

**BEFORE THE
UNITED STATES COPYRIGHT OFFICE
WASHINGTON, D.C.**

**NOTIFICATION OF INQUIRY REGARDING
ONLINE PUBLICATION**

**PUBLIC REPLY COMMENTS OF
AUTHORS ALLIANCE**

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I. THE SCOPE OF THIS REPLY

Authors Alliance is pleased to provide these reply comments in connection with the Copyright Office’s December 4, 2019 Notice of Inquiry (the “NOI”) regarding online publication.¹ In its initial comments, Authors Alliance encouraged the Copyright Office to adopt guidance stating that “Publication” occurs when a work is first offered, under the rights-owner’s authority, for viewing online without technological restrictions that prevent downloading or other reuse.² Authors Alliance based this position on the statutory text, the legislative history, the case law, and the policy goals of (1) clear, bright-line guidance and (2) promoting broad use of works by reducing the availability of statutory damages and fee-shifting (which chill use and expression).³

Many other commenters agreed with Authors Alliance that treating an online posting without restrictions on redistribution as a “Publication” is the best way to interpret the statutory definition of that term—*i.e.*, an “offering to distribute copies [of the work] . . . for purposes of further distribution, public performance, or public display.”⁴ A number of other commenters argued to the contrary that an online posting should be equated with “[a] public performance or display[,]” which “does not of itself constitute publication.”⁵ However, commenters making that argument did not respond to the legislative history of the clause on which they rely (as discussed in the NOI), which explains and limits its intended application to bygone technological issues.⁶ Nor did they explain why the statutory definition’s “offering to distribute” clause does not apply.

Authors Alliance submits this reply to explain and expand on an argument that both sides of this debate claim as their own—the “forfeiture of rights” under Section 411, as exemplified by *Gold Value Int’l Textile, Inc. v. Sanctuary Clothing, LLC*, 925 F.3d 1140 (9th Cir. 2019). Various commenters raise forfeiture as a specter to justify essentially unlimited deference to applicants’ description of “Publication” status, even in later, amended applications. That approach misstates the stakes of the “forfeiture” issue and misunderstands the salience of *Gold Value* here, which is not that all rights must be protected at all costs, but that clear and intuitive guidance is essential.

¹ 84 Fed. Reg. 66,328 (Dec. 4, 2019).

² See Authors Alliance’s Initial Comments at 4.

³ See *id.* at 4-9.

⁴ See *id.* at 5 (quoting 17 U.S.C. § 101 (definition of “Publication”). Despite agreement on this overarching point, some commenters differed in their understandings as to what specific kinds of restrictions on redistribution would be necessary to create—or prevent the creation of—a “Publication.” Compare Authors Guild’s Initial Comments at 5 (proposing that “Publication” can be avoided by including on the work or online site “an express statement by the copyright owner or website operator that the work may not be copied, saved to a computer, distributed, printed, or further transmitted”) with Creative Commons’s Initial Comments at 2 (stating that in some circumstances, works “should still be considered Published even if restricted by TPM/DRM”). Because Authors Alliance favors rules that encourage the broad use of works, it believes the “express statement” proposal sets the bar too low, and some form of actual, technological restriction on copying or redistribution should be required to prevent “Publication.” See Authors Alliance’s Initial Comment at 4. In addition, the “express statement” proposal unjustifiably sacrifices clear guidance for subjective, case-by-case notions of conspicuity and adequacy of notice.

⁵ 17 U.S.C. § 101.

⁶ See Authors Alliance’s Initial Comment at 5-6 (citing GOLDSTEIN ON COPYRIGHT § 3.3.3 (3d ed. 2016)). There is one exception—Copyright Alliance, which does not dispute Professor Goldstein’s account of the legislative history and intent, nor his account of the changes in technology since the statutory definition of “Publication” was enacted, but instead argues with his conclusions on policy grounds. See Copyright Alliance’s Initial Comments at 4.

II. THE RISKS OF FORFEITURE DO NOT JUSTIFY AN APPLICANT'S GENERAL RIGHT TO REVISE PUBLICATION STATUS

In *Gold Value*, the Ninth Circuit considered an error in the plaintiff's registration certificate—which wrongly described a fabric design as unpublished—in light of 17 U.S.C. § 411(a)-(b)(1).⁷ Under those provisions, a civil action for copyright infringement cannot stand where the plaintiff “knowingly included inaccurate information in its copyright application that would have caused the Copyright Office to deny registration.”⁸ In response to the district court's inquiry, the Copyright Office stated that the representation of the work “as unpublished when in fact it had been published” would have led the Copyright Office (if it had known) to refuse registration.⁹ The district court therefore dismissed the case on summary judgment, and the Ninth Circuit affirmed.¹⁰

A number of commenters decried this result as a “harsh forfeiture,”¹¹ with some going as far as calling it “antithetical to the purposes of copyright law,”¹² or even a decision that “perverts the law by allowing a copyright infringer to . . . get away with infringement.”¹³ According to some of these commenters, the risks posed by *Gold Value* and Section 411(a)-(b) more generally should lead the Copyright Office to let applicants be the sole arbiters of whether or not their online works are published. That is, the Copyright Office should not only defer to the applicants' views of the work's “Publication” status at the time of registration, but also should allow applicants to reverse that status later through a supplementary registration.¹⁴

As an initial matter, an unlimited ability to revise “Publication” status would render any registration guidance the Copyright Office may give—and, indeed, this entire NOI—irrelevant. Liberally allowing applicants to redefine unpublished works as published, even in the midst of litigation, is also difficult to reconcile with the statutory directive that “[t]he information contained in a supplementary registration augments but does not supersede that contained in the earlier registration.”¹⁵ Indeed, the NOI did not solicit comments on whether applicants should be allowed to revise “Publication” status *in general*, only whether amendment “to partition the application into published and unpublished sections” would be appropriate.¹⁶ The NOI posed that question because under the existing registration system, “[a]pplicants cannot currently register published works and unpublished works in the same application.”¹⁷ The proper response to that narrow logistical problem cannot be a call for limitless deference to amendments in “Publication” status.

⁷ *Gold Value*, 925 F.3d at 1142-43.

⁸ *Id.* at 1142; *see also* 17 U.S.C. §§ 411(a) and (b)(1).

⁹ *Gold Value*, 925 F.3d at 1143.

¹⁰ *Id.* at 1148 (“In light of the Register's response, we agree that § 411(b)(1)(B) is satisfied and that the inaccuracy in the '509 registration renders it invalid Because a valid registration is a precondition to bringing an action for infringement, we affirm the district court's grant of summary judgment in favor of Defendants.”).

¹¹ *See* INTA's Initial Comments at 10.

¹² *See* Copyright Alliance's Initial Comments at 6.

¹³ *See* Mariah Lichtenstern's Initial Comments at 2-3.

¹⁴ *See, e.g.*, INTA's Initial Comments at 8-10; American Photographic Artists's Initial Comments at 7; Motion Picture Association, Inc.'s Initial Comments at 4; NYIPLA's Initial Comments at 2-3.

¹⁵ 17 U.S.C. § 408(d); *see also* 37 C.F.R. § 201.5(d)(2).

¹⁶ *See* NOI, 84 Fed. Reg. at 66,334.

¹⁷ *Id.*

None of the consequences from *Gold Value* or Section 411(a)-(b) would support that result. Implicit (and occasionally explicit) in many of the critiques of *Gold Value* is the claim that the outcome in such a case leaves the copyright owner with no remedy at all and utterly defenseless against infringements. That claim is not correct.

The risks of forfeiture posed by registration errors are narrowed by Section 411 itself. Specifically, inaccurate information in a registration certificate impacts “the institution of and remedies in infringement actions under this section [411] and 412”—and nothing else.¹⁸ Thus, an inaccurate statement of “Publication” status in a registration statement could lead to the loss of the statutory damages and attorneys’ fees that may otherwise be available under 17 U.S.C. § 412. But as Authors Alliance explained in its Initial Comment, that is not invariably a bug rather than a feature; the statutory damages regime in many respects is ill suited to its purposes, chills valuable uses, fails to yield consistent or proportional damages awards, and is both over-inclusive and under-inclusive.¹⁹ If in some instances this one particular—decidedly imperfect—remedy is unavailable under a straightforward and predictable reading of the plain meaning of the term “Publication,” that result hardly justifies an alternative interpretation.

Separate from the loss of statutory damages, a finding of invalid registration would also lead to dismissal of the infringement lawsuit under Section 411(a). Importantly, however, that is not the end of the road for a plaintiff copyright owner. After a copyright suit is dismissed under Section 411(a), it can be *refiled* once the precondition of registration has been met (or once the registration application has been refused). At that point, the “copyright owner can recover for infringement that occurred *both before and after* registration.”²⁰ Thus, re-registration (or refusal of re-registration) effectively allows a claim dismissed on Section 411(a) grounds to be revived.²¹

In a slightly different sequence, that is what happened in *Gold Value*. There, before the case was dismissed, the plaintiff completed a separate, accurate registration, and pursued its infringement claim in a separate action.²² In other words, the plaintiff was able to “reinstate” its claim even before it was dismissed.²³ Moreover, in certain other cases, no separate action was

¹⁸ 17 U.S.C. § 411(b)(3).

¹⁹ See Authors Alliance’s Initial Comments at 7 & nn.32-35.

²⁰ *Fourth Estates Public Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881, 886-87 (2019) (emphasis added).

²¹ The time difference between dismissal and reinstatement could theoretically change the period of recoverable damages in light of Section 507(b)’s “separate accrual rule” for the statute of limitations (see *Petrella v. MGM, Inc.*, 572 U.S. 663, 671 (2014)), but the application of equitable tolling (see *id.* at 664-65) would likely render any differences immaterial.

²² *Gold Value*, 925 F.3d at 1143.

²³ The fact that the plaintiff’s case was effectively split into two separate actions allowed the district court to order (and the Ninth Circuit to affirm) an award of attorneys’ fees to the defendants in the first, dismissed suit. *Id.* at 1149. That particular aspect of the *Gold Value* decision is unduly harsh, and Authors Alliance agrees with other commenters that good-faith errors in the registration process should not lead, by virtue of a fee award, to a copyright owner’s having to pay a defendant while a separate but largely indistinguishable legal fight between those same parties lies unresolved. But the general rules of fee-shifting under 17 U.S.C. § 505 are flexible, and any defect in those rules or particular unfairness in the *Gold Value* case should not be the tail that wags the Copyright Office’s guidance on the definition of “Publication.”

necessary; plaintiffs have been permitted to cure their Section 411 defect during the pending case and have proceeded on an amended complaint.²⁴

Accordingly, the “risk of forfeiture” posed by Section 411 is directed almost entirely at the right to statutory damages, and as Authors Alliance previously explained in depth, that is a right that the Copyright Office’s guidance should strive to limit in scope.²⁵ Commenters who suggest that the stakes of an error in “Publication” status are all or nothing are therefore wrong—as is the suggestion that to prevent the total deprivation of *all* of the rights-holder’s remedies under copyright law, the Copyright Office should declare such errors to be free of any consequence. A careful examination of the effects of registration errors shows that the stakes are not that high, and most rights can be substantially restored after dismissal due to an invalid registration, with the exception of the already undesirable right to statutory damages.

The true relevance of *Gold Value* and Section 411, therefore, is not to raise the specter of copyright owners without remedies, but to underscore the necessity of clear and bright-line guidance in this area.²⁶ The intuitive and unambiguous approach to online publication proposed by Authors Alliance responds to that critical issue. It is a prophylactic against any forfeitures of rights or requirements to reinstate claims, and also against the Section 411 disputes that lead to those outcomes. Clear and intuitive guidance would allow copyright owners in the future to avoid not only the consequences of losing *Gold Value*-style fights, but also the burden of having those fights in the first place.

²⁴ See, e.g., *VHT, Inc. v. Zillow Grp., Inc.*, No. C15-1096JLR, 2020 WL 2307492, at *10 n.10 (W.D. Wash. May 8, 2020) (“District courts are split on this question[.]”); see also *Cortés-Ramos v. Martin-Morales*, 956 F.3d 36, 44 (1st Cir. 2020) (remanding to the district court to assess propriety of amendment in the first instance).

²⁵ See Authors Alliance’s Initial Comments at 7 & nn.32-35.

²⁶ See Authors Alliance’s Initial Comments at 5.