

# Reexamination in copyright

Ulmer & Berne's **John X Garred** explores the mechanisms used by the US Copyright Office to solve litigation issues



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**Post-grant review has been an option for US patent holders for many years. Patent owners, as well as third parties, may contact the US Patent and Trademark Office (USPTO) to reconfirm patentability of an active patent, reassess the scope of its protection or address errors in a patent grant.** Post-grant patent review has been expanded recently by passage of the America Invents Act, signed into law on 16 September 2011. A party can now request cancellation of a patent for reasons other than prior patents and publications.

Post-grant review is used to ensure the integrity of granted patents and to streamline or eliminate issues from judicial challenge. Highly technical issues, both technological and legal, can be decided by the USPTO, the agency charged with maintaining expertise and experience in these areas. While not quite as obvious, there are indeed mechanisms by which the US Copyright Office may similarly use its expertise to resolve copyright issues that are often relegated to litigation.

## Patent and copyright laws

It should be noted initially that while there are some similarities in copyright and patent laws, they afford very different intellectual property protection. In the US, and most other countries, a patent right does not exist until a patent is granted by a designated governmental authority. On the other hand, in most countries including the US, copyright subsists at the time of creation. Constitutional authority for copyright in the US is tied to "writings".<sup>1</sup> Copyright is defined in the US as subsisting from the time that an original work of authorship is fixed in a tangible medium of expression.<sup>2</sup>

While copyright exists upon creation, the United States has established a mechanism for registration of a claim to copyright.<sup>3</sup> Copyright registration is administered by the Copyright Office, which falls under the umbrella of the Library of Congress.<sup>4</sup>

Unlike with patents, there is no requirement of novelty or originality to sustain a copyright. Two authors may claim copyright to similar works provided each is independently created by its respective author

or authors. It is possible, therefore, that works which are identical, or nearly identical, can each sustain an independent claim to copyright. It is also possible that two or more parties may each lay a legitimate, competing claim to the same work. The Copyright Office is thus not tasked with completing a search of other works relative to the content of that submitted for registration.<sup>5</sup> Instead, the Copyright Office is entitled to rely on the facts and claims submitted by the applicant for registration, which must be accurate.<sup>6</sup> But the Copyright Office is charged with awarding registrations only on works that meet the statutory criteria of copyrightability.<sup>7</sup>

## Copyrightability

Copyrightable subject matter is defined as existing in "original works of authorship".<sup>8</sup> The Copyright Office has promulgated a series of informational "Circulars" that summarise and relay the office's interpretation of the applicable law.<sup>9</sup> 'Circular 1: Copyright Basics' at page 3 sets forth that copyrightable subject matter includes:

- Literary works.
- Musical works, including any accompanying words.
- Dramatic works, including any accompanying music.
- Pantomimes and choreographic works.
- Pictorial, graphic and sculptural works.
- Motion pictures and other audiovisual works.
- Sound recordings.
- Architectural works.

On the other hand, copyrightable subject matter specifically excludes:

- Works that have not been fixed in a tangible form of expression (for example, choreographic works that have not been notated or recorded, or improvisational speeches or performances that have not been written or recorded).
- Titles, names, short phrases, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering, or colouring; mere listings of ingredients or contents.

- Ideas, procedures, methods, systems, processes, concepts, principles, discoveries, or devices, as distinguished from a description, explanation, or illustration.
- Works consisting entirely of information that is common property and containing no original authorship, (for example: standard calendars, height and weight charts, tape measures and rulers, and lists or tables taken from public documents or other common sources).<sup>10</sup>

Copyright protection is also available for a “derivative work”<sup>11</sup> or “compilation”<sup>12</sup> that contains preexisting material if it represents an “original work of authorship” and falls within a category listed in 17 USC § 102. Legislative history clarifies that “the criteria of copyrightable subject matter stated in Section 102 applies with full force to works that are entirely original and to those containing preexisting material.”<sup>13</sup>

### Copyright infringement and the “lack-of originality” defence

A copyright is infringed when an accused work is substantially similar to the original work and when the accused infringer had access to the preexisting work before creation of the accused work. When a lawsuit is brought for copyright infringement, there are several, relatively standard defences upon which defendants frequently rely, including lack of substantial similarity between the registered and accused works or failure to prove access to the registered work before creation of the accused work. A defendant may also allege that the registered work upon which an infringement claim is based is not copyrightable, and therefore not capable of being infringed. Standing alone, the latter “lack-of-originality” argument may be difficult to sustain at the judicial level.

For example, registration is generally a prerequisite to judicial copyright enforcement.<sup>14</sup> And the Copyright Office is statutorily mandated to determine if a work submitted for registration is comprised of copyrightable subject matter before issuing a registration. Moreover, registration is typically completed in advance of litigation to secure a presumption relative to the facts set forth in the registration certificate<sup>15</sup> and an opportunity for alternative or enhanced remedies.<sup>16</sup> As a result, and because the Supreme Court of the US has a long-standing policy to give deference to determinations made by federal agencies,<sup>17</sup> a defendant bears a significant burden to demonstrate that the Copyright Office erred in a determination as to copyrightability, in view of the submitted materials.

Once such circumstance that may make a lack-of-originality defence viable is when the defendant can produce preexisting works accessed by the author in advance of his or her creation of the registered work. If a prospective plaintiff is aware, in advance of registration, of the existence of preexisting works accessed by an author, a preemptive position to counter a lack-of-originality defence may be established by submitting the earlier works contemporaneously with the application for registration. Such a submission might advantageously be coupled with a cover letter reiterating the relationship summarised in the application form itself. For example, Form TX, used in connection with applications for registration of copyright to text-based works, includes a section for information relating to, “Preexisting Material,” and the applicant is asked in Box 6 to identify any preexisting work or works that this work is based on or incorporates. The applicant is then prompted to supply information as to the “Material Added to This Work,” including a brief, general statement of the material that has been added to this work and in which copyright is claimed.<sup>18</sup>

If the subject work is derived solely from preexisting work or works, the applicant might sustain a position of copyrightability relative to legitimate adaptation, modification or incorporation of each such work. Since one right of copyright ownership is the right to make derivative

works, this may be based on ownership of or licence under the earlier work, the underlying work is in the public domain, or that the underlying work itself is not copyrightable.

The Copyright Office is required to complete a substantive examination of the facts set forth in the application and all materials submitted in connection with an application for registration,<sup>19</sup> including copies of preexisting works accessed by the author or authors prior to the creation of the work for which registration is sought.<sup>20</sup> The Copyright Office does not engage in a determination as to ownership of underlying works. It limits its analysis to whether the modifications to the earlier work are themselves sufficient to merit copyright protection. If the office proceeds to register the work in view of the application form, correspondence and background materials, the registrant has effectively diminished, if not eliminated, a defence position based on lack of originality.

### Copyright ‘reexamination’

Now comes a somewhat more problematic, and perhaps more likely scenario: what happens if a preexisting work is identified for the first time while being raised as a defence during litigation? At that point, a registration is presumably preexisting and forms a basis to sustain the infringement litigation.<sup>21</sup> Presumably, the author of the registered work did not make reference to the preexisting work in the application, and the Copyright Office has not passed on the copyrightability of the registered work over the preexisting work. It is not too late, however, to vet the issue of copyrightability to the expertise of the Copyright Office.

The copyright statute establishes a less-frequently used mechanism by which an existing registration may be supplemented. The statute allows the Register to establish “formal procedures for the filing of an application for supplementary registration, to correct an error in a copyright registration or to amplify the information given in a registration.” 17 USC § 408(d).<sup>22</sup> The procedure established by the Copyright Office to correct or amplify an existing registration is by the filing of an application to secure an additional *registration*:

“Supplementary registrations may be made, under the conditions of § 201.5 of these regulations, to correct or amplify the information in a registration made under this section”.<sup>23</sup>

This is an exception to the general rule of one registration per work.<sup>24</sup> The correction and amplification registration procedure is commenced by completing and filing Form CA. The form is structured so as to allow an applicant to reference any area of a prior registration, set forth the incorrect or omitted information in the earlier registration, supply the corrected or additional information, and provide an explanation of such modification. As a result, this procedure may be used in conjunction with application Form TX noted before, including the section relating to preexisting material.

Insofar as Form CA is itself an application for registration, it too is subject to the requirements relative to examination as to copyrightable subject matter. It is also subject to the requirements that all materials submitted in conjunction with the application be considered. And, once a CA registration is issued, it too evidences that the Copyright Office has determined that the subject work is comprised of copyrightable subject matter. The CA registration augments, but does not supersede information in the earlier registration.<sup>25</sup> In this situation, the preexisting and CA registrations would be harmonious.

Thus, copyright holders are provided with a mechanism by which potentially significant litigation defences, based on asserted lack of copyrightability, may be taken before the Copyright Office. This can be accomplished contemporaneously with litigation, and completed in as soon as five business days by taking advantage of the Copyright Office’s special handling procedures. See ‘Copyright Circular 10: Special

Handling'. Once a registration, or supplemental registration, has been acquired wherein earlier material has been passed upon, it would serve to counter lack of copyrightability defence at trial. To the extent judicial deference might be given to determinations made by federal agencies, such a registration could help set the stage for addressing the copyrightability aspect via summary judgment.<sup>26</sup>

**“Defences based on lack of copyrightability can be particularly problematic for jurors. One not versed in copyright may be inclined to look as to ‘who was first’, in connection with the creation of a work, even if properly instructed under the copyright law.”**

## Summary

Defences based on lack of copyrightability can be particularly problematic for jurors. One not versed in copyright may be inclined to look as to “who was first”, in connection with the creation of a work, even if properly instructed under the copyright law. As a result, plaintiffs have much to gain by elimination of such claims before they reach a jury or allowing a jury to consider actions of the Copyright Office as they make their factual determinations.

## Footnotes

1. US CONST art 1, § 8, cl 8.
2. See 17 USC. § 101.
3. See 17 USC § 408.
4. See 17 USC § 701.
5. The Copyright Office does not generally make comparisons of copyright deposits to determine whether or not particular material has already been registered. *US Copyright Office, Compendium of US Copyright Office Practices* § 602.4(C) (3d ed. 2014). The Compendium is a guide published by the Copyright Office of the Library of Congress. It provides information on registration, recordation and related practices by the Office.
6. The facts and claims must be accurate. Registration application forms include the following: “Any person who knowingly makes a false representation of a material fact in the application for copyright registration provided for by section 409, or in any written statement filed in connection with the application, shall be fined not more than \$2,500.” 17 USC § 506(e).
7. The Copyright Office will not register a claim where the material deposited does not constitute copyrightable subject matter. *Compendium (Third)* § 602. (“When the US Copyright Office determines that the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of the US copyright law have been met, it will register the claim...”)
8. 17 USC § 102.
9. Copyright circulars are available from the office website at: <http://www.copyright.gov/circls/>.
10. *Id.* This summarises the rule set forth in 37 CFR § 202.1.
11. A “derivative work” is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatisation, fictionalisation, motion picture version, sound recording, art reproduction, abridgment,

condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a “derivative work”. 35 USC § 101.

12. A “compilation” is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term “compilation” includes collective works. 35 USC § 101.
13. HR REP No 94–1476 (1976).
14. “Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), no civil action for infringement of the copyright in any US work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.” 17. USC § 411(a).
15. 17 USC § 410(c).
16. 17 USC § 412.
17. “We have long recognised that considerable weight should be accorded to an executive department’s construction of a statutory scheme it is entrusted to administer, and the principle of deference to administrative interpretations has been consistently followed by this court whenever decision as to the meaning or reach of a statute has involved reconciling conflicting policies, and a full understanding of the force of the statutory policy in the given situation has depended upon more than ordinary knowledge respecting the matters subjected to agency regulations.” *Chevron USA v Natural Res Def Counsel*, 467 US 837 (1984).
18. Analogous entries are provided in application forms for registration of other types of works, such as visual art works registered under a Form VA.
19. The Copyright Office will generally consider all statements and materials submitted with an application. See ‘Compendium (Third)’ at § 605.1.
20. In theory, making and submitting with an application an unauthorised copy of a preexisting work, proprietary to another, may itself be a technical copyright infringement. However, the circumstances would certainly look to fall under the “fair use” exception of the copyright law. See 17 USC § 107.
21. This presumes, of course, that the earlier work is similar to the registered work in suit, and that the earlier work was likely accessed by the author or authors prior to creation of the registered work.
22. This section further provides that “such application shall be accompanied by the fee provided by section 708, and shall clearly identify the registration to be corrected or amplified.” The information contained in a supplementary registration augments but does not supersede that contained in the earlier registration.
23. 37 CFR § 202.3(b)(11)(iv).
24. See 37 CFR § 202.3(b)(11).
25. 17 USC § 408(d).
26. The plaintiff is advised to file an amended complaint to reference the additional registration.

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