**Office Research Memorandum**

To: John Picard  
From: Fall Associate

Date: Wednesday, November 22, 2017

RE: Motion to Dismiss Copyright Infringement Claim

**Questions Presented**

1. Under the Second Circuit, will Archer Enterprises’ motion to dismiss for failure to state a claim be granted when Janeway’s registration for copyright occurred on the same day as her infringement suit and her registration application is still pending?
2. Under the Second Circuit, will Archer Enterprises be able to meet the threshold requirements for a safe harbor defense, when they are a service provider, and implement a repeat infringer policy?

**Brief Answers**

1. Yes. The Second Circuit will likely grant the motion to dismiss. The Copyright office must accept or reject a copyright owner’s application before suit can be brought. This is the registration approach, other circuits follow the application approach, accepting. pending applications alone are sufficient). Janeway applied for copyright registration on the same day as she filed suit, and her application is still pending. Therefore, the registration requirement is not fulfilled, and she can not bring suit.
2. Probably Yes. Archer Enterprises will probably meet the threshold requirements for a safe harbor defense. The threshold requirements for a safe harbor require defendant to be a service provider, implement a repeat infringer policy, and employ standard technical measures. Archer is a service provider and they terminate user accounts with three or more take down notices. Whether they accommodate and employ standard technical measures is not clear from the facts given. Therefore it is likely they can use a safe harbor defense, but more facts are required.

**Statement of Facts**

On August 27, Janeway completed a music video to her new song “Nashville to New York”, which begins with a five second still of her personal logo. On August 30, she found the music video on Holodeck, Archer Enterprise’s video-hosting site. Archer Enterprises notifies users that they reserve the right to remove videos and terminate accounts for violating terms of service. The Terms of Service state that Archer Enterprises can and will terminate accounts that are found to be repeat copyright infringers (repeat infringers are those with three or more valid takedown notices). Archer monitors infringement notices to determine when take down is appropriate. When take down notices are received, Archer reviews a user’s account for additional violations of Terms of Service. Archer also has technical means of preventing re-upload of infringing material. On September 1, Janeway submitted an application for copyright registration. The same day she filed suit against Archer Enterprises in the Southern District of New York, alleging copyright infringement. As part of suit, she claims that Archer Enterprises violated her exclusive rights under 17 U.S.C. § 106(A).

**Conclusion**

Archer’s motion to dismiss will likely be granted because Janeway applied for copyright registration on the same day she filed for infringement, which is insufficient as her application has not been accepted or rejected by the copyright office. Further, Archer Enterprises may also be eligible for safe harbor because they are a service provider, terminate repeat infringers, employ standard technical measures. The Second Circuit and the Southern District of New York is likely to use the registration approach of interpreting 17 U.S.C. § 411(a), which requires applications to be accepted or rejected by the Copyright Office. Janeway’s claim under § 106(A) will be dismissed because the music video is not a work of visual art, and it is promotional. If the motion to dismiss is denied, Archer may be able to use a safe harbor defense. However, from the facts presented it is unclear if Archer meets the safe harbor threshold requiring standard technical measures.

**Discussion**

Archer’s motion to dismiss will likely succeed because Janeway applied for copyright registration on the same day she filed for infringement, which is insufficient as her application has not been accepted or rejected by the copyright office. Further, Archer Enterprises may also be eligible for safe harbor because they are a service provider, terminate repeat infringers, employ standard technical measures. Under the Copyright Act, 17 U.S.C. §§ 101 et *seq*., a plaintiff must show four elements to state a claim for copyright infringement: (1) which original works are the subject of the claim; (2) that the plaintiff is the owner of the works; (3) that the works have been registered in accordance with the statute; and (4) which acts of the defendant caused the infringement. *Gattoni v. Tibi, LLC*, 254 F. Supp. 3d 659 (S.D.N.Y. 2017); *Palatkevich v. Choupak*, Nos. 12 Civ. 1681 (CM), 12 Civ. 1682 (CM), 2014 1509236, at \*6 (S.D.N.Y. Jan. 24, 2014). What defines proper registration as required by the third element differs, with some courts requiring only the application (the application approach), and some requiring the Copyright office to accept or reject the application (the registration approach). *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612 (9th Cir. 2010)(holding that the application alone is enough for preregistrationunder 17 U.S.C. § 411(a)); *Gattoni*, 254 F. Supp. 3d at 659 (requiring that the application must be accepted). Here, only the registration requirement of the third element is at issue. This memorandum will discuss the Southern District of New York’s likely use of the registration approach to determine the requirements for copyright registration, and whether Archer meets the threshold requirements of a “safe harbor” defense.

1. **Janeway has not met the preregistration requirement of 17 U.S.C. § 411(a) because her application has not been accepted, the Second Circuit is likely to use the registration approach, and the music video is not protected by the Visual Artists Rights Act, 17 U.S.C. § 106(A) (2012) [hereinafter VARA].**

Under the Copyright Act, “no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.” 17 U.S.C. § 411(a). The preregistration requirement has been interpreted in two ways: the registration approach, which requires plaintiff’s copyright application to have been accepted or rejected before filing suit, and the application approach, which only requires plaintiff’s to have submitted the application before filing suit. *Psihoyos v. John Wiley & Sons, Inc*., 748 F.3d 120 (2d Cir. 2014). These approaches have created a circuit split. *Id.* at 125.

1. **Janeway’s registration is not sufficient because she filed her application for copyright on the same day she filed for infringement, and the Second Circuit will use the registration approach.**

The Fifth and Ninth Circuit follow the application approach. *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386–87 (5th Cir.1984); *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612 (9th Cir. 2010). The Eight Circuit endorsed application in dicta, and Seventh Circuit’s dicta conflicts and supports both. *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338 (11th Cir. 2017) (summarizing the circuit split regarding the use of the registration or application approach). Courts applying the application approach seek to interpret the ambiguous language of the statute, understand the legislative intent of the statute, and policy impacts of the approach. The circuit split has been caused by ambiguous language in 17 U.S.C. § 411(a), which describes what is required to bring suit for copyright infringement. *Cosmetic Ideas*, 606 F.3d at 616. § 410(a) and § 411(a) suggest the need for affirmative acts from the Copyright Office, however § 408(a) suggests delivery to the office is enough for registration, and § 410(d) could be interpreted in either way. *Id.* at 616. With the language of the statute bringing no clarity, courts turn to the legislative intent to discern the requirements. The Copyright Act made registration for copyright optional, but encouraged registration with incentives. Copyright holders often register specifically for the purpose of bringing suit, and courts have found that the application approach better fulfills Congress’s purpose of providing broad copyright protection. *Id.* at 619. The intent of Congress was to simplify the copyright process, and the needless formality of approval or rejection is what Congress sough to eliminate with the passing of the act. *Id.* at 619. After assessing the legislative intent, courts turn to the policy impacts of each approach. The need for affirmative acceptance or rejection causes unnecessary delay which could permit an infringing party to continue to profit from wrongful acts or the copyright owner to unable to sue due to the statute of limitations. *Id.* at 620. The statute of limitations for infringement is three years and formal acceptance or rejection can take over a year. *Id.* at 620. Additionally, the ability to sue whether the application is accepted or rejected suggests that the process is needless formality. *Chevrestt v. Am. Media, Inc.*, 204 F. Supp. 3d 629, at 631 (S.D.N.Y. 2016).

The registration approach has been adopted by the Tenth and Eleventh Circuits. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005), abrogated on other grounds by *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, (2010); *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338 (11th Cir. 2017). These courts find the plain language of the statute compels using the registration approach, relying only in part on legislative intent and policy arguments. *See La Resolana*, 858 F.3d at 1202. The Eleventh circuit holds that the language of 17 U.S.C. § 411(a) suggests the need of an affirmative act from the Copyright Office. *Fourth Estate*, 856 F.3d at 1341 (holding that Copyright Act defines registration as a process that registration action by both copyright own and the Copyright Office BECAUSE…). The statute states registration is required to file suit, and application is used in the same section and is clearly separate and apart. *Mays & Assocs. v. Euler*, 370 F. Supp. 2d 362, 368 (D.Md.2005). The statue also distinguishes between application and registration in § 410(a) and (d). *Fourth Estate*, 856 F.3d at 1341 (upholding registration approach because the phrase “after examination” in § 410(a) indicative that registration occurs after filing of the application and that § 410(d) shows registration occurs only after an application is deemed acceptable).

The plain language of the statute also evidences Congress’s intent to require something more than application in filing suit. *Mays & Assocs*, 370 F. Supp. 2d at 368. The Copyright Act does not require copyright owners to register, but registration allows for additional protections, including the right to sue for infringement. *Asche & Spencer Music, Inc. v. Principato-Young Entm't, Inc.*, 147 F. Supp. 3d 833, 837 (D. Minn. 2015) (finding legislative intent for copyright owners to proactively register BECAUSE…). In the proposed Copyright Reform Act of 1993, § 411(a) would have been repealed, allowing infringement suits to be brought upon application, however the congress did not enact bill. *Robinson*, 1996 WL 663880, at \*8 (stating while not conclusive, it “serves as a reminder that the Court should not lightly disregard what arguably is a congressional determination that no exception is to be made for injunction actions”). The Copyright Office itself finds the registration approach to be correct and the intent of Congress. U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 625.5 (3d ed. 2014), *available at* copyright.gov/comp3/. Additionally, the registration application does not cause undue delay. *Asche*, 147 F. Supp. 3d at 838 (dismissing delay caused by registration approach by stating copyright owners may request special handling by the Copyright Office to improve speed in which the office processes the application, allow copyright owners to avoid being unable to sue due to the statute of limitations, or infringers unjustly profiting for prolonged periods).

The Second Circuit abstains from joining the circuit split, *Psihoyos*, 748 F.3d at 125, however, it would likely follow the registration approach because its districts almost unanimously hold that application for registration is not sufficient for bringing suit as required by § 411(a). The majority of copyright infringement suits that are brought in the Second Circuit originate in the Southern District of New York. While a minority of cases employ the application approach, the Western, Eastern, Northern, and Southern Districts of New York apply the registration approach. *Lumetrics, Inc. v. Blalock*, 23 F. Supp.3d 138 (W.D.N.Y. 2014); *Capitol Records, Inc. v.* *Wings Digital Corp*., 218 F. Supp. 2d 280 (E.D.N.Y. 2002); *Rommel v. Laffey*, 194 F.R.D. 441, at 443 (N.D.N.Y 2000); *Silver v. Lavandeira*, No. 08 Civ. 6522 (JSF) (DF), 2009 WL 513031 (S.D.N.Y. Feb. 26, 2009); *Zuma Press, Inc. v. Getty Images (US), Inc.*, No. 16 Civ. 6110 (AKH), 2017 WL 2829517 (S.D.N.Y. June 29, 2017); *but see Well–Made Toy Mfg. Corp. v. Goffa Int'l Corp*., 210 F.Supp.2d 147, 157 (E.D.N.Y.2002); *Havens v. Time Warner, Inc.*, 896 F.Supp.141 (S.D.N.Y 1995). The District of Connecticut has not touched the issue in great amount, and so determining its position is not possible. *Oban US, LLC v. Nautilus, Inc.*, No. 3:13CV2076 (JBA), 2014 WL 2854539, (D. Ct. June 23, 2014) (preferring the application approach); *RBC Nice Bearings, Inc. v. Peer Bearing Co*., No. 3:06–CV–1380 (VLB), 2009 WL 3642769, at \*4 (D.Conn. Oct. 27, 2009) (applying the registration approach). The District of Vermont has not addressed the issue. The registration approach is more faithful to statutory construction because while the language in § 411(a) may seem ambiguous, the statute clearly distinguishes between application and registration in other sections, and the Copyright Office itself supports the registration approach and the legislative intent requiring acceptance.

Janeway’s registration will be ruled as insufficient because the Southern District will likely use the registration approach. While not binding, the Southern District of the Second Circuit has almost unanimously used the registration approach. *Silver*,2009 WL 513031, at \*5; *but see Chevrestt*, 204 F. Supp. 3d at 631*.* In *Wings Digital*, plaintiff’s pending applications where deemed as insufficient registration under § 411(a) because they were not yet accepted or rejected by the Copyright Office, as such defendant’s motion to dismiss regarding the infringement was granted. *Wings Digital Corp*., 218 F. Supp. 2d at 284. In *Zuma*, defendant’s motion to dismiss was granted in part in respect to photographs that did not having valid copyright registration, because some were not registered at all, and some were still pending. *Zuma*, 2017 WL 2829517, at \*4. Here, Janeway’s application has not been approved or rejected by the Copyright office, and so Archer’s motion to dismiss will likely be approved. However, if the Southern District used the application approach, the motion would be denied. In *Chevrestt*, copyright owner could bring infringement action enough his application had not yet been accepted or rejected. *Chevrestt*, 204 F. Supp. 3d at 631. Here, Janeway’s application has not been accepted or rejected, and if the application approach is used, will be allowed to bring suit and the motion will be denied.

1. **Janeway will not receive the lenient standard of registration granted for works of art protected by VARA because it is an audiovisual work and promotional in nature.**

The Copyright Act, 17 U.S.C. § 411(a), requires preregistration for civil action for infringement, “Except for an action brought for a violation of the rights of the author under section 106A(a)[.]” VARA gives visual artists additional rights and control over their works. VARA only applies to “visual art” which as defined in 17 U.S.C. § 101 “a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.” VARA’s protection is limited to works intended for exhibition use only. *Pollara v. Seymour*, 344 F.3d 265, 270 (2d Cir.2003). § 101 specifically excludes audiovisual works and items of a promotional nature. This has been established in the common law. *Scott v. Carlson,* No. 2:17-CV-10011, 2017 WL 3599249, at \*2 (W.D.Va. Aug. 21, 2017)(holding that neither audiovisual material nor promotional logos are a visual art, and that their creators do not afford the special rights under § 106(A) because the subsection only address works of visual art, which excludes audiovisual work); *Kleinman v. City of San Marcos*, 597 F.3d 323 (5th Cir. 2010)(finding that an item which was a distinctive symbol of the owner's business did not qualify as a work of visual art because it promotional works are excluded by the statute as works of visual art).

Here, Janeway’s use of VARA would allow her to file suit despite not having her registration accepted, however as seen in *Scott,* WL 3599259, at \*1 and *Kleinman,* 597 F.3d at 329, her music video is an audiovisual work and begins with a five second still shot of her personal logo, precluding her use of VARA., and its protections.

1. **Archer Enterprises may be eligible for Safe Harbor defense because they are a service provider, ban repeat infringers, and employ standard technical measures as required in the three prongs of the safe harbor threshold.**

To qualify for safe harbor defense from a copyright infringement suit, a party must meet a threshold of three criteria: (1) the party must be a service provider; (2) satisfy conditions of eligibility, including implementation of a repeat infringer policy; and (3) employ standard technical measures. *Viacom Intern., Inc. v. YouTube, Inc.*, 676 F.3d 19, 27 (2d Cir. 2016). For Transitory Communication Safe Harbor, a service provider is defined as “an entity offering the transmission, routing, or providing of connections for digital online communications, between or among parties specified by a user, of material of the user's choosing, without modification of the content of the material as sent or received.” 17 U.S.C. § 512(k)(1)(A). For other forms of safe harbor, a service provider is defined as “a provider of online services or network access, or the operator of facilities therefor.” 17 U.S.C. § 512(k)(1)(B). The second definition includes anything that qualifies under the first. *In re Aimster Copyright Litig.*, 252 F. Supp. 2d 634, 658 (N.D.Ill 2002). These definitions include virtually all internet services. *Id.* at 658. *See also Capitol Records, LLC v. Vimeo, LLC*, 826 F.3d 78 (2d Cir. 2016).

The second threshold for safe harbor under the Copyright Act requires service providers to have “adopted and reasonably implemented ... a policy that provides for the termination in appropriate circumstances of subscribers and account holders of the service provider's system or network who are repeat infringers.” 17 U.S.C. § 512(i)(1)(A). A repeat infringer is one who repeatedly interferes with the exclusive rights of a copyright. *EMI Christian Music Group, Inc. v. MP3tunes, LLC*, 844 F.3d 79, at 89 (2d Cir. 2016). Copyright infringement is a strict liability offense, and infringers need not be culpable. *Id.* at 89. A reasonably implemented repeat infringer policy: (1) has a system for responding to takedown notices; (2) does not interfere with copyright owner’s ability to issue notices; and (3) terminates users who are repeat infringers. *Capitol Records, Inc. v.* *MP3tunes, LLC*, 821 F. Supp. 2d 627 (S.D.N.Y. 2011).

The last threshold requirement for safe harbor are “standard technical measures”. 17 U.S.C. § 512(i)(1)(B). These standard technical measures are measures used by copyright owners to identify or protect copyright works. 17 U.S.C. § 512(i)(2). They have been developed by consensus of copyright owners in a multi-industry process, must be available to any person, and must not impose substantial costs on service providers or their networks. 17 U.S.C. §§ 512(i)(2)(A), (B), and (C). Interfering with a standard technical measure exposes a service provider to liability.” *Viacom,* 676 F.3d at 41. Plaintiffs must specifically allege that the service provider is blocking a standard technical measure. *Id.* at 41. *Wolk v. Kodak Imaging Network, Inc.*, 840 F. Supp. 2d 724 (S.D.N.Y. 2012) (holding that editing tools do not disqualify a service provider from safe harbor eligibility because it users rather than the service provider who use the tools to infringe copyrights). *Perfect 10* was able to determine if accessing websites is a standard technical measure.

Archer Enterprises clearly meets the first threshold for a safe harbor defense: they are a service provider. They provide online services and network access as described in 17 U.S.C. § 512(k)(1)(B). YouTube and Vimeo, which are internet sites which allow users to upload and watch videos, are service providers. *Viacom,* 676 F.3d at XX; *Vimeo,* 826 F.3d at XX. Here, Archer Enterprises also allows users to upload and watch videos, and are a service provider.

Archer Enterprises has adopted a repeat infringer policy, meeting the second threshold requirement for a safe harbor defense. In Capitol Records v. MP3Tunes, it was required that a reasonably implemented repeat infringer policy must have a system to respond to infringement notices, not interfere with copyright owner’s ability to issue notices, and terminate repeat infringers. *Capitol Records, Inc. v. MP3tunes, LLC, 821 F. Supp. 2d 627 (S.D.N.Y. 2011).* Here, Archer has employees who monitor infringement notices, and determine when take down is appropriate. Archer keeps track of users who have received takedown notices and terminate user accounts with three or more valid takedown notices. In *Viacom*, a reasonable policy only required the termination of repeat infringers. *See* *Viacom v. YouTube*, 718 F.Supp.2d 514, 528–29 (S.D.N.Y.2010) (finding reasonable a policy that terminated users who uploaded content after warning).

Archer Enterprises may not meet the third threshold, accommodating standard technical measures. Standard technical measures are not well defined. Here, Archer has the means of preventing the re-upload of infringing material.