**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 Copyright Act, will the Southern District of New York (“S.D.N.Y”) grant Archer Enterprises’ (“Archer) Motion to Dismiss for failure to state a claim when Kate Janeway (“Janeway”) filed for copyright registration on the same day that she filed for copyright infringement and her registration application has not yet been accepted or rejected by the Copyright Office?
2. Under the S.D.N.Y, will Archer be able to meet the threshold requirements for a safe harbor defense, when they are a service provider, implement a repeat infringer policy, and probably accommodate standard technical measures?

**Brief Answers**

1. Yes. The S.D.N.Y will probably grant the Motion to Dismiss. The S.D.N.Y will likely hold that the Copyright Office must accept or reject a copyright owner’s application before suit can be brought. The S.D.N.Y interprets the Copyright Act to require acceptance or rejection by the Copyright Office as a requirement to bring suit for copyright infringement in almost all cases. 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 will probably meet the threshold requirements for a safe harbor defense. The threshold requirements for a safe harbor require the defendant to be a service provider, implement a repeat infringer policy, and accommodate standard technical measures. Archer is a service provider and they terminate user accounts with three or more take down notices. Whether they accommodate 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’s video-hosting site. Archer 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 can and will terminate accounts that are found to be repeat copyright infringers (repeat infringers are users 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 to the Copyright Office, the same day she filed suit against Archer in the S.D.N.Y., alleging copyright infringement. As part of hersuit, she claims that Archer violated her exclusive rights under 17 U.S.C. § 106(A).

**Discussion**

Archer’s Motion to Dismiss will likely succeed because Janeway applied for copyright registration on the same day she filed for infringement, her application has not yet been accepted or rejected by the Copyright Office, and the S.D.N.Y. will likely require her application to be accepted or rejected by the Copyright Office. Further, Archer may also be eligible for a safe harbor defense because they are a service provider, terminate repeat infringers, and accommodate 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, 662 (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: some courts require only an application to be submitted to the Copyright Office (the application approach) while others require the Copyright Office issue an acceptance or rejection of 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 or rejected by the Copyright Office before bringing suit). Here, only the registration requirement of the third element is at issue. This memorandum will discuss the S.D.N.Y’s likely use of the registration approach to determine the requirements for a copyright infringement suit, 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 or rejected by the Copyright Office, the S.D.N.Y. 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) (“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 insufficient for her suit because she filed her application for copyright on the same day she filed for infringement and the S.D.N.Y. 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 the Seventh Circuit’s dicta is conflicting. *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). The Tenth and Eleventh Circuits have adopted the registration approach. *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,* 856 F.3d at 1338. Courts seek to interpret the ambiguous language of in 17 U.S.C. § 411(a) by interpreting the plaint language of the statute, determining legislative intent behind the statute, and policy impacts of each approach to determine which is best.  *Cosmetic Ideas*, 606 F.3d at 616.

When the language of a statutory section is not clear, the court turns to the context of the statute as a whole. *Cosmetic Ideas*, 606 F.3d at 616. The language of § 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. *Cosmetic Ideas*, 606 F.3d at 616. The Tenth and Eleventh Circuits find the language so plain, that other arguments are unnecessary. *Fourth Estate*, 856 F.3d at 1342; *See also* *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 requires action by both copyright owner and the Copyright Office). 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) is indicative that registration occurs after filing of the application and that § 410(d) shows registration occurs only after an application is deemed acceptable).

Next, courts turn to the legislative intent of the statute. Courts applying the application approach examine the legislative intent because they find no clarity in the statute. *Cosmetic Ideas*, 606 F.3d at 618. The Ninth Circuit argues that because registration for copyright is optional copyright holders often register specifically to bring suit, and courts have found that the application approach better fulfills Congress’ purpose of providing broad copyright protection. *Cosmetic Ideas*, 606 F.3d at 619. Congress intended to simplify the copyright process, and the needless formality of approval or rejection is what Congress sought to eliminate with the passing of the Copyright Act. *Id.* at 619. Courts following the registration approach argue that legislative intent wanted that formality. *See Asche & Spencer Music, Inc. v. Principato-Young Entm't, Inc.*, 147 F. Supp. 3d 833, 837 (D. Minn. 2015). The S.D.N.Y. argues that Congress could have repealed § 411(a) in the proposed Copyright Reform Act of 1993, but did not enact the bill suggesting their approval of the registration approach. *Robinson v. Princeton Review, Inc.*, No. 96 Civ. 4850 (LAK), 1996 WL 663880, at \*8 (S.D.N.Y. Nov. 15, 1996). The Copyright Office finds the registration approach to be correct and what was intended by Congress. U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 625.5 (3d ed. 2014), *available at* copyright.gov/comp3/.

Courts then turn to policy to determine which approach to apply. *See* *Cosmetic Ideas*, 606 F.3d at 619. The Ninth circuit uses the application approach because it minimalizes delay. *Id.* at 619. 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). However, the District of Minnesota finds that the registration approach does not cause delay because copyright owners may request special handling by the Copyright Office, preventing harms the application approach seeks to prevent. *Asche*, 147 F. Supp. 3d at 838.

The Second Circuit abstains from joining the circuit split, *Psihoyos*, 748 F.3d at 125, however, it will likely follow the registration approach because almost all its district courts hold that application for registration is insufficient for bringing suit as required by § 411(a). 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 registration approach is more faithful to statutory construction because despite ambiguous language in § 411(a), 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.

The S.D.N.Y will rule Janeway’s registration as insufficient because it will likely use the registration approach. The S.D.N.Y. 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, therefore Archer’s Motion to Dismiss will likely be granted as in *Wings Digital* and *Zuma*. However, if the S.D.N.Y. used the application approach, the Motion to Dismiss would be denied. In *Chevrestt*, copyright owner could bring infringement action when 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 visual art protected by VARA because her music video an audiovisual work and promotional in nature.**

The Copyright Act requires preregistration for civil action for infringement, “[e]xcept for an action brought for a violation of the rights of the author under section 106A(a)[.]”. 17 U.S.C. § 411(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 is “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). Visual works of art specifically excludes audiovisual works and items of a promotional nature. 17 U.S.C. § 101; *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). Promotional works include any merchandising, advertising, or promotional items. *See Wilson* *v. New Place Casino, L.L.C.*, No. 1:11CV447-HSO-JMR, 2013 WL 870350, at \*7 (S.D. Miss. Mar. 7, 2013); *Kleinman v. City of San Marcos*, 597 F.3d 323, 329 (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).

Janeway cannot make a claim under VARA because her music video is not a work of visual art. Janeway’s use of VARA would allow her to file suit despite not having her registration accepted or rejected by the Copyright Office and give her work additional protections. In *Kleinman*, a distinctive symbol of a business was determined to not be a visual work of art and was not granted protection under VARA. Here, Janeway’s music video is begins with a five second still shot of her personal logo. Like in *Kleinman,* Janeway’s logo is a distinctive symbol of her business, and thus will not be protected by VARA because it is promotional. In *Scott,* it was ruled that a music video that began with a promotional logo was not a work of visual art because it was an audiovisual work and promotional in nature, and so a Motion to Dismiss was granted. Here, Janeway also is seeks protection for a music video that begins with a promotional logo and so Archer’s Motion to Dismiss should be granted.

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

The Copyright Act protects a service provider from liability only if they have reasonably implemented a repeat infringer policy and accommodate standard technical measures. Title 17 U.S.C. § 512(i)(1). To qualify for a 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) accommodate standard technical measures. *Viacom Intern., Inc. v. YouTube, Inc.*, 676 F.3d 19, 27 (2d Cir. 2016). For a safe harbor defense, 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). This definition encompasses virtually all internet services, including video sharing sites. *In re Aimster Copyright Litig.*, 252 F. Supp. 2d 634, 658 (N.D. Ill 2002); *Capitol Records, LLC v. Vimeo, LLC*, 826 F.3d 78 (2d Cir. 2016); *Viacom v. YouTube*, 718 F. Supp. 2d 514, 528–29 (S.D.N.Y. 2010).

The second threshold for a safe harbor defense 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 … 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 a safe harbor defense 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.

Archer meets the first threshold for a safe harbor defense: they are a service provider as evidenced by the fact that they provide online services and network access as described in 17 U.S.C. § 512(k)(1)(B). Similar to YouTube and Vimeo, which are internet sites that allow users to upload and watch videos, which were ruled as service providers. *Viacom,* 676 F.3d at 26; *Vimeo,* 826 F.3d at 82. Archer’s Holodeck is an internet site that allows users to upload and watch videos, therefore is a service provider.

Archer 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, therefore Archer’s sufficient repeat infringer policy is reaffirmed by the determination in *Viacom*, which found that 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 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.

Archer’s Motion to Dismiss will likely be granted by the Second Circuit’s likely subscription to the registration approach because Janeway applied for copyright registration on the same day she filed for an infringement suit, which is insufficient as her application has not been accepted or rejected by the copyright office. Further, Archer may also be eligible for a safe harbor defense because they are a service provider, terminate repeat infringers, accommodate standard technical measures. The Second Circuit and S.D.N.Y 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 VARA will be dismissed because the music video is not a work of visual art according to § 101, and it is seemingly promotional in purpose. 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.