, 455 (2004). Once Congress has spoken, the federal courts “have no warrant to expand Congress’ jurisdictional grant ‘by judicial decree.’” *Empire Health Choice Assurance, Inc. v. McVeigh*, 547 U.S. 677, 696 (2006). Nor can litigants extend federal jurisdiction by commanding courts to decide controversies.

The Constitution trusts courts to enforce the jurisdictional lines that Congress draws. By defending those boundaries, the courts preserve the balance of powers and build respect for their authority. The United States courts have earned worldwide esteem because they vigilantly uphold “the central principle of a free society that courts have finite bounds of authority.” *U.S. Catholic Conference v. Abortion Rights Mobilization, Inc.*, 487 U.S. 72, 77 (1988).

This Court has developed three inquiries that help detect jurisdictional lines drawn by Congress. *First*, the Court examines the statutory language. Textual signs of a jurisdictional boundary include a statute that “speak[s] in jurisdictional terms,” *Arbaugh v. Y & H Corp.*, 546 U.S. 500, 514 (2006) (internal citation omitted); language defining discrete “classes of cases” for adjudication, *Kontrick*, 540 U.S.

at 455; and indications that the trial courts should determine threshold facts “on their own motion.” *Arbaugh*, 546 U.S. at 501.

*Second*, the Court weighs the history of the rule’s application. If the courts have consistently construed a statutory limit as jurisdictional and Congress has not disturbed that interpretation, the Court is more likely to regard the boundary as settled. *Bowles v. Russell*, 551 U.S. 205, 206, 209-10 (2007); *John R. Sand & Gravel Co. v. United States*, 128 S. Ct. 750, 756-57 (2008).

*Finally*, the Court inquires whether the boundary-setting language attempts to “achieve a broader system-related goal” rather than “case-specific interest[s].” *John R. Sand*, 128 S. Ct. at 753. Congress does not place systemic goals solely in the hands of litigants; it uses jurisdictional lines to assure that judges enforce those goals.

This nuanced jurisprudence belies the petitioners’ attempt to condense the Court’s jurisdictional rulings to a solitary “bright line.” Pet. Br. 18-23. Determinations of federal court power depend upon more than a single query.<sup>6</sup> All of the factors outlined above

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<sup>6</sup> In *Arbaugh*, the Court proposed a “bright line” to distinguish congressional restraints on subject-matter jurisdiction from “essential ingredients of a federal claim for relief.” 546 U.S. at 516, 503. But the *Arbaugh* line incorporates the Court’s other inquiries; *Arbaugh* asks whether Congress “rank[ed] a statutory limitation on coverage as jurisdictional,” *id.* at 516, not merely whether Congress used the word “jurisdiction.”

(Continued on following page)

demonstrate that Congress drew an indelible jurisdictional line in Section 411(a) of the Copyright Act.

**A. The Plain Language of Section 411(a)  
Restricts Subject-Matter Jurisdiction**

At the start of mediation, the petitioners claimed that Section 411(a)'s "language could hardly be clearer." App. 47a (Defendants' Joint Memorandum). They were correct: Congress's language forcefully commands that "no 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." 17 U.S.C. § 411(a). These words, as petitioners themselves argued in both lower courts, mean that Section 411(a) "confers jurisdiction only for claims concerning registered works and precludes any infringement action for an unregistered work." App. 26a (Defense Group's Response in the District Court); *see also* App. 61a (Second Circuit Brief for Defendants-Appellees).

Section 411(a) carries all of the statutory-language indicia that the Court has used to identify a

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*Arbaugh's* streamlined inquiry is most useful when courts must distinguish claim elements from jurisdictional limits. Here, all parties agree that registration is not an element of copyright; the question is whether an admitted prerequisite to judicial enforcement is an unwaivable jurisdictional constraint or a less restrictive, waivable limit.

jurisdictional constraint. Congress included an explicit reference to “jurisdiction” in Section 411(a), underscoring the provision’s jurisdictional nature. The section also distinguishes carefully between the “classes of cases” suitable for federal adjudication and those that are not. Finally, a companion provision of the Copyright Act directs the district court to ascertain registration “[w]ithin one month after the filing” of an infringement action. 17 U.S.C. § 508(a).

1. *Section 411(a) Expressly Refers to “Jurisdiction.”* Section 411(a) explicitly uses the word “jurisdiction” to describe the section’s scope, declaring: “[T]he Register’s failure to become a party shall not deprive the court of jurisdiction.” The parties want the Court to ignore this key word, scoffing that it appears in Section 411(a)’s “last sentence.” Pet. Br. 19; Pogrebin-Resp. Br. 12 n.9. But Section 411(a) is a concise provision of 166 words. Congress’s use of the word “jurisdiction” in that terse statutory section offers powerful evidence that Congress understood registration as a jurisdictional requirement. The judicial precedents prompting inclusion of this word “jurisdiction” further confirm Congress’s intent.

As all parties recognize, Section 411(a) derives from the 1909 Copyright Act. That Act barred suits for copyright infringement of unregistered works, using language very similar to today’s statute: “No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of

this Act with respect to the deposit of copies and registration of such work shall have been complied with.” Pub. L. No. 60-349, § 12, 35 Stat. 1075, 1078 (1909).

The federal courts understood that this language limited their subject-matter jurisdiction. “A prohibition so broad as this,” Judge Lacombe wrote just three years after the statute’s enactment, “goes to the jurisdiction of the courts to entertain such action or proceedings.” *New York Times Co. v. Star Co.*, 195 F. 110, 112 (C.C.S.D.N.Y. 1912). Congress, he noted, “had full power to restrict in any way it chose the maintaining of [copyright infringement] actions.” *Id.* The plaintiff in *Star* had not satisfied the conditions mandated by Congress, so “the court could not have jurisdiction.” *Id.*

The Second Circuit approved Judge Lacombe’s interpretation the following year. *New York Times Co. v. Sun Printing & Publishing Ass’n*, 204 F. 586, 588 (2d Cir. 1913) (“The questions involved are carefully discussed by Judge Lacombe in *New York Times v. Star Co.* and we agree with what is there said . . . .”) (citation omitted). And in 1921, the court of appeals acknowledged the absolute, unwaivable nature of the 1909 registration requirement. Affirming District Judge Learned Hand’s dismissal of a copyright claim for lack of proper registration, the court of appeals declared: “The parties cannot by agreement, expressed or implied, alter the statute” requiring registration. *Lumiere v. Pathé Exchange, Inc.*, 275 F. 428, 430 (2d Cir. 1921).



These rulings, which recognized the registration and deposit requirements as a complete bar to adjudication, culminated with the Second Circuit's decision in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 640-41 (2d Cir. 1958). *Vacheron* construed the 1909 Act to bar infringement suits by claimants who had applied for copyright registration but had been denied that registration. The result followed logically from the statute's language: Unsuccessful applicants had not secured registration so they were ineligible to maintain suits for copyright infringement. But the ruling burdened these claimants unduly by requiring them to sue the Register for mandamus before pursuing an infringement claim.

When Congress recast the copyright laws in 1976, it preserved the 1909 Act's strict registration requirement. Courts had construed that mandate as jurisdictional and unwaivable for more than sixty years, and Congress did nothing to disturb that understanding. On the contrary, Congress patterned Section 411(a)'s language on the older statute, declaring that 411(a) "restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted." H.R. Rep. No. 94-1476, at 157 (1976).

At the same time, Congress decided to relieve the burden that the 1909 Act had imposed on unsuccessful registration applicants. To alter the outcome of *Vacheron*, Congress added two new sentences to Section 411(a). These sentences (1) authorize claimants

who have been denied registration to file infringement claims, and (2) allow the Register to join the action to contest registrability. The two sentences conclude by specifying that the Register's failure to join the action does not "deprive the court of jurisdiction" to determine registrability. 17 U.S.C. § 411(a).

Congress's choice of the word "jurisdiction" for this final phrase of Section 411(a) confirms that Congress viewed the *whole* provision as jurisdictional. Congress added a new phrase to Section 411(a) in the wake of judicial decisions construing the section's predecessor as a limit on "the jurisdiction of the courts" that "the parties cannot by agreement, expressed or implied, alter." *Star Co.*, 195 F. at 112; *Lumiere*, 275 F. at 430. Intending to maintain that requirement, with a minor adjustment for unsuccessful registration applicants, Congress naturally chose the word "jurisdiction" to describe the modification.

If Congress believed that Section 411(a) created a waivable condition, as the parties argue, it would have concluded Section 411(a) with the words: "but the Register's appearance is not a condition of the court determining registrability." Instead, by adding the word "jurisdiction" to a terse statutory section that courts had already construed as jurisdictional, Congress confirmed that section's jurisdictional reach.

2. *Section 411(a) Creates Classes of Cases.* In addition to using the word "jurisdiction," Congress structured Section 411(a) to "delineat[e] the classes of

cases” appropriate for federal adjudication. *Kontrick*, 540 U.S. at 455. The first sentence of Section 411(a) crisply divides civil copyright infringement claims into two categories: (1) claims based on a “United States work” that has not completed Copyright Office review, and (2) all other claims. Creations in the first category fall outside the court’s jurisdiction; those in the second category lie within.

Congress specified these jurisdictional distinctions with care. Section 411(a) enforces a simple, but critical, bargain between Congress and authors who claim their work’s initial copyright under United States law: Those authors may use United States courts to enforce their claims only if they first comply with the United States registration system.

The “exceptions” noted by the parties merely elaborate this principle. Congress, for example, concluded that registration of domestic works is more necessary than tracking foreign material; it accommodated the international Berne Convention by excluding foreign works from Section 411(a) in 1988. *See* Point I.B.5 *infra*. Similarly, Congress determined that the policies supporting Section 411(a)’s jurisdictional bar do not limit criminal prosecutions. *Id.* And, as explained above, Congress designed a special litigation path for works that have been denied registration; that mechanism promotes judicial efficiency while preserving the underlying jurisdictional bargain.

Congress frequently calibrates jurisdictional statutes this way. Before 1980, for example, Congress enacted dozens of exceptions to the amount-in-controversy requirement that once restricted federal-question jurisdiction. *See* Charles Alan Wright, *Handbook of the Law of Federal Courts* § 32 (3d ed. 1976). More recently, Congress adopted a potpourri of complex rules governing diversity jurisdiction in interstate class actions. 28 U.S.C. § 1332(d). These exceptions did not destroy either statute’s jurisdictional nature; on the contrary, they demonstrate Congress’s care when setting jurisdictional limits. Section 411(a), similarly, draws precise lines that reveal Congress’s attentiveness to jurisdictional boundaries.

Section 411(a), finally, falls comfortably within a group of statutes that tie jurisdiction to the parties’ actions. Courts don’t create lawsuits, litigants do. As a result, some jurisdictional statutes define jurisdiction by referring to the parties’ conduct. The Code of Judicial Procedure, for example, limits federal appellate jurisdiction by providing: “no appeal shall bring any judgment, order or decree in an action, suit or proceeding of a civil nature before a court of appeals for review unless notice of appeal is filed, within thirty days after the entry of such judgment, order or decree.” 28 U.S.C. § 2107(a). This Court has repeatedly recognized that language, centered on a party’s action, as jurisdictional. *United States ex rel. Eisenstein v. City of New York*, 129 S. Ct. 2230 (2009); *Bowles*, 551 U.S. at 214. Section 411(a), analogously, defines jurisdiction by declaring that “no civil action

... shall be instituted until” after registration. This phrase succinctly conveys the jurisdictional boundary that Congress intended.<sup>7</sup>

3. *The Copyright Act Directs Courts To Assure That the Registration Requirement Is Met.* A statutory provision that directs courts “on their own motion, to assure that [a threshold] requirement is met” offers particularly strong evidence of a jurisdictional limit. *Arbaugh*, 546 U.S. at 514. Section 508 of the Copyright Act does just that: It instructs district courts “[w]ithin one month after the filing of any action under this title,” to “send written notification to the Register of Copyrights setting forth . . . the names and addresses of the parties and the title, author, and *registration number* of each work involved in the

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<sup>7</sup> The parties’ proposed rule, that jurisdictional statutes must address courts directly, could upset a wide range of statutory schemes. The Anti-Terrorism Act, for example, withdraws the courts’ jurisdiction to compensate terrorism victims when their injuries stem from an act of war. Congress established that essential boundary with the simple words: “No action shall be maintained . . . for injury or loss by reason of an act of war.” 18 U.S.C. § 2336(a). Although those words focus on the parties’ conduct, Congress undoubtedly intended courts to enforce this constraint rigorously and *sua sponte*. Otherwise, the litigation strategies of private litigants could escalate wartime hostilities. *Cf. Morris v. Khadr*, 415 F. Supp. 2d 1323 (D. Utah 2006) (examining act-of-war limit on jurisdiction *sua sponte*).

Notably, the jurisdictional limit on terrorism-related claims fails to reference Congress’s grant of federal question jurisdiction in 28 U.S.C. § 1331. Courts, however, have readily construed the provision as a jurisdictional limit. *E.g., Morris*, 415 F. Supp. at 1330-34.

action.” 17 U.S.C. § 508(a) (emphasis added). District courts must update these notices by advising the Register of any new works – and their registration numbers – added to the action. *Id.* The courts use Form AO 121, reproduced as Appendix B, to transmit this information to the Copyright Office.

Section 508 serves two related purposes. First, the section “establish[es] a method for notifying the Copyright Office and the public of the filing and disposition of copyright cases.” H.R. Rep. No. 94-1476, at 164 (1976). Just as local courthouses record claims related to real property, the Copyright Register notes litigation affecting copyrights. Second, the section confirms Congress’s intent to limit infringement suits to claims based on registered works. By requiring courts to transmit registration numbers promptly to the Copyright Office, Section 508 assures attention to Section 411(a)’s jurisdictional limit.

Some courts have incorporated Section 508 into their local rules, requiring copyright plaintiffs to complete Form AO 121. *See* E.D. Tex. R. CV-4(a); W.D. Wash. Civ. R. 3(a). Other courts include a similar direction on the civil cover sheet completed by all plaintiffs. *See, e.g.,* D. Mass. R. Appendix C. These processes, implementing Section 508’s notification requirement, allow courts to identify jurisdictionally deficient infringement claims at the outset of

litigation.<sup>8</sup> The provision thus supports the jurisdictional scheme Congress enacted in Section 411(a): Infringement claimants must complete Copyright Office examination before proceeding to court.

**B. Courts, Legislators, and Scholars Have Consistently Construed Section 411(a) as Jurisdictional**

Precedent carries special weight when interpreting a congressional check on the courts' own power. If the courts have long recognized a boundary as jurisdictional, and if Congress has never disturbed that understanding, then Congress should initiate any change in the settled view. Under these circumstances, deference to established practice honors the principle that "[o]nly Congress may determine a lower federal court's subject-matter jurisdiction." *Kontrick*, 540 U.S. at 452.

In this case, denying 411(a)'s jurisdictional status would "require the repudiation of a century's worth of precedent and practice in American courts." *Bowles*, 551 U.S. at 209 n.2. Since 1909, judges, legislators, and copyright experts have consistently construed Section 411(a) and its predecessor as jurisdictional. Congress, moreover, has repeatedly

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<sup>8</sup> As with other jurisdictional limits, the courts may accept the plaintiff's unchallenged allegations. Section 508(a) directs the court to transmit registration numbers and other information "as far as is shown by the papers filed in the court."

acceded to that unbroken history. During the last twenty-one years alone, Congress revisited Section 411(a) five times. None of those deliberations overturned – or even questioned – the courts’ ongoing construction of Section 411(a) as jurisdictional. On the contrary, Congress has modified Section 411(a) in ways that confirm its jurisdictional character.

1. *The 1790 Copyright Bargain.* Section 411(a)’s registration requirement stems from a key bargain underlying U.S. copyright law. Our copyright system rewards the creation of original works to “promote the progress of science and useful arts.” U.S. Const. art. I, § 8. Fulfillment of this constitutional goal requires public identification of copyright holders. If consumers cannot identify a work’s owner, they cannot obtain permission to reproduce and disseminate the work. Under those circumstances, copyright inhibits free trade in artistic, literary, and scientific ideas.

To address this problem, the first Congress created the copyright registration system that endures today. The registry allows members of the public to identify copyright holders, purchase licenses, and distribute the copyrighted works. Federal copyright law promotes free trade in intellectual property by exacting a price for federal copyright protection: Congress allows authors to enforce their rights in court only if they are willing to advance the public good by registering their copyrights.



The 1790 Copyright Act captured this bargain in the statutory language itself: “[N]o person shall be *entitled to the benefit* of this act . . . *unless* he shall before publication deposit a printed copy of the [work] in the clerk’s office. . . . And the clerk . . . is hereby directed and required to record the same forthwith.” Copyright Act of 1790, § 3, 1 Stat. 124, 125 (1790) (emphasis added).<sup>9</sup> The nineteenth-century courts viewed these registration and deposit requirements as absolute prerequisites to federal copyright. Unless an author complied meticulously with these conditions, no federal copyright existed and the author had no claim to enforce. The courts did not adjudicate infringement claims based on the federal Copyright Act unless the author proved both deposit and registration.

Courts monitored these conditions with special strictness, because Congress exercised limited power during the nineteenth century. Authors during that era could still claim common-law copyrights under state law, and courts guarded state power jealously. The federal courts, therefore, demanded punctilious compliance with the conditions set by Congress. No court allowed a litigant to waive the registration and deposit elements; nor did any commentator suggest

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<sup>9</sup> The 1790 Act required authors to register their copyrights with local district courts. *See* 1 William F. Patry, Patry on Copyright § 1:19 (2009). Congress centralized registration in the Library of Congress in 1870, *id.* § 1:33, and authorized a Register of Copyrights in 1897. *Id.* § 1:41.

that these elements were optional. See 5 William F. Patry, *Patry on Copyright* § 17:64, at 17-194 (2009).

The Supreme Court confirmed this view in *Wheaton v. Peters*, 33 U.S. 591 (1834). Registration and deposit, the Court concluded, “form a part of the [federal copyright] title, and until they are performed, the title is not perfect.” *Id.* at 665. The Court rejected analogies to “[t]he rule by which conditions precedent and subsequent are construed, in a grant.” *Id.* Instead, “every requisite, in both acts [of Congress establishing copyright], is essential to the title.” *Id.* Plaintiff Wheaton thus could claim a federal copyright only if he had satisfied all of Congress’s registration and deposit requirements. If any gap existed in that chain, then Wheaton’s only claim rested on state common law. And without diversity of citizenship, which Wheaton’s suit lacked, the federal court lacked jurisdiction to hear the state claim.

As petitioners note, the Court remanded Wheaton’s federal copyright claim for a jury to determine whether Wheaton had complied with Congress’s deposit requirements. *Id.* at 667. Jury determination was proper because deposit and registration were still – in 1834 – essential to establish the plaintiff’s claim. The key point, however, is that Congress and the Court viewed these elements as imperative. *Wheaton* does not suggest that any party could waive an opponent’s failure to register or that a court could ignore this defect; nor does any other case suggest that possibility. Before 1909, Congress and the courts viewed registration as an absolute,

unwaivable prerequisite for establishing a property right enforceable under federal law.

2. *The 1909 Copyright Act.* As the nation's creative output increased, Congress recognized a flaw in its copyright system: Since registration and deposit were essential to create copyright, and since federal law required authors to complete those acts within prescribed time periods, authors could irretrievably forfeit valuable rights through minor missteps. Congress observed that “[t]he failure of a shipping clerk to see that the copies go promptly forward to Washington may destroy a copyright of great value, and many copyrights have been lost because by some accident or mistake this requirement was not complied with.” H.R. Rep. No. 60-2222, at 11 (1909).

Congress's solution was to change deposit and registration from claim elements to jurisdictional prerequisites. Congress still vigorously supported the public purposes of registration, and it wanted to maintain the fundamental copyright bargain: Copyright holders could not enforce their claims in court unless they provided the public benefits of registration and deposit. But by making the latter requirements jurisdictional, Congress allowed copyright holders to satisfy these conditions any time before filing suit; authors would not lose all rights through minor lapses.<sup>10</sup>

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<sup>10</sup> Contrary to the parties' claims, conditions that can be satisfied any time before suit characterize many jurisdictional  
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The 1909 Act thus continued the steadfast line that Congress and the courts had drawn for more than a century: Parties could sue for infringement of a federal copyright only after registering and depositing their works. Congress preserved this statutory boundary by declaring simply: “No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with.” § 12, 35 Stat. at 1078.

As discussed above, judges quickly recognized the jurisdictional nature of this language. In 1912, a leading trial judge acknowledged that the prohibition against any “action or proceedings” without registration “goes to the jurisdiction of the courts.” *Star Co.*, 195 F. at 112; Point I.A.1 *supra*. By 1917, the point was so well established that *Corpus Juris* concluded: “[R]egistration and deposit of copies is a condition precedent to any right of action for infringement. This requirement is jurisdictional.” 13

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limits. Diversity of citizenship, for example, usually depends on the parties’ citizenship when the complaint is filed – not when the cause of action arose. Erwin Chemerinsky, *Federal Jurisdiction* § 5.3, at 301 (4th ed. 2003). Conditions affecting a claim element, on the other hand, typically depend on facts at the time the claim arose. The employee numerosity requirement disputed in *Arbaugh*, for example, depended on the employer’s size at the time of the alleged discrimination. *Arbaugh v. Y & H Corp.*, 380 F.3d 219, 222, 225 (5th Cir. 2004), *rev’d*, 546 U.S. 500 (2006).

Corpus Juris *Copyright and Literary Property* § 380, at 1191 (1917).

Copyright experts sounded the same theme. Herbert Howell's treatise warned copyright holders of registration's "utmost importance" and described cases in which "the court refused to entertain jurisdiction in the absence of a certificate of registration of the published work." Herbert A. Howell, *The Copyright Law* 82, 84 (1942). Howell's index, similarly, showed a heading for "Jurisdiction of Courts in Copyright Causes" with the subheading "deposit and registration necessary to confer." *Id.* at 274. Horace Ball's treatise agreed that the 1909 Act's prohibition against maintaining a suit based on unregistered works "goes to the jurisdiction of the court and clearly bars the plaintiff . . . from procuring any relief." Horace G. Ball, *Law of Copyright and Literary Property* 190 (1944).

In *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939), this Court affirmed the uniform view that registration and deposit were essential to support a federal action for infringement under the 1909 Act. The defendant in *Pearson* argued that another sentence in the Act, which required copyright claimants to deposit their works "promptly" after publication, modified the "no action" language that courts had interpreted as jurisdictional. The Court refused to elevate the word "promptly" to jurisdictional status, but confirmed the consistent understanding of lower courts and commentators that "no action can be maintained before copies are actually

deposited.” *Id.* at 42. Notably, the Court concluded its *Pearson* opinion by observing that its result was “in accord with . . . the conclusions reached in *Lumiere v. Pathé Exchange*.” *Id.* *Lumiere* was the widely cited opinion in which the Second Circuit held that “[t]he parties cannot by agreement, expressed or implied, alter” the requirement of registration as a condition of federal adjudication. 275 F. at 430; Point I.A.1 *supra*.

After *Pearson*, courts continued to dismiss infringement claims for lack of jurisdiction when the plaintiff had failed to register. In 1942, for example, Judge Rifkind dismissed a claim “for lack of jurisdiction” because the plaintiff had neglected to register the work. *Rudolph Lesch Fine Arts v. Metal*, 51 F. Supp. 69, 71 (S.D.N.Y. 1942). A judicial colleague reached the same result in 1966, citing well-established precedent that “[t]he proscription against the maintenance of actions [without registration] ‘goes to the jurisdiction of the courts to entertain such action or proceedings.’” *G.P. Putnam’s Sons v. Lancer Books, Inc.*, 251 F. Supp. 210, 214 (S.D.N.Y. 1966) (quoting *Star Co.*, 195 F. at 112). And in *Frederick Fell Publishers, Inc. v. Lorayne*, the court required the plaintiff to plead registration, even though the defendant had registered the work before licensing it to the plaintiff. 422 F. Supp. 808, 811 (S.D.N.Y. 1976). Although pleading registration would be “a mere technicality under the circumstances,” the court concluded, “such recitation is jurisdictionally required.” *Id.*

Perhaps most notable, the district court ruling reviewed in *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1108 (9th Cir. 1970), rebuffed an infringement claim for both “lack of jurisdiction and lack of . . . copyrightable material” *after* trial. Although the court had devoted substantial resources to the trial, it found that the plaintiff had failed to complete registration before filing its complaint. *Id.* The Ninth Circuit disagreed with the trial court’s conclusion on the facts, but the appellate court agreed that registration was a jurisdictional requirement; it addressed that jurisdictional issue before reviewing the district court’s alternative dismissal on the merits of copyrightability. *Id.* at 1108-09.

From 1909 through 1976, therefore, courts consistently recognized registration as a jurisdictional prerequisite for any infringement claim based on federal law. Melville Nimmer summarized this jurisprudence in 1976 by stressing that registration was an *unwaivable* element of any infringement claim founded on federal law: “Failure to offer a registration certificate in an infringement action is clearly fatal to the plaintiff’s claim. . . . Moreover, the parties do not have the power to vary by agreement the requirement of a registration certificate as a condition precedent to maintaining an action or proceeding.” 1 Melville B. Nimmer, *Nimmer on Copyright* § 92.1, at 345-46 (1976). The petitioners quote the first part of this statement, Pet. Br. 30, but omit the final sentence. That sentence flatly contradicts the petitioners’ assertion that courts, commentators,

and members of Congress believed in 1976 that the registration requirement was waivable.

3. *The 1976 Copyright Act.* Congress drafted the 1976 Copyright Act against the backdrop outlined above: Courts had consistently construed the 1909 Act's registration requirement as jurisdictional; no court had ever allowed a litigant to waive registration; and experts uniformly recognized registration as an unwaivable condition of federal adjudication. The registration requirement had served the public purposes of copyright law for almost two centuries.

In light of this history, the Copyright Office recommended that Congress preserve registration as an unwaivable prerequisite for infringement suits. Congress readily agreed. Section 411(a) "restates the [1909] statutory requirement that registration must be made before a suit for copyright infringement is instituted." H.R. Rep. 94-1476, at 157 (1976). That statutory requirement, as the experts who drafted the 1976 Act well knew, had been repeatedly construed as jurisdictional.

Courts immediately recognized that Section 411(a) continued registration as an unwaivable, jurisdictional requirement. In one of the earliest cases decided under the 1976 Act, the defendant questioned the plaintiff's registration after trial. The court unhesitatingly addressed this challenge to its subject-matter jurisdiction. "That an infringement suit may not be instituted until the plaintiff registers its copyright," the court declared, "is axiomatic." *Pillsbury*



*Co. v. Milky Way Productions*, 215 U.S.P.Q. 124, 127 (N.D. Ga. 1981). The court cited both 411(a) and its 1909 predecessor for this proposition, acknowledging the statutory continuity. *Id.* Only after finding that the plaintiff had properly registered its work did the court conclude that it had “subject matter jurisdiction over the plaintiff’s claim.” *Id.* at 128.

In two other early cases, the Department of Justice asserted the jurisdictionality of Section 411(a), and courts readily endorsed that view. In *Proulx v. Hennepin Technical Centers District No. 287*, the plaintiff served the Copyright Register with a copy of his infringement complaint, and the Department of Justice moved on behalf of the Register to dismiss the entire action for lack of subject-matter jurisdiction. Civ. No. 4-79-637, 1981 U.S. Dist. LEXIS 17634, at \*2, \*9 (Dec. 7, 1981) (magistrate recommendation), *enforced*, 1981 U.S. Dist. LEXIS 17575 (D. Minn. Dec. 30, 1981). The court enforced the magistrate’s conclusion that: “It is settled that the requirements of § 411 are jurisdictional and unless these prerequisites have been met a federal court cannot hear a copyright infringement claim.” *Id.* at \*10.

Similarly, in *International Trade Management, Inc. v. United States*, the Department of Justice moved to dismiss a copyright infringement action filed against the Small Business Administration. 553 F. Supp. 402 (Cl. Ct. 1982). The plaintiffs in *International Trade* had applied to register their copyright, but their application was still pending. The Claims

Court granted the government's motion to dismiss, noting both the clarity of Section 411(a) and its continuity with earlier law. *Id.* at 403 ("the language is clear"). Chief Judge Kozinski recognized the possible inefficiency of this result, because the plaintiffs could refile their claim after registering, but concluded: "Considerations of judicial economy . . . carry little weight where jurisdiction is in issue. The court cannot assert jurisdiction over a matter simply because it considers Congress' decision to withhold jurisdiction to be unwise or uneconomical." *Id.*

Immediately after enactment of the 1976 Copyright Act, therefore, the Copyright Office, Department of Justice, and federal courts unreservedly viewed Section 411(a) as an absolute jurisdictional limit. Copyright experts expressed the same understanding. In 1977, the *UCLA Law Review* gathered the nation's experts to preview the new Copyright Act. The professionals who assessed Section 408 (governing registration) and Section 411(a) noted: "Upon complying with these formalities and satisfying the Copyright Office that the work is copyrightable subject matter, the applicant is entitled to assert the jurisdiction of the federal courts to enforce a copyright." Arthur J. Levine & Jeffrey L. Squires, *Notice, Deposit and Registration: The Importance of Being Formal*, 24 *UCLA L. Rev.* 1232, 1261 (1977). Moreover, these authors concluded, "the effect of section 411 of the Act is unequivocal: An author cannot bring suit against an infringer until he has registered copyright . . ." *Id.* at 1262.

4. *Ongoing Judicial Interpretation of Section 411(a)*. Since Section 411(a) took effect on January 1, 1978, scores of judicial opinions have explicitly construed the provision as jurisdictional. Those opinions span every federal circuit and include rulings by most courts of appeals. Appendix C demonstrates this remarkable consistency by listing more than 200 opinions in which federal judges have expressly recognized Section 411(a) as jurisdictional.

The petitioners and Pogrebin-respondents display surprising disdain for the judges who wrote these opinions, denigrating their work as “drive-by jurisdictional rulings” that lack “rigor.” Pet. Br. 3, 17, 40; Pogrebin-Resp. Br. 15. These parties particularly disparage the reasoning of Second Circuit Judges Straub and Winter, who issued the opinion below. Petitioners claim that the analysis of these distinguished judges “resembles Gertrude Stein’s Oakland: There’s no there there.” Pet. Br. 41. But the petitioners themselves told the Second Circuit that “the Copyright Act confers jurisdiction over suits for infringement of United States works only if those works are registered,” App. 61a, and they cited the same precedent that Judges Straub and Winter invoked in their opinion. *Compare id.* (citing *Morris v. Business Concepts, Inc.*, 259 F.3d 65 (2d Cir. 2001), *modified*, 283 F.3d 502 (2d Cir. 2002)) *with* Pet. App. 12a (same).

The petitioners’ mockery is a smokescreen. As the parties know from their lower-court representations, the federal courts have developed an extensive,

careful jurisprudence detailing Section 411(a)'s jurisdictional constraints. Courts have probed Section 411(a)'s plain language, legislative purpose, and history for more than a quarter century. The courts have also relied upon an unbroken line of precedent, stretching back to Judge Lacombe's 1912 recognition that Section 411(a)'s predecessor spoke "to the jurisdiction of the courts." *Star Co.*, 195 F. at 112. Hundreds of federal judges have parked on Section 411(a) and visited at length; they have hardly "driven by."<sup>11</sup>

Furthermore, at least nine different courts have dismissed copyright infringement claims *sua sponte* for failure to comply with Section 411(a)'s registration requirement. In *Jennette v. United States*, for example, the Court of Federal Claims concluded that it was "unnecessary to await a response from defendant United States" because "[t]he provisions of 17 U.S.C. § 411(a) are jurisdictional" and the plaintiff had "proffered no evidence of copyright registration nor the denial of copyright registration." 77 Fed. Cl. 132, 133, 137 (2007). The court dismissed the complaint for lack of subject-matter jurisdiction, saving the government the burden of responding.

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<sup>11</sup> For just a few examples of recent opinions that extensively explore the jurisdictional bounds of Section 411(a), see *Torres-Negrón v. J&N Records, LLC*, 504 F.3d 151, 156-65 (1st Cir. 2007); *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1198-1208 (10th Cir. 2005); *Mays & Associates, Inc. v. Euler*, 370 F. Supp. 2d 362, 365-71 (D. Md. 2005); *Dielsi v. Falk*, 916 F. Supp. 985, 993-95 (C.D. Cal. 1996).

Similarly, in *Derminer v. Kramer*, the district judge observed that “[a]lthough the parties do not raise the subject matter jurisdiction issues directly, I have a responsibility to do so.” 386 F. Supp. 2d 905, 909 (E.D. Mich. 2005). The court then discussed at length its obligation to resolve subject matter jurisdiction before standing, *id.* at 909 & n.7; the proper role of affidavits to evaluate disputed jurisdictional facts, *id.* at 910; and whether a registration application suffices to confer jurisdiction under Section 411(a), *id.* at 910-11. The *Derminer* court, therefore, both noted the plaintiff’s lack of registration on its own motion and wrestled with three separate facets of that jurisdictional problem before concluding that Section 411(a) “explicitly limited” the court’s “subject matter jurisdiction over copyright infringement claims.” *Id.* at 910.<sup>12</sup>

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<sup>12</sup> For additional examples of *sua sponte* rulings based on Section 411(a), see *Goffe v. Winfrey*, Civ. Action No. 09-1438, 2009 U.S. Dist. LEXIS 66863 (D.D.C. July 31, 2009); *Goffe v. Winfrey*, No. 08 Civ. 8653, 2008 WL 4787515 (S.D.N.Y. Oct. 31, 2008); *Ogindo v. DeFleur*, No. 07-CV-1332, 2008 WL 5105153 (N.D.N.Y. Oct. 16, 2008); *Lucky Break Wishbone Corp. v. Sears, Roebuck & Co.*, No. C06-312Z, 2007 WL 4561124 (W.D. Wash. Dec. 18, 2007); *Kettenburg v. University of Louisville*, No. CIV 3:05CV384R, 2005 WL 4444100 (W.D. Ky. Nov. 7, 2005); *Marshall & Swift v. BS & A Software*, 871 F. Supp. 952, 958 (W.D. Mich. 1994); *Dodd v. Fort Smith Special School District No. 100*, 666 F. Supp. 1278, 1282 (W.D. Ark. 1987).

As the petitioners note, the Eleventh Circuit has also invoked 411(a) *sua sponte* to vacate a declaratory judgment involving ownership of an unregistered work. *Weitzman v. Microcomputer Resources, Inc.*, 542 F.3d 859 (11th Cir. 2008).

(Continued on following page)

Among the hundreds of federal opinions discussing Section 411(a), only two unpublished district court opinions directly suggest that the section lacks jurisdictional force.<sup>13</sup> Neither has influenced other courts. The Seventh Circuit recently reserved judgment on the jurisdictionality of Section 411(a) in dictum, noting this Court’s grant of certiorari on the issue. *Brooks-Ngwenya v. Indianapolis Public Schools*, 564 F.3d 804, 806 (7th Cir. 2009) (per curiam).<sup>14</sup> But other courts have continued to enforce the section’s jurisdictional constraints, including a recent decision that spared Oprah Winfrey harassment by dismissing an infringement claim *sua sponte* for lack of registration. *Goffe v. Winfrey*, Civ. Action No. 09-1438, 2009 U.S. Dist. LEXIS 66863 (D.D.C. July 31, 2009).

The parties do not cite a single case – from the entire 219-year span of copyright law – in which a court has allowed litigants to waive the registration requirement. The parties’ plea for waiver, spun from

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The court erroneously applied 411(a) in that case, because the jurisdictional limit applies only to infringement actions – not to declarations of ownership. 5 Patry § 17:49.50. Enforcing Section 411(a)’s jurisdictional constraint in infringement suits need not produce the “unpalatable result” in *Weitzman*. Pet. Br. 43.

<sup>13</sup> *Nova Design Build, Inc. v. Grace Hotels, LLC*, No. 08 C 2855, 2008 WL 4450305 (N.D. Ill. Sept. 30, 2008); *Batesville Services, Inc. v. Funeral Depot, Inc.*, No. 1:02-cv-01011, 2004 U.S. Dist. LEXIS 24336 (S.D. Ind. Nov. 10, 2004).

<sup>14</sup> The court in *Brooks-Ngwenya* suggested that a minor aspect of 411(a), notification of the Register, is not jurisdictional – although even that point proved “academic” in the case before it. 564 F.3d at 808.

illusory threads, would unwind more than two centuries of judicial precedent.

5. *Recent Congressional Action.* In the face of myriad judicial opinions construing Section 411(a) as jurisdictional, Congress has remained silent: It has never challenged the courts' consistent application of this unwaivable barrier. Congress, moreover, has revisited Section 411(a) at least five times since 1976 without disputing the provision's jurisdictional character. On the contrary, Congress's actions have repeatedly confirmed that it intended Section 411(a) to constrain the federal courts' jurisdiction over copyright infringement claims.

In 1988, while fitting domestic copyright law to the international Berne Convention, Congress addressed Section 411(a) at length. The Senate worried that applying Section 411(a) to foreign works would violate the Convention; in response, Congress excepted those works from the registration requirement. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853. Tellingly, however, no participant in this extensive debate questioned 411(a)'s absolute, unwaivable nature. Congress resoundingly reaffirmed its commitment to Section 411(a)'s jurisdictional limit for domestic works: It maintained that restriction without noting any disagreement with the courts' ongoing construction of the section as jurisdictional.

Congress revisited Section 411(a) in 1990 when it recognized new rights of attribution and integrity for

visual artists. Congress permitted those artists to enforce these new rights without registering their works. Visual Artists Rights Act of 1990, Pub. L. No. 101-650, § 606(c), 104 Stat. 5089, 5131. Once again, however, Congress maintained Section 411(a)'s jurisdictional restriction for infringement suits.

In 1993, Congress fielded a direct assault on Section 411(a)'s registration requirement. Both the House and Senate held hearings on bills to repeal Section 411(a), with proponents vigorously pushing to expand federal court access for copyright plaintiffs. *See* 5 Patry § 17.80 (summary by then-counsel to the House Judiciary Committee). The sharp attacks highlighted the strict boundary that courts continued to enforce. But Congress again adhered to the jurisdictional lines it had drawn in 1976.

In 2005, Congress created an avenue for commercial publishers to preregister works with a "history of infringement prior to authorized commercial distribution." 17 U.S.C. § 408(f)(2). This addition to the Copyright Act, as the United States acknowledges, "demonstrate[s] the high priority that Congress placed on registration." U.S. Br. 22 n.12. Rather than abolish the jurisdictional requirement of registration, which had impeded one category of claims, Congress remedied the narrow problem. Preregistration, moreover, does not excuse registration; claimants must still register these works within three months after publication. 17 U.S.C. § 408(f)(3).



In 2008, finally, Congress amended Section 411(a) to clarify that the provision limits jurisdiction only in civil, not criminal, cases. Prioritizing Resources and Organization for Intellectual Property Act of 2008, Pub. L. No. 110-403, § 102, 122 Stat. 4257. The House Report on this legislation referred explicitly to “the jurisdictional . . . provisions of [section] 411.” H.R. Rep. No. 110-617, at 39 (2008).<sup>15</sup> Equally significant, Congress’s consideration of the 2008 amendment occurred entirely after the Second Circuit issued its highly publicized decision in this lawsuit. If Congress disagreed with the Second Circuit’s prominent ruling – or with the hundreds of other federal decisions treating Section 411(a) as jurisdictional – it would have modified Section 411(a)’s application to civil suits as well as criminal ones. Instead, Congress once again protected the jurisdictional limit it has imposed on civil infringement actions since at least 1909.

### **C. Section 411(a) Furthers Vital Public Purposes**

Section 411(a), like other jurisdictional lines, advances “broader system-related goal[s]” that Congress relies upon the courts to enforce. *See John R.*

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<sup>15</sup> The petitioners dismiss this Report as one related to a prior version of the bill. Pet. Br. 32 n.14. But the House’s bill was identical to the Senate version on changes to Section 411(a), and only the House produced a Report. Both bills stemmed from the same legislation proposed by the Department of Justice.

*Sand*, 128 S. Ct. at 753. Section 411(a) promotes four distinct public ends: It (1) supports a national registration system that publicly identifies copyright holders; (2) shelters the federal courts from a deluge of minor infringement claims; (3) shields defendants from frivolous claims that curb expression; and (4) sustains the world’s largest library. Allowing the parties to overstep Section 411(a)’s boundary would defeat these goals while defying Congress’s authority to define subject-matter jurisdiction.

1. *Section 411(a) Supports a Public Record of Copyright Claims.* The copyright registry, which dates to 1790, furthers a central purpose of federal copyright law: promoting free trade in creative works by allowing consumers to identify copyright owners. The Register of Copyrights stressed this longstanding function during deliberations preceding the 1976 Copyright Act. “[I]t is often cumbersome,” the Register noted, “for would-be users to seek out the copyright owner and get his permission.” Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong., 1st Sess. 6 (H. Judiciary Comm. Print 1961). To address that problem, federal copyright law had long “imposed certain limitations and conditions on copyright protection,” including “[t]he registration of copyrights.” *Id.* As a result of this system, the Register advised Congress, “[t]he public is . . . given the means of determining the status and ownership of copyright claims.” *Id.*

In 1976, Congress determined that it would no longer demand registration of every copyrighted work. It continued to further the free-trade goals of public registration, however, through Section 411(a). By demanding that copyright claimants register their works before suing for infringement, Congress guaranteed public access to information about contested works. A creative work that is significant enough to support a federal infringement claim, Congress concluded, is one that warrants public registration.

In 1988, Congress confirmed Section 411(a)'s significant role in preserving public access to copyright records. Although Congress accommodated the Berne Convention by withdrawing Section 411(a)'s jurisdictional requirement for many foreign works, it adamantly maintained Section 411(a)'s jurisdictional mandate for domestic works. That decision reflected the House's determination that "registration as a prerequisite to suit helps to ensure the existence of a central, public record of copyright claims. This publicly available depository of information is of benefit to both copyright owners and users." H.R. Rep. No. 100-609, at 42 (1988).

Private litigants cannot waive this public purpose. Before using judicial resources to enforce their copyrights, authors of U.S. works must register their works publicly. That requirement assumes particular importance in the current class action. The publishers here refused to seek licenses from individual freelancers because they considered it an

“insuperable task.” Pet. Br. 4. Instead, they negotiated a class-action settlement that would confer court-ordered licenses on the defense group. JA 127-28, 140-41. If the settlement stands, the defendants will enjoy a perpetual right to use absent class members’ works without ever identifying those authors.

Potential competitors, however, would not possess that right. Those competitors never contracted with the freelancers; they have less ability than members of the defense group to identify authors of the disputed works. If the task was “insuperable” for the defendants, it will be even more challenging for potential competitors. By enforcing a broad agreement that gives the defendants unlimited access to the unregistered works of absent class members, the district court would ratify a formidable barrier to entry in the field of electronic databases. That result is the antithesis of the free market in copyrighted works that Congress intended to further through Section 411(a)’s registration requirement: The settlement would privilege a few companies at the expense of the public registration system Congress designed.

2. *Section 411(a) Shields Federal Courts from Burdensome Litigation.* Section 411(a) serves a second public purpose by shielding the federal courts from a barrage of dubious copyright claims. The provision reserves judicial power for the most significant infringement cases, those based on works that have been publicly registered. The section also streamlines adjudication of these claims by requiring

authors to define their claims before presenting them in court.

These functions assumed critical importance in 1976, when Congress expanded federal copyright protection for unpublished works. Before then, federal copyright law protected primarily published material; most unpublished work depended on state common law for any copyright protection. The 1976 Copyright Act abolished this dual system by extending federal copyright law to all unpublished material. The unified system conferred numerous advantages, but it swept a vast number of new works under federal law.

Drafters of the 1976 Act recognized this shift. Sydney Kaye, the founder of Broadcast Music, Inc. (BMI), reminded an advisory panel that “we have to envision a world in which every scrap of paper, every fleeting mimeograph sheet, every interoffice memorandum, and every letter will be entitled to statutory copyright.” Copyright Law Revision (Part 5): 1964 Revision Bill with Discussions and Comments 89th Cong., 1st Sess. 206 (H. Judiciary Comm. Print 1965). On the eve of the 1976 Act’s implementation, Copyright Register Barbara Ringer acknowledged that “[t]he Copyright Office expects an influx of unpublished material” under the new provisions. Barbara Ringer, *First Thoughts on the Copyright Act of 1976*, 22 N.Y.L. Sch. L. Rev. 477, 492 (1977). That material would include “manuscripts of poems, articles, stories, novels, reports, monographs, advertising copy, song lyrics, tapes of unpublished sound

recordings, and masses of other unpredictable and virtually unclassifiable works that may be considered creative brain children by someone.” *Id.*

Today, the maelstrom of unpublished works is wilder than Kaye or Ringer envisioned. New technologies have unleashed a torrent of material that elicits copyright protection. Every word processing file, every web page, every email, every blogger’s post, and every cell phone snapshot may constitute an “original work[] of authorship fixed in any tangible medium of expression” that creates a federal copyright. 17 U.S.C. § 102. Each of these works, in turn, can spawn infringement claims.

Adjudicating copyright claims based on unregistered work imposes a particular burden on the courts. Although the Copyright Office conducts only limited assessment of registration applications, its review helps establish authorship, copyrightability, and the priority of competing claims. Equally important, the application process forces *claimants* to organize and define their works. Authors must describe the contours of their work and deposit a copy with the Register. Especially for unpublished material, this process helps narrow the scope of any infringement claim brought to court. Even if the Register denies registration, the application will mark the outer boundaries of a subsequent infringement claim.

Section 411(a) provides a levee against the rising river of inchoate copyright claims founded on unpublished work. Copyright registration is a simple task, but it deters casual litigants and winnows overly ambitious claims. Since 1976, Congress and other agencies have repeatedly stressed this public purpose of Section 411(a). During deliberations over the Berne Convention, for example, the Copyright Register advised that Section 411(a) “greatly ease[s] the strain on the courts by providing a reliable record and an initial screening process. . . . Indeed, after the Copyright Office makes its preliminary findings [on authorship, copyrightability, and priority of title], many potential court cases just disappear.” Letter From Ralph Oman, Register of Copyrights, to L. Ralph Mechem, Director, Administrative Office of the United States Courts (June 4, 1987). Eliminating Section 411(a)’s registration requirement, the Register concluded, would “grievously compromise” the “speedy and inexpensive resolution of copyright litigation in the federal courts.” *Id.*

Congress expressed similar concerns during the Berne Convention debates. “Copyright registration,” the House Report noted, “promotes efficient litigation practices” because it “narrows the issues that must be litigated and . . . assists the courts in resolving the underlying copyright dispute.” H.R. Rep. No. 100-609, at 41 (1988). “In a world without section 411(a),” the House concluded, “it is likely that a greater number of suits would be brought in Federal court.” *Id.* at 42.

3. *The Registration Requirement Protects Defendants from Frivolous and Scattershot Claims.* Section 411(a) protects defendants, as well as courts, from oppressive infringement claims. Successful authors, musicians, and film studios regularly face copyright suits claiming infringement of an unknown plaintiff's work. Even when the complaint lacks any factual basis, the lawsuit can delay distribution of the defendant's work and stir unfavorable publicity. See H. Rep. No. 100-609, at 42 (1988).

Section 411(a)'s jurisdictional line plays two roles in protecting defendants from harassing lawsuits. *First*, the registration requirement allows courts to quickly dismiss many frivolous claims. In *Kettenburg v. University of Louisville*, for example, the plaintiff alleged that a television movie copied a short story that he had written for a freshman English class. No. CIV 3:05CV384R, 2005 WL 4444100, at \*1 (W.D. Ky. Nov. 7, 2005). The plaintiff sued the university for copyright infringement, claiming that the English Department "obviously submitted this story to someone in Hollywood and made a movie out of it without giving [him], the author, any credit." *Id.* The plaintiff had not registered his story and the court promptly dismissed his claim, saving the University the burden of even responding to the complaint. See Docket for *Kettenburg* (on PACER).

Threshold dismissals for lack of jurisdiction commonly are without prejudice, so disappointed plaintiffs like *Kettenburg* sometimes register their works and file new complaints. The passage of time



or Register's response, however, more often tempers the plaintiff's unrealistic notions. Section 411(a)'s registration requirement thus erects an important safeguard against frivolous claims.

Diluting that protection could encourage plaintiffs with the weakest copyright claims to file lawsuits without seeking registration. Those authors have an incentive to forego registration's other benefits, like statutory damages, and try their hand in court. A district judge, less expert in copyright law, may enforce a claim that the Register would have denied. As Congress has observed, "claimants who do not have a cognizable claim to copyrightability" may be most likely to avoid the Copyright Office and file civil complaints that allow them to "exploit discovery and other procedures . . . to extract settlements and cause financial harm." H. Rep. 100-609, at 42 (1988). Section 411(a) helps deter these vexatious strategies.

*Second*, Section 411(a) shields defendants from vague, scattershot complaints. By limiting infringement claims to registered works, Section 411(a) requires plaintiffs to specify each work that has been infringed. A plaintiff cannot simply allege that the defendant has infringed a mass of unregistered material. *See Lennon v. Seaman*, 84 F. Supp. 2d 522, 524 (S.D.N.Y. 2000) (dismissing claims for lack of subject-matter jurisdiction when the plaintiff alleged infringement of unregistered "photographs, videotapes, or depictions"). To prevent unbounded burdens on

expression, copyright plaintiffs must allege infringement of specific works that have been defined by registration.

Copyright expert Paul Goldstein recently underscored this distinctive aspect of copyright law. Section 411(a)'s predecessor, Goldstein notes, "did not permit fishing expeditions." Paul Goldstein, *Copyright's Highway 71* (rev. ed. 2003). That section, like the current 411(a), confined copyright adjudication to claims based on enumerated, registered works. Thus, Goldstein explains:

Unlike class action suits – in which a single purchaser injured by a defective product can sue the manufacturer on behalf of a vast, unnamed class of individuals who bought the same product – the Copyright Act require[s] the copyright owner to produce a copyright registration certificate for each and every work that he claim[s] was infringed. Without a registration certificate, the court would have no jurisdiction even to entertain the claim. *Id.*

Open-ended lawsuits against newspapers, libraries, orchestras, and broadcasters could hamstring those institutions. Congress helped avoid interference with creative expression by requiring copyright claimants to specify infringement of particular registered works.

The courts could not adequately protect defendants from either frivolous claims or scattershot complaints if Congress had drafted Section 411(a) as

the type of waivable requirement that the parties advocate. A waivable condition requires the defendant to answer the complaint and move to dismiss; otherwise the court will not know whether the defendant chooses to enforce the requirement. Responding to frivolous complaints imposes a heavy tax on expression. Congress prudently concluded that authors, publishers, and other potential defendants should not have to answer infringement claims that have not stood the test of registration.

4. *The Library of Congress Depends Upon Section 411(a)*. The Library of Congress is the world's largest library, housing more than 142 million books, manuscripts, serials, recordings, photographs, maps, and pieces of sheet music. Library of Congress, *About the Library: Fascinating Facts*, <http://www.loc.gov/about/facts.html> (last visited Aug. 10, 2009). These deposits are far larger than any database maintained by the petitioners. The Library of Congress, for example, preserves the "world's most extensive newspaper collection," with papers dating from 1659 to the present. *Id.* These carefully preserved archives, not the petitioners' commercial databases, document our nation's history.

The Library of Congress, moreover, offers unparalleled public access to its resources. Any adult may use the Library's collection without charge, and internet users worldwide can freely search a growing collection of digitized databases. These searchable, historical records range from nineteenth-century

American song sheets to twenty-first century websites documenting the September 11 attacks. See Library of Congress, *American Memory*, <http://memory.loc.gov/ammem/index.html> (last visited Aug. 10, 2009); Library of Congress, *Web Archives: Minerva*, <http://lcweb2.loc.gov/diglib/lcwa/html/lcwa-home.html> (last visited Aug. 10, 2009). One of the Library's fastest growing online collections is a fully searchable electronic library of historic newspapers. That archive already contains one million pages and will expand to 20 million. Library of Congress, *News from the Library of Congress*, <http://www.loc.gov/today/pr/2009/09-123.html> (last visited Aug. 10, 2009).

As the United States recognizes in its amicus brief, Section 411(a) offers indispensable support to these public resources. U.S. Br. 4-5, 20, 22, 26. The Copyright Office annually forwards more than one million works, all drawn from registration applications, to the Library. Library of Congress, *Annual Report for the Fiscal Year Ending September 30, 2007*, at 25 (2008). Registration thus "contributes to the Library's role as keeper of a mint record of American creativity and helps sustain the comprehensiveness of the Library's collections." *Id.* at 23 (quoting Copyright Register Marybeth Peters).

Maintaining our nation's historical archive is a quintessentially public purpose. Private litigants cannot choose whether to waive this interest, just as they cannot decide to forego any of the other public goals discussed above. The defendants in this case are

particularly ill suited to defend Congress's goal of maintaining a comprehensive national archive freely accessible to the public. The database defendants are commercial entities that charge users for access to historical data; they have an economic interest in restricting free access to that information. Congress did not rely upon litigants with private concerns to assert the Library of Congress's interests.

Nor does this settlement fully protect the nation's archival interests. Although the parties' initial dispute centered on freelance articles written for periodicals that likely appear in the Library, their settlement reaches much more broadly. The proposed releases encompass every "English language literary work" that a member of the defense group used without an author's express permission between August 15, 1997, and March 31, 2005. JA 110-11. The record contains little information about this immense category of works; there is no way to ascertain what proportion of the unregistered material has been deposited in the Library. Congress did not entrust the Library's archives to the vagaries of far-reaching settlement agreements: It offered the resources of the federal courts only in return for registration of all works supporting infringement claims.

## **II. The Integrity of the Judicial Process Precludes the Parties from Waiving Section 411(a)**

The parties claim that Section 411(a) is a mandatory provision that defendants control; they assert that the petitioners waived this registration requirement in the district court. The United States advocates a tauter construction of Section 411(a), awarding less power to copyright defendants. The government would enforce Section 411(a)'s mandate before final judgment, even if parties attempt to waive the provision. After final judgment, however, the United States would impose Section 411(a)'s mandatory bar only in unusual circumstances that “seriously affect the fairness, integrity or public reputation of judicial proceedings.” U.S. Br. 28 (quoting *Silber v. United States*, 370 U.S. 717, 717-18 (1962)).

Neither of these theories acknowledges the unwavering line that Congress drew in Section 411(a). Equally important, neither of these theories fits the facts of this case. The petitioners never waived Section 411(a): They used that jurisdictional hammer to forge an advantageous settlement. The petitioners and Pogrebin-respondents then relied explicitly on Section 411(a)'s jurisdictional line to defend their settlement in both the district court and the court of appeals. Allowing the parties to rewrite their litigation history would destroy the integrity of the judicial process.

This Court has estopped litigants from “playing fast and loose with the courts” by “deliberately changing positions according to the exigencies of the moment.” *New Hampshire v. Maine*, 532 U.S. 742, 750 (2001) (internal quotations and citations omitted). This case presents a particularly compelling case for estoppel because the parties have not simply changed their positions: They are attempting, instead, to recast their conduct below. The record shows that the parties deliberately invoked Section 411(a)’s jurisdictional bar before both the district court and court of appeals; that jurisdictional argument formed an essential ingredient of the district court’s settlement approval. No countervailing public interests justify the parties reconstructing that history now. *Cf. Maine*, 532 U.S. at 750-51 (non-exclusive list of factors that may influence application of judicial estoppel). Even if Section 411(a) lacks jurisdictional stature, therefore, the parties are bound by their exploitation of its strictures below.

#### **A. The Parties Deliberately Invoked Section 411(a)’s Jurisdictional Bar**

In February 2002, before any court or party had devoted substantial time to this case, the petitioners unequivocally advised the mediator that Section 411(a) imposed a jurisdictional bar that would “preclude[ ] the certification of any class respecting works in which copyright has not been registered.” App. 47a (Defendants’ Joint Memorandum). The petitioners cited “[e]xtensive authority” to substantiate

this point. *Id.* The petitioners then “repeatedly delivered” these arguments to the class representatives during their lengthy mediation. *Id.* at 37a (Declaration of Charles S. Sims). This was no bluster; as Appendix C documents, hundreds of decided cases supported the petitioners’ invocation of Section 411(a) as a jurisdictional bar.

By pressing Section 411(a)’s impassable barrier, the petitioners achieved the result that this Court warned against in *Amchem Products, Inc. v. Windsor*, 521 U.S. 591 (1997). The class representatives were “disarmed” in mediation because they could not litigate the vast majority of class members’ claims in court. *Id.* at 621. Indeed, the petitioners acknowledge that their assertion of Section 411(a)’s jurisdictional bar “was intended to, and did, play a key role in tempering plaintiffs’ expectations.” App. 56a (Second Circuit Brief for Defendants-Appellees).

The adversary system allowed the petitioners to throw Section 411(a)’s hardball: The publishers and database defendants correctly contended that a century of precedent precluded litigation of most class members’ claims. Faced with that limit, the class representatives could have pared their lawsuit to claims based on registered works. The parties could also have negotiated private agreements governing unregistered works or created a copyright registry to benefit all freelance authors. Those solutions could have been adopted privately without seeking a judicial order that violated Section 411(a)’s mandate.



But the adversary system has bounds. The petitioners here insisted upon Section 411(a)'s unwaivable, jurisdictional barrier to drive a hard bargain, then purported to "waive" that bar to enforce the settlement against absent class members. Contrary to the petitioners' representations here, this settlement does not represent "private ordering," a "private agreement," or an attempt to "clarify their rights outside of court." Pet. Br. 3, 14, 39. The parties' class action settlement asks the district court to exercise a particularly potent form of judicial power: extinguishing legal claims held by absent class members. Concerns for the integrity of the judicial process counsel against enforcing a settlement negotiated under representations that the court lacked power to adjudicate most class members' claims.

The petitioners' and Pogrebin-respondents' reliance on Section 411(a)'s jurisdictional character, however, reached even further than this. When the objectors challenged the adequacy of class representation, noting that authors of primarily unregistered works lacked representation, both the petitioners and Pogrebin-respondents explicitly raised Section 411(a)'s rigorous bar. A challenge to representation was "outlandish," the Pogrebin-respondents complained, because "no author *without* a registered work could have sued. *See* 17 U.S.C. § 411(a)." App. 19a; *see also* Statement of the Case Point 6 *supra*. More generally, both of these parties asserted that the settlement's "adequacy, fairness, and reasonableness" all derived from the fact that "a huge proportion of

the claims were for works in which copyright had never been registered, and which were not, therefore, within the court's subject matter jurisdiction." App. 23a (Defense Group's Response in the District Court).

After invoking these arguments successfully in the district court, the parties repeated them in the court of appeals. Statement of the Case Point 7 *supra*. Those arguments, not any spontaneous discovery by the Second Circuit, prompted the appellate court's deeper examination of the petitioners' and Pogrebin-respondents' puzzling claim that they could judicially enforce a settlement structured on the district court's lack of jurisdiction.

### **B. Petitioners' Waiver Would Destroy Their Own Settlement**

Allowing the petitioners to waive Section 411(a) would overturn a century of copyright law, but it is unlikely to preserve their settlement with the Pogrebin-respondents. Those parties structured both the substance and procedure of their settlement on the assumption that Section 411(a) absolutely bars infringement claims based on unregistered works. The settlement negotiations offered no subclass representation for authors of primarily unregistered works, and the agreement allocates scant compensation to those works. If the petitioners now waive Section 411(a)'s registration requirement, they fatally poison the procedural and substantive fairness of their settlement.

Judge Walker signaled this paradox in the final words of his Second Circuit dissent. The plaintiffs' failure to designate a separate representative for class members holding primarily unregistered works, Judge Walker noted, was a "serious problem." Pet. App. 45a n.5. The panel failed to reach this issue only because the majority enforced Section 411(a)'s jurisdictional bar and vacated the settlement on that ground. But if Section 411(a) is a provision that the petitioners can retroactively waive, then Judge Walker's concerns are difficult to assuage.

This Court has recognized the critical role of adequate representation in assuring the fairness of settlements, especially when a settlement attempts to impose "a global compromise" covering "diverse groups and individuals." *Amchem*, 521 U.S. at 627. Under those circumstances, class representatives who "act on behalf of a single giant class" do not provide "structural assurance of fair and adequate representation for the diverse groups and individuals affected." *Id.* at 626-27. The parties' assertions of Section 411(a)'s jurisdictionality were key to their defense of class representation. Without Section 411(a)'s jurisdictional peg, those justifications fall.

### **C. No Public Interest Justifies This Retroactive Waiver**

The parties, as well as the amici supporting them, ask the Court to waive Section 411(a)'s

mandate to further three public interests: preservation of “the nation’s archival databases,” *e.g.*, Pogrebin-Resp. Br. 4; promotion of judicial economy, *e.g.*, Muchnick-Resp. Br. 33; and recognition of the “substantial time and resources” that the parties invested in their mediation. *E.g.*, U.S. Br. 30. All three of these public interest claims are illusory.<sup>16</sup>

*First*, none of the parties control our nation’s historical archives. The database defendants market commercial products that reproduce some portions of periodicals published during recent decades. For many publications, coverage dates back no further than 1990; even before this litigation, moreover, the defendants omitted tables, photographs, and other significant elements from included works. Most important, the defendants have never promised to preserve their records as a historical resource – or even to restore the works disputed in this controversy. The parties’ lengthy settlement, notably, does not require the defendants to restore or maintain any works within their databases. The defendants add and delete works from their products purely in response to market demand.

*Second*, approving this settlement will not promote judicial economy. On the contrary, the

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<sup>16</sup> If Section 411(a) is jurisdictional, these arguments are irrelevant: The courts cannot bend jurisdictional lines drawn by Congress. *Bowles*, 551 U.S. at 214-15. This section addresses the parties’ claims that public interests support waiver of a “mandatory but not jurisdictional” registration requirement.

parties have fashioned a sprawling agreement that will demand ongoing judicial administration. The settlement agreement encompasses works drawn from at least 26,000 publications; the parties themselves often express confusion about the agreement's scope. The class definition, which rests on whether any member of the defense group previously used a writer's work "without the person's express authorization," JA 111, will generate ongoing, highly fact-specific disputes about which claims have been released; as the petitioners advised the mediator, the contested works involve "discrete contractual relations between thousands of individual authors and thousands of content providers with respect to tens of thousands of different articles." App. 40a. The parties saddled the district court with ongoing jurisdiction to resolve all disputes involving "interpretation, effectuation, and implementation of the Settlement Agreement." JA 156-57.

Conversely, the parties could quickly end this controversy by compensating the authors who have submitted claims and executing private releases with those writers. The parties could also ask the district court to enforce their settlement agreement with respect to registered works held by absent class members. As the petitioners have recognized throughout this litigation, few remaining authors will register their works, file independent lawsuits, and attempt to prove actual damages for the infringements claimed here. If individual authors do sue, the defendants can settle those claims quickly; small

claims by freelance writers will not burden the courts any more than the stream of lawsuits that media companies file against individual students who download music: The federal courts are always open to copyright plaintiffs who have registered their works.

*Finally*, the parties' lengthy, contentious negotiations do not justify waiving Section 411(a). This dispute has crowded the federal docket for nine long years partly because the parties refuse to acknowledge that the courts cannot extinguish claims stemming from controversies that fall outside their subject-matter jurisdiction. As Point III briefly explains, the parties have persistently confused claims with controversies. That mistake, combined with the parties' own vacillation on the jurisdictionality of Section 411(a), has prolonged this litigation unduly. Rewarding the parties' flip-flopping arguments will encourage similar litigation strategies in the future, without providing a secure basis for the settlement contested here.

### **III. Neither a Special Rule for Settlement Nor the Supplemental Jurisdiction Act Cures the Jurisdictional Defect**

All three parties argue that, even if Section 411(a) limits jurisdiction, the district court may enforce a class action settlement that releases claims based on unregistered works. The petitioners and Pogrebin-respondents rest their contention on a

strained interpretation of Section 411(a)'s reference to "institut[ing]" lawsuits, and on a line of cases stemming from *Matsushita Electric Industrial Co. v. Epstein*, 516 U.S. 367 (1996). The Pogrebin-respondents and Muchnick-respondents advance a third argument based on the supplemental jurisdiction statute, 28 U.S.C. § 1367(a).

All three of these arguments fall outside the Court's limited grant of certiorari. Equally important, the arguments misconstrue the bounds of judicial power. In bending the words of Section 411(a) to suggest that courts may settle class actions they have not "adjudicated," Pet. Br. 47, the petitioners imply that class action settlements require no exercise of judicial authority. But as explained above, class action settlements depend upon courts to issue final judgments terminating the claims of absent class members. Those decrees bind class members as surely as a judgment entered after trial. Congress did not intend its ban on "institut[ing]" actions to give courts expansive authority to extinguish the very claims they could not try.

The parties' *Matsushita* argument fares no better; it mistakes claims for controversies. A controversy arises from "a common nucleus of operative fact." *United Mine Workers v. Gibbs*, 383 U.S. 715, 725 (1966). Once a court possesses jurisdiction over a controversy, it may enforce a class action settlement that releases all claims arising out of that controversy. In *Matsushita*, for example, a state court released federal securities claims stemming from a

disputed tender offer. This Court accorded full faith and credit to the state judgment, even though the state court could not have decided the federal claims. But in *Matsushita*, the tender offer constituted a “common nucleus of operative fact” embracing all of the shareholders’ claims. The state court had jurisdiction to decide each class member’s state-law claims deriving from that nucleus, so it could also release federal claims tied to the same controversy.<sup>17</sup>

The alleged infringements in this class action, however, do not constitute a single controversy. On the contrary, a dozen competing databases published hundreds of thousands of articles at different times and in varying contexts. The plaintiffs’ infringement claims turn on the distinctive terms of contracts executed by “thousands of individual authors and thousands of independent content providers.” App. 40a. Those claims raise similar legal issues and share some common facts, but they are not a single controversy. *Matsushita* offers no precedent for the wholesale release of claims deriving from the thousands of independent controversies in this class action.

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<sup>17</sup> The same principle explains why courts occasionally have power to enjoin infringements of unregistered works. If infringement of a plaintiff’s registered and unregistered works constitutes a single controversy, the court has power to enjoin the entire wrong. A controversy of this nature may arise from an ongoing pattern of infringement by one defendant against a particular plaintiff. See Pet. App. 16a (citing *Olan Mills, Inc. v. Linn Photo Co.*, 23 F.3d 1345, 1349 (8th Cir. 1994)).



Similarly, Congress’s grant of supplemental jurisdiction in 28 U.S.C. § 1367(a) encompasses only claims that “are so related to claims in the action within [the court’s] original jurisdiction that they form part of the same case or controversy under Article III of the United States Constitution.” That statute does not empower federal courts to assert jurisdiction over new controversies, even if those disputes share some factual and legal features with a controversy properly before the court.

The Court’s decision in *Exxon Mobil Corp. v. Allapattah Services, Inc.*, 545 U.S. 546 (2005), confirms that supplemental jurisdiction applies only to “claims that are part of the same case or controversy.” *Id.* at 552. In that case, a class of Exxon dealers “alleged an intentional and systematic scheme by Exxon,” *id.* at 550, in which Exxon fraudulently concealed the same information from all of them. 333 F.3d 1248, 1252 (11th Cir. 2003), *aff’d*, 545 U.S. 546 (2005). Since the alleged misrepresentation was a single wrong directed at all dealers, it constituted a single controversy. *Allapattah* does not allow district courts to release class action claims that, like the ones in this action, stem from thousands of unrelated controversies falling outside the court’s jurisdiction.



Congress constructed Section 411(a) as a firm jurisdictional barrier to the adjudication of unregistered copyright claims. The parties attempt to crash that gate by casting aside a century of judicial

precedent, disavowing their representations in the lower courts, and expanding the scope of judicial power. But Congress enacted Section 411(a)'s bar to further the public purposes of copyright law. Congress trusts the courts to honor that statutory bound.

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◆

## CONCLUSION

The judgment of the court of appeals should be affirmed.

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Respectfully submitted,

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August 19, 2009

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**APPENDIX A-1**

IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

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IN RE LITERARY WORKS IN	)	Master Docket No.
ELECTRONIC DATABASES	)	M-21-90 (GBD)
COPYRIGHT LITIGATION	)	(MDL # 1379)

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**MEMORANDUM OF LAW IN SUPPORT OF  
PLAINTIFFS' MOTION FOR PRELIMINARY  
SETTLEMENT APPROVAL**

(Filed Mar. 31, 2005)

\* \* \*

**IV. ARGUMENT**

\* \* \*

**E. The Substance Of The Settlement Falls  
Within The Range Of Possible Final  
Approval.**

The remaining consideration at the preliminary approval stage is whether the settlement overall falls within the range of possible [final] approval," *NASDAQ Market Makers*, 176 F.R.D. at 102. The settlement here easily meets this criterion.

First and foremost, this settlement is an exceptional result for the Class. The Class consists almost entirely of freelance authors who did not register their Subject Works with the U.S. Copyright Office. Generally, registration is a requirement for standing to bring infringement actions under the

Copyright Act. *See* 17 U.S.C. § 411. Although plaintiffs have advanced colorable arguments in favor of certification of a copyright class where the class representatives have satisfied the registration requirement but not the absent class members, those arguments are as yet untested in the courts. There is a risk that, if forced to litigate the infringement claims in this proceeding, absent class members could be found to lack standing and, as a result, would be unable to receive any legal redress for the copyright infringement on which these actions are based.

\* \* \*

DATED: March 22, 2005 Respectfully submitted,

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**APPENDIX A-2**

IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

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IN RE LITERARY WORKS IN	)	
ELECTRONIC DATABASES	)	MDL No. 1379
COPYRIGHT LITIGATION	)	

---

**DECLARATION OF ROBIN BIERSTEDT**  
**IN SUPPORT OF PRELIMINARY**  
**APPROVAL OF THE SETTLEMENT**

(Filed Mar. 31, 2005)

I, Robin Bierstedt, declare as follows:

1. I am Vice President and Deputy General Counsel of Time Inc. (“Time” or the “Company”), one of the defendants in *Tasini v. New York Times, et al.*, Case No. 93 Civ 8678 (“Tasini Action”), filed in 1993 in the United States District Court for the Southern District of New York. The Tasini Action was filed on behalf of six individual freelance authors and challenged publishers’ rights under Section 201(c) of the Copyright Act of 1976, 17 U.S.C. § 101 *et seq.* (“Copyright Act”), to use freelance content in electronic formats.

2. In mid-2000, four class action cases were filed in New York, Delaware, and California which were consolidated in December 2000 into *In re Literary Works in Electronic Databases Copyright Litigation*, MDL No. 1379 (the “Class Action Database



Case”). The Class Action Database Case was filed on behalf of 21 representative plaintiffs and a class of other freelance authors alleging violations of the Copyright Act arising out of the electronic reproduction, display, sale, and/or distribution of freelance authors’ works without their authorization. As counsel for Time, I have participated in the voluntary mediation of settlement discussions in the Class Action Database Case since November 2001.

3. I submit this declaration in support of the request for preliminary approval of the proposed settlement and notice program in the Class Action Database Case. This declaration sets forth in detail the reasonable efforts Time made to identify the names and addresses of freelance authors who have written for the Company and who may be potential class members in the Class Action Database Case. As described more fully below, while Time can identify names of some potential class members from its records, it can neither match these names with addresses nor recreate any “last known address” lists for these names.

#### Background

4. Time is the largest magazine publisher in the world, publishing such popular titles as TIME, SPORTS ILLUSTRATED, PEOPLE, FORTUNE, ENTERTAINMENT WEEKLY and INSTYLE. Each of the magazines operates independently, with its own separate editorial and business staffs. Each

magazine hires its own employees and engages its own freelance contributors. There is no central division or common department that acts as a clearinghouse for freelance authors.

5. The Tasini Action was brought in December 1993. At that time, because the Company believed it had the right to put freelance articles on third-party databases pursuant to Section 201(c) of the Copyright Act, Time did not have written contracts with all its freelancers, and the practices as to specific agreements varied among the magazines it published. Beginning in 1994, following the filing of the Tasini Action, Time changed its practices with regard to freelancers and by 1995 made consistent use of work-for-hire contracts or other forms of agreement that provided Time with the right to republish freelance articles on databases.

6. The process of identifying freelance authors began in early 2001. Time had decided that if the Supreme Court ruled adversely to defendants in the Tasini Action, it would endeavor to remove from its external databases (the defendants in the Class Action Database Case) all articles written by freelancers with whom we had no written agreement conferring database rights. Several months prior to the Supreme Court's decision on June 25, 2001, in anticipation of an adverse ruling, we began the process of identifying freelance writers whose articles we would remove from the databases.

7. The process was time-consuming and laborious. Neither Time nor the individual magazines it published had an internal database or other electronic or paper list of freelance writers. The database of independent contractors who received Forms 1099 for tax purposes was a much larger list, and it was impractical if not impossible to identify freelance writers from such a list. For example, there was no way to distinguish a pizza deliverer from a freelance writer. The only feasible way for us to obtain a list of freelance writers was to engage in a multi-step process.

#### The Multi-Step Process to Identify Freelancers

8. We first identified the magazines that used freelance writers prior to 1995 (through conversations with the magazines' lawyers and editors), and which of these magazines had content on databases that pre-dated 1995 (through conversations with employees of Editorial Services, a group that oversaw the contractual relationships with database companies). The year 1995 was relevant because, as stated above, it was in that year that Time consistently made use of work-for-hire agreements or other contracts conveying electronic database rights for all magazines.

9. We next identified the range of years, ending in 1995, for which issues of the magazines were on the databases. In most cases the database companies carried magazine issues dating back to 1982. Thus,

the relevant time period was 1982-1995. Time then identified the magazines that used freelance writers during the relevant time period, and then identified among them the magazines that did not consistently, during the time period, use contracts conveying electronic database rights.

10. Having identified the relevant magazines and time periods, we created for each magazine a list of all bylined names (the names of people credited with authorship) on the articles in the databases. This was a laborious process that required pulling the individual author's name from each article. We then created a list of employees at each of the magazines from our internal business records. We next compared the Company employee list to the bylined name list for each magazine, removing the names of all employees from the byline list.

11. At the end of this process we had initial lists of freelance writers for all of the relevant magazines (the "Initial Lists"). But the Initial Lists were imperfect, since there were misspelled names as well as different versions of the same name caused by things like misspellings, errors in spacing, the use of middle initials, nicknames, and shortened versions of names. Some employees appeared erroneously on the Initial Lists.

12. To correct the errors, a manual review of each list was conducted by a group of people who had been at the Company for many years and who were familiar with both the personnel and practices of each

magazine. This group included, for each magazine, at least one lawyer, one editor, and in some cases a person from the business side.

13. We also knew that each list was over-inclusive, since they included freelance writers who had work-for-hire or other agreements with the magazines conveying database rights. The same group of people who reviewed for errors noted anyone on the Initial Lists who fell into the foregoing category, and we removed those people from each list.

14. We had a final list of names from each of the magazines completed in late July 2001 and consolidated them into a final master list (the “Final List”). There was a total of 1,877 names on the Final List. We sent the Final List to each of the electronic databases carrying Time material and asked them to remove all articles written by those authors identified on the Final List.

#### The Difficulty of Obtaining Addresses

15. The names we obtained for the Final List were not attached to or affiliated with any mailing addresses. There is no feasible way of obtaining mailing addresses for them.

16. While the Company issued Forms 1099 to freelance authors and paid them for their articles, accounting records for all years prior to 1993 have been purged. (The IRS requires that they be kept for only seven years.) Prior to 1993, Time used the “DDA”

software system for all of its accounts payable information. When Time switched to the Geac software system in 1993, everything prior to that time was purged and subsequently destroyed. There is no accounts-payable information dating back to 1992 or earlier.

17. The Geac system was in place between 1993 until 2000, when Time changed over to PeopleSoft and transferred to the new system only those names and addresses of independent contractors who had payment activity as recent as 1999. The Geac system was purged in 2000, but the information in the system continues to exist in an historical archive. This information is not searchable by payee name, however, and can be searched only by vendor number. In the case of freelance writers, the vendor number was usually the individual's social security number, which the Company does not have.

I declare under penalty of perjury that the foregoing is true and correct. Executed this 7th day of January, 2005, at New York, New York.

/s/ Robin Bierstedt  
ROBIN BIERSTEDT

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**APPENDIX A-3**

**IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK**

IN RE LITERARY WORKS IN ELECTRONIC DATABASES COPYRIGHT LITIGATION	) ) ) )	MDL No. 1379
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**MEMORANDUM OF LAW IN SUPPORT OF  
PLAINTIFFS' MOTION FOR FINAL  
SETTLEMENT APPROVAL**

\* \* \*

**III. ARGUMENT**

\* \* \*

**C. The Terms of the Settlement Agreement  
Are Fair, Adequate and Reasonable.**

\* \* \*

**1. The Complexity, Expense and Likely  
Duration of the Litigation**

The *Tasini* decision resolved a significant liability issue in favor of plaintiffs. It held that the non-image-based electronic reproduction of freelance works is not a “revision” of a collective work under Section 201(c) of the Copyright Act, and therefore defendants may not assert that statutory provision as a defense in this case. *New York Times Company, Inc. v. Tasini*, 533 U.S. 483, 493 (2001). *Tasini*, however, did not even address let alone dispense with a vast array of other complex issues facing plaintiffs here in a

litigation context. *See Wal-Mart*, 396 F.3d at 118-19 (although government’s successful prosecution of key liability issue “improved plaintiffs’ likelihood of success,” court nevertheless found case complex in light of defenses with respect to damages element).

Defendants have aggressively argued, for example, (1) that the Class must be limited to authors who registered their works in the U.S. Copyright Office; (2) no class would be certified in this case because of asserted numerous individual issues (*e.g.*, the calculation of damages for each class member is an individual issue that predominates over common issues); (3) the databases do not distinguish between “freelance works” and works for hire, and such information is in the possession of the many thousand content providers, if at all; (4) identification of the infringed works is unmanageable; and (5) determining damages would be extremely complex. “[F]ocused and diligent labor was required because of the novelty and difficulty of the legal questions involved. . . .” *In re Copley Pharmaceutical, Inc., “Albuterol” Prod. Liab. Litig.*, 1 F. Supp. 2d. 1407, 1413 (D. Wyo. 1998).

\* \* \*

#### **4. The Risks of Establishing Liability**

While plaintiffs are confident that they would ultimately prevail, there is the risk that they would not establish liability on their claims. Contrary to certain objectors’ misinformed assumption that once *Tasini* was decided the class action became a “slam



dunk,” plaintiffs still faced the risk that liability on a classwide basis would not be established. For one thing, the vast majority of works at issue were never registered with the U.S. Copyright Office, and thus could not have been included in the action. *See* 17 U.S.C. § 411(a) (stating that generally, copyright infringement action may not be brought unless preregistration or registration of copyright has been made: or application for registration has been properly made and refused, and notice of action and complaint are served on Register of Copyrights; *Morris v. Business Concepts, Inc.*, 283 F.3d 502 (2d Cir. 2002) (where plaintiff sued defendants for publishing article that had been written by plaintiff and previously licensed to magazine, Second Circuit held that the registration of copyright in a collective work does not constitute registration of copyright in a freelance article contained in the collective work, and precluded plaintiff from proceeding with suit for lack of standing). (*See* Morrison Decl. ¶ 9; Aiken Decl. ¶¶ 16-17.)

For another, even as to the works that were registered and therefore inarguably within the Court’s jurisdiction, defendants advised plaintiffs during the mediation that other colorable defenses against liability existed, including the existence of oral and implied-in-fact licenses, and claim bars based on estoppel, acquiescence and laches. (Boni Decl. ¶ 8.) The decision in *Tasini* removed but one defense advanced by the defendants, *i.e.*, that the “revision” provision in Section 201(c) of the Copyright Act

encompassed the electronic reproduction of freelance articles contained in collective works.

### **5. The Risks of Establishing Damages**

Nor did *Tasini* resolve, or even address, the issue of damages. Plaintiffs faced a substantial uphill battle establishing damages. Again, the overwhelming majority of works at issue would have gone completely uncompensated because freelance authors typically did not register their works and thus lacked standing to bring an infringement action.

\* \* \*

### **6. The Risks of Maintaining the Class Action Through Trial.**

The risk that a motion for class certification would be denied is another factor favoring the Settlement. To the extent any class were to be certified in the present action, it would almost certainly be limited to authors of registered works, thereby excluding virtually all freelance authors, precisely the persons for whom this case was brought. *See Ryan v. CARL Corp.*, No. C-97-3873-FMS, 1999 U.S. Dist. LEXIS 366 (N.D. Cal. Jan. 14, 1999) (injunctive relief class limited to authors of registered works).

\* \* \*

**8. The Range of Reasonableness of the Settlement Fund in Light of the Best Possible Recovery.**

\* \* \*

In comparing the settlement recovery to what could have been possibly achieved for the Class through further litigation, it must be reiterated that the likely exclusion of unregistered works would reduce the actual damages by more than 99%. In that regard, the amount achieved by the settlement is very likely *higher* than what could have been achieved on behalf of a registered works class at trial.

**9. The Range of Reasonableness of the Settlement Fund in Comparison to a Possible Recovery in Light of the Attendant Risks of Litigation.**

\* \* \*

As described above, the Settlement offers substantial benefits to the Class Members *now* as opposed to the continued risk and delay offered by further litigation. The risks of further litigation are abundant, and are particularly acute for authors of unregistered works. A highly likely outcome of zero is what the vast majority of the Class would face. Finally, defendants made clear in the mediation that there would be no settlement that involved any more funds or any other payment structure (*e.g.*, a royalty scheme similar to ASCAP). (Feinberg Orig. Decl. ¶ 13.) Given the circumstances, there was no reason

for Plaintiffs' Co-Lead Counsel to disbelieve them. The Settlement should thus be approved.

\* \* \*

**E. The Objections Are Meritless.**

\* \* \*

**1. The Release of Claims for Continued Use of Subject Works Is Proper.**

\* \* \*

**(a) The Settlement Term is Nothing More Than a Release of a Known Claim For Continuing Non-Exclusive Use.**

\* \* \*

Second, the claims being released with respect to continuing use by defendants was undisputedly encompassed in plaintiffs' complaint, which sought both monetary and injunctive relief. (*See* Compl. ¶¶ 68-82 and Prayer for Relief.) Accordingly, this fact takes the release here out of the purview of *Amchem*, in which the Supreme Court rejected a release of claims for future asbestos injuries that class members did not have any way of knowing they would develop when they were called upon to decide whether to stay in or opt out of the class. *See* 521 U.S. 591. (*See* Issacharoff Decl. ¶¶ 12-15) Here, the continued use by defendants of the Subject Works was the basis for plaintiffs' injunctive relief claims, and the Notice made perfectly clear that the Class's works would continue to be used unless Class Members opted

out or exercised their takedown right. Because this case – and the release – involve a finite, identifiable universe of works, every Class Member is capable of making a fully informed decision of whether to opt out or request the takedown of his or her works.<sup>10</sup>

\* \* \*

## **2. The Plan of Allocation Is Fair and Reasonable.**

\* \* \*

As to differential treatment in the Plan of Allocation, less favorable treatment of Category C Claims is appropriate. Unregistered works do not

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<sup>10</sup> Indeed, although not applicable here, it is not uncommon for courts to release claims that were *not* sued upon, and even claims that could never have been sued upon. *See, e.g., Wal Mart*, 396 F.3d at 107 (“The law is well established in this Circuit and others that class action releases may include claims not presented and even those which could not have been presented. . . .”); *In re Prudential Ins. Co. of Am. Sales Practices Litig.*, 261 F.3d 355, 366 (3d Cir. 2001) (holding that “a judgment pursuant to a class settlement can bar later claims based on the allegations underlying the claims in the settled class action . . . even though the precluded claim was not presented, and could not have been presented, in the class action itself) (citing *Grimes*, 17 F.3d at 1563; *In re Baldwin United Corp. (Single Premium Deferred Annuities Ins. Litig.)*, 770 F.2d 328, 336 (2d Cir. 1985); *TBK Partners, Ltd v. Western Union Corp.*, 675 F.2d 456, 460 (2d Cir. 1982); *Class Plaintiffs v. City of Seattle*, 955 F.2d 1268 (9th Cir. 1992) (holding that federal court may release state law claims over which it lacks subject matter jurisdiction if state law claims arise from same nucleus of operative fact as claims over which court does have jurisdiction)); *Uhl*, 309 F.3d at 982, 984-85.

even confer standing to bring a lawsuit, let alone give rise to statutory damages. Thus, even if this action were pursued to a favorable verdict and affirmed on appeal, Category C claimants would end up with nothing, as opposed to the cash payments they can claim now under the Settlement.

It is proper to tailor plans of allocation to reflect the relative strengths and weaknesses of subsets of classes. As the court explained in *In re PaineWebber Limited Partnerships Litigation*, 171 F.R.D. 104 (S.D.N.Y. 1997), *aff'd*, 117 F.3d 721 (2d Cir. 1997), “when real and cognizable differences exist between the ‘likelihood of ultimate success’ for different plaintiffs, ‘it is appropriate to weigh “distribution of the settlement . . . in favor of plaintiffs whose claims comprise the set” that was more likely to succeed.’” *Id.* at 133; *see also In re Charter Communications, Inc., Sec. Litig.*, MDL No. 1506, 2005 U.S. Dist. LEXIS 14772, at \*33 (E.D. Mo. June 30, 2005) (“[T]here is no rule that a settlement benefit all class members equally. Indeed, it is appropriate for inter-class allocations to be based upon, among other things, the relative strengths and weaknesses of class members’ individual claims. . . .”); *In re Gulf Oil/Cities Service Tender Offer Litig.*, 142 F.R.D. 588, 596 (S.D.N.Y. 1992) (“ . . . I find also that the allocation plan proposed by class counsel is reasonable. . . . Among the purchasers, most of the proceeds are allocated to those who . . . who have the strongest claim. . . .”).

Thus, providing for the reduction of Category C Claims under certain circumstances, before reducing Category A and B Claims, is neither arbitrary nor unjustified. To the contrary, **not** treating the claims differently would be unfair to those authors, however few, who did register their works and who alone would have standing to sue and in some cases seek statutory damages.

\* \* \*

### **3. The Other Objections Also Lack Merit.**

#### **(a) Other Chalmers Objections**

\* \* \*

Chalmers also contends that, because they all registered their works, plaintiffs are not adequate to represent those Class Members who did not register their works. This is an outlandish assertion. For one thing, no author **without** a registered work could have sued. *See* 17 U.S.C. § 411(a). For another, the claims of plaintiffs and all other Class Members, both those who registered their works and those who did not, arise from the same factual predicate – the conveyance of their works for electronic display in a form enabling the viewing of their works in isolation from the rest of the collective works in which their works were first published. Thus, the interest of plaintiffs and all other Class Members were aligned with respect to maximizing the amount defendants would pay in the Settlement. *See Wal-Mart*, 396 F.3d at 106-07 (“[P]laintiffs . . . [may] release claims that

share the same integral facts as settled claims, provided that the released claims are adequately represented prior to settlement. Adequate representation of a particular claim is established mainly by showing an alignment of interests between class members . . .”).

As for the treatment of Category C claimants under the Plan of Allocation, as explained above, there is nothing unreasonable about designing the Plan of Allocation to reflect the relative strengths of the claims of subsets of the Class, especially given that unregistered authors would have no available avenue for relief in the courts. In addition, the issue is moot. Based on the claims to date, there will be no reduction at all in the scheduled payments to Category C claimants.

\* \* \*

Respectfully submitted,

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**APPENDIX A-4**

IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

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IN RE LITERARY WORKS IN  
ELECTRONIC DATABASES MDL 1379 (GBD)  
COPYRIGHT LITIGATION

---

**DEFENSE GROUP'S RESPONSE TO  
OBJECTIONS AND BRIEF IN  
SUPPORT OF FINAL APPROVAL**

\* \* \*

**II. CONTRARY TO THE OBJECTORS' IN-  
ACCURATE ASSUMPTIONS, PLAINTIFFS  
FACED ENORMOUS RISK AS TO LIABIL-  
ITY, DAMAGES, AND CLASS CERTIFICA-  
TION, WHICH PROVIDES THE ESSENTIAL  
CONTEXT FOR ASSESSING THE ADE-  
QUACY, FAIRNESS, AND REASONABLE-  
NESS OF THE SETTLEMENT AGREEMENT.**

The fairness, adequacy, and reasonableness of any settlement is always a function of the risks faced by plaintiffs in proceeding to trial. Here, notwithstanding the objectors' assumptions that the plaintiff class faced no obstacles whatever to "cashing in" on the *Tasini* decision, those risks were enormous from every perspective, and the glib assertions of some plaintiff organization leaders at the outset of the litigation that the claims were risk-free or worth more than a billion dollars were nothing but puffery. Defendants and the then-participating publishers

submitted a pre-mediation brief explaining and summarizing those risks to mediators Feinberg and Woodin so that they would have those arguments and be able to bring them to the attention of class counsel. And defendants and those publishers made these arguments directly to class counsel, repeatedly, in every mediation session over three years until the general outline of the settlement terms was reached (and on occasion thereafter as well, when difficulties arose).

Those arguments, outlined in the pre-mediation brief which is Exhibit A to the Sims Declaration submitted herewith, form an essential backdrop for assessing the adequacy, fairness, and reasonableness of the settlement. As class counsel were repeatedly shown, plaintiffs faced enormous risks that they would not succeed in establishing liability for most of the works they attempted to put in suit, because a huge proportion of the claims were for works in which copyright had never been registered, and which were not, therefore, within the court's subject matter jurisdiction; even the relatively few claims for registered works were subject to serious risk of not succeeding, because (a) many claims were barred by the statute of limitations, (b) many claims were barred by express or implied licenses, and (c) many claims were barred by estoppel, acquiescence, and/or laches. *See Pre-Mediation Brief at 18-19, 41-46.*

Plaintiffs also faced substantial risks of not being able to establish damages. Indeed, they almost certainly could not have obtained compensation for

articles in which authors had not registered copyrights, under 17 U.S.C. § 411(a). Even for registered articles they could have obtained at best only *de minimis* compensation, because statutory damages were generally unavailable (17 U.S.C. § 412), an award of “reasonable royalties” or profits was unavailable as a matter of fact and law, and putative class members could show, at best, only *de minimis* revenue attributable to use of their articles (because dividing total gross revenue by the number of archived documents yields a gross revenue-per-article figure of only pennies (or fractions of pennies) per article). See Pre-Mediation Brief at 33-38.

Finally, plaintiffs also faced substantial risks that if the case were litigated no class would have been certified at all, or if initially certified maintained through trial. If claims had been litigated, the law appeared to foreclose certifying any class action that would have encompassed claims respecting unregistered works, and even with respect to registered works litigated claims necessarily require individualized determinations of liability (as to whether freelance authors had granted electronic rights pursuant to written, oral, or implied-in-fact licenses) and damages that precluded any finding that a class action for damages was manageable and a superior way of proceeding and that class issues predominated.<sup>1</sup> As the pre-mediation memorandum

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<sup>1</sup> Notwithstanding defendants’ pre-mediation arguments that plaintiffs claims could not be *litigated* as a class action, we  
(Continued on following page)

and arguments made to plaintiff's counsel repeatedly stressed, no court had *ever* certified a litigated Rule 23(b)(3) class action for copyright infringement damage claims, while such motions had been denied. See Pre-Mediation Brief at 21-22.

In addressing final approval, the court need not, of course, resolve the legal issues addressed in the pre-mediation brief, or decide whether defendants' position on each of those issues was correct. It suffices simply to recognize that the risks existed – that contrary to the objectors' glib assertions, the claims to be litigated were subject to numerous, serious difficulties at every turn – and there is surely no basis whatever to conclude otherwise.

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agree with plaintiffs' conclusion that, in the context of a settlement, all the requirements of Rule 23 have been met. See *Amchem Prods., Inc. v. Windsor*, 521 U.S. 591, 620 (1997) (when a class is certified for settlement purposes only, although the requirements of Rule 23 must be met, "a district court need not inquire whether the case, if tried, would present intractable management problems"); *In re Cmty. Bank of N. Va. & Guar. Nat'l Bank of Tallahassee Second Mortg. Loan Litig.*, 2005 U.S. App. LEXIS 17471, \*49-50 (3d Cir. Aug. 11, 2005) (same); *In re Global Crossing Sec. & ERISA Litig.*, 225 F.R.D. 436, 451 (S.D.N.Y. 2004) (Lynch, J.) (same).

### III. THE PROPOSED SETTLEMENT IS FAIR AND ADEQUATE

\* \* \*

#### **B. Category C Claims Are Not At Risk And Are Properly Represented.**

\* \* \*

Mr. Chalmers' second complaint regarding C claims – that the named plaintiffs are not proper class representatives for authors with such claims, and that authors who have *only C* claims should represent those claimants – is also misguided. First, and fundamentally, there is no alternative here to having the named plaintiffs (who have claims in all three categories) represent all those categories, because no named plaintiff does – and no person intervening as a named plaintiff *could* – have only C claims. Because the Copyright Act confers jurisdiction only for claims concerning registered works and precludes any infringement action for an unregistered work, the Court would lack subject matter jurisdiction over any person whose “claims” all involve unregistered works. 17 U.S.C. § 411(a); *Morris v. Bus. Concepts Inc.*, 259 F.3d 65, 68 (2d Cir. 2001). Named plaintiffs who have C claims in addition to their A and B claims for registered works (and Mr. Chalmers recognizes that named plaintiffs have such claims) are perfectly capable as a matter of law of representing the class of freelance authors, and negotiating for a settlement which pays authors different

amounts depending on whether they have registered at all, or in time to obtain statutory damages.

\* \* \*

September 19, 2005

Respectfully Submitted,  
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**APPENDIX A-5**

IN THE UNITED STATES  
DISTRICT COURT FOR  
THE SOUTHERN DISTRICT  
OF NEW YORK

MDL No. 1379

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IN RE LITERARY WORKS IN **DECLARATION OF**  
ELECTRONIC DATABASES **CHARLES S. SIMS**  
COPYRIGHT LITIGATION

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CHARLES S. SIMS hereby declares as follows under penalty of perjury:

1. I am a partner at Proskauer Rose LLP, counsel for defendant Reed Elsevier Inc. in this matter. I also functioned as coordinating counsel for the entire defense group. As such, I actively participated in every phase of the litigation and mediation of this action and submit this declaration in support of the Defense Group's Response to Objections and Brief in Support of Final Approval.

2. At the outset of the mediation, the mediators, Kenneth Feinberg and Peter Woodin, worked out a substantial exchange of pertinent information at the request of counsel for the plaintiffs and putative class.

3. Among other matters, the various defendant databases disclosed to Mr. Feinberg and the plaintiffs extensive information, including on royalty payments paid to content providers, revenues received from subscribers and/or users, licensing terms, and articles

that had been removed from databases in anticipation of or in the wake of the Supreme Court's decision in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001).

4. Furthermore, content providers participating in the mediation, including the Union Tribune Publishing Company, Knight-Ridder, Inc., The New York Times Company, Time Inc., and Tribune Company, disclosed comparable information, including, for example: information regarding license fees, the number of articles (and such information as existed about the number of freelance articles) per year, the (generally small) percentage of articles that are freelance articles in each publication's database, and expense and revenue for publication archives, if available. Additional information was sought and provided as well, and further information was provided on request.

5. Among other matters, the defense group disclosed to class counsel that:

- recent articles (less than 60 days old) were more likely to be accessed than articles of older vintage;
- neither licensing revenue, nor users, nor user revenues declined when the publishers withdrew hundreds of thousands of articles from databases;
- starting in the mid-1990s, publishers had begun to routinely obtain electronic rights

from freelance authors without any corresponding increase in license fees;

- freelance articles were extremely unlikely to be accessed, much less copied – in one case, by examining the set of nearly 80,000 documents removed by The New York Times over a 10-month period, one of the largest databases was able to ascertain that only 5% of those documents had been “hit”;
- the largest databases (LexisNexis and Westlaw) did not collect information that would permit identification of articles accessed, downloaded, or printed, or have data from which article-specific access could be identified;
- The defendants obtain content from publishers through thousands of formally valid representations (which plausibly rest on written, oral, or implied-in-fact agreements) backed by indemnities. The terms of these agreements have varied over time and differ depending on the particular content provider and freelance author at issue;
- Most database defendants obtained their revenues entirely, or almost entirely, under arrangements other than selling individual articles (*e.g.*, annual fees, such as those paid by the Administrative Office of the Federal Courts and law firms). Per-article download fees generated, if anything, only a few dollars of gross royalties for putative class members, and in most cases nothing at all. For the few if any defendants who charge

ascertainable download fees, most claimed articles were not downloaded during the relevant period;

- Revenue other than download fees is attributable to factors other than the inclusion of any individual article in the databases – e.g., the overall size and scope of the database’s collection, the marquis value of its publication, and its brand name;
- No database customer ever demanded a refund of any portion of its subscription fees, despite defendants’ removal of in excess of 150,000 articles from their databases; and
- Studies undertaken by the defense group indicate that copyrights had been registered for fewer than 1 in 1000 freelance works likely to have been delivered to a database without an express license covering electronic rights.

6. From the outset of the litigation, the Database Defendants advised the plaintiffs and the mediators that by the nature of their agreements and arrangements with content providers (i.e., publishers) they had no knowledge of which authors of articles were staff employees and which were freelance authors; no knowledge of the existence or details of licenses that any given freelance author had given to the publisher of his or her article; that they received content from responsible publishers together with representations, warranties, and indemnities as to the publisher’s right to convey the article for

distribution on the databases; that if the case were litigated the defendants would add, as additional parties, the publisher-content providers, and assert third-party claims against them; and that any settlement must therefore include the publishers, arrange for their responsibility pursuant to their representations and indemnities, and guarantee “complete peace” with respect to the Subject Works. Accordingly, the settlement negotiated was aimed at complete peace between the putative class, the Database Defendants, and the publishers, and the Settlement Amount was expressly designed to comprehensively resolve all infringements by the content providers or Database Defendants or both with respect to the Subject Works.

7. The mediation, which lasted more than four years, was exceedingly complex, involving disagreements not only between plaintiffs and defendants but among four different lead class counsel, between defendants, between defendants and the publishers of the content they carried (whose representations and associated indemnities were implicated), and between various defendants and publishers, on the one hand, and their insurers, on the other. The defendants made plain that there could be no settlement whatever unless their related disputes with the publishers were resolved.

8. The settlement range of \$10 million minimum, \$18 million maximum was agreed to only in conjunction with the publishers, and was not – and would not have been – agreed to independently by the

Database Defendants had the publishers not agreed to share as they did, by providing at least half the consideration.

9. Tribune Company (hereafter, "Tribune"), on behalf of all of its affiliates and subsidiaries, actively participated in the mediation, from its inception through the present. Together with Time Inc. and The New York Times Company, Tribune worked hard and with great success to persuade other leading publishers to participate, so that the settlement could be reached in the first place. In order to secure that broad publisher participation so as to make the settlement possible, Tribune contributed substantial consideration that has been essential to the settlement, including publication in its publications of the class notice for which publishers collectively have a \$1 million credit to the Settlement Amount; its commitment (along with other leading publishers among the Participating Publishers collectively) to guarantee \$4 million of the \$10 million minimum Settlement Amount; and its further commitment (again along with other publishers) to pay all the direct costs of valid claims made against the publications of itself and its subsidiaries and affiliates. Under the agreement between the database defendants and participating publishers, publishers are responsible for 50% of the settlement amount if the settlement does not exceed the \$10 million minimum settlement amount, rising up to 72% of the entire settlement amount if the \$18 million maximum settlement is reached.

10. The parties to the mediation concluded that there was no reasonable prospect at all that claims in categories A and B (for registered works) would exhaust the \$18 million Settlement Fund. That judgment was based on the experience of the named plaintiffs (including freelance author organizations) and confirmed by studies undertaken by defendants, which demonstrated that extraordinarily few freelance authors incur the \$30 fee and effort to register their freelance contributions to newspapers and magazines. (Of 1000 apparently freelance articles checked, only 1 was the subject of a registration, and that happened to be by one of the named plaintiffs).

11. Claims submitted during the claim period continue to confirm that assessment. Based on the claims already submitted through September 7, 2005, as reported by the claims administrator, and extrapolating on a straight-line basis over the final three weeks of the claim period, it appears inconceivable that claims would bring the settlement amount over the \$18 million minimum amount, which would be required for freelance authors with category C claims not to be paid in full. (The Administrator has preliminarily valued claims filed through September 7, assuming them all valid, at roughly \$2.682 million; extrapolated through September 30 would yield claims valued at roughly \$3.192 million.)

12. At the outset of the mediation, the mediators requested that the defendants and participating publishers (hereafter “the defense group”) provide them with a pre-mediation brief describing their



position on any pertinent legal or factual issues which might bear on the defense group's valuation of the claims asserted in the action, and which the defense group believed the plaintiffs should take into account in formulating their demand. A copy of the defense group's pre-mediation brief is annexed below as Exhibit A. Although the pre-mediation brief was supplied directly to the mediators and not to plaintiffs' counsel, the various arguments therein were repeatedly delivered to the plaintiffs by both the mediators and by counsel for the defendants and publishers.

13. One of the new objections made by Mr. Chalmers, which is supposedly supported by a declaration of Edward John Hasbrouck (who has himself opted out), is that the Settlement Agreement releases claims against Amazon.com and "give[s] it a non-exclusive license" in books sold by or available on Amazon.com. That is a fundamental misreading of the Settlement Agreement. Mr. Hasbrouck (and Mr. Chalmers) ignore the Settlement Agreement's definition of "Released Claims," which provides that "(v) no claims shall be released with respect to works that have not, on or prior to the date of this Agreement, been reproduced, distributed, displayed or transmitted by any Defense Group member." Settlement Agreement § 1.n(v). Mr. Hasbrouck does not assert that his book has ever been "reproduced, distributed, displayed or transmitted by any Defense Group member," and as such it is not subject to claim or release under the Settlement Agreement.

14. The Judicial Panel on Multidistrict Litigation (“JPML”) issued a conditional transfer order in the matter of *Roeder v. The Tribune Company, Inc., et. al.*, on or about March 22, 2005. Roeder’s motion to vacate that conditional transfer order was denied by the JPML by order dated August 11, 2005, a copy of which is annexed hereto as Exhibit B.

I declare under penalty of perjury that the foregoing is true and correct. Executed on September 15, 2005.

/s/ Charles S. Sims  
Charles S. Sims

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**APPENDIX A-6**

**DEFENDANTS' JOINT MEMORANDUM  
IN CONNECTION WITH THE MEDIATION IN  
*IN RE LITERARY WORKS IN ELECTRONIC  
DATABASES COPYRIGHT LITIGATION,*  
MDL No. 1379 (S.D.N.Y.)**

**The documents and information contained  
within are confidential, to be used for purposes  
of the mediation only and not otherwise,  
pursuant to the terms  
of the mediation agreement.**

[Submitted as "Exhibit A"  
attached to the Declaration of  
Charles S. Sims filed Sept. 19, 2005,  
in the district court]

February 15, 2002

**PRELIMINARY STATEMENT AND OVERVIEW**

The Supreme Court's decision in *New York Times Co. v. Tasini*, 121 S. Ct. 2381 (2001), resolved in plaintiffs' favor one important legal issue this litigation initially posed. Nevertheless, for a number of compelling procedural, factual, and basic economic reasons, this remains at best a very difficult case for plaintiffs and one in which plaintiffs' prospects of achieving a significant recovery range from remote to nonexistent.

First, from a procedural perspective, this is a case in which the defendants have very strong and substantial arguments against class certification.

Obviously, if a settlement is reached we would stipulate to and seek approval for class treatment for settlement purposes. But if the class issue must be litigated, there are strong arguments against certification based on the fact that the issues to be resolved here are overwhelmingly individual, turning on (i) the discrete contractual relations between thousands of individual authors and thousands of content providers with respect to tens of thousands of different articles, and (ii) discrete calculations of copyright damages which will vary on an article-by-article basis. Ironically, the only truly common issue raised in this case *was* the *Tasini* issue, which the Supreme Court resolved. Neither contract actions (involving multiple contracts) nor copyright actions are typically certified for class treatment – in both situations for reasons fully applicable here. Without class certification, this case will effectively be over.

Second, as a factual matter, freelance articles have never constituted more than a modest percentage of the total content of any of the databases in suit. For example, The New York Times reports that less than 4% of its articles were written by freelancers, while other major content providers such as the Associated Press and PR Newswire report having none at all. Even for those content providers who do employ freelance authors, liability will depend upon whether, in each individual case, the author granted electronic rights to the publisher. All content providers represented and warranted to their database customers that they possessed such rights

for the materials they licensed. Some may have been relying upon the interpretation of § 201(c) rejected in *Tasini* in so doing, but many have secured express written grants all along. Since the mid-1990s, when the *Tasini* case focused attention on the issue, those publishers whose form contracts failed to address electronic distribution began to change their forms, and today virtually everyone's contracts expressly grant such rights. Even in those instances where the written contract is silent, issues of oral or implied license, as well as equitable defenses of waiver and estoppel, will prevent many freelancers from making out an infringement claim. And, finally, unless the freelance author registered his or her copyright – which virtually none ever do – the author may not pursue a copyright claim, even if the author could clear all the contractual and equitable hurdles mentioned above. In short, the registered, unlicensed freelance articles actually at issue here will turn out to be very few in number and of little value due to their dated nature. Prospectively, the issue is of negligible significance, at best.

Third, from an economic perspective, there is no case for a large damage award here. It is a simple fact that precious few, if any, individual articles (freelance, or otherwise) have measurable value standing alone as database components, and the typical freelance author does not have sufficient market power to negotiate to be paid anything extra for a grant of electronic publication rights. How do we know? The former is demonstrated by the fact that

wholesale deletions of freelance and other articles have occurred since the Supreme Court decision in *Tasini*, without any adverse impact on the database companies' revenues and with no measurable drop-off in subscriptions. The latter is shown by the fact that those publishers who have changed their form contracts to include express grants of electronic rights have paid no more for such rights, and no separate market exists for them.

\* \* \*

### **FACTS PERTINENT TO PLAINTIFFS' CLAIMS**

\* \* \*

#### **A. Express And Implied-In-Fact Licenses Between Freelance Authors And Content Providers Apply To The Vast Majority Of Freelance Periodical Content.**

##### **1. Many Content Providers Possess Clear Written Electronic Rights To Freelance Content For The Pertinent Time Period.**

\* \* \*

But many content providers *do* possess written agreements authorizing their distribution of freelance content to defendant databases. Some content providers have consistently obtained electronic rights throughout the *entire* period with respect to content available in electronic databases. For example, The New Yorker reports that of the 1601 articles available in the LexisNexis database, *all of these articles* are subject to express written licenses granting

appropriate electronic rights. *See, e.g.,* New Yorker Disclosures.

Moreover, even those publishers without express electronic rights licenses for some of their earliest content made available online secured such express licenses for more recent works, including all (or virtually all) content written during the *relevant limitations period in this case* and some years before. Beginning in the mid-1990s in response to the *Tasini* litigation, many content providers began to revise their written contracts with freelance authors in order to obtain express grants of electronic rights for freelance content. These revised contracts have become the industry standard, even though publishers have reportedly not added any marginally increased compensation for the written licenses of electronic rights, and these licenses clearly authorize the electronic distribution, display, and copying of freelance content online, thereby negating any claim of infringement. For instance, the New York Daily News reports that it has 249,300 articles available in the LexisNexis database through November 2001, for which it has been unable so far to confirm secure electronic rights for only 1,700, or 0.68%. *See* REI Disclosures, Ex. F. [footnotes omitted]

As a result of these licensing practices, articles written since the mid-1990s are likely to be backed by express written licenses, and freelance articles in the databases that are not supported by express electronic licenses are likely older works delivered to content providers at a time when publishers were

unaware of the need to obtain separate authorization for electronic uses of the works. Recovery for copies of many of these older works, however, will be barred by the three-year statute of limitations and will be of no pertinence to the present case.

\* \* \*

**C. Arguably Relevant Freelance Content Has Little, If Any, Economic Value.**

\* \* \*

**4. The Post-*Tasini* Experience Of Both Defendants And Content Providers Confirms That Plaintiffs Have Not Been Harmed.**

\* \* \*

Second, despite the fact that defendants have removed in excess of 150,000 freelance articles from their databases, *not a single database customer* to defendants' knowledge has demanded a refund of any portion of its subscription fees. Nor has the absence of these articles caused any decline in the contract amounts in newly-negotiated agreements. The value of any individual ARFC [Arguably Relevant Freelance Content] to users and the databases is precisely \$0.

\* \* \*



**E. The Failure Of Virtually All Freelance Authors To Register Their Works Dramatically Reduces The Value Of Freelance Claims In This Litigation.**

**1. Virtually No Freelance Authors Ever Register Their Works.**

Only a tiny percentage of freelance authors – on the order of 0.08% or fewer – ever register the copyrights in their periodical contributions. A comprehensive search of Copyright Office registration records for a random sample of 1,200 purged articles, consisting of 100 randomly-selected articles from each of twelve randomly-selected publications that directed LexisNexis to purge specified articles, reveals that – apart from a single article in the sample written by a named plaintiff and identified in the Amended Complaint – *not a single one of those 1,200 articles has been the subject of a copyright registration. See Addendum C, infra.* The survey indicates that the percentage of purged ARFC in which authors have registered copyright is no more than approximately 0.08% (1 in 1,200). To put that number in context, even on the extravagant assumption that there are 200,000 potentially eligible freelance authors (and the real number is likely far less), the data shows that only 160 authors would have registered and would therefore be eligible to pursue an infringement claim for damages.

\* \* \*

While the named plaintiffs have allegedly obtained copyright registrations for various articles in suit, the registration survey shows the named plaintiffs are, by that very fact, unrepresentative of the thousands of freelance authors who never register their works at all, and who are ineligible to maintain an infringement action against defendants. *See* 17 U.S.C. § 411.

\* \* \*

## **ARGUMENT**

### **POINT I**

#### **IF PLAINTIFFS LITIGATE THIS ACTION THEY WILL FAIL TO OBTAIN CLASS CERTIFICATION**

In the event that the parties are unable to reach a global resolution of this matter, the plaintiffs will not succeed in obtaining certification of the class of freelance authors they seek to represent, because of the highly individualized factual inquiry required to determine liability and damages.<sup>12</sup> Any class would be limited to registering authors works – which is to say, essentially empty.

\* \* \*

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<sup>12</sup> Of course, to the extent that it becomes possible to reach a global resolution of this matter, the defendants will work with other interested parties to structure a settlement that will satisfy the mandates of Rule 23, such that a settlement class can be certified.

### **A. The Court May Not Certify A Class For Claims Respecting Unregistered Works.**

“[N]o action for infringement of the copyright in any United States work shall be *instituted* until registration of the copyright claim has been made in accordance with this title.” 17 U.S.C. § 411(a) (emphasis added). That rule, whose language could hardly be clearer, precludes the certification of any class respecting works in which copyright has not been registered. Even the case on which plaintiffs will principally rely, *Ryan v. Carl Corp.*, 1999 U.S. Dist. LEXIS 366, at \*13 (N.D. Cal. Jan. 14, 1999), strictly limited the class to claims respecting registered copyrights.

Extensive authority suggests that registration *before* institution of the claim is required. *See, e.g., Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452, 453 (2d Cir. 1989) (registration is prerequisite to copyright infringement claim); *U-Neek, Inc. v. Wal-Mart Stores, Inc.*, 147 F. Supp. 2d 158, 169-70 (S.D.N.Y. 2001) (court lacks jurisdiction unless claimant has obtained registration certificate for work at issue).<sup>16</sup>

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<sup>16</sup> *See also City Merch., Inc. v. Kings Overseas Corp.*, 2001 U.S. Dist. LEXIS 3176, at \*7 (S.D.N.Y. Mar. 23, 2001) (Copyright Act and Second Circuit precedent explicitly require registration as prerequisite to infringement claim; actual certificate must be received prior to institution of suit); *Tuff-N-Rumble Mgmt., Inc. v. Sugarhill Music Publ’g, Inc.*, 49 F. Supp. 2d 673, 677 (S.D.N.Y. 1999) (“district courts are

(Continued on following page)

As such, plaintiff will be unable to certify a class covering any unregistered works.

**B. Copyright Class Actions Are Exceedingly Rare, And Have Been Certified Only In Narrow Circumstances Not Present Here.**

It is hard to over-stress the rarity of copyright infringement class actions: we have found only two. As the last court to certify such a class noted, with considerable understatement, there is “scant authority on class certification in copyright infringement cases.” *Ryan*, 1999 U.S. Dist. LEXIS 366, at \*13. This lack of authority is unsurprising, because the highly individualized proof required to establish liability in a copyright infringement action is almost always inconsistent with class action treatment. As one court aptly noted:

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without subject matter jurisdiction to hear claims for federal copyright infringement unless a party asserts in [its] pleadings that he has received an actual certificate of registration or its denial from the Copyright Office”); *Noble v. Town Sports Int’l, Inc.*, 1998 U.S. Dist. LEXIS 919, at \*1 (S.D.N.Y. Feb. 2, 1998) (dismissing Copyright Act claim because plaintiff had only applied for registration and not received it); *National Ass’n of Freelance Photographers v. Associated Press*, 1997 U.S. Dist. LEXIS 19568, at \*39 (S.D.N.Y. Dec. 10, 1997) (“an action for copyright infringement cannot be asserted unless a certificate of registration has been issued; the mere filing of an application is simply insufficient to support such a claim”); *Robinson v. Princeton Review*, 1996 U.S. Dist. LEXIS 16932 (S.D.N.Y. Nov. 15, 1996) (same).

[I]f each individual copyright owner brought a separate copyright infringement claim, there is no common element which each owner would need to prove in each separate action. *The validity of the copyright, the absence of any valid license, and the specific act of infringement are particular to that one case and no other.*

*WB Music Corp. v. Rykodisc, Inc.*, 1995 U.S. Dist. LEXIS 15866, at \*18 (E.D. Pa. Oct. 26, 1995) (emphasis added). *See also Estate of Berlin v. Stash Records, Inc.*, 1996 U.S. Dist. LEXIS 9200, at \*5 (S.D.N.Y. July 2, 1996) (“[e]ach class member would have to provide independent proof, relevant only to its claim, of what activities defendants engaged in which violated its particular copyright”). As such, courts have generally rejected attempts to certify copyright classes outright, and only certified them twice under narrow circumstances not present here.

\* \* \*

In sum, there is no precedent for a class containing unregistered works, virtually no precedent for copyright infringement class actions at all, and none for certification of a case such as this.

## CONCLUSION

For all the foregoing reasons, defendants submit that plaintiffs would not be able to litigate this case

as a class action, and the claims of the class have no real value (other than nuisance value).

Respectfully submitted,

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**APPENDIX A-7**

**05-5943-cv**

*To Be Argued By:*  
CHARLES S. SIMS

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IN THE  
**United States Court of Appeals**  
FOR THE SECOND CIRCUIT

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IRVIN MUCHNICK, ABRAHAM ZALEZNIK, CHARLES  
SCHWARTZ, JACK SANDS, TODD PITOCK, JUDITH  
STACEY, JUDITH TROTSKY, CHRISTOPHER GOODRICH,  
KATHY GLICKEN and ANITA BARTHOLOMEW,

*Objectors-Appellants,*

—against—

THOMSON CORPORATION, DIALOG CORPORATION, GALE  
GROUP, INC., WEST PUBLISHING COMPANY, INC., DOW  
JONES & COMPANY, INC., DOW JONES REUTERS BUSI-  
NESS INTERACTIVE, LLC, KNIGHT RIDDER INC., KNIGHT  
RIDDER DIGITAL, MEDIASTREAM, INC., NEWSBANK, INC.,  
PROQUEST COMPANY, REED ELSEVIER INC., UNION-  
TRIBUNE PUBLISHING COMPANY, NEW YORK TIMES COM-  
PANY, COPLEY PRESS, INC., EBSCO INDUSTRIES, INC.  
and PARTICIPATING PUBLISHER TRIBUNE COMPANY,

*Defendants-Appellees,*

MICHAEL CASTLEMAN INC., E.L. DOCTOROW, TOM  
DUNKEL, ANDREA DWORKIN, JAY FELDMAN, JAMES GLEICK,  
RONALD HAYMAN, ROBERT LACEY, RUTH LANEY, PAULA  
MCDONALD, P/K ASSOCIATES, INC., LETTY COTTIN  
POGREBIN, GERALD POSNER, MIRIAM RAFTERY, RONALD



M. SCHWARTZ, MARY SHERMAN, DONALD SPOTO, ROBERT  
E. TREUHAFI and JESSICA L. TREUHAFI TRUST, ROBIN  
VAUGHAN, ROBLEY WILSON, MARIE WINN, NATIONAL  
WRITERS UNION, THE AUTHORS GUILD, INC. and  
AMERICAN SOCIETY OF JOURNALISTS AND AUTHORS,

*Plaintiffs-Appellees,*

EDWARD ROEDER,

*Appellant.*

ON APPEAL FROM THE UNITED STATES  
DISTRICT COURT FOR THE  
SOUTHERN DISTRICT OF NEW YORK

---

**CORRECTED BRIEF FOR  
DEFENDANTS-APPELLEES**

---

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\* \* \*

**STATEMENT OF FACTS**

\* \* \*

Under the guidance of court-approved mediators Kenneth Feinberg and his colleague Peter Woodin, the mediation commenced in the fall of 2001. Defendants and the publishers agreed to provide extensive information sought by class counsel, which was provided during the first quarter of 2002. A1688, 1567-69, 1467-69. That information was provided together with a brief arming the mediators by assessing the strength of the legal and factual

defenses to class certification, liability and/or damages (discussed at greater length below). Citing cases, the brief addressed the defense group's substantial defenses with respect to any liability at all with regard to the bulk of works in suit (which were unregistered), as well as the enormous risks plaintiffs faced as to liability, damages, and class certification. A1571, 1574-1649. The mediation brief was intended to, and did, play a key role in tempering plaintiffs' expectations.

\* \* \*

**Risks and likely rewards.** Both the outcome of any settlement and the court's assessment of fairness, adequacy, and reasonableness are a function of the risks faced by plaintiffs in proceeding to trial, and an assessment of "the terms of the compromise with the likely rewards of litigation." *Maywalt v. Parker & Parsley Petroleum Co.*, 67 F.3d 1072, 1079 (2d Cir. 1995).

As the defendants explained in their pre-mediation brief detailing and summarizing those risks (A1574-1649), and then in their brief to Judge Daniels on the motion for final approval (which annexed the pre-mediation brief), plaintiffs faced very considerable risks of not establishing liability for most of the works for which they were seeking recovery. *See* A1597-98, 1601-02 and *Morris v. Business Concepts, Inc.*, 259 F.3d 65, 71-72 (2d Cir. 2001) (dismissing infringement action under 17 U.S.C. § 411(a) for failure to register articles, and holding

that registration by collective work owner did not satisfy §411(a)). Surveys defendants undertook indicated that only a small fraction of the freelance works in suit were likely registered – on the order of 0.08 percent, or one in 1200. A1597, 1643-49; *see also* A1464.

Plaintiffs also faced substantial risks that no class would be certified at all because of the difficulty of litigating such claims in a single trial, or if initially certified then maintained through trial. As the pre-mediation memorandum and arguments made to plaintiffs repeatedly stressed, no court had *ever* certified a litigated Rule 23(b)(3) class action for copyright infringement damage claims, while courts had denied such motions. A1602-06. If claims had been litigated, the law appeared to foreclose certifying any class action that would have encompassed claims respecting unregistered works. Even with respect to registered works litigated claims necessarily require individualized determinations of liability (as to whether freelance authors had granted electronic rights pursuant to written, oral, or implied-in-fact licenses) and damages that precluded any finding that a class action for damages was manageable and a superior way of proceeding and that class issues predominated. A1607-15. (Notwithstanding defendants' pre-mediation arguments that plaintiffs' claims could not be adversarially *litigated* as a class action, defendants agreed with plaintiffs that, in the context of a settlement, all the requirements of Rule 23 were met. *See Amchem Prods. v. Windsor*, 521 U.S. 591,

620 (1997) (although the requirements of Rule 23 must be met when a class is certified for settlement purposes only, “a district court need not inquire whether the case, if tried, would present intractable management problems”); *In re Cmty. Bank of N. Va. & Guar. Nat’l Bank of Tallahassee Second Mortg. Loan Litig.*, 418 F.3d 277, 299 (3d Cir. 2005) (same); *In re Global Crossing Sec. & ERISA Litig.*, 225 F.R.D. 436, 451 (S.D.N.Y. 2004) (Lynch, J.) (same)).

Apart from the risk of not obtaining or maintaining class certification for a litigated claim, particularly as to unregistered works, plaintiffs faced a serious risk of not succeeding even with respect to the relatively few claims for registered works, because (a) many claims were barred by the statute of limitations, (b) many claims were barred by express or implied licenses, and (c) many claims were barred by estoppel, acquiescence, and/or laches. A1625-29.

Additionally, statutory damages were generally unavailable for most of the works for which plaintiffs sought recovery (17 U.S.C. § 412), an award of “reasonable royalties” or profits was unavailable as a matter of fact and law, and putative class members could show, at best, only *de minimis* revenue attributable to use of their articles. *See generally* A1616-24. For example, dividing total gross revenue by the number of archived documents yields a gross revenue-per-article figure of only pennies (or fractions of pennies). A1622-24. Moreover, the articles in the databases evidently lack economic value there, as the value of the databases is essentially in the facts they

make easily available, not in expression. For example, the removal of millions of articles because of liability concerns caused by the decisions in *Tasini* did not cause any decline in either license fees received by databases from subscribers who pay a flat fee for database subscription or royalty fees paid by database to publishers. A1592-95. The reason is that most users are seeking information, not expression, and accordingly obtain what they seek (and full value for their subscription fees) when their database searches pull up the facts sought in *any* article, regardless of whether additional, unlicensed freelance articles would have contained additional sources for that same information as well.

\* \* \*

### **ARGUMENT**

#### **I. THE DISTRICT COURT DID NOT ABUSE ITS DISCRETION, AND WAS CORRECT, IN FINDING ADEQUACY OF REPRESENTATION**

The objectors' attack on class certification aims solely at adequacy of representation and does not challenge the district court's findings concerning all the remaining Rule 23 criteria. Neither of the two alleged conflicts identified as reasons for finding that the court abused its discretion in finding adequacy of representation – that the Settlement Agreement disadvantages authors of unregistered works relative to the class members, who assertedly represent only registered works, and that “the C reduction provision

favors one part of the class at the expense of another part of the class” – provides any basis for reversing the district court’s certification.

\* \* \*

**A. The Class Representatives Had the Same Interests as Other Class Members**

Objectors try to force this case into the mold of *Amchem Prods. v. Windsor*, 521 U.S. 591 (1997), where different putative class members had fundamentally different objectives, with some seeking larger immediate payments and persons as-yet-unharmed seeking assurance of a larger future fund for such later time, if any, as their injuries materialized. They complain that the Settlement Agreement’s terms reveal inadequate representation of “part of the class,” by “prejudice[ing] the unregistered owners to the benefit of registered owners.” (Br. 26). That attack, and the resulting complaint that the Court should have certified subclasses with unregistered owners as class representatives, reflect a fundamental misunderstanding of fact and law.

First, and dispositively, there is no conflict at all between the named plaintiffs and freelance authors holding C claims (for unregistered work), much less a conflict sufficiently “fundamental” to defeat adequacy, because there are not different categories of freelance authors but only a single category of writers who have written both registered and unregistered works.

\* \* \*



Second, at the threshold, because there was no alternative here to having the named plaintiffs, with works in all three categories, represent authors with unregistered works. No named plaintiff did – and no person intervening as a named plaintiff to serve as a class representative *could* – assert claims only for unregistered works. Because the Copyright Act confers jurisdiction over suits for infringement of United States works only if those works are registered – and requires every infringement plaintiff to allege registration – the district court would have lacked subject matter jurisdiction over any complaint for infringement of articles in U.S. newspapers and periodicals filed by a person whose “claims” all involved unregistered works. 17 U.S.C. § 411(a); *Morris v. Business Concepts Inc.*, 259 F.3d 65, 68 (2d Cir. 2001). No plaintiff could have sued over only unregistered works, and no freelance author who did not allege infringement of at least one registered work could have intervened to represent such a subclass.

\* \* \*

The same reasons addressed above for concluding that no fundamental conflict was implied or created by different payment schedules for registered works (categories A and B) and unregistered works (category C) compel that same conclusion with respect to the differences between payment schedules for late-registered (B) works and unregistered (C) works. That the settlement agreement provides greater compensation for registered work (which would have

survived a motion to dismiss) than for unregistered work (which would not), and greater compensation still for work eligible for statutory damages, reflects the kind of compromise that settlements entail – *i.e.*, simple settlement value – and not any inherent or structural conflict between different categories of claimants rendering a conclusion of adequate representation an abuse of discretion. In view of the registration requirement of 17 U.S.C. §411(a), the risks plaintiffs faced with respect to including claims for such works in any certified class, or of such works being subject even to (economically practicable) individual suits, were obviously enormously greater than the risks they faced with respect to B category works, justifying lower payments. *In re Paine Webber Ltd. P'ship. Litig.*, 171 F.R.D. 104 (S.D.N.Y.), *aff'd*, 117 F.3d 721 (2d Cir. 1997). Further, objectors ignore that the awards for unregistered works are effectively worth an additional \$30 per work, since authors will have avoided the registration fee that is ordinarily a precondition to any infringement suit.

### **B. Category C Claims**

Objectors' remaining theory of a conflict requiring separate representation for authors of unregistered works (notwithstanding their inattention to the showing that the registration requirement precluded any subclass representatives for such authors) is what they term the "C reduction," under which, *if* sufficient valid claims of sufficient value were asserted to take the prima facie settlement amount

upward of \$18 million, then claims for unregistered works (C claims) would be ratcheted down to hold the Settlement Amount at the guaranteed \$18 million maximum.

\* \* \*

17 U.S.C. § 411 is the answer to objectors' question (Br. 30-31), "If they believed there was no chance of a reduction, why did they place the entire risk on one part of the class?" – although the question needs rephrasing to accord with the fact that the risk was placed not "on one part of the class" but on unregistered works of all class members. Because only registered (and no unregistered) works would have been eligible for relief had the case been litigated and plaintiffs prevailed, the class representatives concluded that it would be unfair to place the burden of any necessary reduction anywhere else. Having paid for registration precisely so as to be eligible for seeking damages, owners of registered works seemed entitled, in fairness, not to bear the burden of any "C reduction" if, contrary to all expectation, one were ever triggered. A 1447. *See In re Paine Webber, supra.*

\* \* \*

**II. THE DISTRICT COURT DID NOT ABUSE ITS DISCRETION, AND WAS CORRECT, IN APPROVING THE SETTLEMENT AS FAIR, REASONABLE, AND ADEQUATE**

\* \* \*

**A. The Process Effectively Guaranteed the Fairness, Reasonableness, and Adequacy of the Settlement Agreement**

\* \* \*

Content providers participating in the mediation, including the Copley Press, Knight-Ridder, Inc., The New York Times Company, Time Inc., and Tribune Company, disclosed comparable information, including, for example, information regarding license fees, the numbers of articles (and such information as existed about numbers of freelance articles) per year; the (generally tiny) percentage of articles that are freelance articles in each publication's database; and expense and revenue for publication archives, if available. Additional information was sought and provided on request. A1567-69, 1688.

Among other matters, information was disclosed to plaintiffs that:

- recent articles (less than 60 days old) were enormously more likely to be accessed than articles of older vintage, demonstrating that the economic value of articles in the database declined sharply after a short period;
- neither licensing revenue, nor users, nor user revenues declined when the publishers

had withdrawn hundreds of thousands of articles from the database (overbroadly, out of an abundance of caution and lack of ability to pinpoint freelance works lacking clear electronic rights), establishing that the genuine economic value of freelance works without adequate rights was \$0;

- publishers had begun to routinely obtain electronic rights from freelance authors without *any* corresponding increase in license fees; and
- freelance articles were extremely unlikely to be accessed, much less copied – in one case, by examining the set of nearly 80,000 documents purged (removed) by The New York Times over a 10-month period, one of the largest databases was able to ascertain that only 5% of those documents had been “hit”.

A1568-69; *see also* 1469-71.

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**APPENDIX A-8**

**05-5943-cv(L)**

COUNSEL TO ARGUE: MICHAEL J. BONI

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UNITED STATES COURT OF APPEALS  
FOR THE SECOND CIRCUIT

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IRVIN MUCHNICK, ABRAHAM ZALEZNIK,  
CHARLES SCHWARTZ, JACK SANDS, TODD  
PITOCK, JUDITH STACEY, JUDITH TROTSKY,  
CHRISTOPHER GOODRICH, KATHY GLICKEN  
AND ANITA BARTHOLOMEW,

*Objectors-Appellants,*

– against –

MICHAEL CASTLEMAN INC., E.L. DOCTOROW,  
TOM DUNKEL, ANDREA DWORKIN, JAY  
FELDMAN, JAMES GLEICK, RONALD HYMAN,  
ROBERT LACEY, RUTH LACEY, PAULA  
McDONALD, P/K ASSOCIATES, INC., LETTY  
COTTIN POGREBIN, GERALD POSNER, MIRIAM  
RAFTERY, RONALD M. SCHWARTZ, MARY  
SHERMAN, DONALD SPOTO, ROBERT E.  
TREUHAFT AND JESSICA L. TREUHAFT TRUST,  
ROBIN VAUGHN, ROBLEY WILSON, MARIE  
WINN, NATIONAL WRITERS UNION, THE  
AUTHORS GUILD, INC. AND AMERICAN SOCIETY  
OF JOURNALISTS AND AUTHORS,

*Plaintiffs-Appellees,*

THOMSON CORPORATION, DIALOG CORPORATION, GALE GROUP, INC. WEST PUBLISHING COMPANY, INC., DOW JONES & COMPANY, INC., DOW JONES REUTERS BUSINESS INTERACTIVE, LLC, KNIGHT RIDDER INC., KNIGHT RIDDER DIGITAL, MEDIASTREAM, INC., NEWSBANK, INC., PROQUEST COMPANY, REED ELSEVIER INC., UNION-TRIBUNE PUBLISHING COMPANY, NEW YORK TIMES COMPANY, COPLEY PRESS, INC., AND EBSCO INDUSTRIES, INC., AND PARTICIPATING PUBLISHER TRIBUNE COMPANY,

*Defendants-Appellees*

EDWARD ROEDER,

*Appellant,*

ON APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

---

**CORRECTED BRIEF  
FOR PLAINTIFFS-APPELLEES**

---

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\* \* \*

**III. THE MEDIATION**

\* \* \*

While plaintiffs were confident they could ultimately prevail on the merits, they recognized, of course, that there was risk. The vast majority of works at issue were never registered with the U.S. Copyright Office, and thus the authors of those works arguably lacked standing to sue for copyright infringement. *See* 17 U.S.C. § 411(a); *Morris v. Bus. Concepts, Inc.*, 283 F.3d 502, 505 (2d Cir. 2002). As to the registered works, defendants presented plaintiffs with colorable defenses against liability, including the existence of oral and implied-in-fact licenses, and claim bars based on estoppel, acquiescence and laches. (A1469.) Although the decision in *Tasini* removed one defense advanced by the defendants, *i.e.*,



that the “revision” provision in Section 201(c) of the Copyright Act, 17 U.S.C. § 201(c), encompassed the electronic reproduction of freelance articles contained in collective works, it did not remove other defenses.

Nor did *Tasini* address the issue of damages. Plaintiffs here faced substantial difficulty establishing damages. First, infringements of the overwhelming majority of works at issue might have gone completely uncompensated because they were not registered.

\* \* \*

### ARGUMENT

\* \* \*

## II. THE DISTRICT COURT DID NOT ABUSE ITS DISCRETION IN APPROVING THE SETTLEMENT.

### A. Plaintiffs Were Adequate Class Representatives.

\* \* \*

With respect to the plan of allocation, less favorable treatment for Category C claims is appropriate. Unregistered works arguably would not even confer standing to bring a lawsuit at all, let alone give rise to statutory damages. Thus, if this action had been pursued to a favorable verdict and affirmed on appeal, Category C claimants could well have ended up with nothing, as opposed to the cash payments they can now claim under the Settlement. *See* 17 U.S.C. § 411(a) (copyright infringement action may not be brought unless pre-registration or

registration of copyright has been made); *Morris v. Bus. Concepts, Inc.*, 283 F.3d 502, 505 (2d Cir. 2002) (registration of copyright in a collective work does not constitute registration of copyright in a freelance article contained in the collective work).

It is appropriate to tailor plans of allocation to reflect the relative strengths and weaknesses of subsets of classes. “[W]hen real and cognizable differences exist between the likelihood of ultimate success for different plaintiffs, it is appropriate to weigh distribution of the settlement . . . in favor of plaintiffs whose claims comprise the set that was more likely to succeed.” *In re PaineWebber Limited Partnerships Litigation*, 171 F.R.D. 104, 133 (S.D.N.Y. 1997) (internal quotation marks and citations omitted), *aff’d*, 117 F.3d 721 (2d Cir. 1997); *accord In re Holocaust Victim Assets Litig.*, 413 F.3d 183 (2d Cir. 2001) (per curiam) (“Any allocation of a settlement of this magnitude and comprising such different types of claims must be based, at least in part, on the comparative strengths and weaknesses of the asserted legal claims.”); *In re Lucent Techs. Inc. Sec. Litig.*, 307 F. Supp.2d 633, 649 (D. N.J. 2004) (“Courts have routinely approved plans of allocation that provide different payments to class members.”).<sup>12</sup>

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<sup>12</sup> Registration costs \$30 per work, or \$30 per group of works registered together in any one year. (A1597.) Thus, the expense borne by authors of registered works is another reason in support of a plan of allocation that favors registered works.

The Settlement fairly reflects the value of those claims eligible for statutory damages, which was greater than for those works registered later, and much greater than for those that were never registered. Providing for the reduction of Category C claims before reducing Categories A and B claims is neither arbitrary nor prejudicial. (App. Br. 16.) Rather, *not* treating the claims differently would have been unfair to those authors, however few, who did register their works and who arguably alone would have standing to sue and in some cases seek statutory damages.

\* \* \*

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**APPENDIX A-9**

**PROSKAUER ROSE LLP**

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February 12, 2007

**BY HAND**

Thomas Asreen, Acting Clerk of Court  
U.S. Court of Appeals for the Second Circuit  
Daniel Patrick Moynihan United States Courthouse  
500 Pearl Street  
New York, New York 10007

Re: *In re Literary Works in Electronic Databases*  
*Copyright Litigation*, 05-5943-cv (2d Cir.)

Dear Mr. Asreen:

I write on behalf of defendants-appellees to address the question posed by the Court's January 31, 2007 Order, namely "whether the District Court had subject matter jurisdiction over claims concerning the infringement of unregistered copyrights." Please provide this response to the panel assigned to the above-captioned case.

1. With respect, we are constrained to rephrase the question, because the question posed implicitly

assumes that the District Court exercised “subject matter jurisdiction over claims concerning the infringement of unregistered copyrights.” We do not understand that the District Court did so. Rather, it asserted jurisdiction over a lawsuit in which each and every claim of each and every named plaintiff concerned a properly registered work, consistent with 17 U.S.C. §411(a), and then exercised its power to approve a class action settlement pursuant to Fed. R. Civ. P. 23(e), as to which §411(a) plays no role.

17 U.S.C. §411(a) is phrased and has been understood as a pre-condition to the exercise of subject matter jurisdiction conferred by 28 U.S.C. §1338. *See Well-Made Toy Mfg. Corp. v. Goffa Int’l Corp.*, 354 F.3d 112, 115 (2d Cir. 2003). It provides that “no action for infringement of the copyright in any United States copyright work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title.” That requirement was literally and completely satisfied here. The actions in the District Court were not instituted until registration of the works named in suit was made in accordance with §411(a).

\* \* \*

Very truly yours,

By: /s/ Charles S. Sims  
 Charles S. Sims  
*Counsel for Defendants-Appellees*

---

**APPENDIX A-10**

**KOHN, SWIFT & GRAF, P. C.**

ONE SOUTH BROAD STREET, SUITE 2100  
PHILADELPHIA, PENNSYLVANIA 19107-3304

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February 15, 2007

**Via Federal Express**

Thomas Asreen, Acting Clerk of the Court  
United States Court of Appeals for the Second Circuit  
Daniel Patrick Moynihan United States Courthouse  
500 Pearl Street  
New York, NY 10007

Re: *In re Literary Works in Electronic Databases*  
*Copyright Litigation* 05-5943-cv (2d Cir.)

Dear Mr. Asreen:

I am counsel of record for plaintiffs-appellees. We have reviewed the letter submission defendants-appellees filed on February 12, 2007 in response to

the Court's Order dated January 31, 2007, and plaintiffs-appellees join in that letter submission.

Sincerely yours,

By: /s/ Michael J. Boni  
Michael J. Boni

MJB/dp

cc: Charles S. Sims, Esquire  
Charles Chalmers, Esquire  
Counsel of Record

---

**APPENDIX A-11**

**05-5943-cv(L),  
06-0223-cv(CON)**

---

**IN THE  
United States Court of Appeals  
FOR THE SECOND CIRCUIT**

---

IN RE LITERARY WORKS IN ELECTRONIC  
DATABASES COPYRIGHT LITIGATION

---

IRVIN MUCHNICK, ABRAHAM ZALEZNIK, CHARLES  
SCHWARTZ, JACK SANDS, TODD PITOCK, JUDITH STACEY,  
JUDITH TROTSKY, CHRISTOPHER GOODRICH, KATHY  
GLICKEN and ANITA BARTHOLOMEW,

*Objectors-Appellants,*

– against –

THOMSON CORPORATION, DIALOG CORPORATION, GALE  
GROUP, INC. WEST PUBLISHING COMPANY, INC., DOW  
JONES & COMPANY, INC., DOW JONES REUTERS  
BUSINESS INTERACTIVE, LLC, KNIGHT RIDDER INC.,  
KNIGHT RIDDER DIGITAL, MEDIASTREAM, INC.,  
NEWSBANK, INC., PROQUEST COMPANY, REED ELSEVIER  
INC., UNION-TRIBUNE PUBLISHING COMPANY, NEW  
YORK TIMES COMPANY, COPLEY PRESS, INC., EBSCO  
INDUSTRIES, INC., and PARTICIPATING PUBLISHER  
TRIBUNE COMPANY,

*Defendants-Appellees,*



MICHAEL CASTLEMAN INC., E.L. DOCTOROW, TOM  
DUNKEL, ANDREA DWORKIN, JAY FELDMAN, JAMES  
GLEICK, RONALD HYMAN, ROBERT LACEY, RUTH LACEY,  
PAULA McDONALD, P/K ASSOCIATES, INC., LETTY COTTIN  
POGREBIN, GERALD POSNER, MIRIAM RAFTERY, RONALD  
M. SCHWARTZ, MARY SHERMAN, DONALD SPOTO, ROBERT  
E. TREUHAFT and JESSICA L. TREUHAFT TRUST, ROBIN  
VAUGHN, ROBLEY WILSON, MARIE WINN, NATIONAL  
WRITERS UNION, THE AUTHORS GUILD, INC. and  
AMERICAN SOCIETY OF JOURNALISTS AND AUTHORS,

*Plaintiffs-Appellees,*

EDWARD ROEDER,

*Appellant.*

---

ON APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

---

**DEFENDANTS-APPELLEES' PETITION  
FOR PANEL REHEARING AND SUGGESTION  
FOR REHEARING *IN* [sic] *BANC***

---

CHARLES S. SIMS  
THEODORE K. CHENG  
JOSHUA W. RUTHIZER  
PROSKAUER ROSE LLP  
1585 Broadway  
New York, New York 10036  
(212) 969-3950

*Attorneys for Defendant-  
Appellee Reed Elsevier, Inc.*

*(Additional counsel continued on inside cover)*

---

\* \* \*

**ARGUMENT**

**REHEARING IS WARRANTED BECAUSE  
THE OPINION IGNORED AND CONFLICTS  
WITH CIRCUIT AND SUPREME COURT  
PRECEDENT, AND THE APPEAL PRESENTS  
QUESTIONS OF EXCEPTIONAL IMPORTANCE**

\* \* \*

B. The Opinion Misapprehends the Import and Purpose of Section 411(a) of the Copyright Act

The “law of releases” canvassed above demonstrates the error in the Opinion, *unless* § 411(a) is an exception to the general rule permitting courts to approve class action settlements that release and compensate claims outside their jurisdiction.

\* \* \*

The court below did not assume jurisdiction to adjudicate infringement claims or grant damages regarding unregistered works – powers that defendants agree the court lacked. Rather, the court dispatched to mediation a lawsuit in which each claim of the named plaintiffs complied with § 411(a) because, when the case was “institute[d]” in 2000, every U.S. work whose infringement plaintiffs complained of had been duly registered.

\* \* \*

Four years after institution, the parties presented a proposed settlement in which, to resolve the

claims within the court's clear jurisdiction, defendants would provide payments to (and obtain releases from) a class of freelance authors. The court approved the settlement and certified the requested class of authors (JA1726) after reviewing the settlement for fairness and reasonableness under Rule 23(e). The court did not adjudicate any infringement claims, much less certify a "class consisting of claims" for unregistered works, but simply approved a private contractual settlement as fair and reasonable. Neither approval of the settlement nor the concomitant certification of the class were the "institution" of an "action for infringement of the copyright." That happened five years earlier, in compliance with §411(a).

\* \* \*

---

<b>TO:</b>  <b>Register of Copyrights                  Copyright Office                  Library of Congress                  Washington, D.C. 20559</b>	<b>REPORT ON THE                  FILING OR DETERMINATION                  OF AN ACTION OR APPEAL                  REGARDING A COPYRIGHT</b>
--	--

In compliance with the provisions of 17 U.S.C. 508, you are hereby advised that a court action or appeal has been filed on the following copyright(s):

<input type="checkbox"/> ACTION <input type="checkbox"/> APPEAL		COURT NAME AND LOCATION
DOCKET NO.	DATE FILED	
PLAINTIFF		DEFENDANT
COPYRIGHT REGISTRATION NO.	TITLE OF WORK	AUTHOR OR WORK
1		
2		
3		
4		
5		

80a

In the above-entitled case, the following copyright(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
COPYRIGHT REGISTRATION NO.	TITLE OF WORK	AUTHOR OF WORK	
1			
2			
3			

In the above-entitled case, a final decision was rendered on the date entered below. A copy of the order or judgment together with the written opinion, if any, of the court is attached.

COPY ATTACHED <input type="checkbox"/> Order <input type="checkbox"/> Judgment	WRITTEN OPINION ATTACHED <input type="checkbox"/> Yes <input type="checkbox"/> No	DATE RENDERED
---	--	---------------

CLERK	(BY) DEPUTY CLERK	DATE
-------	-------------------	------

- DISTRIBUTION:**
- 1) Upon initiation of action, mail copy to Register of Copyrights
  - 2) Upon filing of document adding copyright(s), mail copy to Register of Copyrights
  - 3) Upon termination of action, mail copy to Register of Copyrights
  - 4) In the event of an appeal, forward copy to Appellate Court
  - 5) Case File Copy

**Appendix C**  
**Federal Court Opinions Explicitly Referring**  
**to 17 U.S.C. § 411(a) as Jurisdictional**

This appendix lists more than 200 federal-court opinions issued since enactment of 17 U.S.C. § 411(a); all of these opinions explicitly refer to Section 411(a) as jurisdictional. The list draws from cases cited in chapter 17 of WILLIAM F. PATRY, *PATRY ON COPYRIGHT* (2009), supplemented by a modest database search; the appendix does not attempt to list every opinion describing Section 411(a) as jurisdictional.

To demonstrate the breadth of the historical record, the appendix includes both published and unpublished opinions; the lack of a formal reporter indicates an unpublished opinion. Parentheticals highlight key phrases used in each opinion but, for brevity, do not attempt to capture more extensive discussions. The cases consider Section 411(a) in a wide variety of contexts, so the holdings do not all rest on jurisdictionality. All of these opinions, however, expressly recognize Section 411(a) as jurisdictional.

**Court of Appeals for the First Circuit**

1. *Data General Corp. v. Grumman Systems Support Corp.*, 36 F.3d 1147, 1163 (1st Cir. 1994) (“jurisdictional requirement of Section 411(a)”).
2. *Torres-Negrón v. J&N Records, LLC*, 504 F.3d 151, 154 (1st Cir. 2007) (“complete [registration] application is a jurisdictional prerequisite to

filing suit in federal court for copyright infringement”).

District of Maine

3. *Morgan, Inc. v. White Rock Distilleries, Inc.*, 230 F. Supp. 2d 104, 107 (D. Me. 2002) (“copyright registration is a jurisdictional prerequisite”).

District of Massachusetts

4. *Quincy Cablesystems, Inc. v. Sully’s Bar, Inc.*, 650 F. Supp. 838, 850-51 (D. Mass. 1986) (lack of registration created “jurisdictional defects” in copyright claim).
5. *Lotus Development Corp. v. Paperback Software International*, 740 F. Supp. 37, 79 (D. Mass. 1990) (Section 411(a) is a “jurisdictional” condition precedent).
6. *Steele v. Turner Broadcasting System, Inc.*, 607 F. Supp. 2d 258, 264 (D. Mass. 2009) (to the extent that plaintiff maintains that unregistered works have been infringed, “this Court lacks jurisdiction over such claims”).

District of New Hampshire

7. *Embassy Software Corp. v. eCopy, Inc.*, 592 F. Supp. 2d 225, 226 (D.N.H. 2009) (“this court’s jurisdiction requires the existence of a valid copyright registration”).

District of Puerto Rico

8. *Negrón v. Rivera*, 433 F. Supp. 2d 204 (D.P.R. 2006) (“A valid copyright registration is a jurisdictional prerequisite for maintaining a copyright infringement action under the Copyright Act of 1976, as amended”) (citations omitted), *aff’d*, 504 F.3d 151 (1st Cir. 2007).
9. *Ocasio v. Alfanno*, 592 F. Supp. 2d 242, 244 (D.P.R. 2008) (“jurisdictional prerequisite”).
10. *Sebastian Music Group, Inc. v. Ayala-Rodriguez*, Civ. No. 07-1436, 2008 WL 919683, at \*3 (D.P.R. Apr. 3, 2008) (“jurisdictional prerequisites”).
11. *Amador v. McDonald’s Corp.*, Civ. No. 07-1312, 2008 WL 5683885, at \*10 (D.P.R. Dec. 5, 2008) (“In order to satisfy the jurisdictional prerequisites for an infringement action, registration with the Copyright Office is a must.”), *adopted in relevant part, rejected in part*, 601 F. Supp. 2d 403 (D.P.R. 2009).
12. *Amador v. Sears Roebuck de Puerto Rico, Inc.*, Civ. No. 08-1581, 2009 WL 1076303, at \*1 (D.P.R. Apr. 21, 2009) (“Under 17 U.S.C. § 411(a), copyright registration is a necessary jurisdictional predicate to a claim for infringement.”).

District of Rhode Island

13. *Forasté v. Brown University*, 248 F. Supp. 2d 71, 76 (D.R.I. 2003) (“registration is a condition precedent and a jurisdictional prerequisite to the filing of an infringement action”).

**Court of Appeals for the Second Circuit**

14. *Morris v. Business Concepts, Inc.*, 259 F.3d 65, 72 (2d Cir. 2001) (“subject matter jurisdiction was lacking because the registration requirement of § 411(a) was not satisfied in this case”), *amended on other grounds*, 283 F.3d 502 (2d Cir. 2002).
15. *Well-Made Toy Manufacturing Corp. v. Goffa International Corp.*, 354 F.3d 112, 115 (2d Cir. 2003) (“This registration requirement is jurisdictional.”).
16. *Boone v. Jackson*, 206 F. App’x 30, 31 n.1 (2d Cir. 2006) (411(a) “provid[es] no federal jurisdiction over an infringement action” until after registration).
17. *In re Literary Works in Electronic Databases Copyright Litigation*, 509 F.3d 116, 122 (2d Cir. 2007) (“we again conclude that section 411(a)’s registration requirement limits a district court’s subject matter jurisdiction to claims arising from registered copyrights only”), *cert. granted sub nom. Reed Elsevier, Inc. v. Muchnick*, 129 S. Ct. 1523 (2009).

District of Connecticut

18. *Frontier Group, Inc. v. Northwest Drafting & Design, Inc.*, 493 F. Supp. 2d 291, 301 (D. Conn. 2007) (“This registration requirement is jurisdictional.”).



Eastern District of New York

19. *Goldberg v. "Doe,"* No. CV-85-4293, 1987 WL 4849, at \*2 (E.D.N.Y. April 29, 1987) ("Since plaintiff concedes that he did not register his copyright prior to commencing this action, the Court lacks jurisdiction to adjudicate his claims.").
20. *Capitol Records, Inc. v. Wings Digital Corp.,* 218 F. Supp. 2d 280, 283-84 (E.D.N.Y. 2002) (granting 12(b)(1) motion to dismiss claims that had not satisfied Section 411(a) because of "lack of subject matter jurisdiction.").
21. *Well-Made Toy Manufacturing Corp. v. Goffa International Corp.,* 210 F. Supp. 2d 147, 157 (E.D.N.Y. 2002) ("jurisdictional prerequisite"), *aff'd*, 354 F.3d 112 (2d Cir. 2003).
22. *AMC Film Holdings LLC v. Rosenberg,* No. 03CV3835, 2005 WL 2105792, at \*2 (E.D.N.Y. Aug. 31, 2005) ("This registration requirement is jurisdictional.").
23. *BMG Music v. Pena,* No. 05 CV 2310, 2007 WL 2089367, at \*2 (E.D.N.Y. July 19, 2007) ("Registration of copyright is a jurisdictional prerequisite to bringing a copyright infringement suit in federal court.").

Northern District of New York

24. *Bartell v. Onbank,* No. 95-CV-1807, 1996 WL 421189, at \*3 (N.D.N.Y. July 19, 1996) (denying motion to dismiss for "lack of subject matter jurisdiction" on condition that plaintiffs file

amended complaint reflecting registration numbers).

25. *Ogindo v. DeFleur*, No. 07-CV-1332, 2008 WL 5105153, at \*6 (N.D.N.Y. Oct. 16, 2008) (raising question of subject-matter jurisdiction *sua sponte* and dismissing copyright claim for lack of jurisdiction because plaintiff failed to allege registration of his works), *reconsideration denied*, 2008 WL 5105157, at \*1 (N.D.N.Y. Dec. 1, 2008) (reiterating jurisdictional nature of Section 411).

#### Southern District of New York

26. *Frankel v. Stein & Day, Inc.*, 470 F. Supp. 209, 212 n.2 (S.D.N.Y. 1979), *aff'd mem.*, 646 F.2d 560 (2d Cir. 1980) (under Section 411, a “question arises as to the court’s jurisdiction over this action.”).
27. *Conan Properties, Inc. v. Mattel, Inc.*, 601 F. Supp. 1179, 1182 (S.D.N.Y. 1984) (“Although recitation of the fact that copyrights have been registered appears to be a mere technicality, it is a prerequisite to this court’s jurisdiction.”).
28. *Techniques, Inc. v. Rohn*, 592 F. Supp. 1195, 1197 (S.D.N.Y. 1984) (“Pursuant to 17 U.S.C. § 411(a) as well as its predecessor, § 13, it has been held repeatedly that ownership of a copyright Registration is a jurisdictional prerequisite to an action for infringement.”).

29. *Tooker v. Copley*, No. 86 Civ. 6210, 1987 WL 124315, at \*1 (S.D.N.Y. Mar. 24, 1987) (“Adherence to [§ 411(a)] is a prerequisite to federal subject matter jurisdiction.”).
30. *Siskind v. Newton-John*, No. 84 Civ. 2634, 1987 WL 11701, at \*4 (S.D.N.Y. May 22, 1987) (“This requirement is jurisdictional.”).
31. *Demetriades v. Kaufmann*, 680 F. Supp. 658, 661 (S.D.N.Y. 1988) (“Receipt of an actual certificate of registration or denial of same is a jurisdictional requirement. . .”).
32. *Kenbrooke Fabrics, Inc. v. Soho Fashions, Inc.*, 690 F. Supp. 298, 299 (S.D.N.Y. 1988) (“jurisdictional prerequisites”).
33. *Hudson’s Bay Co. of New York, Inc. v. Seattle Fur Exchange, Inc.*, 15 U.S.P.Q.2d 1316, 1317 (S.D.N.Y. 1990) (“Section 411(a) of the Copyright Act clearly and unambiguously requires that the copyright office make a determination regarding registration before a . . . court has jurisdiction over an infringement action.”).
34. *Kelly v. L.L. Cool J*, 145 F.R.D. 32, 37 n.6 (S.D.N.Y. 1992) (“jurisdictional prerequisite”), *aff’d mem.*, 23 F.3d 398 (2d Cir. 1994).
35. *Greenwich Film Productions S.A. v. DRG Records, Inc.*, 25 U.S.P.Q.2d 1435, 1438 (S.D.N.Y. 1992) (“Absent such registration, courts cannot exercise jurisdiction and the claim must be dismissed.”).

36. *Reid v. ASCAP*, No. 92 Civ. 270, 1994 WL 3409, at \*2 (S.D.N.Y. Jan. 5, 1994) (“jurisdictional defect”).
37. *Carter v. Helmsley-Spear, Inc.*, 861 F. Supp. 303, 331 (S.D.N.Y. 1994) (“Because proper registration is a prerequisite to an infringement suit, this Court is without jurisdiction to decide plaintiffs’ claim that defendants have infringed their copyright in the Work.”), *aff’d in part, rev’d in part on other grounds*, 71 F.3d 77 (2d Cir. 1995).
38. *Geritrex Corp. v. Dermarite Industries, LLC*, 910 F. Supp. 955, 966 (S.D.N.Y. 1996) (without registration, “this court is without jurisdiction to decide plaintiff’s claim for copyright infringement”).
39. *Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 44 U.S.P.Q.2d 1475, 1477 (S.D.N.Y. 1997) (“jurisdictional prerequisite”), *aff’d per curiam*, 164 F.3d 110 (2d Cir. 1999).
40. *Boyle v. Stephens, Inc.*, No. 97 Civ. 1351, 1997 WL 529006, at \*3 (S.D.N.Y. Aug. 26, 1997) (“District courts are without subject matter jurisdiction to hear claims for federal copyright infringement unless a plaintiff asserts in his pleadings that he has received an actual certificate of registration or its denial from the Copyright Office”), *aff’d*, 21 F. App’x 76 (2d Cir. 2001).
41. *J. Racenstein & Co. v. Wallace*, No. 96 Civ. 9222, 1997 WL 605107, at \*1 (S.D.N.Y. Oct. 1, 1997) (“Where there is no registration, a federal

district court lacks subject matter jurisdiction to hear claims for infringement arising under the Copyright Act.”).

42. *Noble v. Town Sports International, Inc.*, No. 96 Civ. 4257, 1998 WL 43127, at \*2 (S.D.N.Y. Feb. 2, 1998) (dismissing for “lack of federal subject matter jurisdiction” because registration certificate had not been issued).
43. *Gillespie v. AST Sportswear, Inc.*, No. 97 Civ. 1911, 1998 WL 289681, at \*2 (S.D.N.Y. June 4, 1998) (“Absent proper registration of the materials at issue, this Court lacks jurisdiction over a claim of copyright infringement.”).
44. *Tuff-N-Rumble Management, Inc. v. Sugarhill Music Publishing Inc.*, 49 F. Supp. 2d 673, 677 (S.D.N.Y. 1999) (“Thus, district courts are without subject matter jurisdiction to hear claims for federal copyright infringement unless a party asserts in his pleadings that he has received an actual certificate of registration or its denial from the Copyright Office.”).
45. *IBS Ketel, Ltd. v. Hanil Bank, Korea*, No. 98 Civ. 3507, 1999 WL 639696, at \*2 (S.D.N.Y. Aug. 23, 1999) (“a district court lacks subject matter jurisdiction unless a plaintiff alleges in the pleadings that the Copyright Office issued a certificate of registration or denied plaintiff’s application for such a certificate”).
46. *Yurman Design Inc. v. Chaindom Enterprises, Inc.*, 53 U.S.P.Q.2d 1590, 1594 (S.D.N.Y. 1999) ([T]he Court does not have jurisdiction over Chaindom’s claim for copyright infringement

because Chaindom has submitted an application but has not yet received a certificate of registration or a denial from the Copyright Office.”), *aff'd*, 4 F. App'x 48 (2d Cir. 2001).

47. *Lennon v. Seaman*, 84 F. Supp. 2d 522, 524 (S.D.N.Y. 2000) (“jurisdictional prerequisite”).
48. *Vapac Music Publishing, Inc. v. Tuff 'N' Rumble Management*, 55 U.S.P.Q.2d 1763, 1765 (S.D.N.Y. 2000) (“‘Registration, or attempted registration, with the Copyright Office . . . is the requirement for establishing federal subject matter jurisdiction.’”) (quoting precedents).
49. *City Merchandise, Inc. v. Kings Overseas Corp.*, No. 99 Civ. 10456, 2001 WL 286724, at \*2 (S.D.N.Y. Mar. 23, 2001) (“It is well settled that the court lacks subject matter jurisdiction unless the claimant has a registration or its registration has been refused.”).
50. *Hanft Byrne Raboy & Partners Inc. v. Matsushita Electric Corp. of America*, No. 00 Civ. 2990, 2001 WL 456346, at \*3 (S.D.N.Y. May 1, 2001) (“jurisdictional prerequisite”).
51. *Archie Comic Publications, Inc. v. DeCarlo*, No. 00 Civ. 5686, 2001 WL 831250, at \*1 (S.D.N.Y. July 23, 2001) (“The amended counterclaims nowhere allege that plaintiff has obtained certificates of registration for the allegedly infringed copyrights. Accordingly, the Court lacks jurisdiction over the subject matter of the fifth and sixth counterclaims.”).
52. *U-Neek, Inc. v. Wal-Mart Stores, Inc.*, 147 F. Supp. 2d 158, 159 (S.D.N.Y. 2001) (“It is well

settled that the court lacks subject matter jurisdiction unless the claimant has a registration or its registration has been denied.”).

53. *McBride v. The Source Merchandising, LLC*, No. 01 Civ. 8103, 2002 WL 2012610, at \*3 (S.D.N.Y. Sept. 3, 2002) (“Further, plaintiffs cannot bring this action under federal question jurisdiction. An action for federal copyright infringement does not lie until the copyrighted material has been registered. *See* 17 U.S.C. § 411(a).”).
54. *Corbis Corp. v. UGO Networks, Inc.*, 322 F. Supp. 2d 520, 521, 522 (S.D.N.Y. 2004) (dismissing infringement claims because the “Court lacks subject matter jurisdiction” over claims that fail to meet the “jurisdictional prerequisites” of Section 411(a)).
55. *Greene v. Columbia Records/Sony Music Entertainment Inc.*, No. 03 Civ. 4333, 2004 WL 3211771, at \*3 (S.D.N.Y. Mar. 1, 2004) (“plain language of Section 411(a) indicates that a federal district court lacks subject matter jurisdiction”).
56. *I.M.S. Inquiry Management Systems, Ltd. v. Berkshire Information Systems, Inc.*, 307 F. Supp. 2d 521, 526 (S.D.N.Y. 2004) (“The registration requirement is jurisdictional; a lack of registration bars an infringement claim.”).
57. *Tabachnik v. Dorsey*, 04 Civ. 9865, 2005 U.S. Dist. LEXIS 14267, at \*10-\*11 (S.D.N.Y. July 15, 2005) (dismissing complaint “for lack of subject matter jurisdiction” because absent registration,

the court “lacked jurisdiction”), *aff’d*, 257 F. App’x 409 (2d Cir. 2007).

58. *Kenny v. Ryan Web Solution, LLC*, No. 05 Civ. 0727, 2005 WL 1719878, at \*1 (S.D.N.Y. July 22, 2005) (permitting amended complaint to cure “jurisdictional defect” of lack of registration that had prompted court to dismiss for “lack of subject matter jurisdiction”).
59. *eScholar, LLC v. Otis Educational Systems, Inc.*, 76 U.S.P.Q.2d 1880, 1887 (S.D.N.Y. 2005) (“A valid copyright [registration] is a prerequisite for subject matter jurisdiction.”).
60. *Caldwell v. Rudnick*, No. 05 Civ. 7382, 2006 WL 2109454, at \*2 (S.D.N.Y. July 26, 2006) (“a plaintiff’s failure to register a copyright before bringing an infringement action requires dismissal on jurisdictional grounds”).
61. *Richard Feiner & Co. v. New York Times Co.*, No. 07 Civ. 11218, 2008 WL 2963550, at \*2 (S.D.N.Y. Aug. 1, 2008) (“Copyright registration is a jurisdictional prerequisite to an infringement suit.”) (quoting precedent).
62. *Muniz v. Morillo*, No. 06 Civ. 6570, 2008 WL 4219073, at \*3 (S.D.N.Y. Sept. 10, 2008) (“a district court does not have subject matter jurisdiction over an infringement claim until the Copyright Office either issues a certificate of registration or rejects the application”).
63. *Eyal R.D. Corp. v. Jewalex New York, Ltd.*, 576 F. Supp. 2d 626, 633 (S.D.N.Y. 2008) (“in the absence of a valid copyright registration the



Court lacks subject matter jurisdiction over an action for infringement”).

64. *Goffe v. Winfrey*, No. 08 Civ. 8653, 2008 WL 4787515 at \*1 (S.D.N.Y. Oct. 31, 2008) (“without a properly registered copyright, this Court must dismiss any claims brought under 17 U.S.C. § 501 for lack of jurisdiction”) (raising jurisdictional and pleading issues *sua sponte*).
65. *R.F.M.A.S., Inc. v. So*, 619 F. Supp. 2d 39, 51 (S.D.N.Y. 2009) (“barring some applicable exception, the absence of a valid copyright registration divests the Court of subject matter jurisdiction over an action for copyright infringement”).
66. *Business Management International, Inc. v. Labyrinth Business Solutions, LLC*, No. 05 Civ. 6738, 2009 WL 790048, at \*11 (S.D.N.Y. Mar, 24, 2009) (“This registration requirement limits a district court’s subject-matter jurisdiction to claims arising from registered copyrights. . . .”).
67. *DO Denim, LLC v. Fried Denim, Inc.*, No. 08 Civ. 10947, 2009 U.S. Dist. LEXIS 51512, at \*8 (S.D.N.Y. June 17, 2009) (“[t]he plain language of the statute compels dismissal of Plaintiff’s copyright claims for lack of subject matter jurisdiction” when the claims rest on unregistered works).
68. *Simplexgrinnell LP v. Integrated Systems & Power, Inc.*, No. 07 Civ. 2700, 2009 U.S. Dist. LEXIS 64684, at \*18 (S.D.N.Y. July 27, 2009) (“the Court is without jurisdiction over claims of infringement in unregistered works”).

Western District of New York

69. *Toms v. Pizzo*, 4 F. Supp. 2d 178, 185 (W.D.N.Y. 1998) (“jurisdictional prerequisite”), *aff’d mem.*, 172 F.3d 38 (2d Cir. 1998).

**Court of Appeals for the Third Circuit**

70. *Raquel v. Education Management Corp.*, 196 F.3d 171, 176, 180 (3d Cir. 1999) (affirming dismissal for “lack of subject matter jurisdiction” because of failure to satisfy “jurisdictional requirement of 17 U.S.C. § 411(a)”), *vacated and remanded on other grounds*, 531 U.S. 952 (2000).

District of Delaware

71. *SportsMEDIA Technology Corp. v. Upchurch*, 839 F. Supp. 8, 9 (D. Del. 1993) (“jurisdictional defect”).

District of New Jersey

72. *Wellness Publishing v. Barefoot*, Civ. Action No. 02-3773, 2008 WL 108889, at \*8 (D.N.J. Jan. 9, 2008) (“The terms of the statute are clear and unambiguous, and its requirements are jurisdictional.”).
73. *Mortgage Market Guide, LLC v. Freedman Report, LLC*, Civ. Action No. 06-cv-140-FLW, 2008 WL 2991570, at \*14 (D.N.J. July 28, 2008)

“Copyright registration is a jurisdictional prerequisite to bringing an action for infringement under the Copyright Act.”).

Eastern District of Pennsylvania

74. *Blue Fish Clothing, Inc. v. Kat Prints*, Civ. Action No. 91-1511, 1991 WL 71113, at \*1 (E.D. Pa. Apr. 29, 1991) (“prerequisite to the court’s jurisdiction”).
75. *Cameron v. Graphic Management Associates, Inc.*, 817 F. Supp. 19, 22 (E.D. Pa. 1992) (“so long as the copyright was registered prior to the filing of the lawsuit, the court has jurisdiction to hear the claim”).
76. *Hung Tang v. Ho Yong Hwang*, 799 F. Supp. 499, 503 (E.D. Pa. 1992) (“the registration or the application for copyright registration . . . is a jurisdictional prerequisite to a suit for infringement”).
77. *McCormick v. Fugerson*, 34 U.S.P.Q.2d 1735 (E.D. Pa. 1995) (“jurisdictional requirements”).
78. *Sungard Data Systems, Inc. v. Devlin*, 37 U.S.P.Q.2d 1190, 1193, 1194 (E.D. Pa. 1995) (referring to “jurisdictional test” and “jurisdictional requirements of 17 U.S.C. Section 411(a)”).
79. *Morelli v. Tiffany & Co.*, 186 F. Supp. 2d 563, 565 (E.D. Pa. 2002) (“jurisdictional question”).

80. *Zimmer v. CooperNeff Advisors, Inc.*, Civ. Action No. 04-3816, 2004 WL 2933979, at \*2 (E.D. Pa. Dec. 20, 2004) (“this Court determined that Zimmer could not satisfy the prerequisites of Section 411(a) of the Copyright Act to maintain his copyright infringement claim” and so “granted CooperNeff’s Motion to Dismiss for Lack of Subject Matter Jurisdiction”), *vacated on other grounds*, 523 F.3d 224 (3d Cir. 2008).

Western District of Pennsylvania

81. *Harris v. Morgan*, Civ. Action No. 98-639, 1999 WL 34977892, at \*2 (W.D. Pa. Nov. 4, 1999) (“jurisdictional prerequisite” of Section 411(a) prevented court from adjudicating infringement claims based on 99,000 photographic images).
82. *Tegg Corp. v. Beckstrom Electric Co.*, 87 U.S.P.Q.2d 1880, 1885 (W.D. Pa. 2008) (“the Court acknowledges that Plaintiff has obtained copyright registrations from the Copyright Office and is satisfied that it can exercise subject matter jurisdiction over the Plaintiff’s copyright infringement claims, if properly pled”).
83. *Morgan v. Hanna Holdings, Inc.*, Civ. Action No. 07-803, 2009 WL 1871626, at \*3 (W.D. Pa. June 29, 2009) (“This registration requirement is jurisdictional.”).

**Court of Appeals for the Fourth Circuit**

84. *Xoom, Inc. v. Imageline, Inc.*, 323 F.3d 279, 283 (4th Cir. 2003) (“Copyright registration is a jurisdictional prerequisite to bringing an action for infringement under the Copyright Act.”).

District of Maryland

85. *Araya v. Latino Publishing, Inc.*, Civ. Action No. AW-00-1571, 2001 WL 436155, at \*2 (D. Md. Apr. 20, 2001) (“Without proof of registration, the Court lacks subject matter jurisdiction and will not discuss the merits of Defendants’ alternative grounds for dismissal.”).
86. *Berlyn, Inc. v. The Gazette Newspapers, Inc.*, 157 F. Supp. 2d 609, 623 (D. Md. 2001) (recognizing “copyright registration as a jurisdictional prerequisite”).
87. *Mays & Associates, Inc. v. Euler*, 370 F. Supp. 2d 362, 370 (D. Md. 2005) (“the plain language of the Copyright Act, reflecting sound public policy, requires registration of a copyright or denial of same as jurisdictional prerequisites”).
88. *Smoot v. Simmons*, Civ. Action No. RDB 05-3106, 2006 WL 1999203, at \*5 (D. Md. July 14, 2006) (“axiomatic” that registration is necessary for subject-matter jurisdiction).
89. *Scholz Design, Inc. v. Zimmerman*, Civ. Action No. DKC 08-1759, 2009 U.S. Dist. LEXIS 62689,

at \*10 (D. Md. July 22, 2009) (“in the absence of a copyright registration for the Masco House Special, the court lacks subject matter jurisdiction over Plaintiff’s copyright infringement claim”).

Middle District of North Carolina

90. *Iconbazaar L.L.C. v. America Online, Inc.*, 308 F. Supp. 2d 630, 632 (M.D.N.C. 2004) (“neither party disputes that registration is a jurisdictional prerequisite”).

Western District of North Carolina

91. *Carriker v. A&M Records*, No. 3:96CV476-P, 1997 U.S. Dist. LEXIS 10934, at \*1 (W.D.N.C. June 30, 1997) (“Because the pro se Plaintiff failed to show the Court that he has registered the alleged copyrighted works, the Court lacks subject matter jurisdiction over the Plaintiff’s claims.”).
92. *Pure Country Weavers, Inc. v. Bristar, Inc.*, 410 F. Supp. 2d 439, 443 & *passim* (W.D.N.C. 2006) (addressing registration issue before other challenges because registration is a matter of “subject matter jurisdiction”).

District of South Carolina

93. *Miller v. CP Chemicals, Inc.*, 808 F. Supp. 1238, 1241-42 (D.S.C. 1992) (registration is an “essential jurisdictional prerequisite”).

Eastern District of Virginia

94. *Young Design, Inc. v. Teletronics International, Inc.*, Civ. Action No. 00-970-A, 2001 WL 35804500, at \*12 (E.D. Va. July 31, 2001) (“this Court has subject matter jurisdiction over YDI’s copyright infringement action because the derivative work is properly registered”).
95. *Balzer & Associates., Inc. v. Union Bank & Trust Co.*, 2009 U.S. Dist. LEXIS 49710, at \*10 (E.D. Va. June 15, 2009) (“Because such registration is a ‘jurisdictional prerequisite,’ *Xoom, Inc.*, 323 F.3d at 283, to bringing a suit for infringement and seeking injunctive relief, the Court will grant Defendant’s Rule 12(b)(1) Motion to Dismiss Count I for lack of subject matter jurisdiction.”).

**Court of Appeals for the Fifth Circuit**

96. *Creations Unlimited, Inc. v. McCain*, 112 F.3d 814, 816 (5th Cir. 1997) (per curiam) (“registration with the copyright office is a *jurisdictional* prerequisite to filing a copyright infringement suit”) (emphasis original).

97. *Positive Black Talk Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 365 (5th Cir. 2004) (“jurisdictional prerequisite”).
98. *Starr v. DaimlerChrysler Corp.*, 252 F. App’x 590, 590 (5th Cir. 2007) (per curiam) (“Registration is a jurisdictional prerequisite to filing an infringement action.”).

Eastern District of Louisiana

99. *Makedwde Publishing Co. v. Johnson*, Civ. Action No. 91-0879, 1992 WL 125428, at \*1 (E.D. La. May 19, 1992) (Rule 12(b)(1) motion to dismiss for lack of “subject matter jurisdiction” denied “on the condition that . . . plaintiffs file an amended complaint alleging copyright registration in the song, Carnival Time”).
100. *Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 66 U.S.P.Q.2d 1468 (E.D. La. 2003) (“It is well-settled that registration with the Copyright Office is a jurisdictional prerequisite to filing a copyright infringement suit.”).
101. *Levingston Corp. v. DeWayles Ltd. International*, Civ. Action No. 07-7169, 2008 WL 449843, at \*1 (E.D. La. Feb. 13, 2008) (“*jurisdictional prerequisite*”) (emphasis original).



Middle District of Louisiana

102. *Trill Entertainment, LLC v. B C D Music Group, Inc.*, Civ. Action No. 07-559-JJB-SCR, 2008 WL 2354424, at \*2 (M.D. La. June 9, 2008) (“The Fifth Circuit has consistently held that registration is a ‘jurisdictional prerequisite to an infringement claim.’ . . . This jurisdictional defect can only be cured by registering the copyright and amending the complaint.”) (internal citation omitted).

Western District of Louisiana

103. *McConley v. Boise Building Solutions Manufacturing, L.L.C.*, Civ. Action No. 05-1006-A, 2006 WL 709599, at \*4 & n.2 (W.D. La. Mar. 21, 2006) (“jurisdictional defect”).
104. *Sartor v. Walters*, No. 06-0011, 84 U.S.P.Q.2d 128, 1281-83 (W.D. La. 2006) (“Registration of a copyright is a jurisdictional prerequisite to filing a copyright infringement suit. 17 U.S.C. § 411(a). . . . Because Sartor failed to register a copyright for the advertisements prior to filing suit, the Court lacks jurisdiction over this claim.”).

Southern District of Mississippi

105. *Starr v. DaimlerChrysler Corp.*, Civ. Action No. 2:05CV2107, 2006 WL 2175394, at \*2 (S.D. Miss. June 14, 2006) (“The plaintiff does not

even allege that she has either filed a copyright application for her model or received a copyright registration for it. The court is without subject matter jurisdiction to entertain the plaintiff's copyright infringement claim."), *aff'd per curiam*, 252 F. App'x 590 (5th Cir. 2007).

106. *Beau Rivage Resorts, Inc. v. Bel Aire Productions, Inc.*, Civ. Action No. 1:07cv49WJGJMR, 2008 WL 3978097, at \*2 (S.D. Miss. Aug. 20, 2008) ("Registration is a jurisdictional prerequisite to filing an infringement action.").

Eastern District of Texas

107. *Powerhouse Productions, Inc. v. Widgery*, No. 4:07-cv-071, 2008 WL 4331428, at \*3 (E.D. Tex. Sept. 17, 2008) ("Because, in the absence of such an allegation [of registration], the court lacks subject matter jurisdiction over the Plaintiffs' copyright infringement claim, . . . that claim should be dismissed without prejudice.").

Northern District of Texas

108. *Drake v. Malouf*, Civ. Action No. 3:99-CV-0315-G, 1999 WL 1007642, at \*3 (N.D. Tex. Nov. 5, 1999) ("Drake is correct that registration with the copyright office is a jurisdictional prerequisite to filing a copyright infringement claim.").

109. *Isbell v. DM Records, Inc.*, Civ. Action No. 3:02-CV-1408-G, 2004 WL 1243153, at \*3 (N.D. Tex. June 4, 2004) (“District courts are without subject matter jurisdiction to hear claims for federal copyright infringement unless a plaintiff asserts in its pleadings facts showing it has satisfied the statutory formalities found in section 411 of Title 17 of the United States Code.”).
110. *Busch v. Williams*, Civ. Action No. 3:06-CV-1352-D, 2007 WL 2254939, at \*2 (N.D. Tex. Feb. 7, 2007) (“jurisdictional prerequisite”).

Southern District of Texas

111. *Emme Bridal Inc. v. Milady Bridals Inc.*, 46 U.S.P.Q.2d 1555, 1561 (S.D. Tex. 1998) (“jurisdictional prerequisite”).
112. *Compliance Review Services, Inc. v. Davis-Osuawu*, Civ. Action No. H-04-3635, 2006 WL 3541715, at \*1 (S.D. Tex. Dec. 7, 2006) (“jurisdictional prerequisite”).

Western District of Texas

113. *Messina v. Hailey*, Civ. Action No. SA-07-CV-0469, 2008 WL 678580, at \*1 (W.D. Tex. Mar. 11, 2008) (“jurisdictional prerequisite”).

**Court of Appeals for the Sixth Circuit**

114. *Cawley v. Swearer*, No. 90-1981, 1991 WL 108725, at \*2 (6th Cir. June 20, 1991) (per curiam) (“Given Mr. Cawley’s failure to comply with the requirements of § 411(a), the district court was without jurisdiction to hear Counts II and III and should have dismissed them without prejudice on that ground.”).
115. *Buemi v. Lewis*, No. 94-4156, 1995 WL 149107, at \*2 (6th Cir. Apr. 4, 1995) (per curiam) (“Registration is a jurisdictional prerequisite to an infringement suit.”).
116. *Murray Hill Publications, Inc. v. ABC Communications, Inc.*, 264 F.3d 622, 632 (6th Cir. 2001) (“jurisdictional requirements”).

Eastern District of Kentucky

117. *National Information and Communications Equipment Network Inc. v. Willigan*, Civ. Action No. 06-28-DLB, 2007 WL 2979928, at \*10 (E.D. Ky. Oct. 11, 2007) (“Plaintiff’s admitted failure to register any of its alleged materials compels the dismissal of its copyright claim . . . without prejudice for lack of subject matter jurisdiction.”).

Western District of Kentucky

118. *Kettenburg v. University of Louisville*, Civ. Action No. 3:05CV384 R, 2005 WL 4444100

(W.D. Ky. Nov. 7, 2005) (“jurisdictional prerequisite”) (dismissal without any defendant’s response or motion noted on docket).

Eastern District of Michigan

119. *Derminer v. Kramer*, 386 F. Supp. 2d 905, 909, 913 (E.D. Mich. 2005) (“Although the parties do not raise the subject matter jurisdiction issues directly, I have a responsibility to do so. . . . I lack subject matter jurisdiction over all claims regarding copyrighted works for which Plaintiff provided no proof of registration. . . .”).
120. *Hawaiian Village Computer, Inc. v. Print Management Partners, Inc.*, 501 F. Supp. 2d 951, 954 (E.D. Mich. 2007) (“express language of the statute” requires registration for jurisdiction).
121. *Tenneco Automotive Operating Co. v. Kingdom Auto Parts*, No. 08-CV-10467, 2008 WL 2478317, at \*4 (E.D. Mich. June 17, 2008) (“jurisdictional requirement of a registered copyright”).

Western District of Michigan

122. *Marshall & Swift v. BS & A Software*, 871 F. Supp. 952, 958 (W.D. Mich. 1994) (“although the defendants have not specifically raised the jurisdictional issue, the court has examined the question and concludes that it lacks jurisdiction over Marshall’s claim of infringement”).

123. *Dekoven v. Avengical Press*, No. 4:98-CV-43, 1999 WL 34794967, at \*3 (W.D. Mich. May 12, 1999) (“It is undisputed that plaintiff has not registered his copyright. Consequently, this court lacks jurisdiction to entertain plaintiff’s claim for copyright infringement.”).
124. *Bird Brain, Inc. v. Menard, Inc.*, No. 1:00-CV-514, 2000 WL 35453916, at \*5 (W.D. Mich. Aug. 4, 2000) (acknowledging that “this court has previously interpreted Section 411(a) of the Copyright Act as requiring ‘registration [as] a jurisdictional prerequisite to the initiation of an infringement action in federal court,’” (internal citation omitted), *order corrected* (Aug. 23, 2000), *order modified* (Oct. 5, 2000).
125. *LaFace Records, LLC v. Does 1-5*, No. 2:07-cv-187, 2008 WL 513508, at \*4 (W.D. Mich. Feb. 22, 2008) (“jurisdictional requirement”).

#### Northern District of Ohio

126. *Stainbrook v. Fox Broadcasting Co.*, No. 3:05 CV 7380, 2006 WL 3757643, at \*8 (N.D. Ohio Dec. 19, 2006) (“this court does not have jurisdiction over Plaintiff’s copyright infringement claim under 17 U.S.C. § 411(a)”).

#### Southern District of Ohio

127. *Ripple Junction Design Co. v. Olaes Enterprises, Inc.*, No. 1:05-CV-43, 2005 WL 2206220, at \*5 (S.D. Ohio Sept. 8, 2005) (“Ripple Junction has

not met the condition precedent to filing an infringement suit and the Court does not have jurisdiction over its copyright infringement claims.”).

Middle District of Tennessee

128. *Journal Communications, Inc. v. Sabo*, No. 3:07-00605, 2008 WL 821524, at \*2 (M.D. Tenn. Mar. 26, 2008) (“The Court agrees that without a registered copyright, this Court lacks jurisdiction to entertain an infringement action.”).
129. *Specific Software Solutions, LLC v. Institute of WorkComp Advisors, LLC*, 615 F. Supp. 2d 708, 712 (M.D. Tenn. 2009) (“jurisdictional requirement of registration”).

**Court of Appeals for the Seventh Circuit**

Central District of Illinois

130. *Century Consultants, Ltd. v. Miller Group, Inc.*, No. 03-3105, 2006 WL 1985508, at \*3 (C.D. Ill. July 13, 2006) (registration is a “jurisdictional element”).

Northern District of Illinois

131. *Weigel Broadcasting Co. v. Topel*, No. 83 C 7921, 1985 WL 2360, at \*5 (N.D. Ill. Aug. 21, 1985) (“jurisdictional prerequisite”).
132. *Markovitz v. Camiros, Ltd.*, No. 02 C 9403, 2003 WL 21517364, at \*2 (N.D. Ill. June 30, 2003) (“Plaintiff’s individual work must be registered

in accordance with the Copyright Act for this Court to have proper subject matter jurisdiction.”).

133. *Leventhal v. Schenberg*, No. 03 C 8772, 2004 WL 1718512, at \*2 (N.D. Ill. July 30, 2004) (“Because Leventhal has failed to allege copyright registration, this Court is without subject matter jurisdiction, and the Complaint must be dismissed under Rule 12(b)(1).”).
134. *HyperQuest, Inc. v. N’Site Solutions, Inc.*, 559 F. Supp. 2d 918, 920 (N.D. Ill. 2008) (“Because plaintiff in that case had failed to register the claimed copyright, . . . the federal district court there had no jurisdiction – no power – to adjudicate the substantive copyright issue.”).
135. *Kluber Skahan & Associates, Inc. v. Cordogen, Clark & Associates, Inc.*, 90 U.S.P.Q.2d 1560, 1565 (N.D. Ill. 2009) (rejecting defendants’ challenge to validity of registration and “retaining jurisdiction”).

#### Northern District of Indiana

136. *Haan Crafts Corp. v. Craft Masters, Inc.*, 683 F. Supp. 1234, 1242 (N.D. Ind. 1988) (“jurisdictional requirement”).

#### Eastern District of Wisconsin

137. *Stanislawski v. Jordan*, 337 F. Supp. 2d 1103, 1110 (E.D. Wis. 2004) (“Failure to register a copyright or to have an application refused divests a court of subject matter jurisdiction.”).



**Court of Appeals for the Eighth Circuit**Western District of Arkansas

138. *Dodd v. Fort Smith Special School District No. 100*, 666 F. Supp. 1278, 1282 (W.D. Ark. 1987) (“jurisdictional prerequisite”) (court appears to have raised jurisdictional issue *sua sponte*: district judge noted that he had “some doubts as to whether subject matter jurisdiction existed in this case” and “requested the parties to brief several issues”).

Southern District of Iowa

139. *TMT Manufacturing, Inc. v. Illowa Resource Develop Inc.*, No. 3:08-cv-0106-JAJ, 2008 WL 4911850, at \*2 (S.D. Iowa Nov. 14, 2008) (“The case law is clear that copyright registration is a jurisdictional prerequisite to an infringement action under section 411.”).

District of Minnesota

140. *Proulx v. Hennepin Tech Centers District No. 287*, Civ. Action No. 4-79-637, 1981 U.S. Dist. LEXIS 17634, at \*10 (D. Minn. Dec. 7, 1981) (magistrate’s recommendation) (finding in response to Copyright Register’s motion to dismiss that “[i]t is settled that the requirements of § 411 are jurisdictional”), *adopted by court*, 1981 U.S. Dist. LEXIS 17575 (D. Minn. Dec. 30, 1981).
141. *Action Tapes, Inc. v. Mattson*, Civ. Action No. 04-935, 2004 WL 5551811 (D. Minn. July 9, 2004)

(subject-matter jurisdiction existed; evidence revealed valid registrations).

142. *Tri-Marketing, Inc. v. Mainstream Marketing Services, Inc.*, Civil Action No. 09-13, 2009 WL 1408741, at \*2 (D. Minn. May 19, 2009) (“jurisdictional requirements of § 411(a)”).

Eastern District of Missouri

143. *TVI, Inc. v. InfoSoft Technologies, Inc.*, No. 4:06CV00697JCH, 2006 WL 2850356 (E.D. Mo. Sept. 29, 2006) (“17 U.S.C. § 411(a) addresses when the Court has jurisdiction over a copyright infringement action.”).

Western District of Missouri

144. *Scarborough v. Johnson*, No. 06-0567-CV-W-ODS, 2007 WL 2609815, at \*1 (W.D. Mo. Sept. 5, 2007) (“Courts have construed this statutory command [of § 411(a)] as a jurisdictional requirement.”), *amended in other respects*, 2007 WL 2873499 (W.D. Mo. Sept. 25, 2007).

District of Nebraska

145. *Denenberg v. Berman*, 64 U.S.P.Q.2d 1054, 1055 (D. Neb. 2002) (treating § 411(a) as an issue of “subject-matter jurisdiction,” a “fundamentally preliminary . . . absolute stricture[] on the court” that cannot be waived by the parties; “Case law interpreting section 411 has made it clear that copyright registration is a jurisdictional prerequisite.”).

**Court of Appeals for the Ninth Circuit**

146. *Invision Media Services, Inc. v. Glen J. Lerner P.C.*, 175 F. App'x 904, 907 (9th Cir. 2006) (district court did not abuse discretion in awarding attorneys' fees because plaintiff's "failure to meet the jurisdictional prerequisite of registering its copyrights prior to filing suit, see 17 U.S.C. § 411(a), rendered its Copyright Act claims objectively unreasonable").
147. *Perfect 10, Inc. v. Amazon.com*, 508 F.3d 1146, 1154 n.1 (9th Cir. 2007) ("jurisdictional prerequisite").

District of Arizona

148. *Dalton-Ross Homes, Inc. v. Williams*, No. CV-06-1301-PCT-FJM, 2007 WL 2461892, at \*2 (D. Ariz. Aug. 29, 2007) ("jurisdictional issue," "jurisdictional prerequisite").
149. *Bean v. McDougal Littell*, 538 F. Supp. 2d 1196, 1198 (D. Ariz. 2008) ("jurisdictional prerequisite of registration").
150. *Designer Skin, LLC. v. S&L Vitamins, Inc.*, 560 F. Supp. 2d 811, 822 (D. Ariz. 2008) ("registration of a copyright claim is a jurisdictional prerequisite to an action for infringement").
151. *Giddings v. Vision House Production, Inc.*, 584 F. Supp. 2d 1222, 1226 (D. Ariz. 2008) (unregistered paintings are "outside this Court's subject matter jurisdiction").

Central District of California

152. *Dielsi v. Falk*, 916 F. Supp. 985, 994 (C.D. Cal. 1996) (“Plaintiff’s failure to plead that he has applied for a copyright registration deprives this court of subject matter jurisdiction over his copyright claim.”).
153. *Globe International, Inc. v. National Enquirer, Inc.*, No. 98-10613, 1999 WL 727232, at \*4 (C.D. Cal. Jan. 25, 1999) (“a federal court has no jurisdiction to hear the claim until the plaintiff has submitted a copyright registration”).
154. *Joyce v. Renaissance Design, Inc.*, 56 U.S.P.Q.2d 1541, 1544 (C.D. Cal. 2000) (failure to register “deprives this Court of subject matter jurisdiction over Plaintiff’s copyright claim”).
155. *Gable-Leigh, Inc. v. North American Miss*, No. CV 01-01019, 2001 WL 521695, at \*3-\*4 (C.D. Cal. Apr. 13, 2001) (addressing Section 411(a) as a “jurisdictional requirement” governing “subject matter jurisdiction”).
156. *Loree Rodkin Management Corp. v. Ross-Simmons, Inc.*, 315 F. Supp. 2d 1053, 1056 (C.D. Cal. 2004) (Section 411(a)’s “plain language . . . unavoidably leads to the conclusion that a federal district court lacks subject matter jurisdiction over a copyright claim if the certificate of registration is yet to be issued”).
157. *RDFMedia Ltd. v. Fox Broadcasting Co.*, 372 F. Supp. 2d 556, 562 (C.D. Cal. 2005) (“registration is a condition precedent for a court to exercise jurisdiction in an infringement action”).

Eastern District of California

158. *Proven Methods Seminars, LLC v. American Grants & Affordable Housing Institute, LLC*, 519 F. Supp. 2d 1057, 1063-64 (E.D. Cal. 2007) (section 411(a) controls “subject matter jurisdiction” and must be addressed before considering the plaintiff’s likelihood of success on the merits).

Northern District of California

159. *Tabra, Inc. v. Treasures de Paradise Designs, Inc.*, 20 U.S.P.Q.2d 1313 (N.D. Cal. 1992) (“Plaintiff obtained presumably valid registrations, upon which this court’s jurisdiction can be based. . .”).
160. *Determined Productions, Inc. v. Koster*, Nos. C 92-1697, C 92-2475, 1993 WL 120463, at \*1 (N.D. Cal. Apr. 13, 1993) (party committed a “fundamental registration error, which deprives this court of jurisdiction over the copyright claim”).
161. *Jefferson Airplane v. Berkeley Systems, Inc.*, 886 F. Supp. 713, 715 (N.D. Cal. 1994) (“jurisdictional prerequisite”).
162. *Ashlar Inc. v. Structural Dynamics Research Corp.*, 36 U.S.P.Q.2d 1402, 1405 (N.D. Cal. 1995) (“Section 411(a) requires registration of the copyright as a jurisdictional prerequisite to an infringement suit”), *aff’d per curiam*, 124 F.3d 228 (Fed. Cir. 1997).

163. *Oyster Software, Inc. v. Forms Processing, Inc.*, No. C-00-0724 JCS, 2001 WL 1736382, at \*11 (N.D. Cal. Dec. 6, 2001) (“Because Oyster does not allege that its copyright has actually been registered, the Court does not have subject matter jurisdiction over this claim under 17 U.S.C. § 411(a).”).
164. *In re Napster, Inc. Copyright Litigation*, 191 F. Supp. 2d 1087, 1101 (N.D. Cal. 2002) (“A copyright registration is a jurisdictional prerequisite to an infringement action. 17 U.S.C. § 411. For those fifteen works for which plaintiffs have not yet filed an application, this court lacks subject matter jurisdiction.”).
165. *Brush Creek Media, Inc. v. Boujaklian*, No. C-02-3491, 2002 WL 1906620, at \*2-\*3 (N.D. Cal. Aug. 19, 2002) (discussing whether application for registration suffices “to confer federal jurisdiction” before Register acts on application).
166. *Goodwin v. Best Plan, International, Ltd.*, No. C-04-2219EDL, 2004 WL 1924147, at \*1 (N.D. Cal. Aug. 30, 2004) (dismissing infringement claims for lack of “subject matter jurisdiction” because plaintiff did not allege registration, but granting leave for plaintiff to file an amended complaint alleging registration).
167. *Bespaq Corp. v. Haoshen Trading Co.*, No. C 04-3698, 2005 WL 14841, at \*2 (N.D. Cal. Jan. 3, 2005) (“the court would not have jurisdiction to hear claims of copyright infringement based on those items until the registrations are filed with the Copyright Office and cited in the complaint”).

168. *Kantemirov v. Goldine*, No. C05-01362 HRL, 2005 WL 1593533, at \*6 (N.D. Cal. June 29, 2005) (“jurisdictional prerequisite”).
169. *Just Water Heaters, Inc. v. Affordable Water Heaters & Plumbing, Inc.*, No. C 05 4996 SC, 2006 WL 449136, at \*2 (N.D. Cal. Feb. 23, 2006) (“A Court does not have jurisdiction over a copyright claim until the copyright has been registered. . .”).
170. *Identity Arts v. Best Buy Enterprise Services Inc.*, Nos. C 05-4656, C 06-1631, 2007 WL 1149155, at \*6 (N.D. Cal. Apr. 18, 2007) (“jurisdictional defect”), *aff’d mem.* 320 F. App’x 772 (9th Cir. 2009).
171. *Jonathan Browning, Inc. v. Venetian Casino Resort, LLC*, No. C Q7-3983, 2007 WL 4532214, at \*2 (N.D. Cal. Dec. 19, 2007) (adequate allegation of compliance with Section 411(a) gives court “subject matter jurisdiction”).

#### District of Nevada

172. *Salestraq America, LLC v. Zyskowski*, No. 2:08-CV-01368, 2009 WL 1652146, at \*2 (D. Nev. June 10, 2009) (“Courts generally agree that § 411(a) creates a condition precedent to a court’s exercise of subject matter jurisdiction in an infringement action.”).

#### District of Oregon

173. *Re-Creation v. Ty, Inc.*, Civ. Action No. 93-1380-FR, 1994 WL 41345, at \*1 (D. Or. Feb. 1, 1994)

(“jurisdictional standards of 28 U.S.C. §§ 1331 and 1338 and 17 U.S.C. § 411(a)”).

174. *Precision Automation, Inc. v. Technical Services, Inc.*, No. 07-CV-707-AC, 2008 WL 4449890, at \*3 (D. Or. Sept. 29, 2008) (“jurisdictional prerequisite”).

Western District of Washington

175. *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1111-13 (W.D. Wash. 2004) (“plain language of the Copyright Act” establishes that the “district court does not have subject matter jurisdiction over an infringement claim until the Copyright Office grants the registration application”).
176. *Painted Word, Inc. v. Haley’s Cottage*, No. C04-2229C, 2005 WL 1529592, at \*1 (W.D. Wash. June 23, 2005) (dismissing copyright claim for lack of “subject matter jurisdiction” because applications are still pending).
177. *Chihuly, Inc. v. Kaindl*, No. C05-1801-JPD, 2006 WL 83462, at \*2 (W.D. Wash. Jan. 11, 2006) (the court has “subject matter jurisdiction” because plaintiff alleged infringement of “approximately forty registered copyrights”).
178. *Kurtz v. Capgemini America, Inc.*, No. C05-1817JLR, 2006 WL 223754, at \*1 (W.D. Wash. Jan. 30, 2006) (court “lacks subject matter jurisdiction” and “is not free to rewrite the text of the Act”).



179. *Berry v. Penguin Group (USA), Inc.*, 448 F. Supp. 2d 1202, 1202 (W.D. Wash. 2006) (without a certificate of registration, the court “concludes that it lacks subject matter jurisdiction over this action”).
180. *Propet USA, Inc. v. Shugart*, No. C06-0186, 2007 WL 2766718, at \*1 (W.D. Wash. Sept. 19, 2007) (“the absence of copyright registrations deprives this Court of subject matter jurisdiction”).
181. *Lucky Break Wishbone Corp. v. Sears, Roebuck & Co.*, No. C06-312Z, 2007 WL 4561124 (W.D. Wash. Dec. 18, 2007) (court noted jurisdictional flaw, lack of registration, *sua sponte*), *motion for reconsideration denied in relevant part*, 2008 WL 189675, at \*5 (W.D. Wash. Jan. 18, 2008) (reiterating that court lacks jurisdiction over claims based on unregistered work).
182. *Safeair, Inc. v. Airtran Airways, Inc.*, No. 09-5053RJB, 2009 WL 801754, at \*2 (W.D. Wash. Mar. 25, 2009) (“A district court does not have subject matter jurisdiction over an infringement claim until the Copyright Office grants the registration application and issues a certificate of registration.”).

### **Court of Appeals for the Tenth Circuit**

183. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200 (10th Cir. 2005) (“411(a) is the jurisdictional linchpin to copyright infringement actions”).

District of Colorado

184. *Swarovski America Ltd. v. Silver Deer Ltd.*, 537 F. Supp. 1201, 1204 n.2 (D. Colo. 1982) (“jurisdictional prerequisite”).
185. *General Electric Property Management Co. of Colorado v. Broadcast Information Services, Inc.*, Civ. Action No. 88-A-325, 1988 WL 106018, at \*1 (D. Colo. Oct. 12, 1988) (court has “subject matter jurisdiction” only if work qualified for preregistration under Section 411(b) or was registered under Section 411(a)).
186. *Gates Rubber Co. v. Bando American, Inc.*, 798 F. Supp. 1499, 1503 (D. Colo. 1992) (“jurisdiction is appropriate as to the copyright infringement action as the Plaintiff has met the registration requirements of 17 U.S.C. § 411(a)”), *aff’d in part, vacated in part on other grounds*, 9 F.3d 823 (10th Cir. 1993).
187. *Home Design Services, Inc. v. B&B Custom Homes, LLC*, 81 U.S.P.Q.2d 1363, 1365 (D. Colo. 2006) (court has “subject matter jurisdiction” where plaintiff has “properly filed this action after registering its copyrights”).

District of Kansas

188. *Relational Design & Technology, Inc. v. Brock*, Civ. Action No. 91-2452-EEO, 1993 WL 191323, at \*5 & n.1 (D. Kan. May 25, 1993) (“jurisdictional prerequisite”).
189. *Westport Historical Society v. Lee*, 43 U.S.P.Q.2d 1858, 1860 (D. Kan. 1997) (“registration of a

copyright is a jurisdictional prerequisite to an infringement suit”).

190. *In re Independent Services Organizations Antitrust Litigation*, 964 F. Supp. 1469, 1474 (D. Kan. 1997) (“jurisdictional prerequisites”), *motions for reconsideration granted in part and denied in part on other grounds*, 964 F. Supp. 1479 (D. Kan. 1997), *motion for reconsideration denied and interlocutory appeal certified on other questions*, Civ. Action No. MDL-1021, 1997 WL 450028 (D. Kan. July 17, 1997), *permission to appeal denied*, 129 F.3d 132 (Fed. Cir. 1997) (unpublished table decision), *modified on other grounds*, 989 F. Supp. 1131 (D. Kan. 1997).
191. *Goebel v. Manis*, 39 F. Supp. 2d 1318, 1320 (D. Kan. 1999) (“plain language of the statute” requires registration to establish jurisdiction).
192. *Gerig v. Krause Publications, Inc.*, 33 F. Supp. 2d 1304, 1306 (D. Kan. 1999) (“The court recognizes there is some inconvenience in this course of action [dismissing the action and instructing the plaintiff to file a new action once he has properly registered under Section 411(a)], but subject matter jurisdiction requires no less.”).

#### Western District of Oklahoma

193. *Berry v. Borders Group, Inc.*, No. CIV-06-297-C, 2006 WL 2773198, at \*2, \*3, \*4 (W.D. Okla. Sept. 25, 2006) (Failure to satisfy Section 411(a)’s “jurisdictional prerequisites” and “jurisdictional requirements” means that the “Court

lacks power to rule on a substantive motion or enter judgment, it may only announce its lack of subject matter jurisdiction and dismiss the action.”).

### **Court of Appeals for the Eleventh Circuit**

194. *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488 (11th Cir. 1990) (“jurisdictional prerequisite”).
195. *Montgomery v. Noga*, 168 F.3d 1282, 1288 (11th Cir. 1999) (background statement of “basic principles of copyright law” notes that “[t]he registration requirement is a jurisdictional prerequisite to an infringement suit”) (quoting precedent).
196. *Brewer-Giorgio v. Producers Video, Inc.*, 216 F.3d 1281, 1285 (11th Cir. 2000) (jurisdictional nature of 411(a) is “well settled”).
197. *Watkins v. Southeastern Newspapers, Inc.*, 163 F. App’x 823 (11th Cir. 2006) (without registration, “the district court did not have jurisdiction to consider [the plaintiff’s] claims”).
198. *Oravec v. Sunny Isles Luxury Ventures L.C.*, 527 F.3d 1218, 1228-29 (11th Cir. 2008) (Section 411(a) establishes “jurisdiction prerequisite”).
199. *Stuart Weitzman, LLC v. Microcomputer Resources, Inc.*, 542 F.3d 859, 863 (11th Cir. 2008) (“the case law is clear that only those copyright holders that at least apply to register their copyrights may invoke the subject matter

jurisdiction of the federal courts in an infringement suit”).

200. *St. Luke’s Cataract & Laser Institute, P.A. v. Sanderson*, No. 08-11848, 2009 U.S. App. LEXIS 15268, at \*36 (11th Cir. July 9, 2009) (“the consensus among federal courts . . . is that § 411(a)’s registration requirement is a jurisdictional prerequisite to a copyright infringement suit”).

Southern District of Alabama

201. *Dapremont v. CFI Sales, Inc.*, Civ. Action No. 98-0836-BH-M, 1999 WL 34795810, at \*2 (S.D. Ala., May 25, 1999) (“The registration requirement is a jurisdictional prerequisite to an infringement action.’ Here, plaintiffs do not allege and have not shown the registration of a valid copyright on ‘the Cookin’ Cajun’ slogan or image.”) (citation omitted).
202. *Abbott v. Tyson*, Civ. Action No. 01-0111-CB-S, 2001 WL 228169, at \*2 (S.D. Ala. Feb. 16, 2001) (“Because Plaintiff has failed to obtain a copyright registration prior to filing this infringement action, the Court is without subject matter jurisdiction.”).

Middle District of Florida

203. *John Alden Homes, Inc. v. Kangas*, 142 F. Supp. 2d 1338, 1340 (M.D. Fla. 2001) (“jurisdictional prerequisite”), *aff’d*, 37 F. App’x 979 (11th Cir. 2002).

204. *Home Design Services, Inc. v. Green Horne Corp.*, No. 6:03CV425-ORL-22DAB, 2003 WL 21544165, at \*2 (M.D. Fla. May 30, 2003) (“In the absence of a Certificate of Registration this Court lacks subject matter jurisdiction.”).
205. *Kaye Homes, Inc. v. Original Custom Homes Corp.*, No. 2:07-cv-392-FtM-29SPC, 2007 WL 2407005, at \*2 (M.D. Fla. Aug. 20, 2007) (“jurisdictional statute”).
206. *Simplexgrinnell, L.P. v. Ghiran*, No. 2:07-cv-456-FtM-29DNF, 2007 WL 2480352, at \*2 (M.D. Fla. Aug 29, 2007) (“The Eleventh Circuit has held that registration is necessary for a federal court to have subject matter jurisdiction.”).

Southern District of Florida

207. *Rene Perez & Associates v. Almeida*, No. 96-1201-CIV-DAVIS, 1996 WL 541736, at \*3 (S.D. Fla. May 30, 1996) (“The language of the section 411(a) is clear and unambiguous: copyright registration is a jurisdictional prerequisite to a lawsuit for infringement.”).
208. *Telex Entertainment, Inc. v. Telemundo Network, Inc.*, No. 04-20150-CIV-GRAHAM, 2004 WL 3019373, at \*3 (S.D. Fla. Dec. 16, 2004) (failure to register “strips the Court of jurisdiction over the copyright claims”).
209. *SM Licensing Corp. v. U.S. Medical Care Holdings, L.L.C.*, No. 07-20293-CIV. 2007 WL 1238582, at \*1 (S.D. Fla. Apr. 26, 2007) (“In the Eleventh Circuit, simply filing an application for

copyright registration is not sufficient to provide federal courts with jurisdiction.”).

210. *Dellacasa, LLC v. John Moriarty & Associates of Florida, Inc.*, No. 07-21659-CIV. 2008 WL 299024, at \*12 (S.D. Fla. Feb. 1, 2008) (because plaintiff registered the contested copyrights, “the Court has subject matter jurisdiction over the instant copyright infringement action”).

Northern District of Georgia

211. *Pillsbury Co. v. Milky Way Productions*, 215 U.S.P.Q. 124, 127, 128 (N.D. Ga. 1981) (registration is necessary to “fulfill[] the jurisdictional prerequisites of the Copyright Act,” this is “axiomatic”).
212. *Georgia Television Co. v. TV News Clips of Atlanta, Inc.*, 718 F. Supp. 939, 951 (N.D. Ga. 1989) (“Registration is a condition precedent to the filing of an infringement action. . . . Section 411 is therefore a jurisdictional statute.”).
213. *Infodek, Inc. v. Meredith-Webb Printing Co., Inc.*, 830 F. Supp. 614, 620 n.6 (N.D. Ga. 1993) (“Section 411(a) of the Copyright Act of 1976 requires registration of the copyright as a jurisdictional prerequisite to an infringement suit.”).

Southern District of Georgia

214. *Watkins v. Southeastern Newspapers, Inc.*, Civ. Action No. CV 104-127, 2005 WL 1429894, at \*2

(S.D. Ga. June 17, 2005) (“jurisdictional requirement”), *aff’d*, 163 F. App’x 823 (11th Cir. 2006).

### **Court of Appeals for the District of Columbia Circuit**

#### District of the District of Columbia

215. *Strategy Source, Inc. v. Lee*, 233 F. Supp. 2d 1, 4 (D.D.C. 2002) (“The language of Section 411(a) is clear and unambiguous. . . . To conclude that registration or the refusal of registration by the Copyright Office are not jurisdictional prerequisites is to disregard the plain language of these statutes. . . .”).
216. *DSMC, Inc. v. Convera Corp.*, 479 F. Supp. 2d 68, 80 (D.D.C. 2007) (“jurisdictional prerequisite”).
217. *Prunté v. Universal Music Group*, 484 F. Supp. 2d 32, 40 (D.D.C. 2007) (Court found that the registration requirement had been satisfied by registration application and therefore “it [had] subject matter jurisdiction over Mr. Prunté’s infringement claims”).

### **Court of Appeals for the Federal Circuit**

218. *Siler v. United States*, 296 F. App’x 32, 33 (Fed. Cir. 2008) (“This is a jurisdictional requirement.”).
219. *Tavory v. NTP, Inc.*, 297 F. App’x 986, 989 n.1 (Fed. Cir. 2008) (applying law of the 4th Circuit) (“an invalid registration divests the court of



subject matter jurisdiction”), *cert. denied*, 129 S. Ct. 1677 (2009).

### Court of Federal Claims

220. *International Trade Management, Inc. v. United States*, 553 F. Supp. 402, 403 (Ct. Cl. 1982) (“[T]he language is clear. A suit for copyright infringement is conditioned on obtaining (or being denied) a certificate of registration. . . . [I]t is not for this court to second-guess Congress in the exercise of its authority to regulate the jurisdiction of the federal courts.”).
221. *Jennette v. United States*, 77 Fed. Cl. 132, 137 (2007) (dismissing copyright claim *sua sponte* for lack of jurisdiction, because plaintiff had not alleged registration) (“The provisions of 17 U.S.C. § 411(a) are jurisdictional.”).
222. *Walton v. United States*, 80 Fed. Cl. 251, 260 (2008) (“The consensus among federal appellate courts is that the provisions of 17 U.S.C. § 411(a) are jurisdictional.”), *aff’d*, 551 F.3d 1367 (Fed. Cir. 2009).
223. *Rice v. United States*, No. 08-734 C, 2009 WL 607404, at \*4 (Fed. Cl. Mar. 10, 2009) (Section 411(a) is jurisdictional and “[i]t is beyond cavil that no party can bring a copyright infringement claim without at least trying to register a copyright.”).
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