



New Ruling Requires Copyright Registration as Condition to Legal Action.

SLG Legal Update

By SLG Staff

In a landmark copyright case, the United States Supreme Court has held that copyright infringement suits can only be brought after the U.S. Copyright Office actually issues a registration – not, as some U.S. federal circuit courts had held, as soon as the claimant applies for copyright protection. *Fourth Estate Pub. Ben. Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881 (2019).

The U.S. Copyright Act is clear on the basic principle that “no civil action for infringement of the copyright in any United States work shall be instituted until . . . registration of the copyright claim has been made . . .” 17 U. S. C. §411(a). However, federal circuit courts had been split on the question of when registration is deemed to have been made – upon application or upon issuance of a valid registration by the U.S. Copyright Office.

In Fourth Estate, the plaintiff, a news organization, sued the news-website operator Wall-Street.com, LLC for continuing to display the plaintiff’s news articles – for which copyright applications had been filed but registration had not yet been issued – after the license agreement between them had been canceled. The U.S. Supreme Court agreed with the Eleventh Circuit’s affirmation of the case’s dismissal.

The *Fourth Estate* decision comes with several important caveats. First, there remains an option for “preregistration”: a copyright owner who is preparing to distribute a work of a type vulnerable to predistribution infringement—e.g., a movie or musical composition—may apply to the Copyright Office for preregistration. 17 U.S.C. §408(f)(2). Second, even if registration is *refused* in response to a complete and proper copyright application, a plaintiff may still be able to institute a suit if notice is served on the Registrar. 17 U.S.C. §411(a).

Nonetheless, the general rule – that suing for infringement is generally not an option until the U.S. Copyright actual registers the copyright – has tremendous ramifications. Depending on the circumstances, it may often be worthwhile to file an expedited application despite the higher fee if a suit may need to be brought soon (e.g. there exists a known or imminent threat of infringement).

It is important to note that the *Fourth Estate* decision does *not* limit the copyright holder to suits for post-registration infringement. Rather, the exclusive rights of a copyright holder vest from the moment the relevant work is created: once a claimant is able to file a lawsuit, he or she is free



to sue for any infringement, whether it occurred before or after registration. The case merely requires the claimant to wait for the Copyright Office's decision on her application before instituting the suit.

Please do not hesitate to contact SLG to discuss any questions on this important matter at info@shelgroup.com