

## INTELLECTUAL PROPERTY ALERT

### New Guidance: File Copyright Applications Routinely for Important Works

Whether you prepare creative works (like books, photos, movies, music, graphics or artwork), write and publish articles, write software programs, games or other applications for use by others, design and publish websites, or prepare any other work capable of copyright protection, **a new Supreme Court case clarifies the timing of steps you need to take to protect your rights and enforce them if (and when) needed.**

On March 4, 2019, the U.S. Supreme Court clarified that copyright owners must wait until after the Copyright Office has reviewed their copyright registration application and either granted or refused registration before they can file a complaint in federal court for the infringement of their works. [\*Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC\*](#), No. 17-571 (U.S. Mar. 4, 2019). **This decision confirms that copyright plaintiffs must first have their registration certificates in hand before filing a complaint in federal court**, unless they qualify for one of the few statutory exceptions in the Copyright Act.

U.S. copyright law protects "original works of authorship" immediately upon creation, but the law has always been that a copyright owner could not enforce these rights without first registering them with the U.S. Copyright Office.

In some jurisdictions, filing the application was sufficient to satisfy the pre-requisite of "registration of the copyright claim." This meant that once an owner learned of a potential infringement, the owner would file an application with the Copyright Office, complete with full payment of the Copyright Office's fees and submission of a proper deposit copy of the works - sometimes on an expedited basis if litigation was likely. In other jurisdictions, obtaining the certificate of registration was the only way to satisfy the condition.

The Supreme Court has now made the process consistent - regardless of your jurisdiction. **All owners now must file their applications first and wait for the Copyright Office to either grant or refuse registration before filing suit.**

This new requirement could add weeks or even months to a copyright owner's timeline for taking action to enforce its rights. Critical timing can vary - in some states, the three-year statute of limitations begins to run upon discovery of infringement; in others, it runs from when the infringement started. Seeking expedited treatment may alleviate some of the delay and may be the only option to avoid missing the three-year statute of limitations for bringing such suits, but expedited processing at the Copyright Office has much higher filing fees.

## INTELLECTUAL PROPERTY ALERT

### **Recommendations - START NOW!**

- Consider whether there are "works" owned by you or your Company that are at risk of being copied by others. (Competitors? Fans? Former employees?)
- Is there an imminent risk of infringement by others? (Are you aware of any potential lawsuits involving specific works?) If so, consider filing applications for expedited treatment so that you can receive registration of your rights as soon as possible.
- File applications using the standard application process for each other important work so that you can receive registration certificates in the normal course.
- Keep careful records of your applications and registrations and scan all registration certificates once received for electronic storage.
  - Keep the originals of your registration certificates in a safe place, along with a physical and electronic copy of the deposit you submitted to the Copyright Office when you applied.
  - You will need to attach copies of these certificates to any complaint filed in court, and you will need a copy of your deposit to help prove the infringing copy is "substantially similar" to what you filed with the Copyright Office.
- If you have multiple versions of works - such as periodic updates to software - consider filing updated applications on a regular basis to cover major revisions.

*This **Intellectual Property Alert** is intended to keep readers current on copyright matters and is not intended as legal advice. If you have any questions, please contact authors [Christina D. Frangiosa](mailto:cfrangiosa@eckertseamans.com) at [cfrangiosa@eckertseamans.com](mailto:cfrangiosa@eckertseamans.com) or 215-851-8432 or [Candace Lynn Bell](mailto:cbell@eckertseamans.com) at [cbell@eckertseamans.com](mailto:cbell@eckertseamans.com) or 716-835-0240.*

*©Eckert Seamans Cherin & Mellott, LLC, 2019, all rights reserved.*