

COMMITTEE ON COPYRIGHT & LITERARY PROPERTY

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Hon. Maria Strong Acting Register of Copyrights and Director of the U.S. Copyright Office U.S. Copyright Office 101 Independence Avenue, S.E. Washington, DC 20559-6000

Re: Docket No. 2019-7: NYCBA Committee on Copyright & Literary Property /Response to NOI re Electronic Publication

Dear Acting Register Strong:

On behalf of the Committee on Copyright & Literary Property (the "Committee") of the New York City Bar Association (the "City Bar"), we write to offer reply comments in response to the 42 previously posted comments to the U.S. Copyright Office's Notification of Inquiry ("NOI") on "Online Publication" as published in the Federal Register at 84 Fed. Reg. 66328-66334 (December 4, 2019) and the related Extension of Comment Period published in the Federal Register at 85 Fed. Reg. 19919 (April 9, 2020).

The City Bar, founded in 1870, is a voluntary association of lawyers and law students. Today the City Bar has over 24,000 members. The City Bar's mission is to equip and mobilize a diverse legal profession to practice with excellence, promote reform of the law, and uphold the rule of law and access to justice in support of a fair society and the public interest in our community, our nation, and throughout the world. The City Bar has over 150 committees that focus on legal practice areas and issues. Through reports, amicus briefs, testimony, statements and letters drafted by committee members, the City Bar comments on public policy and legislation. The Committee addresses a wide variety of issues of concern to the copyright bar and to industries that are focused on content creation, distribution and publication, including book and magazine publishing, media, entertainment, music, art, film, and online content delivery technologies and business models.

The responses set forth below reflect the unanimous consensus of the Committee, and are supported by the City Bar's Council on Intellectual Property (the "Council"). The Council is a

long-established standing committee of the City Bar, and is constituted principally of the Chairs of the following Committees: Art Law; Communications & Media Law; Copyright & Literary Property; Entertainment Law; Fashion Law; Information Technology & Cyber Law; Patents; Sports Law; Trade Secrets; and Trademark & Unfair Competition. The Council's membership reflects a wide range of corporate, private practice and academic experience in intellectual property law, and is dedicated to promoting the City Bar's objective of improving the administration of intellectual property laws..

Committee's Specific Responses to the NOI Questions:

1. Section 409(8) of the Copyright Act requires applicants to indicate the date and nation of first publication if the work has been published. What type of regulatory guidance can the Copyright Office propose that would assist applicants in determining whether their works have been published and, if so, the date and nation of first publication for the purpose of completing copyright applications? In your response, consider how the statutory definition of publication applies in the context of digital on-demand transmissions, streaming services, and downloads of copyrighted content, as well as more broadly in the digital and online environment.

<u>Committee's Response</u>: We believe that additional guidance from the Copyright Office as to what constitutes online publication would be welcome in the form of additional plain language Circulars, FAQs, videos posted publicly on Facebook and similar online platforms, webinars (similar to the USPTO's online webinar offerings), and with further explanations and examples added to the Compendium 3d, which are consistent with applicable scenarios raised in many of the previously posted Comments. However, any additional guidance must be consistent with the Copyright Act's statutory requirement of publication, which requires a distribution of a work for that work to be considered published. We provide our views on that issue in our response to Question 2 below.

2. Specifically, should the Copyright Office propose a regulatory amendment or provide further detailed guidance that would apply the statutory definition of publication to the online context for the purpose of guiding copyright applicants on issues such as: i. How a copyright owner demonstrates authorization for others to distribute or reproduce a work that is posted online; ii. The timing of publication when copies are distributed and/or displayed electronically; iii. Whether distributing works to a client under various conditions, including that redistribution is not authorized until a "final" version is approved, constitutes publication and the timing of such publication; iv. Whether advertising works online or on social media constitutes publication; and/or v. Any other issues raised in section I(C) above.

Committee's Response:

We do not believe that additional regulatory action applying the statutory definition of publication to the online context is needed so long as the Copyright Office is authorized to provide additional informal guidance (per Question No. 1 above).

On sub-question (i), we believe that the author's intent to allow distribution of his or her work should govern whether online publication has occurred, such as through use of a download button, Creative Commons license notification, or where a website/social media platforms' terms

of service authorize end users to download posted content and the author has accepted such terms (in accordance with applicable law and legal precedent respecting the binding nature of online terms of use). While the technical features of a website or platform, such as a download button, might show intent, we do not believe that the absence of download preclusion measures (such as disabling the right click save function) should—standing alone—be equated with such authorization.

We are not responding to sub-question (ii).

We answer "no" to question (iii) because distribution to a "client," without express authorization to further re-distribute to a much wider audience, does not authorize such further distribution, and sending a copyright-protected work only to a client is clearly not distribution to the "public."

We answer "no" to question (iv) because online advertising alone should not constitute publication unless the advertisement expressly provides recipients/viewers with a download option or similar mechanism for the downloading of copyrighted content contained in the advertisement—and then only as to such content, and not a work that is advertised but not distributed by means of the advertisement.

In response to sub-question (v), we note that we have no additional comments regarding issues raised in section I(C) of the NOI.

3. Can and should the Copyright Office promulgate a regulation to allow copyright applicants to satisfy the registration requirements of section 409 by indicating that a work has been published "online" and/or identifying the nation from which the work was posted online as the nation of first publication, without prejudice to any party subsequently making more specific claims or arguments regarding the publication status or nation(s) in which a work was first published, including before a court of competent jurisdiction?

Committee's Response:

We find this question somewhat confusing. We do not see what adding a new category of "published online" to the two existing published/unpublished registration options would accomplish because a determination must still be made as to what is "published." We believe promulgating this third option would just compound the confusion that now exists over what publication means in the online setting.

We do not think the nation from which the work was first posted (presumably by, or authorized by, the legitimate author) should be the nation of first publication as opposed to the nation(s) to which the content was first distributed for public downloading, etc., with authority of the copyright owner. Various posted Comments agree with this view.

4. Applicants cannot currently register published works and unpublished works in the same application. Should the Copyright Office alter its practices to allow applicants who pay a fee to amend or supplement applications to partition the application into published and unpublished sections if a work (or group of works) the applicant mistakenly represented was either entirely published or unpublished in an initial application is subsequently determined to

contain both published and unpublished components? What practical or administrative considerations should the Office take into account in considering this option?

Committee's Response:

Applicants should be permitted to register both published and unpublished works in the same application. This is widely supported in the existing posted Comments.

We concur that as a matter of fairness and in principle, the current result of dismissal of a copyright action with no right to amend (per the 9th Circuit's decision) is too harsh in cases where the plaintiff made a good faith mistake in their registration application due to uncertainty about whether a work was deemed published online.

However, this alone is not a reason to allow an unlimited right of amendment, because such an unlimited right would prejudice the rights of defendants in pending cases, given the practicalities of federal court litigation. Judges are not obligated to suspend cases while the Copyright Office reviews and decides whether to accept a Supplemental Registration to correct a publication designation, and we do not think the Copyright Office can require courts to do so by regulation. Plus, defendants who already invested in a case, possibly filing dismissal motions and taking other actions in reliance on and in response to a filed complaint, could be prejudiced or harmed by a plaintiff's subsequent attempt to amend a registration.

We therefore support permitting a copyright owner to amend/file a Supplemental Registration only <u>before</u> any infringement litigation is commenced. This avoids the practical issues and potential prejudice to defendants, noted above, while providing a procedural cure for the copyright owner pre-litigation that does not currently exist. For example, lay copyright owners could readily make mistakes in assessing whether their work was deemed published online, but when they retain competent counsel to sue for infringement, their counsel would likely assess the published status and have an opportunity to file for a correction before filing an infringement action is commenced. Expedited processing should also be made available for such supplemental applications.

In the context of such Supplemental Registration to correct the publication status, the copyright owner should be required to subscribe to a declaration under penalty of perjury, attesting that the error was made in good faith and setting forth a general reason for the error. That way, a defendant could still challenge the amendment thereafter in any litigation. Any such amendment should require the applicant to make clear which of his/her works is/are published and unpublished. This is a critical distinction that has significant legal ramifications, such as in the context of assessing the "nature of the copyrighted work" under the Section 107(2) second fair use factor and whether the effective date of a registration is within the three-month grace period respecting first publication under Section 412. We note that Section 1802.12 of the Compendium 3rd leaves it to the courts to decide whether the changes made to a registration by a supplementary registration should be deemed effective as of the date a basic registration was filed or the date a supplementary application was filed, but we are not aware that any existing regulation authorizes this (37 CRF § 202.6, which governs Supplemental Registration, is silent on effective dates).

5. For certain group registration options, should the Copyright Office amend its regulations to allow applicants in its next generation registration system to register unpublished and published works in a single registration, with published works marked as published and the date and nation of first publication noted? What would the benefits of such a registration option be, given that applicants will continue to be required to determine whether each work has been published prior to submitting an application? What practical or administrative considerations should the Office take into account in considering this option?

Committee's Response:

There was widespread consensus in the posted Comments that such group registrations should be permitted, and the Committee concurs. This would allow individual and small business copyright owners, such as photographers and artists, to file group registrations for published and unpublished works that are part of a collection. For example, a photographer could create 36 photographs during a photo shoot but initially publish only two images (by license or otherwise), while still wanting to protect the other unpublished images in the same collection for future potential exploitation.

The Copyright Office would of course need to develop the infrastructure necessary to process such group applications. As that will likely entail additional development and administrative costs, the application filing fee structure should be amended to include an enhanced application processing fee for including both published and unpublished works in a single registration. Such additional fees will also compensate for the loss of revenue the Office currently receives from separate group applications filed for published and unpublished works.

6. [No question 6 in NOI]

7. Is there a need to amend section 409 so that applicants for copyright registrations are no longer required to identify whether a work has been published and/or the date and nation of first publication, or to provide the Register of Copyrights with regulatory authority to alter section 409(8)'s requirement for certain classes of works?

Committee's Response:

We do not believe that Section 409 should be amended. We further believe that dispensing with the date and nation of publication for registration but keeping the date and nation relevant for other aspects of copyright law is untenable because it will make resolving disputes pre-litigation much harder. For example, absent a publication date, a defendant will not always know, at least pre-litigation or pre-discovery, if a plaintiff can obtain statutory damages and will not want to just trust a putative plaintiff to explain the applicable facts. Nor would a defendant be able to properly assess any fair use defense under Section 107 of the Copyright Act without a clear designation of the published nature of the registered work (*see also* our above response to Question No. 4). Similarly, the nation of first publication has important ramifications (including under the Berne Convention) with respect to choice of law to assess copyrightability and copyright ownership.

In short, the need to designate the published/unpublished status of a work and the country of first publication transcends any practical benefits for a copyright owner that might arise by

eliminating such requirements, but impacts significantly other substantive provisions of the Copyright Act.

8. Is there a need for Congress to take additional steps with respect to clarifying the definition of publication in the digital environment? Why or why not? For example, should Congress consider amending the Copyright Act so that a different event, rather than publication, triggers some or all of the consequences that currently flow from a work's publication? If so, how and through what provisions?

Committee's Response:

We do not believe that Congressional action is needed or advised at this time. In the current statutory and regulatory landscape, new legislation would risk creating additional complications and ambiguities and would impact a longstanding statutory requirement that could be addressed by further Office clarifications (*see* our response to Question No. 1). Nevertheless, we do recognize that meaningful arguments can be made that the distribution requirement for publication is outmoded and serves no real purpose in an online world, and legislation might be appropriate at some future point.

9. The Copyright Office invites comment on any additional considerations it should take into account relating to online publication.

<u>Committee's Response</u>: We are not responding to this Question.

The Committee appreciates the opportunity to provide these comments. If there are any questions respecting our comments, please feel free to contact me.

Respectfully submitted,

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Bar Association

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Committee Working Group / Online Publication