

THE EMPEROR HAS NO COPYRIGHT: REGISTRATION, CULTURAL HIERARCHY, AND THE MYTH OF AMERICAN COPYRIGHT MILITANCY

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ABSTRACT

This Article subverts the myth of American copyright militancy by providing a more nuanced view of our enforcement regime and detailing how, in the age of mechanical (and digital) reproduction, procedural niceties establish cultural hierarchy through the selective restoration of Benjaminian ‘aura’ to creative works. As it turns out, the Emperor has been sold a suit of copyright that leaves a surprising number of authors naked—without sufficiently meaningful remedies for infringements of their creative output. Copyrighted works are effectively placed into a hierarchy of protection that, in many ways, safeguards creators less vigorously than regimes in other countries. Through the use of ostensibly neutral formalities, the current system privileges the interests of repeat, sophisticated rights holders, often at the expense of smaller, less sophisticated creators. Moreover, existing law practically encourages certain kinds of infringement. In the end, sophisticated players enjoy powerful remedies when enforcing their copyrights. They dangle the legal Sword of Damocles—draconian statutory damages—over the heads of accused infringers, threatening to hand defendants their heads on a platter with more fervor than Salomé’s dance (to licensed music, of course). By sharp contrast, when they function as users of intellectual property (something all creators do), these same players often face only the most paltry of penalties for unauthorized exploitation—even when they infringe willfully. Our copyright regime therefore beatifies the works of elites—consecrating their cultural production as sacred texts and subjecting

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any use to permission and payment—while rendering the creative output of the rest of society into fodder for unauthorized manipulation and commercialization. The point of this analysis is not to call for even greater copyright protection for all creators. Rather, this Article deconstructs the beneficiaries of the existing regime and highlights the need for holistic reform that equalizes protection among different classes of authors and rights holders while also balancing the interests of copyright users.

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I. INTRODUCTION: ART, AURA, AND AUTHENTICITY

In his seminal meditation on art and technology, Walter Benjamin contemplated the transformative role of mechanical reproduction on society's relationship with creative works.¹ Specifically, he postulated that the increasing ease of replication would destroy art's *aura*—its perceived authenticity and ritualistic value. “For the first time in world history,” argued Benjamin, “mechanical reproduction emancipates the work of art from its parasitical dependence on ritual.”² To Benjamin, mass mechanical reproduction would result in the demystification of art by liberating it from its erstwhile settings. He concluded that “the technique of reproduction detaches the reproduced object from the domain of tradition. . . . [I]n permitting the reproduction to meet the beholder or listener in his own particular situation, it reactivates the object reproduced.”³

Benjamin's prescient views on art in the postmodern and digital eras have been widely appreciated.⁴ But just as nature cannot escape Newton's Third Law of Motion,⁵ there have been forces pushing against the inexorable march of technology. Benjamin underestimated the way in which law could emerge as a powerful countervailing force against the demystification of art. Indeed, as mechanical reproduction has flourished—thereby subverting art's *aura*—copyright law has concomitantly grown more robust—thereby policing authenticity and reaffirming the *aura*. In short, copyright law has served as a powerful bulwark against the demystifying tide of mechanical reproduction.

Copyright law, where it is most strictly applied, prohibits any kind of reproduction, whether manual or mechanical.⁶ It controls exhibition of

1. Walter Benjamin, *The Work of Art in the Age of Mechanical Reproductions*, in ILLUMINATIONS (Hannah Arendt ed., Harry Zohn trans. 1968).

2. *Id.* at 224.

3. *Id.* at 221.

4. See, e.g., Robert W. Sweeny, *Three Funerals and a Wedding: Simulation, Art Education, and an Aesthetics of Cloning*, 31 VISUAL ARTS RES. 60 (2005) (discussing Benjamin's theory in the context of mediating the relationship between art and developing technologies); LIZ WELLS, PHOTOGRAPHY: A CRITICAL INTRODUCTION (2004) (discussing Benjamin's argument that changes brought about by mechanical reproduction precipitated a sea change in attitudes toward the arts, especially photography); Najmeh Khalili, *Walter Benjamin Revisited: The Work of Cinema in the Age of Digital (Re)production*, OFFSCREEN, Oct 31, 2003, available at http://www.horschamp.qc.ca/new_offscreen/new_media.html (discussing digital media theory in light of Benjamin's work).

5. For every action, there is an equal and opposite reaction. See Isaac Newton, *Mathematical Principles of Natural Philosophy*, in THE AGE OF REASON 108 (Louise L. Snyder ed., 1955).

6. 17 U.S.C. § 106(1) (2006) (granting copyright holders the exclusive right to make any type of reproduction of a protected work).

works through public performance and display rights.⁷ And it carefully patrols a creative work's cultural value through the derivative-works doctrine.⁸ Moreover, the decoupling of a copyright from ownership of a physical object enables the exertion of control over a creative work to be distant and omnipresent. As Christian Stallberg points out, “[i]f intellectual works can be used everywhere, then the exclusive protection of those works restricts people everywhere.”⁹ After all, in the age of mechanical (and digital) reproduction, creative works can be disseminated universally. Yet copyright law imposes an artificial scarcity. It may do so with very good reason, but the consequences of this regulatory power bear careful scrutiny.

To understand the role of copyright law in enforcing artificial scarcity, this Article closely examines the practicalities of infringement litigation, specifically the issue of copyright registration and damages. Perhaps due to its banal technicalities, our registration regime has received little attention from academics, who have eschewed analysis of its various niceties in favor of more substantive aspects of copyright law. However, the registration system is deeply relevant to anyone attempting to enforce his or her copyright and, as such, plays a key role in understanding how copyright law functions in practice. As we shall see, the remedies afforded under the Copyright Act, and the prerequisites for their availability, inextricably affect infringement behavior. Moreover, they determine the types of works that are entitled, in the age of mechanical reproduction, to resurrect the Benjaminian *aura*, and the types of works that are not. As theory begets praxis, these seemingly procedural rules have a profound and substantive impact on the fundamental nature of our copyright regime. Specifically, the registration system reifies the divide between high and low-brow works, sustaining the *aura* of art according to a cultural hierarchy policed by legal formalities.

The implications of this gestalt are significant, contradicting one of the most oft-repeated axioms about our intellectual property laws: that we take copyright seriously and enforce it vigorously with one of the most protective regimes in the world. Academics, politicians, trade representatives, and the content-creation industries alike have reiterated this apparent truism time and time again.¹⁰ But it is not entirely accurate. In a sense, the Emperor has been

7. 17 U.S.C. §§ 106(4)–(5) (2006).

8. See 17 U.S.C. §§ 103, 106(2) (2006).

9. Christian G. Stallberg, *Towards a New Paradigm in Justifying Copyright: An Universalistic-Transcendental Approach*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 333, 337 (2008).

10. See, e.g., BÉNÉDICTE CALLAN, PIRATES ON THE HIGH SEAS: THE UNITED STATES AND GLOBAL INTELLECTUAL PROPERTY RIGHTS 1 (1998) (noting that, in recent years, the United States has “cast itself as the great proponent of intellectual property rights worldwide”).

sold a suit of copyright that leaves unsophisticated creators naked—that is, without sufficiently meaningful remedies for infringements of their creative works. Copyrighted works are effectively placed into a hierarchy of care that in many ways safeguards creators less vigorously than regimes in other countries. At its core, the current system privileges the interests of repeat, sophisticated, and monied rights holders—rights holders who are invariably also users of content. And it does so at the expense of smaller, less sophisticated creators and authors.¹¹ Moreover, existing law practically encourages certain kinds of infringement. Specifically, a vast disparity has emerged between sophisticated and unsophisticated creators of copyrightable content—a divide enforced through a single technical feature of our copyright regime: the registration requirement. For the sophisticated creators who timely register their copyrighted content, the inviolable aura of their works is virtually assured. For unsophisticated creators who fail to timely register their copyrighted content, their works enjoy only low-tier protection and remain vulnerable to unauthorized manipulation and appropriation.

By unfurling the unique importance of timely registration in shaping remedies, this Article punctures the myth of American copyright militancy. Part II examines how judicial interpretations of the Copyright Act have narrowed the availability of enhanced damages for continuing infringements, created a one-way risk of attorneys' fees assessments for unsophisticated plaintiffs, foreclosed availability of punitive and reputational damages, and, in short, left most authors at a comparative disadvantage in protecting their intellectual property rights in the United States vis-à-vis the rest of the world. As a result, the registration system has failed to achieve its basic notice function and has potentially shirked our international treaty obligations—a particularly salient problem in light of our efforts to combat lax copyright enforcement in many developing countries.

Part III deconstructs the failure of prior efforts to amend the harsh results of the timely registration requirement. This analysis suggests that certain sophisticated, repeat players in the content industries derive the best of both worlds from the timely registration requirement. On one hand, they enjoy strong rights when seeking to enforce their copyrights, often wielding the threat of disproportional penalties against accused infringers. On the other hand, when they function as users of intellectual property (something all creators do), these same players often face only the most paltry of

11. One might argue that it is unsurprising that any aspect of our legal regime would privilege repeat players, but copyright law does so with extreme vigor. And the particular privileges that copyright law grants go against conventional wisdom on the subject.

penalties, even when they infringe willfully. Finally, Part IV assesses possible avenues for change and offers some caveats regarding outright repeal of the timely registration requirement. Specifically, upon consideration of the consequences of copyright law's remaining technicalities, this Article proposes holistic reform measures that place creators—both sophisticated and unsophisticated alike—on a relatively equal footing while balancing the rights of copyright holders with copyright users.

II. FORM FRUSTRATES FUNCTION? RE-EXAMINING COPYRIGHT'S REGISTRATION REQUIREMENT

A. CHALLENGING THE CONVENTIONAL WISDOM ON AMERICAN COPYRIGHT PROTECTION: CONTENT HIERARCHY AND THE REGISTRATION REQUIREMENT

Conventional wisdom maintains that we enjoy one of the world's most robust intellectual property regimes through our arduous protection of the exclusive right of creators to control the reproduction, distribution, and exploitation of their works. Indeed, we pride ourselves on our respect for creations of the mind, often analogizing the piracy of copyrighted works to the outright theft of tangible property.¹² This view is further buoyed by our reputation on the international scene and the heated rhetoric of federal officials and entertainment industry players in chastising some countries for their more lax intellectual property regimes. Our demands for stronger copyright enforcement abroad have led to high profile clashes with officials in such countries as China¹³ and Russia,¹⁴ where loose enforcement and rampant piracy have drawn our ire.

There are two limited exceptions, however, to this general proposition. First, as many observers have noted, our legal regime is less protective of the moral rights of creators than regimes in some other countries, especially

12. *See, e.g.*, *Grand Upright Music, Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 183 (S.D.N.Y. 1991) (concluding, upon considering the propriety of digital sampling without authorization, that “[t]hou shalt not steal”).

13. *See, e.g.*, WTO, China - Measures Affecting the Protection and Enforcement of Intellectual Property Rights, http://www.wto.org/english/tratop_e/dispu_e/cases_e/ds362_e.htm (last visited Oct. 25, 2009) (summarizing the conflict between the United States and China over the adequacy of latter country's intellectual property protection and enforcement mechanisms).

14. *See* David E. Miller, *Combating Copyright Infringement in Russia: A Comprehensive Approach for Western Plaintiffs*, 33 VAND. J. TRANSNAT'L L. 1203 (2000) (noting that American corporations lose millions of dollars each year as a result of the illegal reproduction and sale of copyrighted goods in Russia).

those in Western Europe.¹⁵ But, our resistance to moral rights has not been explained as a product of hostility towards copyright protection or even the rights of authors. Instead, it has been rationalized as a product of American capitalism and its desire to maximize the alienability of property rights and to preserve a marketplace for copyrighted works.¹⁶ Moral rights, we are told, may unduly interfere with the disposition of tangible property that incorporates copyrighted content.

Second, observers have pointed out that the hard line that the United States has taken on copyright issues is of relatively recent vintage. Specifically, these critics have questioned the moral undertones of the international North-South discourse on copyright protection by calling attention to the selective historical consciousness at play.¹⁷ Despite efforts by the United States and its copyright allies to pressure some developing countries to increase their enforcement efforts in combating piracy and protecting copyright, it is important to recognize that, at a similar point in our nation's development, we adamantly refused to recognize the copyrights of foreign authors. In short, until the early twentieth century, the United States was the most prominent rogue nation on the international copyright scene.

As law professor Harry G. Henn wrote in 1953, “[t]he United States has been among the most parochial of nations so far as copyright protection for published works is concerned. For over a hundred years, this nation not only denied copyright protection to published works by foreigners . . . but appeared to encourage the piracy of such works.”¹⁸ Our nation's first Copyright Act, passed in 1790, explicitly denied protection to any creative work “written, printed or published by any person not a citizen of the United States, in foreign parts or places without the jurisdiction of the United States.”¹⁹ Indeed, between 1800 and 1860, nearly fifty percent of the

15. Henry Hansmann & Marina Santilli, *Authors' and Artists' Moral Rights: A Comparative Legal and Economic Analysis*, 26 J. LEGAL STUD. 95, 95–97 (1997).

16. See, e.g., Lawrence A. Beyer, *Intentionalism, Art and the Suppression of Innovation: Film Colorization and the Philosophy of Moral Rights*, 82 NW. U. L. REV. 1011, 1047, 1052–54 (1988) (arguing that the moral right of integrity subverts both buyer and seller freedom in market transactions involving copyrighted works); Stephen L. Carter, *Owning What Doesn't Exist*, 13 HARV. J.L. & PUB. POL'Y 99, 101 (1990) (noting that the moral rights doctrine runs counter to traditional property rights notions by telling owners of paintings, films and other works that they “should not have the right to do with their possessions as they wish”).

17. Peter K. Yu, *The Copyright Divide*, 25 CARDOZO L. REV. 331 (2003).

18. Harry G. Henn, *The Quest for International Copyright Protection*, 39 CORNELL L. Q. 43, 52 (1953).

19. Act of May 31, 1790, ch. 15, 1 Stat. 124, § 5.

bestsellers in the United States were pirated English novels.²⁰ It was not until the end of the nineteenth century that things changed, after heavy lobbying by prominent British and American writers. Authors across the pond, such as Charles Dickens, were deprived of royalties for sales in the States. Domestic authors, such as Mark Twain,²¹ were being denied foreign royalties since other countries were reciprocally declining to grant copyright to American authors.²² Not until the passage of the International Copyright Act of 1891, also known as the Chace Act, would foreign authors finally enjoy copyright protection in the United States.²³

According to the popular narrative, such unabashedly piratical lapses are merely vestiges of a bygone era.²⁴ As a result, we continue to view our modern copyright regime as muscular and highly protective of creators. Indeed, many observers—myself included—have critiqued the growing magnitude of our copyright monopoly and how it has often come at the

20. Yu, *supra* note 17, at 341.

21. See, e.g., R. KENT RASMUSSEN, MARK TWAIN A TO Z: THE ESSENTIAL REFERENCE TO HIS LIFE AND WRITINGS 54 (1995). Rasmussen noted that

[t]he absence of international copyright laws allowed Canadian publishers to prey on Mark Twain's early books. He was hurt badly in 1876, when the Toronto publisher Charles Belford issued *Tom Sawyer* before the American edition even appeared. To combat this problem, Mark Twain spent several weeks in Montreal in November–December 1881 with James R. Osgood to meet a residency requirement to protect his *The Prince and the Pauper* copyright.

Id.

22. Prior to 1891, some foreign authors circumvented America's refusal to honor copyrights of foreign authors by having an American citizen collaborate in the publishing process. Usually, this would take the form of the American writing a short preface to the book and then registering the work with the U.S. Copyright Office under the collaborator's name. For example, Thomas Henry Huxley took this route to gain protection. See, e.g., Philip V. Allingham, *Nineteenth-Century British and American Copyright Law*, VICTORIANWEB, Jan. 5, 2001, <http://www.victorianweb.org/authors/dickens/pva/pva74.html> (detailing the technical subterfuge and arduous machinations required of British authors to obtain American copyright protection both before and after 1891, respectively).

23. Chace Act, ch. 565, 26 Stat. 1106, 1110 (1891).

24. According to the Council on Foreign Relations' American Intellectual Property Rights Policy Study Group, the merely "nominal protection" of intellectual property rights and "indifference and resistance from American officials . . . to enforce copyrights for literary works" in the nineteenth century has given way in recent years to a regime of strong enforcement, with the United States "cast[ing] itself as the great proponent of intellectual rights worldwide . . . [by] tak[ing] the moral high ground in the battle against international piracy and counterfeiting, denouncing unfair practices abroad and claiming that strong rights can only help the economy in developing countries." CALLAN, *supra* note 10, at 1.

expense of the public interest and the rights of users of expressive materials.²⁵

However, broadly speaking, the copyright regime is not nearly as uniformly protective of copyright holders and creators as we often think. On the surface, we appear to advance the interests of copyright holders with vigor—perhaps too much so. But, the formalities of copyright protection and enforcement reveal a more complex system at operation.

Through formalities, the 1976 Copyright Act actually created two distinct tiers of effective protection for copyrighted works. Sophisticated, routine creators—generally corporations in content-creation industries—timely register their works and therefore enjoy generous remedies against infringers. These remedies include the recovery of reasonable attorneys' fees and the assessment of statutory damages—which can rise to the draconian level of up to \$150,000 per willful act of infringement. Absent any proof of actual damages, such plaintiffs can elect statutory damages that quickly create the possibility of a multi-million dollar judgment in their favor. By sharp contrast, unsophisticated creators, like individual artists, typically do not timely register their works and are often left with little except moral force and the uncertain threat of injunctive relief to enforce their intellectual property rights. The dichotomy between sophisticated and unsophisticated creators thereby determines the relative sanctity of copyrighted works.

25. See, e.g., James Boyle, *The Second Enclosure Movement and the Construction of the Public Domain*, 66 LAW & CONTEMP. PROBS. 33, 34–37, 40–41 (2003) (questioning the recent expansion of intellectual property monopolies by comparing it to the enclosure movement of the eighteenth century); Jessica Littman, *Creative Reading*, 70 LAW & CONTEMP. PROBS. 175, 180 (2007) (criticizing the prevailing position that any use of an existing work constitutes an infringement unless specifically exempted from liability by law); Robert P. Merges, *One Hundred Years of Solicitude: Intellectual Property Law, 1900-2000*, 88 CALIF. L. REV. 2187, 2191 (2000) (characterizing the history of intellectual property rights over the past one-hundred years as a century of “solicitude” by corporate interests bent on maximizing monopoly-like protections for their intellectual properties); John Tehranian, *Et Tu, Fair Use? The Triumph of Natural-Law Copyright*, 38 U.C. DAVIS L. REV. 465, 466 (2005) (arguing that “the fair use doctrine has actually enabled the expansion of the copyright monopoly well beyond its original bounds and has undermined the goals of the copyright system as envisioned by the Framers of the Constitution.”); Rebecca Tushnet, *Copy This Essay: How the Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535 (2004) (criticizing existing copyright doctrine for failing to recognize adequately the public interest served through unauthorized non-transformative reproduction of copyrighted works); Pamela Samuelson, *The Copyright Grab*, WIRED.COM, Jan. 1996, http://www.wired.com/wired/archive/4.01/white.paper_pr.html (critiquing proposed expansions in copyright protection by the Clinton administration for their harm to the freedom and privacy of the general public).

B. REGISTRATION AND THE PIVOTAL ROLE OF STATUTORY DAMAGES
AND ATTORNEYS' FEES

The registration requirement is a critical aspect of the governing 1976 Copyright Act. Oddly enough, however, the abandonment of key formalities required for copyright protection was a purported hallmark of the Act.²⁶ Most notably, the Act vested an automatic federal copyright with authors from the moment that they fix an original work in a tangible medium, without the need for registration or any other procedural step.²⁷ Nevertheless, upon closer examination, the 1976 Act's general reputation for eschewing formalism appears vastly exaggerated.

While formalities for subsistence may have been eliminated under the 1976 Act, formalities for effective enforcement of a copyright actually *increased*. First, the 1976 Act retained its predecessor's requirement of registration prior to the filing of an infringement action.²⁸ Even more significantly, the 1976 Act dramatically expanded formalities in a key regard.

26. See, e.g., Shira Perlmutter, *Freeing Copyright from Formalities*, 13 CARDOZO ARTS & ENT. L.J. 565, 566, 568, 581 (2006). Perlmutter notes that

[f]ormalities have long been a hallmark of the American copyright system. . . . In the 1976 Act, Congress began the journey toward eliminating formalities from our copyright law The 1976 Copyright Act and adherence to the Berne Convention marked a sea change in U.S. copyright law—a profound shift in philosophy.

Id.; Malla Pollack, *Towards a Feminist Theory of the Public Domain, or Rejecting the Gendered Scope of United States Copyrightable and Patentable Subject Matter*, 12 WM. & MARY J. WOMEN & L. 603, 603–04 (2006) (“The Copyright Revision Act of 1976 moved the general line of protection from the point of publication to the point of fixation. In combination with the Berne Implementation Act, it eliminated most of the prior need for copyright formalities.”); see also Pamela Brannon, *Reforming Copyright To Foster Innovation: Providing Access To Orphaned Works*, 14 J. INTELL. PROP. L. 145, 145, 158 (2006) (“Copyright protection prior to the 1976 Act was attended by a bevy of formalities. . . . The 1976 Copyright Act discarded most of these formalities, shifting to an ‘opt-out’ system that granted copyright protection upon the initial creation and fixation of a work.”); Wendy J. Gordon, *Toward a Jurisprudence of Benefits: The Norms of Copyright and the Problem of Private Censorship*, 57 U. CHI. L. REV. 1009, 1010 (1990) (“One major reason for the increasing breadth of copyright scholarship is the 1976 Copyright Act, which simplified and rationalized the complexities and formalisms of prior law”); Matt Jackson, *The Digital Millennium Copyright Act of 1998: A Proposed Amendment to Accommodate Free Speech*, 5 COMM. L. & POL’Y 61, 71 (2000) (“Prior to the 1976 Copyright Act, authors had to comply with a laundry list of formalities in order to enjoy federal copyright protection.”).

27. 17 U.S.C. § 102(a) (2006) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”).

28. 17 U.S.C. § 411(a) (2006) (requiring registration of a copyrighted work prior to the initiation of an infringement suit based thereon).

Under 1909 Act, a prevailing plaintiff could recover statutory damages and attorneys' fees without timely registration.²⁹ All of that changed with the 1976 Act. What the 1976 Act gave to creators of copyrighted works through its purported reduction of vesting formalities, it more than took away through the imposition of timely registration as a precondition for recovery of statutory damages and attorneys' fees—two of the most powerful weapons in a copyright holder's arsenal.³⁰ Thus, although creative works are now "protected" under federal law from the moment of creation, litigation rarely makes sense without proper and timely registration. In an ordinary case of copyright infringement—where an infringed work is not registered before the infringement begins—a plaintiff can only recover actual damages that directly result from the defendant's action. As we shall see, such a remedy is rarely adequate to enable a copyright holder to vindicate his or her interests in even the most clear-cut and brazen case of infringement.

Moreover, rather than further harmonizing our copyright regime with those of other countries, the 1976 Act, through its timely registration requirement, has ironically enhanced the exceptionalism of the American copyright system. Specifically, the United States is the only major country in the world with a timely registration prerequisite for the recovery of certain forms of damages and attorneys' fees.³¹ In other countries, full legal vindication of one's exclusive rights does not require the added procedure of registration, let alone timely registration.³²

The registration requirement plays an instrumental role in the enforcement of copyright in the United States. As Nimmer reminds us,

29. 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[C][2] (2008). Nimmer states,

Under the 1909 Act . . . registration was only required . . . prior to the filing of an infringement action, and, in such an action, there might be a recovery (including, under the 1909 Act, statutory damages and attorney's fees) with respect to infringing acts that occurred prior to, as well as after, registration.

Id. (internal citations omitted).

30. Under the traditional American rule, parties bear the costs of their own representation, regardless of the outcome. By statute, however, prevailing plaintiffs in copyright infringement suits are eligible to receive their attorneys' fees—but only if the work was timely registered. Although the grant of fees lies squarely within the discretion of courts, prevailing plaintiffs often recover their fees. *See, e.g.*, *Columbia Pictures TV v. Krypton Broad. of Birmingham, Inc.*, 106 F.3d 284, 296 (9th Cir. 1997) (“[A] plaintiff in a copyright action is generally awarded fees by virtue of prevailing in the action . . .”).

31. 4 NIMMER & NIMMER, *supra* note 29, § 17.01.

32. *See, e.g., id.* § 17.03 (“[U]nlike the United States copyright law, under virtually all foreign copyright laws . . . there are no administrative formalities that must be satisfied in order to create or to perfect a copyright.”).

“statutory damages may often constitute the only meaningful remedy available to a copyright owner for infringement of his work.”³³ Yet not all copyright holders can qualify for statutory damages in an infringement suit—far from it, in fact. Under the reigning 1976 Copyright Act, statutory damages are only available to a certain class of copyright holders: those who register their works with the United States Copyright Office in a timely manner in relation to the infringement. The absence of timely registration also precludes an award of attorneys’ fees to a prevailing plaintiff. As 17 U.S.C. § 412 provides,

[N]o award of statutory damages or of attorney’s fees . . . shall be made for . . . any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.³⁴

Thus, to qualify for statutory damages and the potential recovery of attorneys’ fees, a copyright plaintiff must register before a defendant’s act of infringement or within ninety days of publication. Registration, especially timely registration, therefore represents a pivotal feature on the copyright landscape. Without it, a plaintiff’s remedies are dramatically constrained.

Assume, for example, that a pharmaceutical company usurps five of an artist’s illustrations, without permission, for use on the packaging of their new male enhancement drug. With proper and timely registration, the artist can immediately force the pharmaceutical company to pay attention to her infringement claims and to cease the infringing conduct. Even without a demonstration of actual damages or profit from the infringement, a suit would expose the defendant to potential liability for statutory damages in the amount of \$750,000 (\$150,000 for each of five acts of infringement), reimbursement of the artist’s reasonable attorneys’ fees, and expenditure of its own attorney’s fees.

Without proper and timely registration, however, the situation is radically different. The artist can generally recover only actual economic damages from the company—lost sales, or disgorgement of profits. Not surprisingly, the amount of these damages is often riddled with ambiguity. Moreover, unless the artist is world-renowned, her damages claim will rarely amount to more than a few thousand dollars. But pursuing an infringement suit will cost her several hundred thousand dollars in attorneys’ fees. And although the artist might receive an injunction to prevent further infringement, it will be

33. 2 *id.* § 7.16[C][1].

34. 17 U.S.C. § 412(2) (2006).

costly to obtain since the significant fees she would have to incur are not recoupable. Thus, even under the most optimistic scenario, legal action will not be worth pursuing, unless she has a desire to fight for principal and end up bankrupt. In short, the artist may ultimately recover \$5000 from the defendant, but such a victory would be pyrrhic at best, especially after accounting for the \$250,000 invoice from her attorney.³⁵

To make matters worse, a quarter of a million dollars is a conservative estimate for the cost of copyright litigation. According to the 2007 Report of the Economic Survey conducted by the American Intellectual Property Law Association, the mean cost of taking a relatively small instance of copyright infringement (one involving less than \$1 million in potential liability) to trial in United States is \$310,000.³⁶ For a middle-of-the-road infringement case (one involving \$1-\$25 million in potential liability), that figure rises to a mean of \$749,000.³⁷

As such, it frequently makes no economic sense to pursue litigation. The cost of filing a complaint in federal court will likely exceed the total amount of damages recoverable under even the most sanguine scenario. And this is true even though a defendant has undoubtedly infringed the work and done so with gusto. In short, the law fails to provide an effective remedy from the wrongdoing the artist has suffered at the hands of the pharmaceutical company, even though we think of our laws as protecting the sanctity and inviolability of intellectual property rights, especially when they are indisputably infringed.

This all-too-common situation allows large, sophisticated corporations to enforce their copyright with a vast array of tools, including statutory damages and attorneys' fees, while simultaneously enabling them to laugh in the face of less sophisticated players who lodge infringement claims against them. If you infringe the copyrights of the major motion picture studios or the major record labels, the specter of statutory damages and fees will squarely put you on the defensive. Witness the onslaught of suits against ordinary Americans filed by the Recording Industry Association of American (RIAA) for unauthorized peer-to-peer file sharing.³⁸ By contrast, if a large corporation

35. *See infra* text accompanying notes 150–55155.

36. AM. INTELL. PROP. LAW ASS'N, 2007 REPORT OF THE ECONOMIC SURVEY I-100 (2007).

37. *Id.* at I-101. When the amount at controversy exceeds \$25 million, the mean cost of taking a case to trial is \$1.292 million. *Id.*

38. Leslie Walker, *New Movement Hits Universities: Get Legal Music*, WASH. POST, Mar. 17, 2005, at E1 (noting that the RIAA has filed “thousands of suits against people for sharing copyrighted material”).

violates your copyright, it can often thumb its nose at claims of infringement. In many cases, there is little you can do since most copyright holders are unlikely to register their copyright on a timely basis. As such, you are left with an appeal not to law but to morality. Thus, the dynamics of the existing registration regime—put into place on January 1, 1978 and largely unchanged by the implementation of the Berne Convention and other subsequent amendments to the Copyright Act—elevate procedural steps into outcome-determinative hurdles. The impact is both dramatic and underappreciated.

C. HIERARCHY AND THE UNSOPHISTICATED CONTENT CREATOR

A closer examination of the language and extant interpretation of the Copyright Act reveals the particular difficulties facing unsophisticated creators in seeking to vindicate their rights in the United States, especially in comparison to their peers in foreign countries. First, courts have found that § 412 precludes recovery of statutory damages and attorneys' fees when an infringement continues after registration. As a result, an infringer has veritable carte blanche to continue its wrongful activity with impunity if a work is not timely registered at the moment of first infringement. Second, unsophisticated creators face a dangerous one-way risk of attorneys' fees. Plaintiffs who fail to register their copyright on a timely basis are *never* eligible to recover their fees if they prevail in a suit, no matter how wanton the infringement at issue. By contrast, defendants are *always* eligible to recover their fees if they prevail. This unbalanced fees matrix dampens any enthusiasm that unsophisticated creators might have about seeking redress through the judicial system. Third, unsophisticated creators have no ability to seek punitive or reputational damages; the actual damages which they can receive are insufficient to make them whole and provide no deterrent effect against infringers. All told, these factors combine to create a rather bleak enforcement regime for the rights of creators who do not register in a timely manner.

1. *Interpreting § 412's Timeliness Requirement: The Unavailability of Partial Eligibility for Statutory Damages or Attorneys' Fees*

First, the challenges facing unsophisticated creators seeking to be made whole for unauthorized exploitation of their copyrighted works have grown more pronounced with the courts' reading of § 412's timely registration requirement. Specifically, even in cases of egregious and continuing infringement after registration, courts have denied plaintiffs access to statutory damages and attorneys' fees. On one hand, courts may have had no other alternative but to do so: there is little doubt that § 412 is perfectly clear in proscribing the imposition of statutory damages and attorneys' fees when

all acts of infringement by a defendant occur before registration. On the other hand, the issue is more ambiguous when an infringement occurs, the copyright holder then registers the work, and the infringement continues. Nevertheless, courts have almost uniformly resolved this issue in favor of defendants, holding that in such an instance statutory damages and attorneys' fees may not be awarded for any act of infringement—either before or after registration.

Courts have adopted this narrow view of the scope of plaintiff eligibility for statutory damages and attorneys' fees through their interpretation of the term “any infringement.” Indeed, the reported cases considering the issue have determined that “infringement ‘commences’ for the purposes of § 412 when the first act in a series of acts constituting continuing infringement occurs.”³⁹ Thus, “*the first act of infringement* in a series of ongoing infringements of the same kind marks the commencement of one continuing infringement under [§] 412.”⁴⁰ As a result, if an artist discovers a company is infringing her work and then registers that work and sues for infringement, the artist cannot seek any recompense in the way of statutory damages or attorneys' fees, even for those acts of infringement that occur *after* the registration. Moreover, the narrow construction of “any infringement” under § 412 has led courts to insulate from statutory damages and attorneys' fees defendants who infringed prior to registration of the operative work, even if they conduct new acts of infringement after registration occurs.⁴¹ The results of this rule are dramatic and perverse. As one disgruntled copyright claimant put it, this judicial interpretation grants infringers a “license to steal.”⁴²

39. *Johnson v. Jones*, 149 F.3d 494, 506 (6th Cir. 1998); *accord* *Derek Andrew, Inc. v. Poof Apparel Corp.*, 528 F.3d 696, 700–01 (9th Cir. 2008); *Bouchat v. Bon-Ton Dep't Stores, Inc.*, 506 F.3d 315, 330 (4th Cir. 2007), *cert. denied*, 128 S.Ct. 2054 (2008); *Troll Co. v. Uneeda Doll Co.*, 483 F.3d 150, 158 (2d Cir. 2007); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 142–44 (5th Cir. 1992).

40. *See* *Derek Andrew, Inc. v. Poof Apparel Corp.*, 528 F.3d 696, 701 (9th Cir. 2008).

41. *See, e.g.*, *Qualey v. Caring Ctr. of Slidell*, 942 F. Supp. 1074, 1076 (E.D. La. 1996). The court noted,

[B]ecause the defendants commenced the first alleged infringement (preparing derivative works) prior to registration and publication, plaintiff is barred from recovering statutory damages or attorneys fees not only for that specific act of infringement, but also for any subsequent infringements of the drawings commenced after registration (or within the three-month period between first publication and registration).

Id.; *see also* *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 144 (5th Cir. 1992) (holding that “a plaintiff may not recover an award of statutory damages and attorney’s fees for infringements that commenced after registration if the same defendant commenced an infringement of the same work prior to registration.”).

42. *Teevee Toons, Inc. v. Overture Records*, 501 F. Supp. 2d 964, 966 (E.D. Mich.

Consider a scenario where officials at a major clothing manufacturer decide to use the work of an artist for their new autumn line. Assume that they contemplate approaching the artist for a license but ultimately decide to use the work without authorization. Maybe they cannot be bothered to track down the author, perhaps they are concerned about the extra costs that a license would add to product development, maybe they think the chance of getting caught is remote, or perhaps they attempt to obtain a license but talks with the artist break down when the parties cannot agree on a rate of compensation. Regardless of the particular context and motivations at play, the officials are aware of the need to license under federal law but they decide to bring the product to market without a license. Several months later, the artist discovers the wholesale infringement. He immediately registers his work with the Copyright Office and then files suit against the company.

Because of the courts' narrow interpretation of § 412, the best the artist can hope for is to receive actual damages for the company's willful infringement. As a result, there is little incentive for the company to stop infringing. After all, whether the company ceases and desists now that it has been caught red-handed will play little role in any damages that the artist can receive. There are no punitive damages available in copyright actions. And statutory damages, which alone provide discretionary enhancements for willful infringement, are not available. The company can continue to infringe with impunity and, at the most, pay only actual damages that leave the unrepentant infringer without an incentive to respect copyright ex ante and effectively granting the infringer a compulsory license. Even if the artist attempts to obtain preliminary injunctive relief, the prospects for such relief are dubious. By the time he obtains an injunction, its value has diminished significantly: the clothing manufacturer may have moved on to its next line of seasonal clothing. Moreover, obtaining injunctive relief is expensive and the fees for doing so are non-recoupable.

The underlying rationale for this result is particularly problematic and rests on several unfounded assumptions about our registration system. In 2008, the Ninth Circuit addressed the registration timing issue on damages for the first time with its ruling in *Derek Andrew, Inc. v. Poof Apparel Corp.*⁴³ In its opinion, the court adopted the reasoning and conclusion of the other circuits that have considered the issue by finding that such an interpretation

2007).

43. *Derek Andrew, Inc. v. Poof Apparel Corp.*, 528 F.3d 696 (9th Cir. 2008). The Ninth Circuit joined with the Second, Fourth, Fifth, and Sixth Circuits in barring recovery of statutory damages and fees when an infringement begins pre-registration and continues post-registration. *Id.* at 701.

of § 412 advanced Congress's intent to "promote early registration of copyright" by (1) "provid[ing] copyright owners with an incentive to register their copyright promptly" and (2) "encourag[ing] potential infringers to check the Copyright Officer's database."⁴⁴

While the statute may not leave sufficient room for alternate interpretations, these rationalizations themselves do not hold up under scrutiny. First, if a court held that each of a series of on-going infringements constituted a new act of infringement for the purposes of § 412, copyright holders would still have a strong incentive to register. After all, there are numerous other advantages to registration besides qualification for statutory damages and attorneys' fees. Specifically, timely registration serves an important evidentiary function by enabling rights holders to make out infringement cases more easily. For example, registration provides a plaintiff with a *prima facie* presumption of copyright validity—but only if a work is registered within five years of publication.⁴⁵ Thus, plaintiffs have a strong incentive to register on relatively timely basis in order to enjoy the presumption of validity. Registration also provides proof of the date of creation. This benefit encourages timely registration because, *ipso facto*, a work's date of registration sets its latest possible date of creation. Thus, a registration certificate dated March 6, 2003 irrefutably establishes that the registered work must have been created before March 6, 2003. Such proof can be instrumental in many cases, especially where a defense of independent, or earlier, creation is proffered.

Second, as we explore later, the idea that potential infringers can confidently check the Copyright Office's database for complete registration information is deeply flawed. In short, the entire notion that registration will serve a notice function to potential infringers is vastly exaggerated. Moreover, the consequences of the current reading of § 412 are perverse. In many instances, it immunizes defendants to infringe with impunity.

Of course, it is fair to ask whether a different reading of § 412 by the courts, in which each violation of an exclusive right secured under § 106 constitutes a new infringement for the purposes of § 412, would fare any better. As it turns out, such an alternate reading would lead to a whole new set of policy problems. First, courts would have to address the thorny issue of when one violation ends and the next one begins. In the pre-Internet age,

44. *Id.* at 700–01.

45. 17 U.S.C. § 410(c) (2006) ("In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.").

it was easier to make such a determination. After all, infringements came in more discrete bits—each day’s edition of the newspaper featuring the infringement or each broadcast of an infringement could constitute a new act. But in the non-discrete world of the Internet, online newspapers and blogs are updated continuously and websites stream infringing content at all hours of the day. Second, a different reading of § 412 might nullify the entire purpose of the timely-registration incentive for statutory damages and attorneys’ fees. After all, a plaintiff could wait for an infringement to occur, register and then sue with a colorable demand for statutory damages and attorneys’ fees so long as defendant violates just a single exclusive right of the plaintiff after the effective date of registration. In the end, however, the shortcomings of an alternative interpretation of § 412 provides further reason to rethink the registration requirement as it pertains to statutory damages and attorneys’ fees.

2. *The One-Way Risk of a Fees Award*

The 1976 Copyright Act disincentivizes unsophisticated artists from vindicating their legal rights through litigation in another way: the one-way risk of an attorneys’ fee award. Section 505 gives courts the general discretion to grant fees to a prevailing party in an infringement suit, and frequently courts do so. For example, the Ninth Circuit, billed by Judge Alex Kozinski as “the Court of Appeals for the Hollywood Circuit,”⁴⁶ has, in the past, generally awarded fees to prevailing plaintiffs in copyright suits.⁴⁷ However, § 412 of the Act prevents courts from awarding fees to a plaintiff who has not timely registered.⁴⁸ This creates a one-way risk for any individual artist attempting to be made whole. Most individual artists do not timely register and are therefore ineligible for attorneys’ fees. Yet a prevailing defendant *always* enjoys the potential to recover fees. Thus, without timely registration, you can never obtain attorneys’ fees if you prevail in your infringement suit. But, should you lose, the defendant can recover fees against you.

46. *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1521 (9th Cir. 1993) (Kozinski, J., dissenting).

47. *Columbia Pictures Television v. Krypton Broad. of Birmingham, Inc.*, 106 F.3d 284, 296 (9th Cir. 1997) (“[A] plaintiff in a copyright action is generally awarded fees by virtue of prevailing in the action.”).

48. 17 U.S.C. § 412 (2006). The statute states,
[N]o award of statutory damages or of attorney’s fees . . . shall be made for . . . any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.

Id.

This state of affairs significantly dissuades the individual artist from pursuing even a clear-cut case of infringement, lest something go wrong at trial. Even in the most obvious case of infringement, there is always a chance that the case may go awry due to an error in registration, a difference of opinion over “substantial similarity,” or a generous reading of the fair use doctrine by the trier of fact.

For example, errors in registration⁴⁹ are commonplace and almost always play a role in a defense to an infringement suit. As Charles Ossola reminds us, parties will often spend hundreds of thousands of dollars in a suit dealing with the inevitable claim of fraud on the Copyright Office based on mistakes in an application for registration. As he explains, “[t]here are almost always mistakes, or at least arguable mistakes, [in a registration application] which are invariably discovered during litigation.”⁵⁰ On occasion, courts have looked askance at such errors, throwing out suits in their entirety, no matter how strong the merits and how blatant the infringement.⁵¹

49. Registration, even if untimely for purposes of § 412, is required to have standing to bring an infringement suit. 17 U.S.C. § 411(b) (2006) (“[N]o 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.”).

50. Charles Ossola, *Registration and Remedies: Recovery of Attorney’s Fees and Statutory Damages under the Copyright Reform Act*, 13 CARDOZO ARTS & ENT. L.J. 559, 561 (1993).

51. *See, e.g.*, *Torres-Negron v. J & N Records, LLC*, 504 F.3d 151, 162 (1st Cir. 2007) (affirming judgment as a matter of law to defendants on a copyright infringement claim on the grounds of improper registration since the songwriter’s deposit of a reconstruction with his registration paperwork resulted in an incomplete application); *Morris v. Bus. Concepts, Inc.*, 259 F.3d 65, 71 (2d Cir. 2001) (affirming grant of summary judgment to defendant for lack of subject matter jurisdiction on the grounds that plaintiff had not properly registered articles which appeared in a magazine since only the magazine itself had been registered); *Raquel v. Educ. Mgmt. Corp.*, 196 F.3d 171, 180 (3d Cir. 1999) (dismissing a suit for lack of standing due to improper registration since the registrant had mischaracterized the work in question as audiovisual rather than musical in nature). *See also* *Kodadek v. MTV Networks, Inc.*, 152 F.3d 1209, 1212 (9th Cir. 1998) (invalidating a copyright registration on the grounds that the works deposited did not constitute bona fide copies of the original works). As Ossola points out,

If anyone is of the opinion that there are no such registration errors, he should sit through a deposition with a client when he is asked to justify his position on work made for hire in light of Reid factors, joint work in light of the recent case law, or what constitutes preexisting material for the purpose of derivative works. These are all questions that must be filled in on the application registration form, and they each provide fertile territory for attack in litigation.

Ossola, *supra* note 50, at 561.

3. *The Inadequacy of Remedies Absent Timely Registration: The Limits of Actual Damages and Injunctive Relief*

Absent access to statutory damages and attorneys' fees, a creator has little meaningful ability to punish an infringer or deter future acts of infringement. As Judge Richard Posner has stated,

[T]here is no basis in the law for requiring the infringer to give up more than his gain when it exceeds the copyright owners' loss. Such a requirement would add a punitive as distinct from a restitutionary element to copyright damages, and . . . the statute contains no provision for punitive damages.⁵²

Posner's conclusion is widely shared. As Nimmer observes, "[t]he cases are clear that exemplary or punitive damages should not be awarded in a statutory copyright infringement action."⁵³ On one hand, it would appear that the Copyright Act provides plenty of room for punitive style damages under the guise of the statutory damages regime and pursuant to the courts' authority to enhance those statutory damages five-fold on the grounds of willful infringement. However, in the vast majority of real world infringements, untimely registration of a copyright precludes a prevailing plaintiff from recovering statutory damages (or any willfulness enhancement), no matter how egregious the conduct of the defendant.

Thus, with punitive damages unavailable, a prevailing unsophisticated creator is left with only actual damages or disgorgement of profits. However, for copyright infringement, actual damages are often speculative and expensive to prove. Moreover, case law interpreting the Copyright Act has specifically excluded psychological injury from the equation for actual damages. Thus, if your artwork is used in an unauthorized manner that is repulsive to you, the modern damages analysis provides you with no relief on these grounds.⁵⁴

52. *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 931–32 (7th Cir. 2003) (dictum).

53. 4 NIMMER & NIMMER, *supra* note 29, § 14.02.

54. *Id.* Nimmer observes,

The Act provides that the "copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement. . . ." Yet neither its text nor the Committee Reports attempt to define the nature of those actual damages. Reference must therefore be made to both statutory and common law copyright case law.

Id.; see, e.g., *Mackie v. Rieser*, 296 F.3d 909, 917 (9th Cir. 2002) (noting that "hurt feelings" cannot form the basis of damages awards under copyright law); *Baker v. Urban Outfitters, Inc.*, 254 F. Supp. 2d 346, 356–57 (S.D.N.Y. 2003) (providing that an award to plaintiff based upon his personal feelings of moral debt is without basis).

Disgorgement of profit can certainly be a useful remedy, but it is often difficult to quantify. While case law does establish a presumption that all profits stem from the infringing act, defendants can rebut this presumption, leading courts to engage in the problematic task of accurate apportionment.⁵⁵ Moreover, a defendant will often show no profit. For example, the entertainment industry is notorious for its ability to show a loss on virtually every project, including some of its biggest hits.⁵⁶ To scrutinize such troublesome accounting, a plaintiff needs to spend extensive time in discovery without any hope of recovering fees for the effort.

When it becomes too difficult for a plaintiff to demonstrate profit by the defendant from an act of infringement, a few courts have analogized to patent law's reasonable royalty analysis for damages and have allowed the assessment of a hypothetical license value for the unauthorized use of the copyrighted work.⁵⁷ But as Nimmer notes, this line of authority is of relatively recent vintage, and only a "smattering" of decisions have explicitly followed the lead of the Seventh Circuit, which first allowed such a recovery in its 1985 ruling.⁵⁸ Under this analysis, a court determines *ex ante* the price

55. See 17 U.S.C. § 504(b) (2006); *Harper & Row Pub., Inc. v. Nation Enter.*, 471 U.S. 539, 567 (1985). The court noted,

With respect to apportionment of profits flowing from a copyright infringement, this Court has held that an infringer who commingles infringing and noninfringing elements "must abide the consequences, unless he can make a separation of the profits so as to assure to the injured party all that justly belongs to him."

Id. (quoting *Sheldon v. Metro-Goldwyn Pictures Corp.*, 309 U.S. 390, 406 (1940))

56. See, e.g., *Buchwald v. Paramount Pictures, Corp.*, No. 706083, 1992 WL 1462910, *1–2 (Cal. Super. Ct. Mar. 16, 1992) (declaring Paramount's accounting methodology unconscionable when it showed that the hit movie *Coming to America* had earned no net profits).

57. See, e.g., *Deltak, Inc. v. Advanced Sys., Inc.*, 767 F.2d 357 (7th Cir. 1985). Plaintiffs had not timely registered and therefore could not recover statutory damages. *Id.* at 359. Actual damages proved difficult to ascertain, as there was no provable out-of-pocket harm, such as lost sales, to the plaintiff. *Id.* at 360. Moreover, the court was "unable to determine what portion of the gross revenues were due to the infringement and what portion were due to their factors such as lawful marketing methods," thereby preventing any disgorgement recovery. *Id.* at 359. With what Nimmer dubs "triple circumstances (no out-of-pocket losses to plaintiff, no profits to defendant, no ability to recover statutory damages)" in play, the Seventh Circuit reversed an order denying plaintiffs any damages and allowed recovery of an implied license fee. *Id.* at 364. See also 4 NIMMER & NIMMER, *supra* note 29, § 14.02[B][1].

58. *Id.*; see, e.g., *Kleier Adver., Inc. v. Premier Pontiac, Inc.*, 921 F.2d 1036, 1040 (10th Cir. 1990); *Roeslin v. Dist. of Columbia*, 921 F. Supp. 793, 799–800 (D.D.C. 1995); *Kleier Adver. Co. v. James Miller Chevrolet, Inc.*, 722 F. Supp. 1544, 1546 (N.D. Ill. 1989). *But see* *Widenski v. Shapiro, Bernstein & Co.*, 147 F.2d 909, 911–12 (1st Cir. 1945). The court found that the Copyright Act's provision for statutory damages serves as an absolute bar to the recovery of a reasonable license:

upon which a willing licensor and licensee would have agreed for the use. But unlike patents, copyrighted works are not merely commodities. As such, there are many more unwilling copyright licensors than unwilling patent licensors. One's willingness to license one's invention might differ markedly from one's willingness to license one's song. In the realm of patents, for example, there are no hold-outs from licensing on the grounds that licensing will diminish the inherent beauty of the invention. The same is not true of copyrighted content, largely because of the personal and artistic content that form its subject matter. Consider the reticence of some major bands to license their music for use in advertising. R.E.M. famously rejected an offer of more than \$10 million from Microsoft for use of their tune *It's the End of the World as We Know It (And I Feel Fine)* for the launch of Windows 95—though The Rolling Stones were more than happy to step in and ultimately ended up licensing *Start Me Up* for use).⁵⁹ However, a medical device maker is

[I]t seems to us highly significant that we have been referred to and have found no case applying the patent rule contended for by the defendant in a copyright case, and that the Supreme Court in the Sheldon case, supra, refused to sanction the closely analogous contention that damages in a copyright case ought to be the price at which the copyright proprietor had indicated his willingness to sell to the infringer.

Id. Cf. *Childress v. Taylor*, 798 F. Supp. 981, 990 (S.D.N.Y. 1992); *Lundberg v. Welles*, 93 F. Supp. 359 (S.D.N.Y. 1950). Arguably, older cases finding an absolute bar to the award of a reasonable licensing fee are distinguishable since they were decided under the 1909 Copyright Act. However, even modern cases under the 1976 Copyright Act have concluded that the law bars recovery of a reasonable license fee when there are no lost sales or disgorgable profits. In *Business Trends Analysts, Inc. v. Freedomia Group, Inc.*, 887 F.2d 399 (2d Cir. 1989), for example, the Second Circuit explicitly

decline[d] to adopt *Deltak's* approach . . . We see no room for such a speculative and artificial measure of damages under Section 504(b) . . . It is surely true that where an infringer such as TFG sells the offending publication at a nominal price, and there is no evidence of lost sales of the infringed publication, a conventional profits test may seem inadequate. Nevertheless, we believe we must follow the statutory scheme.

Id. at 405.

59. See Barnet D. Wolf, *Selling Out*, COLUMBUS DISPATCH, Sept. 29, 2002, at 01E. On a related note, when U2 allowed *Vertigo* to be used in an iTunes commercial, the band took pains to explain to fans that the use of the song was like a 30 second music video and that Apple did not pay the band anything directly for use of the song in the advertisement. See Chris Ayres, *U2 Online Deal Hastens Last Spin for the CD*, THE TIMES (U.K), Oct. 30, 2004 (“Some fans feel cheated that the band is getting so corporate. Apple’s latest iPod advertising campaign . . . features U2 performing their new single, *Vertigo*—in what could be construed as the band’s first commercial endorsement.”). However, the band’s comments ignored the profit sharing arrangement U2 enjoyed from sales of the special U2 iPod. *Id.* (noting the “unprecedented joint marketing and licensing deal” between U2 and Apple that was “by far the most lucrative [deal] signed by any rock band in history”).

unlikely to refuse to license their patented technology for a rate far above market.

The one area of potentially meaningful leverage that an unsophisticated creator does possess is the threat of injunctive relief. But this leverage is limited in several critical ways. To begin with, the creator must first discover the infringement at the ideal time in order to effectively utilize the threat of injunctive relief. This occurs on the eve of a product release, when enjoining the distribution of an infringing product is both at its most feasible and economically painful. Often, however, infringement is not discovered until much later, after the infringer has already enjoyed significant unauthorized use of the work.

Second, the burdens facing a plaintiff seeking injunctive relief in an intellectual property dispute have grown markedly in recent years. Specifically, there is no automatic entitlement to injunctive relief in a copyright dispute, no matter what the merits of a claim. Rather, the choice to grant an injunction—either preliminary or permanent—resides within the sound discretion of the trial court.⁶⁰ Courts used to routinely grant permanent injunctions to prevailing plaintiffs in intellectual property cases, absent exceptional circumstances. However, starting with dicta in *New York Times Co. v. Tasini*,⁶¹ and culminating in an express statement in *eBay v. Mercantile Exchange*,⁶² which ruled on the issue in the patent context, the Supreme Court has abandoned this general rule.⁶³ By allowing judges the discretion to transform patent, copyright, and trademark protection from property rights to a liability regime, the Court reasserted the importance of a critical element sometimes overlooked in the adversarial setting: the public interest. Courts

60. 17 U.S.C. § 502 (2006) (providing that a court “may” grant injunctive relief “on such terms as it may deem reasonable to prevent or restrain infringement of a copyright”). Appellate courts have cautioned that preliminary injunctions, even in the intellectual property context, are considered to be “an extraordinary remedy involving the exercise of a very far-reaching power, which is to be applied ‘only in [the] limited circumstances which clearly demand it.’” *Direx Israel, Ltd. v. Breakthrough Med. Corp.*, 952 F.2d 802, 811 (4th Cir. 1991) (reversing a grant of preliminary injunction in a trade secret case).

61. 533 U.S. 483, 505 (2001) (“[I]t hardly follows from today’s decision [finding infringement] that an injunction against [the infringing use] must issue.”); *see also* 17 U.S.C. §502(a) (2006) (stating that a court “may” enjoin infringement); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n.10 (1994) (holding that goals of copyright law are “not always best served by automatically granting injunctive relief”).

62. *eBay Inc. v. MercExchange L.L.C.*, 547 U.S. 388 (2006).

63. In rejecting this general rule, *eBay* claimed true fealty to the traditional four-part balancing test historically used by courts of equity when contemplating injunctive relief. *Id.* at 392. As such, the Court actually characterizes an automatic-injunction rule as wayward and inconsistent with precedent. Nevertheless, the automatic-injunction rule dominated intellectual property jurisprudence in the twentieth century.

therefore possess the option to order damages but allow an act of infringement to continue unabated. As the Supreme Court held in *eBay*, “this Court has consistently rejected invitations to replace traditional equitable considerations with a rule that an injunction automatically follows a determination that a copyright has been infringed.”⁶⁴

Courts have begun to apply the principals of *eBay* in the context of preliminary injunctions as well. A recent wave of cases has questioned the presumption of irreparable harm that all intellectual property plaintiffs used to enjoy when applying for injunctive relief.⁶⁵ Of course, there may be plenty of good public policy reasons to make obtaining injunctive relief in intellectual property disputes more difficult, both at the preliminary and permanent levels. As Justice Kennedy noted in his *eBay* concurrence,

When the patented invention is but a small component of the product the companies seek to produce and the threat of an injunction is employed simply for undue leverage in negotiations, legal damages may well be sufficient to compensate for the infringement and an injunction may not serve the public interest. In addition injunctive relief may have different consequences for the burgeoning number of patents over business methods, which were not of much economic and legal significance in earlier times.⁶⁶

Along the same lines, during a widespread outbreak of Anthrax, it may not make sense to enjoin an infringing company from distributing life-saving drugs to the infected. That said, however, the increased difficulty in obtaining injunctive relief in intellectual property disputes dramatically and disproportionately impacts unsophisticated creators seeking to vindicate their rights.

64. *eBay*, 547 U.S. at 392–93.

65. *See, e.g.*, *MGM Studios, Inc. v. Grokster, Ltd.*, 518 F. Supp. 2d 1197, 1212 (C.D. Cal. 2007) (“[T]he longstanding rule that irreparable harm can be presumed after a showing of likelihood of success for purposes of a copyright preliminary injunction motion may itself have to be reevaluated in light of *eBay*.”); *Allora, LLC v. Brownstone, Inc.*, No. 07-87, 2007 WL 1246448, at *5 (W.D.N.C. Apr. 27, 2007) (applying *eBay* to increase the burden on plaintiffs in requests for preliminary injunctions in copyright claims, thereby trumping older circuit court precedent); *Canon, Inc. v. GCC Int’l Ltd.*, 450 F. Supp. 2d 243, 254 (S.D.N.Y. 2006) (drawing upon *eBay* to hold that “the movant must demonstrate the likelihood of irreparable injury in the absence of a grant of the requested [preliminary] injunction”). *Cf.* *Lorillard Tobacco Co. v. Engida*, 213 Fed. Appx. 654 (10th Cir. 2007) (declining to address whether *eBay* changed the standards for preliminary injunctions in intellectual property cases, but affirming a district court’s decision to deny preliminary injunctive relief based on a balance of hardships).

66. *eBay*, 547 U.S. at 396–97 (Kennedy, J., concurring).

Additionally, with the burden on the plaintiff to demonstrate a likelihood of success on the merits, a defendant need only poke sufficient doubt into a single issue, such as registration or ownership, in order to defeat an application for preliminary injunctive relief. Moreover, even if a court grants an injunction, it can be stayed pending an appeal and, in the end, can only issue after the plaintiff posts a bond.⁶⁷ Under the Federal Rules, a court must therefore set the security to an amount sufficient “for the payment of such costs and damages as may be incurred or suffered by any party who is found to have been wrongfully enjoined.”⁶⁸ Thus, a bond can be especially expensive when seeking to halt the distribution of a valuable product and the high price can be cost-prohibitive for many plaintiffs.⁶⁹ Finally, the attorneys’ fees expended to obtain injunctive relief are never recoupable for a plaintiff who has not timely registered an infringed work. In all, therefore, there are numerous shortcomings to the remedies available for plaintiffs whose works are not timely registered but are willfully infringed.

4. *Pitfalls for the Unsophisticated Even with Timely Registration: The Inevitable and Wasteful Scrutinization of Registration Applications.*

At the same time, the registration regime elevates form over substance, leading to a disproportional emphasis on compliance with formalities when one attempts to vindicate one’s intellectual property rights. Indeed, the most profoundly time-consuming and taxing aspect of many copyright infringement suits is the inevitable attack lodged by defendants against the propriety of the registration. Though this arguably should be one of the least important aspects of litigation—after all, questions of copyright ownership, validity and substantial similarity would appear to trump in significance—registration often becomes a central question because the entire value of the case rides on the issue. If registration is declared invalid, a plaintiff loses standing to bring the suit and must begin the litigation anew after filing a new registration form. More problematically, if the registration is deemed invalid, the plaintiff loses the right to recover statutory damages and attorneys’ fees against the defendant, even if the suit is re-filed. Quite simply, valid registration will not have occurred prior to the commencement of infringement.

67. FED. R. CIV. P. 65(c).

68. *Id.*

69. *See* Lawrence v. St. Louis-San Francisco Ry., 278 U.S. 228, 233 (1929) (holding that the recipient of a preliminary injunction assumes the risk of “being required to restore [the status quo ex ante] if it should be held that the . . . injunction was improvidently granted . . . and also the risk of having to compensate the [enjoined] . . . for any damages suffered by reason of the [injunction].”)

Because of the value of timely registration, procedural formalities are crucial in copyright infringement litigation, often overshadowing the merits of a case. For a system purportedly seeking to vindicate the legitimate rights of creators, this can be a devastating turn. Since statutory damages, attorneys' fees, and even the ability to bring a suit in the first place rely on proper and timely registration, the tendency of some courts to lapse into hyper-formalism when scrutinizing registration applications has dramatic consequences. Although there is ample basis to view errors in the registration process forgivingly,⁷⁰ many courts have deviated from this scheme—certainly enough to give unsophisticated plaintiffs pause when pursuing an infringement action. Several cases from the federal circuit courts illustrate this cautionary note.

Consider *Raquel v. Education Management Corp.*,⁷¹ an infringement suit involving the rock band Nirvana. In the case, the copyright holder to the song *Pop Goes the Music* had sued, inter alia, Nirvana and its record label, Geffen, for the unauthorized use of the song in Nirvana's music video *About a Girl*. The defendants responded by arguing, inter alia, that the plaintiff lacked a proper registration for the work. As it turned out, the plaintiff had filed a copyright registration application for a musical composition and described the "nature of the work" as an "audiovisual work." The reason for this designation seemed plausible enough: the claimant had submitted a videotape of a television commercial in which the claimant's song had been performed. Moreover, the claimant had correctly noted on the registration application that the nature of the authorship claim was "[a]ll music and lyrics and arrangement." Nevertheless, the court invalidated the registration on the grounds that the claimant had made a material misrepresentation to the Copyright Office that obfuscated information that would have led to the application's rejection. Moreover, the Court held that the misrepresentation was not inadvertent or innocent, a fact that would ordinarily prevent invalidation. The case drew a vigorous dissent from future Supreme Court Justice Samuel Alito, who charged the majority with irrationally and unfairly elevating form over substance and mandating "a forfeiture of a valid

70. As Nimmer argues, absent fraud, "a misstatement or clerical error in the registration application . . . shall neither invalidate the copyright nor render the registration certificate incapable of supporting an infringement action." 2 NIMMER & NIMMER, *supra* note 29, § 7.20; *see, e.g.*, *Harris v. Emus Records Corp.*, 734 F.2d 1329, 1335 (9th Cir. 1984) ("Absent intent to defraud and prejudice, inaccuracies in copyright registrations do not bar actions for infringement"); *Advisers, Inc. v. Wiesen-Hart, Inc.*, 238 F.2d 706, 708 (6th Cir. 1956) ("[I]nnocent misstatement . . . in the affidavit and certificate of registration, unaccompanied by fraud . . . does not invalidate copyright.").

71. 196 F.3d 171 (3d Cir. 1999).

copyright because of a misstatement that the trial court had already labeled inadvertent.”⁷²

Indeed, the court’s concern about intentional misrepresentation appears particularly misplaced when one considers the real facts. The premise underlying the entire opinion—fraud on the Copyright Office—was simply untrue. As it turns out, the Copyright Office was not misled in any way. The Office took pains to announce this when it formally addressed *Raquel* by issuing a statement of policy on Registration of Claims to Copyright.⁷³ The Copyright Office unequivocally and resoundingly rejected the reasoning of *Raquel*:

The Copyright Office is issuing this policy statement to clarify that it was not misled in registering the copyright claim in the *Raquel* case, and that the Copyright Office knew that the copyright claim was in a musical work, and not an audiovisual work. The Office is also issuing this statement to clarify that in the ‘nature of this work’ space on Form PA, it has been and continues to be acceptable to describe the physical nature of the deposit submitted with the application.⁷⁴

Despite the Copyright Office’s firm rebuke of the holding in *Raquel*, it was too late to help the plaintiff. Moreover, despite the Copyright Office’s statement of policy, the ultimate question of registration validity remains in the hands of the courts. As the *Raquel* case and others demonstrate, there is always the risk of invalidation of a registration on relatively minor grounds.⁷⁵ Indeed, other circuit courts have also invalidated registrations (although not on such a flimsy basis) because of errors contained in the application forms.⁷⁶

At the turn of the last century, the Register of Copyrights at the time, Thorvald Solberg, expressed his profound distaste for the registration regime and its ability to punish seemingly innocuous errors and omissions with the

72. *Id.* at 182 (Alito, J., dissenting).

73. Registration of Claims to Copyright, 65 Fed. Reg. 41508-09 (Jul. 5, 2000).

74. *Id.*

75. *See, e.g.*, *Tavory v. NTP, Inc.*, 297 Fed. App’x 986 (Fed. Cir. 2008) (affirming dismissal of copyright infringement claim on the grounds of improper registration because the programmer’s deposit copy was not an original or bona fide copy); *Torres-Negron v. J & N Records, LLC*, 504 F.3d 151 (1st Cir. 2007) (affirming dismissal of copyright infringement claim on the grounds of improper registration because the songwriter’s submission of a reconstruction with his registration application resulted in an incomplete application).

76. *Kodadek v. MTV Networks, Inc.*, 152 F.3d 1209 (9th Cir. 1998) (invalidating a registration because of a mistake in the application in an infringement suit involving the Beavis and Butthead characters from MTV); *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452 (2d Cir. 1989) (invalidating registrations because of a mistake in the application in an infringement suit involving popular Halloween costumes).

dramatic loss of substantive rights. In a report to the Librarian of Congress dated December 1, 1903, he wrote, “[A] system has gradually grown up under which valuable literary rights have come to depend upon exact compliance with these statutory formalities which have no relation to the equitable rights involved, and the question may very well be raised whether this condition should be continued.”⁷⁷ Over a century later, the same concern continues to resonate.

5. *Comparing American and Foreign Infringement Remedies*

When one considers the remedies available to any creator under foreign laws, the tremendous disadvantages facing unsophisticated creators in the United States become all the more remarkable. Compare our infringement remedies to those of the United Kingdom and Canada—two countries whose legal regimes are most closely aligned to our own. The United Kingdom has no government registration system at all. And while statutory damages are not available, punitive damages—called “‘additional’ damages”—are. The United Kingdom’s Copyright, Designs and Patent Act 1988 provides that a plaintiff can recover actual damages plus ‘additional’ damages to both deter future infringers and punish defendants who willfully violate a plaintiff’s intellectual property rights.⁷⁸ Furthermore, prevailing plaintiffs (whether in copyright cases or otherwise) recover attorneys’ fees.⁷⁹

Canada similarly lacks a registration requirement. And although the country’s remedies are more limited in some ways, they are also more expansive in other ways. First, any prevailing plaintiff in a copyright infringement suit is entitled to recovery of statutory damages and attorneys’ fees, regardless of the existence or date of any copyright registration.⁸⁰ But, to

77. THORVALD SOLBERG, LIBRARY OF CONGRESS, REPORT ON COPYRIGHT LEGISLATION 25 (1904).

78. Copyright, Designs and Patent Act, 1988, ch. 48, § 97(2) (U.K.) (allowing award of “additional” damages based on “flagrancy of the infringement” and “benefit accruing to the defendant by reason of the infringement”).

79. Copyright, Designs and Patent Act, 1988, ch. 48, §§ 96(2), 103 (U.K.).

80. For statutory damages *see, e.g.*, Copyright Act, R.S.C., ch. 42, § 34 (1985) (Can.), amended by 1997 S.C., ch. 24 (Can.) (“Where copyright has been infringed, the owner of the copyright is, subject to this Act, entitled to all remedies by way of injunction, damages, accounts, delivery up and otherwise that are or may be conferred by law for the infringement of a right.”); Copyright Act, R.S.C., ch. 42, § 38.1(1) (1985) (Can.), amended by 1997 S.C., ch. 24 (Can.) (“Subject to this section, a copyright owner may elect, at any time before final judgment is rendered, to recover, instead of damages and profits referred to in subsection 35(1), an award of statutory damages for all infringements involved in the proceedings”). For attorneys’ fees, *see* Copyright Act, R.S.C., ch. 42, § 34(3) (1985) (Can.), amended by 1997 S.C., ch. 24 (Can.) (granting courts the discretion to grant full costs, including attorneys’ fees, to a prevailing party).

counter this expansion in remedy eligibility, Canadian law limits the amount of statutory damages to a maximum award of CN \$20,000 per act of infringement⁸¹—a small fraction of the maximum statutory damages award allowed under American law.⁸² In addition, courts have discretion to award exemplary damages to punish infringers and effectively deter future infringements.⁸³ Thus, in both Canada and the United Kingdom, sophisticated or unsophisticated creators share an equal footing, as far as available remedies for the vindication of their copyright interests go. Additionally, unlike the United States, both the United Kingdom and Canada recognize non-economic injuries, such as moral prejudice or harm to one's reputation, as cognizable damages in an infringement suit. For example, Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights instructed member states to grant judges the authority to fashion infringement awards, when appropriate, based on “moral prejudice”⁸⁴ to rights holders. Pursuant to this directive, the United Kingdom passed the Intellectual Property (Enforcement, etc.) Regulations in 2006.⁸⁵ The Regulations instruct judges to take into account “all appropriate aspects” including negative economic consequences and non-economic factors such as “moral prejudice caused by the infringement.”⁸⁶ In Germany, for example, authors, photographers, and

81. Copyright Act, § 38.1(1).

82. 17 U.S.C. § 504(c)(2) (2006) (“In a case where the copyright owner sustains the burden of proving, and the court finds, that infringement was committed willfully, the court in its discretion may increase the award of statutory damages to a sum of not more than \$150,000.”).

83. *Manitoba Inc. v. Parks*, [2007] N.S.J. No. 128, 2007 NSCA 36 (Can.) (citing *GEORGE S. TAKACH, COMPUTER LAW 122-23* (2nd ed. 2003)). The court stated,

A court may award damages for copyright infringement even where the infringer made no profits. The Copyright Act also contains a statutory damages provision that permits a court to award monetary damages between \$500 and \$20,000. Punitive or exemplary damages for copyright infringement or trade secret misappropriation can also be awarded where the defendant's conduct is egregious and shows virtual contempt for the intellectual property rights of the plaintiff.

Id.; see also *The Queen v. James Lorimer & Co.*, [1984] 1 F.C. 1065 (Can.) (“[I]t is well established that [exemplary damages] are, in appropriate circumstances, available . . . , [and there is] no reason why appropriate circumstances should be different in the case of copyright infringement than in the case of any other civil invasion of another's rights.”); *Osmont v. Petit Journal Inc.*, [1934] 73 Que. S.C. 465, 473 (Can.) (providing for availability of exemplary damages to punish copyright infringement as a species of theft).

84. Council Directive 2004/48, art. 13, § 1, 2004 O.J. (L 157) 78 (EC).

85. Intellectual Property (Enforcement, etc.) Regulations, 2006, S.I. 1028, art. 3, ¶¶ 1, 2 (U.K.).

86. *Id.* ¶ 2.

performers may “recover, as justice may require, a monetary indemnity for the injury caused to them even if no pecuniary loss has occurred.”⁸⁷ Thus, even in absence of actual economic damages, German courts can fashion awards based on subjective, non-economic harms stemming from infringement. Similarly, in Canada, a computation of actual damages, if elected in lieu of statutory damages, can include a claim of non-economic injury, i.e., harm to a copyright holder’s reputation.⁸⁸

All told, the United States’ registration regime fails to protect unsophisticated creators adequately due to the unavailability of statutory damages even for post-registration infringement, the one-way risk of attorneys’ fees, and the absence of any punitive or reputational damages. This situation is all the more concerning when compared to the state of protection under foreign regimes, including those close to our own.

D. REGISTRATION AND THE FAILURE OF THE NOTICE FUNCTION

Besides putting unsophisticated creators at a profound disadvantage when seeking to vindicate their legal interests, the registration system fails to achieve even its basic function of notice. Despite our rhetorical distaste for copyright formalities, courts and commentators have explained the endurance of the registration regime based on the important notice function it serves. As numerous jurists have asserted, the registration requirement “encourages potential infringers to check the Copyright Office’s database” to ascertain protection status.⁸⁹ However, this claim is vastly overstated.

At the outset, it is a dubious proposition that potential infringers would even check the database at all, let alone prior to their infringement. Such an assumption may have made marginally more sense in previous centuries, when the law provided greater incentives to conduct a registration check. Prior to the enactment of the 1909 Copyright Act, for example, a work did not receive any copyright protection at all unless it was registered prior to, or

87. Bürgerliches Gesetzbuch [BGB] [Civil Code] Sept. 9, 1965, BCB II 27 at 1273, § 97(2), as amended by the Law of July 16, 1998 (F.R.G.).

88. *Groller v. Wolofsky*, [1934], 72 Que. S.C. 419 (Can.). For a more extensive discussion on damages available, see *Chaplin v. Hicks*, [1911] 2 K.B. 786.

89. *Derek Andrew, Inc. v. Poof Apparel Corp.*, 528 F.3d 696, 700 (9th Cir. 2008); *see also Johnson v. Jones*, 149 F.3d 494, 505 (6th Cir. 1998). The court noted that

[i]n addition to giving copyright owners incentive to register, [section] 412 also provides potential infringers with an incentive to check the federal register. If [section] 412 succeeds in encouraging copyright owners to register and in encouraging potential infringers to check registration, then it will have reduced both the search costs imposed on potential infringers and the enforcement costs borne by copyright owners.

Id.

simultaneous with, first publication.⁹⁰ The 1909 Act, which governed until December 31, 1977, reduced this formality somewhat by allowing a statutory copyright so long as a registration took place, and a deposit was made, “promptly” after publication.⁹¹ Although the promptness requirement was substantially eviscerated with the Supreme Court’s 1939 ruling in *Washingtonian Publishing Co. v. Pearson*,⁹² delayed registration could give rise to a laches defense preventing enforcement of a copyright.⁹³ Timely registration remained a requirement until 1964 in order to have the option to renew a copyright after the first twenty-eight year term. Thus, in the past, registration determined the copyright status of many works. Failure to conform to certain formalities, such as the provision of proper copyright notice on a work, was fatal to a work’s protection.⁹⁴ Since many published works were not registered, renewed, or published with certain notice formalities, there was a decent chance that any given work had no copyright protection. However, copyright now subsists from the moment of creation for all works created after January 1, 1978, meaning that just about any creative work authored in the past few decades enjoys copyright protection.⁹⁵ As a result, all creative works are copyrighted and are the potential subject of a lawsuit, regardless of registration status.⁹⁶

At the same time, for works registered prior to 1978, the Catalog is not available in any official online format. It is only accessible by visiting the Copyright Office Public Records Room, by paying the Copyright Office to conduct a check, or by accessing a copy of the Office’s Catalog of Copyright

90. 2 NIMMER & NIMMER, *supra* note 29, § 7.16[A][2][b].

91. Copyright Act of 1909 §§ 13–14 (codified as amended at 17 U.S.C. 11, 61 Stat. 652 (1947)) (repealed by Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541).

92. 306 U.S. 30 (1939), *reh’g denied*, 306 U.S. 668 (1939).

93. *See, e.g., Samet & Wells, Inc. v. Shalom Toy Co.*, No. 74-C-695, 1975 U.S. Dist. LEXIS 13683, at *20 (E.D.N.Y. Feb. 24, 1975) (“[T]he delay in filing the copyright notice may prevent plaintiff from complaining of any [infringing] titles which were sold [prior to filing of registration].”); *Kontes Glass Co. v. Lab Glass, Inc.*, 250 F. Supp. 193 (D.N.J. 1966), *aff’d*, 373 F.2d 319 (3d Cir. 1967) (stating that delay in registration may create a defense of laches).

94. 2 NIMMER & NIMMER, *supra* note 29, § 7.14[A][1] (describing how failure to observe proper notice requirements on a work used to lead to its dedication to the public domain); *see Neimark v. Ronai & Ronai, LLP*, 500 F. Supp. 2d 338, 341 (S.D.N.Y. 2007) (noting that “works published without a copyright notice prior to the enactment of the Berne Convention on March 1, 1989 are injected into the public domain and thus lose any copyright protection to which they might otherwise have been entitled”).

95. One notable exception is works authored by citizens of countries that have not signed the Berne convention or that do not have copyright laws.

96. However, available remedies are profoundly affected by registration status. This affects the viability of many potential lawsuits.

Entries. Even after conducting a thorough search, however, one cannot be sure of a work's copyright status. The Office's own searches produce only a "factual, noninterpretive report"⁹⁷ and, as the Office takes pains to caution, no investigation, no matter how comprehensive, can determine copyright status with certainty: "Copyright investigations often involve more than one of these methods [examining the work for proper copyright notice, searching the Copyright Office catalog, having the Copyright Office make a search for you]. Even if you follow all three approaches, the results may not be conclusive."⁹⁸

Thus, on the off-chance that potential infringers do check the Copyright Office's records, they will frequently have difficulty gleaning accurate information about the registration status of a particular work. As regular practitioners know, the Office's database is not up-to-date. Although registration becomes effective upon the Copyright Office's receipt of a complete application,⁹⁹ a copyright registration certificate usually does not issue for several months—until after the Copyright Office has had the opportunity to evaluate and process an application. Even after a certificate is issued, there is an additional delay before the information is entered into the database. Although the Copyright Office's recent move to elective electronic registration may reduce some of these delays, there is still a significant gap between effective registration and the availability of such information on the Copyright Office's database.¹⁰⁰

Additionally, the Copyright Office database—at least in its most accessible, online form—does not contain a single image or copy of a registered work. Instead, one must search for a work via text alone.

97. U.S. COPYRIGHT OFFICE, CIRCULAR 23, THE COPYRIGHT CARD CATALOG AND THE ONLINE FILES OF THE COPYRIGHT OFFICE 1 (2009), *available at* <http://www.copyright.gov/circs/circ23.pdf>.

98. U.S. COPYRIGHT OFFICE, CIRCULAR 22, HOW TO INVESTIGATE THE COPYRIGHT STATUS OF A WORK 1 (2009), *available at* <http://www.copyright.gov/circs/circ22.pdf> [hereinafter CIRCULAR 22].

99. 2 NIMMER & NIMMER, *supra* note 29, § 7.16[B][1][a][i]. Nimmer observes that [17 U.S.C. § 411(a)] provides that "[t]he effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office." The legislative history explains that "[w]here the three necessary elements [of application, deposit and fee] are received at different times, the date of receipt of the last of them is controlling"

Id.

100. CIRCULAR 22, *supra* note 98, at 4 ("Since searches are ordinarily limited to registrations that have already been cataloged, a search report may not cover recent registrations for which catalog records are not yet available.").

Moreover, textual searches yield only the information that an applicant has actually provided. Matching a work to a registration can, therefore, represent a task rife with uncertainty. For example, imagine that you are a potential infringer who wants to use a photograph documenting the infamous night in 2006 when Hollywood starlets Britney Spears, Lindsay Lohan, and Paris Hilton hit Los Angeles's infamous Sunset Strip to celebrate Britney's divorce from Kevin Federline. That November evening, the paparazzi were on the prowl and they caught the moment on film. The photographs hit the Internet and caused an immediate sensation, as several candid shots caught Britney *in flagrante commando*. Spears's unfortunate decision to disregard undergarments that evening led to the exposure of her nether regions to the world. It also raised two central legal issues. First, it traumatized millions, resulting in a potentially viable action for intentional infliction of emotional distress. Second, and less facetiously, it spurred a wave of copyright infringement. Within hours, thousands of blogs reproduced the images without authorization so that they could feature them on their front pages.

If you were seeking to use the photographs legally, you could have approached one of the sources of the photographs: X17.¹⁰¹ However, as easy as it would have been to contact X17 and obtain a license (for the right price, of course), it would have been impossible to determine whether the photographs were registered with the Copyright Office. First, since the photographs had just been published, there was no way to know yet about their registration status. Second, even if you were seeking to use the photographs a year later, definitively determining registration status from the Copyright Office would be next to impossible. After all, you can only search by text and not image on the database. And, to make things worse, the work lacks a determinate title. While movies and music usually have official titles, photographs often do not. Consider some of the most famous images of the 20th century. With a simple description, most readers will immediately recall the photographs to which I am referring: Mohammed Ali (then Cassius Clay) lording over a defeated Sonny Liston,¹⁰² an unnamed couple kissing jubilantly at celebrations marking the end of World War II in New York,¹⁰³ troops raising the American flag on Iwo Jima,¹⁰⁴ the first panoramic color view of planet Earth from space,¹⁰⁵ or the iconic shot of Che Guevara qua

101. X17 is one of Hollywood's leading celebrity and news photography agencies.

102. Muhammad Ali Knocks Out Sonny Liston (Photograph) (1965); Muhammad Ali Taunting Sonny Liston (Photograph) (1965).

103. Alfred Eisenstaedt, *V-J Day in Times Square* (Photograph) (1945).

104. Joe Rosenthal, *Raising the Flag on Iwo Jima* (Photograph) (1945).

105. Apollo 17 Crew, *The Blue Marble* (Photograph) (1972). Because the image is likely

revolutionary.¹⁰⁶ But while recognizing these photographs may be easy, ascertaining their registration statuses or their titles is something else altogether.

For example, to check on the registration status of the Che Guevara photo, it would help to know that the work is actually titled *Guerrillero Heroico*. Even then, the information you learn might lead you to the wrong conclusion. On the Copyright Officer's website, one would find a registration to the work that was based upon the Uruguay Round Agreement Act (URAA). The URAA restored copyright protection to certain foreign works that as of January 1, 1996 had fallen into the public domain in the United States because of a failure to comply with certain American formalities. The first problem with the registration is that it is unclear which photograph the registration relates to—the original version of the Che Guevara photograph or the more stylized, cropped version of the photograph that is more famous. Regardless of which version the registration refers to, even though the copyright records suggest the photograph is protected, the work is likely in the public domain. According to the photographer,¹⁰⁷ the original version was first published in Cuba around 1960, where copyright protection for a photograph extended only ten years from the date of first use.¹⁰⁸ Thus, the photograph has fallen into the public domain in Cuba. But assuming the photograph originally received protection in the United States at the time of

considered a government work, it is in the public domain. 17 U.S.C. § 105 (2006) (“Copyright protection under this title is not available for any work of the United States Government.”).

106. Alberto Korda, *El Guerrillero Heroico* (Photograph) (1960).

107. Sarah Levy, *A Copyright Revolution: Protecting the Famous Photograph of Che Guevara*, 13 L. & BUS. REV. AM. 687, 693 (2007). Levy notes that

[t]he newspaper likely did not request that Korda photograph Guevara specifically, as evidenced by the fact that the newspaper did not even use the photo in its article about the funeral the following day. Korda recalled that the newspaper did keep the photo on file, however, and used it in a subsequent publication alongside an announcement that Guevara would be speaking at a public event.

Id. It should be noted that others claim that publication did not occur until later. *See id.* (“[O]ther sources claim the photo remained unpublished in Korda's studio for the next seven years, leaving Korda's possession for the first time in 1967 when an Italian publisher named Giangiacomo Feltrinelli requested a copy of the image.”).

108. Copyright Law, *Gaceta Oficial de la República de Cuba*, No. 49, art. 47, 30 de diciembre de 1977 (Cuba), translated in 1 COPYRIGHT LAWS & TREATIES OF THE WORLD (U.N. Educ., Scientific & Cultural Org. et al. eds., 2000). Decree Law no. 156, September 28, 1994 extended the copyright term for photographs to twenty-five years from date of first publication. However, Korda's work would have already fallen into the public domain by 1971. Moreover, even if Decree Law No. 156 resurrected protection for works already in the public domain, the copyright would have expired in 1986.

its Cuban publication, its present status in the United States is determined by the fact that no renewal application was filed for the photograph in the twenty-eighth year after its publication, leading it to fall into the American public domain no later than 1988. And even though the URAA restored American copyrights for certain foreign works, it only applies to works that are still in copyright in the country of first publication. Since the photograph has likely fallen into the public domain in Cuba, it is ineligible for restoration. A further wrinkle is that the UGAA may not even be constitutional in the first place.¹⁰⁹ Thus, the work is likely in the public domain in the United States, even though its registration status claims otherwise.¹¹⁰ The cropped version—to the extent that it does not add substantial creativity to the original—is therefore also likely to be in the public domain.¹¹¹ Thus, even if one effectively combs through the Copyright Office’s registration documents, one might conclude that the work is both still in copyright and registered such that an infringer would face the enhanced penalties of statutory damages and attorneys’ fees if caught engaging in unauthorized use. In fact, the work is likely free for anyone to use as it is in the public domain.

Moreover, even if one definitively concludes that no registration under the name of a copyright owner exists, that does not end the inquiry on registration. Copyrights may also be registered by an exclusive licensee of a work.¹¹² As a result, determining that a copyright owner has not registered its own work does not conclusively settle the issue of registration and protection.¹¹³ In fact, the work may have been registered by any number of

109. *See, e.g.*, *Golan v. Gonzales*, 501 F.3d 1179, 1197 (10th Cir. 2007) (finding that the URAA does not violate the Copyright Clause, but remanding to the district court for First Amendment review).

110. *But see* *Levy*, *supra* note 107 (concluding that the work may still be protected).

111. *Cf.* *Hearn v. Meyer*, 664 F. Supp. 832 (S.D.N.Y. 1987) (suggesting that more than minimal creativity is required to copyright modifications to a work in the public domain). *But cf.* *Feist Publ’ns v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340 (1991) (holding that, generally, only minimal creativity is required for copyrightability).

112. *See* 17 U.S.C. § 408(a) (2006) (“[T]he owner of copyright or *of any exclusive right in the work may obtain registration . . .*”) (emphasis added); 37 C.F.R. § 202.3(c)(1) (2009) (“An application for copyright registration may be submitted by any author or other copyright claimant of a work, or the owner of any exclusive right in a work, or the duly authorized agent of any such author, other claimant, or owner.”).

113. *See* *Huthwaite, Inc. v. Sunrise Assisted Living, Inc.*, 261 F. Supp. 2d 502, 510 (E.D. Va. 2003) (noting that it is not necessary that “the party bringing the infringement must have itself registered the claim”); *Tang v. Hwang*, 799 F. Supp. 499, 503–05 (E.D. Pa. 1992) (noting that “there is no requirement under the statute that the only person who may bring an action is the person who applies for the copyright registration” and that the law merely provides that “there must be registration of the copyright”); 3 NIMMER & NIMMER, *supra* note 29, § 12.02[B] (stating that “the plaintiff in court obviously need not be the same party

the owners' exclusive licensees, a potentially large pool of entities given the difficulty courts have faced in drawing a clear distinction between exclusive and non-exclusive licensees.¹¹⁴

Additionally, many works (including photographs) may be constructively registered if they are published as part of a collection, such as a periodical, that is itself registered. In such cases, the Copyright Office records do not separately list the contents of such collections. As the Copyright Office concedes in its Circular 22, "Individual works such as stories, poems, articles, or musical compositions that were published as contributions to a copyrighted periodical or collection are usually not listed separately by title in our records."¹¹⁵ Nevertheless, courts have conferred the benefits of registration to such individual works in a variety of circumstances. For example, in *Abend v. MCA, Inc.*, the Ninth Circuit found that a magazine publisher's registration of a blanket copyright for a particular issue effectively registered a story within the issue, although the author of the story had conveyed to the publisher only magazine publication rights and retained all other rights and the author did not separately register any copyright for the story.¹¹⁶ Thus, the benefits of registration were found to extend to a smaller work contained in a larger work, even when the authors of the two works (the magazine as a whole versus the story itself) were different. Although *Abend* does not deal with the availability of statutory damages and attorneys' fees—it was decided under the 1909 Copyright Act, when timely registration was not a prerequisite for such relief—it does suggest that the benefits of a collection's registration could extend to all of the works within the collection. Other courts have made similar suggestions.¹¹⁷

who initially registered the subject work").

114. 3 NIMMER & NIMMER, *supra* note 29, § 10.02. Nimmer explains that [a]n exclusive license, even if it is "limited in time or place of effect," is equated with an assignment, and each is considered to be a "transfer" of copyright ownership. Nonexclusive licenses, however, do not constitute "transfers," and some residue of the impact of indivisibility with respect to licenses under the 1909 Act remains under the current Act *vis-a-vis* nonexclusive licenses.

Id. (internal citations omitted); David C. Tolley, Note, *Regulatory Priorities Governing Stem Cell Research in California: Relaxing Revenue Sharing & Safeguarding Access Plans*, 23 BERKELEY TECH. L.J. 219, 240 (2008) ("The distinction between an exclusive and a non-exclusive license is not easy to draw in practice. As one treatise author points out, 'commercial practice yields a wide variety of differing transactional frameworks . . . making drawing a simple distinction between exclusive and nonexclusive licenses difficult.'") (quoting RAYMOND NIMMER & JEFF DODD, MODERN LICENSING LAW § 5:1 (2007)).

115. CIRCULAR 22, *supra* note 98, at 3.

116. *Abend v. MCA*, 863 F.2d 1465, 1469 (9th Cir. 1988).

117. *See, e.g., Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 204–05 (3d Cir. 2005)

In the end, this exhaustive examination of the vagaries of the search process and the law surrounding it leads to an inescapable conclusion: registration status can be difficult to determine with certainty. Returning to our example involving Britney Spears and her night on the town with Paris Hilton and Lindsay Lohan, this point becomes clear. In one of my more dubious professional accomplishments, I actually registered the copyright to a set of these photographs.¹¹⁸ Late one night, I was left to decide the title of each photograph, including the infamous “upskirt” shots. In an homage to Spears’s hit, *Oops! . . . I Did It Again*, I briefly contemplated going with *Oops! . . . She Did It Again*. But I ultimately went with the distinctly less titillating, but eminently more descriptive, appellations *Britney Spears exposes her derriere*¹¹⁹ and *Britney Spears exposes herself (again)*,¹²⁰ so as to increase the possibility (no matter how unlikely) that would-be infringers could in fact identify the registration status of the work. However, as this example illustrates, there is no assurance that the title will match the work at all.

All told, the registration requirement—at least as presently implemented—fails its basic notice function. It is doubtful whether would-be infringers would really engage in ex ante consultation of the registration rolls. Even if they did, they would have trouble finding a definitive answer on registration status. For works registered before 1978, registration records are not easily available. For more recent works, the available database is not up to date. Information provided in the database is text-only, making it difficult to identify the registration status of certain works. This problem is especially acute for visual works. Moreover, divining the title of some works can prove to be challenging. Furthermore, registration can be achieved not only by a copyright holder but also by any of its exclusive licensees, of which there may be several. And works can be constructively registered as a part of a larger

(finding that a garden sculpture included in a copyrighted catalog of sculptures was an individually recognizable element of that single work, and thus was entitled to the benefits of the catalog’s copyright registration, regardless of whether it was “related” to other sculptures in catalog); *Warren v. Fox Family Worldwide, Inc.*, 171 F. Supp. 2d 1057, 1065 (C.D. Cal. 2001) (finding that a copyright registration of a motion picture or television show serves to register the musical compositions contained on the soundtrack of the film or show); *Greenwich Film Prods., S.A. v. DRG Records, Inc.*, 833 F. Supp. 248, 250 (S.D.N.Y. 1993) (musical compositions in motion picture were registered with copyright office by virtue of registration of motion picture in which they were contained, and musical compositions did not have to be separately registered).

118. The registrations were part of a suit by X17, Inc. against Mario Lavandeira, aka Perez Hilton, a celebrity gossip blogger accused of infringing X17’s copyrighted photographs en masse. *See X17 v. Lavandeira*, 563 F. Supp. 2d 1102 (C.D. Cal. 2007).

119. X17, Inc., VA0001390186, registered December 1, 2006.

120. X17, Inc., VA0001390193, registered December 1, 2006.

work. In short, the registration system remains relatively opaque, thereby undermining its purported utility.

E. REGISTRATION, REMEDIES, AND INTERNATIONAL TREATY OBLIGATIONS

Besides failing its basic notice function, our registration system also runs into a legal concern that has remained largely unscrutinized: it potentially shirks our international treaty obligations. The timely registration requirement for statutory damages and attorneys' fees arguably flouts the tenets of the Berne Convention. Moreover, the potential incompatibility of the United States' registration regime with international law becomes even clearer when one considers the language of the WIPO Copyright Treaty. These issues are particularly salient at a time when we are taking other countries to task for their failure to honor international copyright obligations. Moreover, it is difficult to call out foreign countries for their alleged disrespect for the value of intellectual property when we do not adequately protect many domestic creators.

The world's oldest international copyright agreement, the Berne Convention for the Protection of Literary and Artistic Works, was first drafted in 1886. But the United States did not accede to the Convention until 1988, more than a century later.¹²¹ According to the principal congressional architect of its implementation, the prohibition on formalities is "the central feature of Berne."¹²² According to conventional wisdom, therefore, Berne's implementation in 1988 eliminated most of the remaining formalities of the American copyright regime. Yet, despite this, the requirement for timely registration in order to recover statutory damages or attorneys' fees continues to survive. All the while, many observers have blithely rejected any possible conflict between § 412 and the dictates of the Convention. For example, as Ralph Oman, who drafted the Practising Law Institute's publication *The Impact of Berne on U.S. Copyright Law*, dismissively argues, "we could scotch the requirement of timely registration as a precondition to statutory damages and attorneys' fees, but, whatever the policy arguments pro and con, it is difficult to argue with a straight face that this fringe-benefit is a formality barred by the Berne Convention."¹²³

121. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (codified as amended in scattered sections of 17 U.S.C.).

122. 134 CONG. REC. H3079-02 (daily ed. May 10, 1988) (statement of Rep. Kastenmeier).

123. Ralph Oman, *The Impact of the Berne Convention on U.S. Copyright*, PATENT, COPYRIGHTS, TRADEMARKS, AND LITERARY PROPERTY COURSE HANDBOOK SERIES,

It is certainly possible that the registration prerequisite for statutory damages and fees does not violate Berne. After all, it was on that understanding that the Berne Convention Implementation Act of 1988 was passed. Before the United States formally enacted the Convention, the State Department put together the Ad Hoc Working Group on U.S. Adherence to the Berne Convention to evaluate areas of American copyright law falling outside of the parameters of Berne. The Group's report formed the basis for the Implementation Act, which, in the words of one scholar, took a "minimalist approach to adherence."¹²⁴ Upon consideration of whether § 412's registration prerequisite for statutory damages and attorneys' fees constituted an impermissible formality, the Ad Hoc Group glibly concluded that "[s]ection 412 is compatible with Berne since it deals with certain specific remedies rather than the ability to obtain redress at all."¹²⁵ Nimmer appears to agree, concluding that "Berne imposes a condition that copyright subsistence for works emanating from other member states may not be premised on formal requirements. It does not, however, prohibit formalities as a condition to certain types of remedies, licenses, exemptions, etc."¹²⁶

However, the contrary position—that the statutory damages prerequisite violates Berne's prohibition on formalities—is hardly as implausible as Oman and others may suggest. Here, perhaps, Oman's impressive background comes into play: he spent almost a decade as the Registrar of the Copyright Office, where he led the federal government's efforts to enter the Berne Convention and served as chief counsel of the Senate Subcommittee on Patents, Copyrights, and Trademarks.¹²⁷ As a result, he may be disinclined to second-guess his own work by legitimizing questions as to whether our statutory damages and fees scheme complies with Berne. Additionally,

Practising Law Institute, PLI Order No. G4-3981, 455 PLI/Pat 233, 255 (October, 1996).

124. William Belanger, *U.S. Compliance with the Berne Convention*, 3 GEO. MASON INDEP. L. REV. 373, 393 (1995).

125. *Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, reprinted in 10 COLUM.-VLA J.L. & ARTS 513 (1986).

126. 4 NIMMER & NIMMER, *supra* note 29, § 17.01(B).

127. U.S. Copyright Office, <http://www.copyright.gov/history/bios/oman.pdf>. Oman's bio states,

In 1982, Mr. Oman became Chief Counsel of the newly revived Subcommittee on Patents, Copyrights, and Trademarks, and in 1985 he scheduled the first Senate hearing in 50 years on U.S. adherence to the Berne Convention for the Protection of Literary and Artistic Works. From the Chief Counsel position, he was appointed Register of Copyrights on September 23, 1985. As Register, Mr. Oman helped move the United States into the Berne Convention in 1989.

Id.

Oman's characterization of statutory damages as mere *fringe* benefits is intellectually disingenuous. Rather than a peripheral or secondary feature of copyright law, statutory damages are in practice the only effective means under U.S. law by which plaintiffs can enforce their copyrights in a matter that deters future infringements.

Indeed, there is reason to believe that the registration prerequisite for statutory damages and attorneys' fees may actually violate treaty obligations such as the Berne Convention. In relevant part, the Berne Convention dictates that "[t]he enjoyment and the exercise of these rights shall not be subject to any formality."¹²⁸ These rights include the exclusive right of reproduction of a copyrighted work.¹²⁹ Because copyright registration is undoubtedly a formality, the threshold question is whether it affects a copyright holder's "enjoyment and exercise" of rights purportedly secured by the Berne Convention.

Though Oman, the Ad Hoc Group, and Nimmer appear to draw a distinction between copyright subsistence and copyright remedies—arguing that Berne prohibits formalities attaching to the former but not the latter—such a conclusion is not inescapable. The language of Berne draws no clear-cut subsistence/remedies dichotomy. Instead, it speaks of the "enjoyment and exercise" of rights, something to which remedies are inextricably related. Consider the most foundational case in American constitutional jurisprudence, *Marbury v. Madison*, which advanced the critical link between the creation of a right and the affordance of a meaningful remedy for violation of that right.¹³⁰ Admittedly, there is no language in the Berne Convention that explicitly requires a member state to provide prevailing plaintiffs with statutory damages or even attorneys' fees. Indeed, the Convention makes no mention of remedies whatsoever. However, one can argue—with a straight face, to boot—that enjoyment and exercise of one's

128. Berne Convention for the Protection of Literary and Artistic Works art. 5(2), Sept. 9, 1886, as last revised at Paris, July 24, 1971, 828 U.N.T.S. 221, S. TREATY DOC. NO. 99-27.

129. *Id.* at art. 9(1).

130. *Marbury v. Madison*, 5 U.S. 137, 163 (1803). The court stated, "The very essence of civil liberty certainly consists in the right of every individual to claim the protection of the laws, whenever he receives an injury. One of the first duties of government is to afford that protection. . . . The government of the United States has been emphatically termed a government of laws, and not of men. It will certainly cease to deserve this high appellation, if the laws furnish no remedy for the violation of a vested legal right."

Id.

exclusive right of reproduction necessarily requires the ability to *deter* infringement.¹³¹

Thus, while Berne may not ban a copyright registration system that serves a procedural end, its language appears to render any copyright registration system that affects substantive rights, including significant remedies, suspect. In the absence of an ability to pursue statutory damages and attorneys' fees, there is little deterrent effect in copyright enforcement under American law. Indeed, the worst-case scenario for a defendant is that they might have to pay damages *ex post* in an amount similar to what they might have paid for a license *ex ante*. They may also face an injunction, but not one that issues automatically upon a finding of infringement. Moreover, making attorneys' fees unavailable to a prevailing plaintiff in an infringement case stifles his ability to be made whole for the injury to his rights. Over the years, I have been approached by hundreds of artists who have no viable infringement suit against monied defendants who have undoubtedly and willfully infringed their copyrights. The first question that any experienced copyright litigator asks a potential plaintiff-client is: "Were the works registered before the infringement occurred?" If the answer is negative, the artist is often left with only extralegal means, such as moral force or business sanctions (where available), to rectify the wrongdoing.

Furthermore, even if one accepts the view that Berne does not proscribe the existence of formal prerequisites for certain remedies, that does not end the discussion on international obligations. More recent treaties also need to be considered. For instance, the WIPO Copyright Treaty (WCT) calls into serious question the continued viability of the registration prerequisite for statutory damages and attorneys' fees.

The United States played a key role in drafting the WCT, which went into force domestically on March 6, 2002. The WCT serves as an extension to the rights established by the Berne Convention and was passed pursuant to Article 20 of the Convention.¹³² Unlike Berne, the WCT actually makes specific reference to the remedy obligations of "Contracting Parties," mandating that the parties "shall ensure that enforcement procedures are

131. Although she does not necessarily argue that the registration requirement explicitly violates the requirements of Berne, Shira Perlmutter has flagged its philosophical incompatibility with Berne. See Shira Perlmutter, *Freeing Copyright from Formalities*, 13 CARDOZO ARTS & ENT. L.J. 565, 565–66, 575–76 (1995).

132. WIPO Copyright Treaty art. 1(1), Dec. 20, 1996, 36 I.L.M. 65, S. TREATY DOC. NO. 105-17 ("This Treaty is a special agreement within the meaning of Article 20 of the Berne Convention for the Protection of Literary and Artistic Works, as regards Contracting Parties that are countries of the Union established by that Convention.").

available under their law so as to permit *effective action* against any act of infringement of rights covered by this Treaty, including expeditious remedies to prevent infringements and remedies which constitute a *deterrent to further infringements*.”¹³³ For creators who do not timely register, American law provides no punitive damages, statutory damages, or attorneys’ fees. With only actual damages or disgorgement of profits left, there is no deterrent effect and plaintiffs are frequently unable to take effective legal action against infringers.

III. HIERARCHY AND REFORM

The American copyright registration system not only frustrates the ability of many creators to be made whole for even the most egregious infringements of their copyrights, but it also fails to fulfill its basic notice function and possibly violates our international treaty obligations. Nevertheless, efforts to eliminate § 412 have been met with steep resistance and therefore have not been enacted. While it is impossible to ascertain precisely why such proposed amendments were never enacted, the hearings surrounding this issue provide clues as to who opposed the elimination of § 412 and why they opposed this change.

As the following analysis reveals, by creating a two-tiered system of protection, the registration requirement constructs a hierarchy of works defined by their violability. Works by sophisticated creators have the opportunity to become part of the commercial canon. Their aura is secured through artificial scarcity perpetuated by copyright law and the dramatic penalties facing infringers for unauthorized exploitations of such works. Thus, sophisticated creators can dangle copyright’s Sword of Damocles over the heads of would-be infringers. Almost any book, periodical, recording, movie, television show, or computer program distributed by a large press, magazine publisher, music label, film studio, broadcast network, or software developer enjoys similar protection, even though many such works may lack continued economic value.¹³⁴ The recent wave of high profile infringement suits involving peer-to-peer file sharing clarifies this point: the expansive remedies provided by the Copyright Act allow organizations such as the RIAA to hand individual defendants their heads on a platter with more fervor than Salomé’s dance (to licensed music, of course).

133. *Id.* at art. 14(2).

134. Of course, this is only true so long as these works remain under copyright protection.

For an illustration of this concept, consider the case of Jammie Thomas-Rasset, a single mother of four who earned her living working as a natural-resources coordinator for a Native American tribe in Minnesota. In 2005, Thomas was sued by the RIAA for sharing 24 songs on the peer-to-peer file-sharing site Kazaa. Initially, the court found Thomas liable for willful copyright infringement in the amount of \$222,000. While the \$9250 per track judgment may seem high, it was far less than the \$150,000-per-track statutory damages that courts are permitted to award plaintiffs, even in the absence of any proof of actual harm. Ultimately, however, Thomas earned a retrial when the verdict was thrown out based on an error in jury instructions.

Unfortunately for Thomas, things went even worse the second time around. In 2009, a jury returned another judgment against her, this time for the whopping amount of \$1.92 million. At \$80,000 per song, this is almost a full order of magnitude larger than the earlier verdict. The infringed songs were sold on iTunes at a price of ninety-nine cents each, arguably making the ratio between the verdict and the actual damages 80,000 to 1.¹³⁵ Ironically, in the context of punitive damages awards, the Supreme Court has ruled that any ratio in excess of ten to one violates the due process clause of the Constitution.¹³⁶

On the other hand, non-registered works—generally those produced by unsophisticated creators such as individual artists—serve as fodder for remix, reinterpretation, transformation, and unauthorized use. These works lack any aura, their violability is not patrolled, and they may be infringed, sometimes even with impunity. As a result, the current system does not uniformly protect the interests of all authors so much as it privileges a certain class of works. The primary beneficiaries of this system are the major players in the copyright industry—the large corporations that are both generators and users of content. A system with more uniformly harsh consequences for infringement would be unfavorable to these players when they are on the receiving end of suits. This is especially so because the law imposes liability

135. Cf. Chris Williams, *Big Fine Could Be Big Trouble in Music Downloading Case*, Associated Press Newswire, June 19, 2009. The article noted that Tom Sydnor, director of the Progress & Freedom Foundation's Center for the Study of Digital Property, defended the verdict, arguing that "[l]egally acquiring a license to give copies of a song to potentially millions of Kazaa users might well have cost \$80,000 per song." *Id.*

136. See *BMW of N. Am. v. Gore*, 517 U.S. 559, 581 (1996) (concluding that the relevant ratio for determining punitive damages as compared to compensatory damages is "not more than 10 to 1"); see also *State Farm Mut. Auto. Ins. Co. v. Campbell*, 538 U.S. 408, 425 (2003) ("Our jurisprudence and the principles it has now established demonstrate . . . few awards exceeding a single-digit ratio between punitive and compensatory damages, to a significant degree, will satisfy due process.").

on both direct and vicarious infringers, regardless of mens rea (though mens rea can affect the amount of damages in a case of timely registration).¹³⁷ A two-tiered system is ideal for these corporations. When they infringe the materials of others—even if they do so willfully—the consequences are relatively benign. Meanwhile, when an outsider infringes their work, the penalties are draconian. The strategic preference of certain sophisticated creators for this dichotomous structure becomes clear when one examines the failed efforts to eliminate § 412 in the early 1990s.

A. SECTION 412 REFORM AND ITS DISCONTENTS

In 1993, Representative William J. Hughes of New Jersey introduced legislation—dubbed the Copyright Reform Act—that, inter alia, repealed the registration requirement for standing, statutory damages, and attorneys' fees.¹³⁸ The House ultimately passed the bill on November 20, 1993 and again on September 20, 1994.¹³⁹ However, the bill died when the Senate failed to act.¹⁴⁰

The available paper trail provides insight into the various interests that worked to prevent the bill from passing. A number of groups that represent libraries or smaller creators including the Graphic Artists Guild, the American Society of Media Photographers, the Software Publishers Association, the Committee for Library Property Studies, and the American Association of Law Libraries all spoke in favor of the bill.¹⁴¹ Just three groups came to speak in opposition.¹⁴² Yet the bill never passed. These three groups were, oddly enough, the Association of American Publishers (AAP), the

137. See, e.g., NIMMER & NIMMER, *supra* note 29, § 13.01 (reflecting that state of mind is not a relevant element in making a prima facie case of copyright infringement).

138. Copyright Reform Act of 1993, H.R. 897, 103d Cong. (1993). Senator Dennis DeConcini introduced a related bill in the Senate. Copyright Reform Act of 1993, S. 373, 103d Cong. (1993). On November 17, 1993, Hughes's bill received a favorable report from the Subcommittee on Intellectual Property and Judicial Administration of the House Committee. See John B. Koegel, *Bamboozlement: The Repeal of Copyright Registration Incentives*, 13 CARDOZO ARTS & ENT. L.J. 529, 529 n.1 (1995); Copyright Reform Act of 1993, H.R. Rep. 103-388 (1993).

139. H.R. 4307, 103d Cong. (1994).

140. Shira Perlmutter, *Freeing Copyright from Formalities*, 13 CARDOZO ARTS & ENT. L.J. 565, 572 (1995).

141. *Copyright Reform Act of 1993: Hearing on S. 373 Before the Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. On the Judiciary*, 103d Cong. (1993) [hereinafter *Hearings*] (witness list).

142. *Id.* Poet and novelist Erica Jong, a member of the Authors Guild, testified in support of the legislation, but she appeared only in her individual capacity because her opinion was not shared by the organization. *Id.* (statement of Erica Jong) (“I emphasize that I am here as an individual author and not in any official capacity.”).

American Association of University Presses (AAUP) and the Authors Guild (AG). The AAP is, in its own words, “the principal trade association of the U.S. book publishing industry.”¹⁴³ The AAUP is a trade association with more than 130 members worldwide, consisting of both non-profit academic and scholarly publishers.¹⁴⁴ Finally, despite its name, the AG neither represents most authors, nor speaks for them. Indeed, by their own description at the time, the Guild was made up of “6500 published writers—authors of fiction, history, biography, textbooks, periodical articles, short stories and other literary works—and includes winners of the Nobel Prize in Literature, the Pulitzer Prize and countless other literary awards.”¹⁴⁵ Their membership numbers have grown since the date of the 1993 hearing,¹⁴⁶ but membership decisions continue to be made on a case-by-case basis upon application. At a minimum, book authors must have published their work with an established American publisher and received a “significant advance” in order to receive consideration.¹⁴⁷ The AG therefore constitutes an elite group of only the most successful commercial authors—individuals who have a strong interest in the inviolability of their works. Not surprisingly, their spokesperson at the hearing on the Copyright Reform Act of 1993 was novelist Scott Turow, an author who has profited handsomely from adaptations of his works in a number of contexts.¹⁴⁸

At first blush, one would think that groups representing the interests of publishers and authors would appreciate the ability to vindicate their rights with fewer formalities. However, such groups already register their works and therefore already have the opportunity to vindicate their rights to the fullest extent possible under the law. Yet when they are on the receiving end of a lawsuit, they would also prefer that their opponents not have the full panoply of remedies available. After all, many creators make use of other copyrighted

143. Association of American Publishers, <http://www.publishers.org/> (last visited Feb. 13, 2010). According to their “Membership” page, approximately 260 publishers belong to the AAP.

144. Association of American University Publishers, <http://aaupnet.org/membership/directory.html> (last visited Feb. 21, 2010).

145. *Hearings*, *supra* note 141, (statement of Scott Turow) (“appearing . . . in [sic] behalf of The Author’s Guild, Inc.”).

146. There are currently over 8000 authors in the Authors Guild. The Authors Guild, History, <http://www.authorsguild.org/about/history.html> (last visited Feb. 13, 2010).

147. The Authors Guild, *Membership Eligibility*, <https://www.authorsguild.org/join/eligibility.html> (last visited Feb. 13, 2010).

148. *See, e.g.*, PRESUMED INNOCENT (Warner Bros. Pictures 1990) (theatrical film version of Turow’s novel of the same name); THE BURDEN OF PROOF (1992) (television miniseries version of Turow’s novel of the same name); REVERSIBLE ERRORS (2004) (television mini-series version of Turow’s novel of the same name).

works. With the current registration regime, sophisticated interests get the best of both worlds: the full range of remedies when they are plaintiffs seeking vindication of their intellectual property interests, but incredibly narrow remedies when they are defendants, thereby helping them to fend off suits for infringement.

Strangely, the forces opposing § 412's repeal dismissed the possibility that the existing system might frustrate the ability of copyright holders to vindicate their intellectual property rights. After what it claimed to be "an elaborate process of consultation with its own members and representatives of other writers groups," the Authors Guild concluded that

[o]ur efforts to find an example of a meritorious claim by a writer that was lost or seriously frustrated under the present system was unsuccessful. Undoubtedly, there must be such cases; but our diligent efforts to study the issue empirically suggest that instances where the lack of statutory damages have prevented writers from bringing infringement claims are far less widespread than imagined and that the currently available remedies appear to be accomplishing their intended effect.¹⁴⁹

Unfortunately, it seems that the Guild's researchers were not looking particularly hard, as such a claim appears thoroughly disingenuous in light of our prior discussion. Indeed, a simple examination of case law reveals numerous cases demonstrating just this point.

Take *Deltak, Inc. v. Advanced Systems, Inc.*,¹⁵⁰ a case decided a decade before the debate over the Copyright Reform Act of 1993 took place. The litigation involved Deltak's claims of literary infringement, but not of the highbrow variety. Rather, copy from a corporate pamphlet describing programs that taught data processing skills were lifted wholesale by a rival company, Advanced Systems, for use in its brochures. In the suit, Judge Richard Posner, who was sitting as by designation, found that the defendant had not only infringed plaintiff's copyright, but had done so willfully. On this basis, he noted that

[i]f Deltak had registered its copyright within the time provided by the Copyright Act, I would have no hesitation in awarding not only the maximum statutory damages [at the time] under section 504(c)(2) of \$50,000, but also attorney's fees, which are authorized

149. *Hearings*, *supra* note 141, (statement of Scott Turow).

150. *Deltak, Inc. v. Advanced Systems, Inc.*, 574 F. Supp. 400 (N.D. Ill. 1983).

by section 505 and are frequently awarded in cases of willful infringement even if no actual damages are proved.¹⁵¹

Not surprisingly, however, the plaintiff had not timely registered its copyright, and was unable to establish damages with sufficient certainty.¹⁵² The defendant's plan to use Deltak's brochures for its own marketing purposes ultimately failed, and therefore there were no proven profits to disgorge or actual sales lost by the plaintiff.¹⁵³ As a result, despite the willful infringement of its works, Posner felt it was left with no alternative to but to award the plaintiff *nothing*, despite the verdict in its favor.¹⁵⁴ As the Second Circuit lamented when dealing with the same issue in a different case, the existing § 412 structure can lead to "the anomaly of affording plaintiffs a right without a remedy."¹⁵⁵ These cases represent only the tip of the iceberg because the dictates of § 412 render such infringements—no matter how unabashed—impractical to litigate.

Conversely, opponents of the reform efforts claimed that the elimination of § 412 would undermine the legitimate fair use of copyrighted works by spurring frivolous and vexatious litigation by rapacious rights holders. As the AAP and AAUP stated,

We oppose repeal because it would upset the careful and critical balance struck by [§]412 among the interests of authors and publishers of pre-existing works and those who would transform, build upon and make reasonable use of those works. Repeal would discourage legitimate and important activities of historians, biographers, journalists, and other authors and publishers.¹⁵⁶

Taken at face value, and viewed narrowly, the sentiments reflected in this testimony seem to make eminent sense. However, when one considers the positions taken by the AAP and AAUP in litigation and its public representations and one assesses the situation in the broader context of rights management, things appear quite different.

151. *Id.* at 402.

152. *Id.* at 411.

153. *Id.* at 403–04, 411–12.

154. *Id.* at 412. Ultimately, on appeal, the Seventh Circuit carved out a relatively novel exception by allowing recovery of a reasonable license fee in such situations. The court therefore remanded the case for recalculation of damages. However, in other circuits, such as the Second, the possibility of such recovery has been clearly disavowed, regardless of the harsh and seemingly inequitable consequences. *See Business Trends Analysts, Inc. v. Freedonia Group, Inc.*, 887 F.2d 399, 406 (2d Cir. 1989).

155. *Id.* at 406 (citing 3 NIMMER & NIMMER, *supra* note 29, § 14.02[A]).

156. *Hearings, supra* note 141, (statements of the American Association of Publishers and the American Association of University Presses).

Unless we make the dubious assumption that the AAP and AAUP are somehow more socially responsible and altruistic than other copyright holders, the arguments of the AAP and AAUP would militate against the availability of statutory damages and fees in *all* infringement suits, lest they encourage frivolous litigation. After all, many of the works to which the AAP and AAUP claim copyright are works of which historians, biographers, journalists, and other authors and publishers would like to make transformative, accretive, or reasonable use. Nevertheless, the AAP and AAUP were clearly not willing to take such a stand. After all, by timely registering their works, they enjoy dramatic benefits when, as rights holders, they seek to assert their copyrights and pursue alleged infringers with the threat of statutory damages and attorneys' fees. Indeed, their palaver regarding legitimate educational activities is readily betrayed by the fact that they have no qualms about opposing the unauthorized use of *their* copyrighted works as primary materials for other historians, biographers, journalists, and researchers in many contexts. As it turns out, the AAP and AAUP have repeatedly asserted that *any* unauthorized use of their works constitutes an act of infringement and they have demonstrated a willingness to sue on the basis of this principle.

For example, in just the past few years, the major academic publishers have filed dozens of lawsuits across the country against reproduction shops that produce course "readers" used on college campuses on the theory that such packets violate the publishers' copyrights.¹⁵⁷ Although the makers of the course readers undoubtedly profit in their provision of these services, the packets directly serve an educational purpose. Section 107 of the Copyright Act explicitly states, "the fair use of a copyrighted work, . . . for purposes such as . . . teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright."¹⁵⁸ Section 107's language may be merely preambulatory, or it may create a bright-line rule protecting the use of copyrighted materials for teaching and research

157. *See, e.g.,* Princeton Univ. Press v. Michigan Document Servs., Inc., 99 F.3d 1381, 1400 (6th Cir. 1996); Basic Books, Inc. v. Kinko's Graphics Corp., 758 F. Supp. 1522, 1532 (S.D.N.Y. 1991) (holding that while the particular course packets at issue were copied for educational purposes, they did not qualify as fair use because, inter alia, they were made for profit).

158. 17 U.S.C. § 107 (2006). It should be noted that, in spite of this language, courts have still managed to find a plethora of instances where use of a copyrighted work for teaching, research, or scholarship constitutes infringement. *See, e.g.,* Princeton Univ. Press, 99 F.3d at 1391; Am. Geophysical Union v. Texaco, 37 F.3d 881, 899 (2d Cir. 1994); Television Digest, Inc. v. U.S. Tel. Ass'n, 841 F. Supp. 5, 11 (D.D.C. 1993); *Basic Books, Inc.*, 758 F. Supp. at 1547.

purposes. But either way, for the concept of fair use to have any meaning, there must be some threshold at which the use of a copyrighted work for such purposes is excused—whether it is the quotation of a single sentence or the unauthorized reproduction of many pages. Nevertheless, the major publishers serving the academic community have vigilantly maintained that any use, no matter how small, by the copy shops requires their authorization and payment through the Copyright Clearance Center—a centralized clearing house for published content.¹⁵⁹ And, in their public statements, it appears that this position is not simply limited to copy-shops but extends to any unauthorized use of their copyright works. In language that has grown almost *de rigueur* in the industry, one leading academic publisher warns: “No part of this book may be reprinted or reproduced or utilized in any form or by any electronic, mechanical, or other means, now known or hereafter invented, including photocopying and recording, on in any information storage or retrieval system, without permission in writing from publishers.”¹⁶⁰

More broadly, an examination of copyright stances taken by some sophisticated creators quickly undermines any assumption that they are less likely to engage in extreme and aggressive positions vis-à-vis their purported intellectual property rights. As Jason Mazzone points out, major publishers often claim copyright protection over works that are indisputably in the public domain. Many of these works constitute important primary source materials for historians and others. In a quintessential example of overbearing copyright claims, Mazzone observes that a pocket version of the United States Constitution sold on the market sternly warns anyone against reproducing the work without written permission from the publisher. As Mazzone quips, “Whatever the Constitution’s framers and ratifiers had in mind when they authorized Congress to create copyright law, they surely did not expect that somebody would one day claim a copyright in the Constitution itself.”¹⁶¹

All told, there is no reason to think that sophisticated creators, such as the AAP, AAUP, or the AG are any more altruistic or socially responsible with the enforcement of their copyrights than any other rights holder. As such, drawing a line on the availability of statutory damages and attorneys’

159. Founded in 1978 by a group of publishers and authors, the CCC is a clearinghouse for the licensing of “millions of books, journals, newspapers, websites, ebooks, images, blogs and more.” Copyright Clearance Center, About Us, <http://copyright.com/viewPage.do?pageCode=au1-n> (last visited Nov. 25, 2009).

160. See, for example, the copyright insert for STEVE NEALE, *GENRE AND HOLLYWOOD* (2000).

161. Jason Mazzone, *Copyfraud*, 81 N.Y.U. L. Rev. 1026, 1028 (2006).

fees with the timely registration requirement in order to prevent a tide of frivolous litigation makes little sense. Moreover, by comparing the purported reasoning of such groups as the AAUP and APA in opposing § 412 reform with their litigation agendas and fair use policies, it becomes reasonable to at least suspect that § 412 serves sophisticated creators quite well by granting them expansive rights to use the works of unsophisticated creators without authorization while simultaneously enabling them to enforce their own copyrights with tenacity and severity.

B. HIERARCHY IN HOLLYWOOD

In light of our foregoing discussions, it is natural to ask how artists could fail to register their works. After all, artists dedicate countless years and make many sacrifices to bring their work to fruition. It may seem surprising that they do not take that extra step to obtain full legal protection for their works. Part of the problem is that many artists are not aware of the importance of registration. Others do not want to be bothered with paperwork and its apparent complexities. However, it is not simply a matter of ignorance or myopia. For many artists, effective and timely registration is cost-prohibitive. For example, for artists such as photographers who create a large volume of works, only a small number of which may attain high value, registration can be a costly affair.¹⁶² In recent years, the Copyright Office has adopted regulations that allow group registration of some works, but these regulations are highly restrictive.¹⁶³ Moreover, many artists are effectively dissuaded from registration by relying on private registration regimes—regimes that grant them some of the benefits of going through the Copyright Office, but not the recovery of statutory damages and attorneys' fees. As we shall see, screenwriters are such a group. At the same time, the field of screenwriting also provides a salient illustration of the modern two-tiered protection system, its perpetuation of hierarchy and the powers that it serves.

162. See Ossola, *supra* note 50, at 560 (1995). Ossola states, Photographers present special problems, given the tremendous volume of works created, but these problems are not unique to them. With thousands of images created each year, it is literally impossible for anybody, even the most successful photographers, to register those images in the Copyright Office. As a result, even the most successful photographers consistently fail to register their works.

Id. In their analysis of copyright registrations and renewals from 1910 through 2000, William Landes and Richard Posner determined that even small fee increases can result in precipitous declines in registrations and renewals. WILLIAM M. LANDES & RICHARD POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 245 (2003).

163. 17 U.S.C. § 408 (2006) (providing for group registration of certain copyrighted works).

In Hollywood, it is no secret that screenwriters often feel unappreciated and disenfranchised. Directors are, after all, viewed as the CEOs of movies—their names drive critical discussions about oeuvres and masterpieces. Through the “a film by” credit, directors are designated by fiat as a film’s auteur. Similarly, actors serve as the industry’s public face and have always represented a key engine of its financial success—at least until recently.¹⁶⁴ And, while it is true that a movie cannot get made without a script, the overriding sentiment towards screenwriters is perhaps best captured by one studio mogul’s famous musing: “If we could only figure out a way to make movies without writers.”¹⁶⁵ In the early days of the industry, some of our finest novelists sought to pay their bills by trying their luck in Tinsel Town. The products of these ill-advised ventures by William Faulkner, Nathanael West, James Agee, Ernest Hemingway, and others are notorious.¹⁶⁶ As critic Edmund Wilson would later observe, the failures of Fitzgerald and West “may certainly be laid partly to Hollywood, with its already appalling record of talent depraved and wasted.”¹⁶⁷ The writers often wound up defeated and desolate. To Wilson, however, the result was not surprising: Hollywood was “an intractable magnetic mountain, which twists American fiction askew.”¹⁶⁸

There are, of course, many factors that allow such “twisting” to take place: commercial realities, the multidimensional nature of the movie-making process, bargaining power disparities, the history of the industry, and the roles of the various guilds representing above-the-line talent such as directors, actors, and writers. However, the “twisting” is also aided by a de facto norm in the industry that is not usually analyzed: the absence of strong copyright protection for scripts.

In Hollywood, paranoia over the unauthorized usurpation of the heart of one’s screenplay or treatment runs rampant. And the reason is simple: it happens. Screenwriters have responded, but not with widespread registration of their works with the Copyright Office. Instead, since 1927, the Writers Guild of America, West (WGAW) has administered a registration system for works that is convenient, easy to use, and relatively inexpensive.

164. See, e.g., Willa Paskin, *WHO KILLED THE MOVIE STAR?: Hollywood’s A-list Idols Are Losing Their Movie-Selling Mojo*, RADAR MAGAZINE, (July/August 2008).

165. See Andrew McWhirter, *Film: Fameless Faces – Hidden Art of Screenwriting Revealed*, TRIBUNE MAGAZINE, Jan. 19, 2009, available at <http://www.tribunemagazine.co.uk/2009/01/19/film-fameless-faces-%E2%80%93%20hidden-art-of-screenwriting-revealed/>.

166. Edmund Wilson, *The Boys in the Back Room*, in CLASSICS AND COMMERCIALS: A LITERARY CHRONICLE OF THE FORTIES 19, 56 (1950).

167. *Id.*

168. HUBERT BUTLER, *INDEPENDENT SPIRIT: ESSAYS* 271, 272 (2000).

Unfortunately, it is also largely useless when utilized in lieu of a copyright registration, as it frequently is.

Billed as “the world’s number one screenplay and intellectual property registration service,”¹⁶⁹ and the “the industry standard in the creation of legal evidence for the protection of writers and their work,”¹⁷⁰ the WGAW Registry is not entirely without utility. Individuals—both the general public and WGAW members alike—can deposit copies of their works, including screenplays and treatments prepared for radio, film, television, video, interactive media, and other works such as theatrical plays, novels, short stories, poems, commercials, lyrics, drawings, and music, with the WGAW. This helps to establish date of creation by producing a record of a screenplay or treatment being held in deposit by the Guild. This record can be useful should charges of plagiarism, misappropriation, or copyright infringement later emerge.

However, there is no good reason to opt for the WGAW’s registration system over that of the Copyright Office. Unfortunately, however, many individuals, both inside and outside of the industry, do. The reason is not surprising. In a blurb buried within its Frequently Asked Questions section, the WGAW website does disclaim that “[r]egistering your work with the WGAW Registry does not take the place of registering with the Library of Congress, U.S. Copyright Office.” But the Guild obfuscates the registration issue by eschewing explanation of the dramatic consequences of failing to register a work with the Copyright Office.¹⁷¹ Moreover, its website states that WGAW registration and Copyright Office registration “both create valid legal evidence that can be used in court,” thereby promoting a deceptive sense of interchangeability between the two regimes.¹⁷²

But the two forms of registration are far from equal. Any work that is capable of being registered with the WGAW is, by its very nature, capable of being registered or pre-registered with the U.S. Copyright Office, since it is an original work of authorship fixed in a tangible medium.¹⁷³ Yet the WGAW registration system fails to provide several of the key advantages of

169. Writers Guild of America, West, Registry, http://www.wga.org/subpage_register.aspx?id=1183 (last visited Sep. 29, 2009).

170. WGA West: Registry, <http://www.wgawregistry.org/> (last visited Sep. 29, 2009).

171. WGA West: Registry, Frequently Asked Questions, Does Registration Take the Place of Copyright?, <http://www.wgawregistry.org/webrss/regfaqs.html#quest14> (last visited Sept. 29, 2009).

172. *Id.*

173. The copyright protection that a treatment or story outline receives may be thin, depending on the nature of the content and considerations such as the idea/expression dichotomy and the *scènes à faire* doctrine.

registration with the Copyright Office—specifically, the presumption of copyright validity and, most importantly, qualification for statutory damages and attorneys’ fees in the event of an infringement suit. Although WGAW registration is less expensive than Copyright Office registration, it is only marginally so.¹⁷⁴

The result of a world dominated by WGAW registrations is dramatic. The movie studios register their films with the Copyright Office. So infringement of those works is subject to harsh penalties. By contrast, the underlying screenplays, treatments, and outlines are usually registered only with the WGAW. As a result, the screenplay becomes a low-tiered work in the copyright schema, subject to manipulation, reinterpretation, transformation, and even unauthorized exploitation to a degree. It is not a sacred text; its inviolability is not ensured by law. Normatively, some will conclude that this is exactly as it should be. Others will be appalled. Either way, however, descriptively, the system constructs a hierarchy of works. In the end, the screenplay is malleable, submissive, and yielding; the movie is untouchable, consecrated, and unassailable. Formality serves function in determining Hollywood’s chain of command.

C. CONSECRATION, CRITICAL THEORY, AND MUSIC

The history of the modern music industry also reveals the stratification process emerging from formalities in action. As K.J. Greene has observed, while ostensibly neutral, the technicalities of our copyright regime undoubtedly exist in a “concrete social milieu”¹⁷⁵ where “not all creators of intellectual property are similarly situated.”¹⁷⁶ Often times, the privileging of certain works takes on the qualities of other social stratifications that divide along lines of class, gender, and race. As Greene argues, inequalities in bargaining power, a fundamental tension between structural components of copyright law and “the oral predicate of Black culture,” and discrimination that resulted in the devaluation of Black creative contributions have resulted in the historical disadvantaging of African-American creators, especially African-American musicians.¹⁷⁷ A prominent example is the growth of the modern music industry. Driven by rock ‘n roll, the industry saw much of its early success from the unauthorized exploitation of old blues riffs, many

174. Online WGAW Registration costs \$10 for WGA members in good standing and \$20 for the general public. Online registration of a copyright with the Copyright Office currently costs \$35.

175. K.J. Greene, *Copyright, Culture & Black Music: A Legacy of Unequal Protection*, 21 HASTINGS COMM. & ENT. L.J. 339, 358–59 (1999).

176. *Id.* at 343.

177. *Id.* at 356–57.

stolen directly from unacknowledged and uncompensated African-American folk artists.¹⁷⁸ Although the resulting musical compositions and sound recordings represent the product of unsanctioned pastiche, the industry continues to vigilantly protect them—not just from wholesale reproduction, as the flood of file sharing suits demonstrates, but from transformative remixing, as the case law on sampling illustrates.

Although sound recordings generally did not receive federal copyright protection until 1972,¹⁷⁹ musical compositions have qualified for protection since 1831.¹⁸⁰ However, in order for a musical composition to receive a copyright, it had to be fixed in a tangible medium—in other words, it had to be written. This situation resulted in what Keith Aoki terms a “dual economy” of music. Under this system, certain kinds of music (and, therefore, composers) received legal protection, and certain kinds of music (and composers) did not. In general, copyrighted (or copyrightable), notated, written scores were composed by upper middle class educated whites, while un-notated musical compositions, including those created by or within folk collectives, did not receive copyright protection. Many unprotected works were intertemporal, intergenerational, anonymous, communal, or improvisational in their composition. Thus, in general, those works that arose within collective experiences of slavery, the struggle for freedom, and post-Reconstruction subordination did not receive protection.¹⁸¹ Indeed, the strictures of our modern copyright regime, with its mystification and fetishization of the Romantic author trope, have often privileged Western forms of (ostensibly) individualistic creation over other modalities.¹⁸²

178. See SIVA VAIDHYANATHAN, COPYRIGHTS AND COPYWRONGS: THE RISE OF INTELLECTUAL PROPERTY AND HOW IT THREATENS CREATIVITY 117–48 (2001) (tracing the appropriation of blues by rock ‘n roll artists over time); K.J. Greene, *Intellectual Property at the Intersection of Race and Gender: Lady Sings the Blues*, 16 AM. U. J. GENDER, SOC. POL’Y & L. 365, 371–74 (2008); K.J. Greene, “Copynorms,” *Black Cultural Production, and the Debate Over African-American Reparations*, 25 CARDOZO ARTS & ENT. L.J. 1179, 1193 (2008) (“The fleecing of Black artists was the basis of the success of the American music industry.”). One example where rights were reasserted several decades later occurred when the Estate of Willie Dixon successfully went after Led Zeppelin for their uncredited, unauthorized, and uncompensated lifting of *You Need Love* for their song *Whole Lotta Love*. See Keith Aoki, *Distributive Justice and Intellectual Property: Distributive and Syncretic Motives in Intellectual Property Law*, 40 U.C. DAVIS L. REV. 717, 763 (2007).

179. 17 U.S.C. § 102(a)(7) (2006) (placing sound recordings within the subject matter of copyright protection); 1 NIMMER & NIMMER, *supra* note 29, § 2.10 (noting that copyright protection was extended to sound recordings fixed on or after Feb. 15, 1972).

180. General Revision of Copyright Act of Feb. 3, 1831, ch. 16, § 1, 4 Stat. 436.

181. Aoki, *supra* note 178, at 760.

182. See, e.g., Peter Jaszi, *Contemporary Copyright and Collective Creativity*, in THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATION IN LAW AND LITERATURE 29

In recent decades, the widespread dissemination of recording and publishing technology has ensured that virtually all creative works are fixed in a tangible medium, thereby avoiding one iteration of the “dual economy” problem identified by Aoki. However, the timely registration requirement has stepped in to enforce a hierarchy of works by distinguishing between sophisticated and unsophisticated creators. Creative works by those at the legal and social margins remain unregistered and therefore unprotected. These intellectual properties become low-tier works, relegated to the status of raw materials subject to remixing, reinterpretation, and transformation. But from these low-tier works come the inviolable commercial products whose iterations are carefully controlled, and whose scarcity is assiduously patrolled. Registered and enforced by the RIAA, the commercial product represents a sacred work that cannot be manipulated without authorization of its rights holders. Thus, the potential socioeconomic and racial dimensions to the cultural hierarchy of copyrighted works live on through the timely registration requirement.

IV. CAVEATS AND CONCLUSIONS

As it turns out, American copyright militancy is vastly overstated. Indeed, by comparison to most developed countries, we continue to provide inadequate remedies to a large class of content creators: authors who do not timely register their copyrights. Instead, we practice a two-tiered protection system that privileges sophisticated creators. Their works become sacred, inviolable matter protected from unauthorized exploitation or transformation by a series of remedies that often rise to draconian levels. Meanwhile, the works of unsophisticated creators remain fodder for remix and reinterpretation. Thus, the registration system plays a critical role in perpetuating a sacralization process. While the emergence of mass reproduction and digital dissemination has threatened the consecration of privileged works, our registration regime has rekindled the aura. What technology has undermined, our two-tiered copyright hierarchy has reinstated, at least in part.

Indeed, a close examination of the language and current interpretation of the Copyright Act reveals several difficulties facing unsophisticated creators

(Martha Woodmansee & Peter Jaszi eds., 1994); Olufunmilayo B. Arewa, *From J.C. Bach to Hip Hop: Musical Borrowing, Copyright and Cultural Context*, 84 N.C. L. REV. 547, 550–51 (2006) (“Copyright legal structures and the classical music canon have thus relied on a common vision of musical authorship that embeds Romantic author assumptions. Such assumptions are based on a vision of musical production as autonomous, independent and in some cases even reflecting genius.”).

who seek to vindicate their rights in the United States. First, courts have found that § 412 precludes recovery of statutory damages and attorneys' fees, when an infringement continues after registration. As a result, an infringer can continue its wrongful activity with impunity if a work is not timely registered at the time of first infringement. Second, unsophisticated creators face a one-way risk of attorneys' fees. Plaintiffs who fail to register their copyright on a timely basis are never eligible to recover their fees if they prevail in a suit, even if the infringement was willful.¹⁸³ By contrast, defendants are always eligible to recover their fees if they prevail. Third, creators cannot seek punitive or reputational damages, and actual damages are often insufficient to make them whole or to deter future infringement. All told, these factors combine to create a rather bleak enforcement regime for the rights of creators who do not register in a timely manner.

Of course, the idea that access to legal counsel and adherence to certain legal formalities can improve the effective scope of one's rights is certainly not novel or surprising. But, the consequences in copyright law are particularly dramatic, virtually determining the rights to and in cultural production. Sophisticated, economically powerful interests receive full protection for their creative works, making their cultural production sacred and inviolable. The Bourdieuan act of cultural reproduction¹⁸⁴ is therefore controlled and patrolled by copyright law—with the hallowed works of elites subject to use and re-use only with proper authorization and payment.

183. 17 U.S.C. § 412 (2006). The section states,

In any action under this title, other than an action brought for a violation of the rights of the author under section 106A(a), an action for infringement of the copyright of a work that has been preregistered under section 408(f) before the commencement of the infringement and that has an effective date of registration not later than the earlier of 3 months after the first publication of the work or 1 month after the copyright owner has learned of the infringement, or an action instituted under section 411(b), *no award of statutory damages or of attorney's fees*, as provided by sections 504 and 505, shall be made for—

- (1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or
- (2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.

Id. (emphasis added).

184. See PIERRE BOURDIEU & JEAN-CLAUDE PASSERON, REPRODUCTION IN EDUCATION, SOCIETY, AND CULTURE (Richard Nice trans. 1977) (using the concept of cultural reproduction to explain the hegemonic process through which the dominant class retains its power).

Meanwhile, the output of the rest of society does not receive such beatification. For unsophisticated players, their production is subject to remix, reinterpretation, and re-commercialization, all without authorization or payment. Thus, while the law purports to grant copyright protection to any work of authorship with minimal creativity fixed in a tangible medium irrespective of whether it was made by Manet or “the Man on the Street,” in practice, such is not the case. All works and creators are not treated alike, and the formalities of the registration requirement establish a hierarchy of protected and less protected works, the untouchable and the readily manipulable. The resulting system enables dominant social forces to freely usurp the creative content of the masses for their own use while simultaneously enjoying the ability to prevent any unauthorized use of their own privileged creative content. Within the confines of this regime, it is the underclass that typically ends up with minimal protection.

It is the African-American blues musician, who just two generations ago saw his riffs and melodies appropriated by the burgeoning modern music industry to “develop” rock ‘n’ roll. As his creative efforts developed a multi-billion dollar marketplace, he watched from the economic sidelines, unable to vindicate the legal rights to his intellectual property because he had failed to conform to the procedural strictures of copyright law.

It is the unheralded rural landscape painter whose evocative depictions of nature are used to decorate and set the mood for the outdoorsy, Western-themed catalog of a major retailer. Although her work is used without permission or payment, her failure to register on a timely basis leaves her without meaningful remedies if she threatens to pursue legal action.

It is the screenwriter—the least valued of Hollywood’s traditional above-the-line creative triumvirate¹⁸⁵—who followed industry protocol by registering his screenplay with the Writers Guild of America and then found original dialogue and a unique action sequence from his work in the summer’s leading blockbuster. Absent a well-timed and successful application for injunctive relief and posting of the necessary bond, he will find himself without meaningful remedies to pursue legal action simply because registration with the WGA fails to provide the legal benefits of registration with the United States Copyright Office.¹⁸⁶

185. Actors, directors, and writers. One could also add producers to this list.

186. The Writer’s Guild Registry does not “bestow any statutory protections.” *See* WGA West Registry, Registration Details, http://www.wgawregistry.org/webrrs/reg_details.html (last visited Nov. 8, 2009).

It is the dance choreographer whose uniquely sequenced moves make their way into the new music video for a leading pop star. Having failed to register her choreography on a timely basis with the United States Copyright Office, she is without an ability to recover statutory damages and attorneys' fees, making legal action of dubious worth.

It is the small businesswoman who drafts effective copy for a marketing pamphlet, only to see it copied wholesale by a competitor. In the absence of timely registration, legal action makes no practical sense. She finds herself holding "a right without a remedy."¹⁸⁷

It is the solo architect whose structural design plans for an industrial building integrating green photovoltaic technology are taken and utilized by a multinational corporation to save itself the cost of generating its own plans. In the unlikely event that the architect catches the infringement and sues, she will, at best, likely recover only the value of the plans in the first place. Facing no punitive consequences for its illicit conduct, the multinational corporation has every incentive to infringe. Absent timely registration, the architect is without meaningful remedies, especially when one considers the (non-recoupable) cost of litigation.

It is the graffiti artists in urban corridors whose renderings eventually make their way into the newly sacralized work of the modern art world's latest sensation, whose multi-million dollar originals and 'affordable' limited edition prints are carefully controlled and regulated, in order to obtain the Benjaminian aura that generates value in the art marketplace.

All the while, back-breaking penalties await those who would touch the copyrighted works of the modern music industry, the major Hollywood studios, the elite art world, or the fashion industry without permission, even when these works are built on the unprotected works of others. One might even posit that by controlling the manipulation and transformation of cultural content through its hierarchical system of protection, copyright law's registration requirement plays a significant role in personhood development and identity formation as it determines the ways in which we can and cannot interact with the cultural content.

Although this Article scrutinizes the peculiar epistemological role of copyright law's registration requirement in controlling the manipulation and transformation of cultural content by creating and patrolling a hierarchical system of protection, it does not necessarily advocate immediate repeal of § 412. First, the registration requirement advances the ability of individuals

187. *Bus. Trends Analysts, Inc. v. Freedomia Group, Inc.*, 887 F.2d 399, 406 (2d Cir. 1989) (citing 3 NIMMER & NIMMER, *supra* note 29, § 14.02[A]).

and corporations to engage in activity akin to efficient breaches of contracts—at least in theory. However, to engage in an efficient infringement, one must be aware of one's rights and potential liabilities *ex ante*. Unfortunately, as we have seen, the copyright system does not enable this since there is no good way to know if a work is registered and therefore entitled to enhanced protection. One can know when a work is registered, but it is difficult to conclude with assurance that a work is *not* registered. Thus, the value of making efficient breaches available through the registration scheme is heavily dissipated.

Additionally, the elimination of the timely registration requirement for statutory damages and fees eligibility could certainly lead to some problems, especially if accomplished without other significant changes to our infringement and remedies regime. As Jon Baumgarten and Peter Jaszi have argued, repealing of § 412 might indeed increase potentially frivolous copyright litigation.¹⁸⁸ Such a claim is not to be taken lightly, especially in an era characterized by overreaching copyright claims and a disparity between copyright norms and laws that has left us all vulnerable to infringement litigation for dozens of our quotidian acts.¹⁸⁹ Indeed, as a critic of over-expansive copyright claims and the threat that copyright enforcement run amuck can inflict on our daily lives, I am keenly aware of the benefits that accrue to society from many works not being registered and, therefore, remaining ineligible for attorneys' fees and statutory damages. By making infringement litigation more profitable for more rights holders, we certainly risk an uptick in litigation by giving even plaintiffs with petty claims more leverage.

However, there are at least some reasons to think that a tide of frivolous litigation may not be unleashed by reform. First, such a position presumes that the existing holders of copyrights that are timely registered are less likely to pursue frivolous litigation than the masses. As we have already discussed, this assumption is relatively untenable. Second, we have direct experience suggesting otherwise. Specifically, under the pre-1976 regime, fees and statutory damages were available to all, regardless of registration. Furthermore, a registration requirement for standing to bring a suit was largely eviscerated by the Supreme Court's decision in *Washingtonian Publishing*

188. See Jon Baumgarten & Peter Jaszi, *Why Section 412 Should Be Retained*, reprinted in ROBERT WEDGEWORTH & BARBARA RINGER, THE LIBRARY OF CONGRESS, ADVISORY COMMITTEE ON COPYRIGHT REGISTRATION AND DEPOSIT, REPORT OF THE CO-CHAIRS A85-A91 (1993) [hereinafter ACCORD REPORT]; Koegel, *supra* note 138; Peter Jaszi, *Section 412*, reprinted in ACCORD REPORT A92-A93 (1993).

189. See John Tehranian, *Infringement Nation*, 2007 UTAH L. REV. 537 (2007).

Co. v. Pearson,¹⁹⁰ in 1939. Despite this lack of a registration requirement, no boom in litigation resulted. Moreover, no other country has a registration requirement. Yet we have not witnessed a flood of frivolous copyright litigation either pre-1976 or in other countries, especially those sharing common legal traditions.

Nevertheless, given a risk of increased litigation, it is important that no change to § 412 occur in a vacuum. Concomitant reform in several areas is needed.¹⁹¹ For example, broader general protection of transformative rights (for both sacred and low-tier works), including the implementation of some bright-line rules, would reduce the likelihood of some socially undesirable litigation.¹⁹² Moreover, a limitation on the recovery of statutory damages would conform the remedies regime to constitutional due process dictates that require punitive assessments to bear some reasonable relationship to actual damages.¹⁹³ Indeed, the disproportional size of statutory damages, decoupled from any proof of actual damages, may do far more to encourage frivolous litigation than putting all creators—sophisticated and unsophisticated—on a level playing field for remedies. As a result, it may make sense to think about simultaneously reducing the upper range of statutory damage awards and providing better protections for innocent infringers, while expanding the availability of statutory damages to all copyrighted holders, regardless of formalities. We should simultaneously consider improving the powers that defendants have in fighting meritless infringement claims by considering greater penalties for overreaching copyright claims¹⁹⁴ and making attorneys' fees recovery for prevailing defendants easier to attain.¹⁹⁵

190. 306 U.S. 30 (1939), *reh'g denied*, 306 U.S. 668 (1939).

191. *See, e.g.*, Pamela Samuelson, *Preliminary Thoughts on a Copyright Reform Project*, 2007 UTAH L. REV. 551 (making the case for preliminary consideration of a holistic reform of copyright law).

192. *See* John Tehranian, *Whither Copyright? Transformative Use, Free Speech, and an Intermediate Liability Proposal*, 2005 B.Y.U. L. REV. 1201 (2005).

193. *See* Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439 (2009) (arguing that the present statutory damages scheme is both inconsistent with congressional intent and in violation of the Supreme Court's due process jurisprudence regarding punitive damages awards).

194. *See, e.g.*, Jason Mazzone, *Copyfraud*, 81 N.Y.U. L. REV. 1026 (2006) (arguing that Congress should amend the Copyright Act to create a cause of action against overreaching claims of copyrightability by purported rights holders).

195. Prevailing parties can, at the court's discretion, receive attorneys' fees. 17 U.S.C. § 505 (2006). However, despite the absence of any statutory language distinguishing between prevailing plaintiffs and defendants, courts have historically applied a bifurcated analysis on the fees question, depending on which side prevailed.

Prior to 1994, many courts—including the copyright-rich Second and Ninth

Thus, any reform of the copyright system that seeks to treat content creators of all stripes on a more equal basis must remain cognizant of the critical need to balance the rights of creators with those of users. In the end, we should not necessarily seek more copyright or less copyright, but, rather, *better* copyright.

Circuits—explicitly adopted an unbalanced approach to the award of fees under § 505, and courts would routinely grant them to prevailing plaintiffs, see, e.g., *Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc.*, 886 F.2d 1545, 1556 (9th Cir. 1989) (“Plaintiffs in copyright actions may be awarded attorney’s fees simply by virtue of prevailing in the action: no other precondition need be met, although the fee awarded must be reasonable.”), but deny fees to prevailing defendants absent a finding of frivolousness or bad faith—an exacting standard. See, e.g., *Warner Bros. Inc. v. Dae Rim Trading, Inc.*, 877 F.2d 1120 (2d Cir. 1989); *Olson v. N.B.C., Inc.*, 855 F.2d 1446, 1454 (9th Cir. 1988) (declining to adopt an evenhanded approach to awarding fees). *But see* *Lieb v. Topstone Indus., Inc.*, 788 F.2d 151 (3d Cir. 1986) (adopting an evenhanded approach to the grant of attorneys’ fees under the Copyright Act in the Third Circuit).

The Supreme Court rejected this dual standard for fees in *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 534 (1994), ordering that “[p]revailing plaintiffs and prevailing defendants are to be treated alike” under § 505. *Id.* However, upon an examination of infringement decisions since 1994, it appears that a dual standard continues to prevail. For example, the Ninth Circuit—home of Hollywood and the entertainment industry—has continued to award fees as a general matter of right to prevailing plaintiffs. See *Columbia Pictures Television v. Krypton Broad. of Birmingham, Inc.*, 106 F.3d 284 (9th Cir. 1997), *rev’d on other grounds sub nom* *Feltner v. Columbia Pictures Television*, 523 U.S. 340 (1998).

Meanwhile, defendants continue to be denied fees “absent bad faith motivation (such as to dominate the market in question), hard-ball tactics [such as discovery abuse] . . . or objective unreasonableness (such as pursuing a claim against a defendant after dismissal of the identical claim against a co-defendant).” 4 NIMMER & NIMMER, *supra* note 29, § 14.10[D][3][b]. Thus, to receive fees, the case must demonstrate almost extraordinary gall and bad judgment by the plaintiff. See, e.g., *Bond v. Blum*, 317 F.3d 385 (4th Cir. 2003) (awarding fees to defendant on grounds that suit was frivolous and motivated by a desire to suppress the underlying facts of the plaintiff’s work—not to protect the creative expression embodied in the manuscript).

