



Michael M. Ratoza
Portland, Of Counsel

Direct Dial: 503.499.4695

Fax: 503.295.0915

Email Attorney

Copyright Litigation Becomes A Little Bit Easier for West Coast Plaintiffs

By Michael M. Ratoza

For years it has been a hard and fast rule of copyright law that the Copyright Office must first issue a copyright registration, or issue a refusal to register, before a plaintiff may file an infringement suit. No registration; no suit. This registration process often took months. While a small exception to this harsh rule allowed a foreign owner of a foreign work to bring suit in the United States without a U.S. certificate of registration, the general rule absolutely prohibited the filing of a copyright infringement complaint by a U.S. citizen without an issued registration or a refusal to register.

For the would-be plaintiff with an infringement claim and no registration, this registration requirement has historically led to cost and delay. And while the Copyright Office provides an expedited registration process, the enhanced fees imposed for expedited registration often transformed a simple \$35 electronic registration into a \$1,000 expedited registration ordeal requiring the services of an attorney.

Things are now a bit easier. Although the pre-litigation registration requirement remains in effect, the Ninth Circuit significantly lightened the burden of this requirement with its decision in *Cosmetic Ideas, Inc. v. IAC/InteractiveCorp*, filed May 25, 2010.

Plaintiff Cosmetic sued for infringement of its costume jewelry design after having applied for registration, but before having received a certificate of registration from the Copyright Office. The District Court dismissed the complaint for failure to comply with the registration requirement. In reviewing the dismissal, the Ninth Circuit considered what it means to "register" a copyrighted work. The Court asked: Is a copyright registered at the time the copyright holder's application is received by the Copyright Office, or at the time that the Office issues a certificate of registration? Reasoning that requiring formal approval or rejection by the Copyright Office prior to suit constitutes needless formality, the Ninth Circuit ruled that mere filing of a copyright application is sufficient to allow a plaintiff to file an infringement lawsuit. The plaintiff need no longer wait months for the Copyright Office to process the application. Practically speaking, the *Cosmetic Ideas* decision obviates the need for expedited registration in cases brought in Ninth Circuit courts, as same-day electronic filing is the fastest way of placing the application in the hands of the Copyright Office.

Notwithstanding the plaintiff-friendly decision of the Ninth Circuit, it is strongly recommended that copyright owners register their works with the Copyright Office as early as possible following publication. Why? Because the Copyright Act still penalizes in other ways a copyright owner who waits too long to register. The law takes away the right to obtain damages and attorneys' fees in some cases if the application is not submitted timely following first publication of the work.

Contact the attorneys at Bullivant Houser Bailey IP Group for more specific information about your rights and responsibilities under U.S. Copyright Law.