

In The  
Supreme Court of the United States

—◆—  
REED ELSEVIER, INC. *et al.*,  
*Petitioners,*

v.

IRVIN MUCHNICK *et al.*,  
*Respondents.*

—◆—  
On Writ Of Certiorari To The  
United States Court Of Appeals  
For The Second Circuit

—◆—  
BRIEF FOR *AMICI CURIAE* COMPUTER &  
COMMUNICATIONS INDUSTRY ASSOCIATION  
AND NETCOALITION IN SUPPORT  
OF THE JUDGMENT BELOW

—◆—  
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August 26, 2009

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**BRIEF FOR *AMICI CURIAE* COMPUTER  
& COMMUNICATIONS INDUSTRY  
ASSOCIATION AND NETCOALITION  
IN SUPPORT OF THE JUDGMENT BELOW**

The Computer & Communications Industry Association (CCIA) and NetCoalition submit this brief as *amici curiae* in support of the judgment below, and urge that the writ be dismissed.



**INTEREST OF *AMICI*<sup>1</sup>**

The Computer & Communications Industry Association is a non-profit trade association dedicated to “open markets, open systems, and open networks.” CCIA members participate in many sectors of the computer, information technology, and telecommunications industries and range in size from small entrepreneurial firms to the largest in the industry.

NetCoalition serves as the public policy voice for some of the world’s most innovative Internet companies, including Google, Yahoo!, IAC/InterActive Corp., Amazon.com, eBay, Wikipedia, and Bloomberg. NetCoalition provides creative and effective solutions

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<sup>1</sup> Pursuant to S. Ct. R. 37, *amici curiae* CCIA and NetCoalition affirm that no monetary contributions were made for the preparation or submission of this brief, and that no part of this brief was drafted by any parties in this action. Counsel of record for Petitioners, Respondents, and court-appointed *amicus* Professor Merritt have consented to the filing of this brief, and their letters of consent have been filed herewith.

to the critical legal and technological issues facing the Internet.

*Amici* represent companies on the cutting edge of information technology. As *amici* are functionally regulated by the copyright system, they depend upon it to fulfill its constitutional purpose of promoting progress. The companies represented by *amici* develop products and services that may qualify for the protection offered by the federal copyright system. At the same time, many of these companies' services or products enable or support the transmission or processing of information that is potentially subject to federal copyright protection. Internet and communications-related services are particularly aware of the reach of federal copyright law. Insofar as every blog post, electronic mail, voicemail, instant message, text message, and "tweet" may constitute works of authorship fixed in a tangible medium, each is potentially entitled to decades of federal copyright protection from the moment of fixation. Even the lowliest email may wield the vast powers bestowed upon works of authorship by Title 17.

Technology industries are therefore both enabled and yet imperiled by the federal copyright system. U.S. courts administer this apparatus in the hopes of achieving the "difficult balance between the interests of authors . . . in the control and exploitation of their writings . . . and society's competing interest in the free flow of ideas, information, and commerce . . . " *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 429 (1984). The inherent challenge in this exercise is

that “[t]he more artistic protection is favored, the more technological innovation may be discouraged; the administration of copyright law is an exercise in managing the trade-off.” *MGM Studios, Inc. v. Grokster Ltd.*, 545 U.S. 913, 928 (2005). One aspect of this trade-off is that registration serves as the gatekeeper to the courthouse.

Although it imposes minor costs upon authors, “[r]egistration of creative works confers significant benefits on the Library of Congress and the public.” United States Brief (“U.S. Br.”) 4. In addition to the public benefits, registration serves to mitigate the number of unmeritorious cases brought. By imposing this minor hurdle to access to the courthouse, the registration system separates wheat from chaff and ensures that only works worthy of a government-created limited monopoly can be the subject of federal litigation. This price – whose deposit and record-creating aspects ultimately inure to the public benefit – is a small one to pay to prevent litigants from invoking the authority conferred by the Copyright Act without just cause.

Registration’s function as gatekeeper to the courthouse is especially important to technology companies. When every blog and tweet might be protectable under copyright, the registration requirement dramatically reduces technology companies’ potential exposure to copyright infringement claims in general and copyright class actions in particular. Every day, the servers operated by Internet companies make copies of billions of copyrightable

works. But because so few of these works are registered, the threat posed by class actions regarding these works currently is small.

However, if this Court reverses centuries of precedent and finds that 17 U.S.C. § 411(a) is not jurisdictional, class action lawyers will declare open season on Internet companies. To be sure, if they chose to litigate, Internet companies would ultimately succeed in convincing courts to dismiss most of these complaints. Nonetheless, a ruling that section 411(a) is not jurisdictional will encourage copyright “trolls” to file more class actions for the purpose of extracting quick nuisance value settlements. Accordingly, *amici* seek to preserve the long-standing rule that section 411(a) is a jurisdictional bar to the federal courthouse.



## **SUMMARY OF THE ARGUMENT**

The Court should leave standing the opinion of the Second Circuit, based on both the record and the law. First, the record indicates that, contrary to assertions at the petition stage, before the district court the parties extensively raised the subject matter nature of 17 U.S.C. § 411(a). Accordingly, under any characterization of section 411(a) offered by the parties or *amici*, the decision below was sound.

Second, on the law, there is no circuit split on the issue. Reading Petitioners’ and Respondents’ two

briefs is to believe that the opinion below is an aberration, a lark, an untoward departure from well-settled case law. The reality is far different: not only does the Second Circuit's opinion faithfully follow precedent in that court going back to 1911, but every other court of appeals to have decided the issue agrees, as do hundreds of district courts.<sup>2</sup> The aberrations are the scattered district court opinions, less than a handful, that take a different view,<sup>3</sup> and even these are inconsistent with governing decisions in the relevant court of appeals. There is therefore no circuit split, the traditional ground on which this Court grants certiorari.

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## ARGUMENT

### I. THE WRIT SHOULD BE DISMISSED.

For 219 years, Congress and the courts have regarded as a subject matter jurisdictional limitation the requirement that registration of a claim to copyright be made (or after 1977, attempted but rejected) prior to instituting an infringement suit. Unlike private interests represented in numerosity or timing requirements in other federal statutes, the copyright registration prerequisite serves valuable, undisputed public policy purposes that cannot be waived by the

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<sup>2</sup> See Brief of Professor Deborah Merritt ("Merritt Br."), Appx. C.

<sup>3</sup> See Merritt Br. 41 n.13.

parties to a lawsuit. To protect those policy goals, the courts, including appellate courts, must be able to raise lack of compliance *sua sponte*. In this case, the parties raised the lack of compliance before both the district court and the court of appeals. In both the lower courts, Petitioners took the position that section 411(a) involved subject matter jurisdiction.

To read the current briefs of the parties and their *amici*, the parties were bushwhacked at the court of appeals: after years of “difficult” and “heated” negotiations, a settlement was reached with the assistance of a mediator and approved by the district court. No one, we are led to believe, questioned the jurisdiction of the district court to hear the case and approve the settlement until the appeal, when the Second Circuit held that the word “jurisdiction” in section 411(a) has meaning.

Thus, Petitioners assert the Second Circuit “upended that agreement on a ground that was not raised by any of the parties”, having “*sua sponte* requested briefing on ‘whether the district court had subject matter jurisdiction over claims concerning the infringement of unregistered copyright.’” Petitioners’ Merits Brief (“Pet Br.”) 2, 7.

One might conclude from this statement that the issue of whether section 411(a) limits the subject matter jurisdiction of the federal courts to hear copyright infringement cases was first raised by the Second Circuit. That is the very basis for the United States’ brief, whose only apparent difference with the

majority opinion below is that other than in exceptional circumstances, the issue will be deemed forfeited unless raised at the trial court. U.S. Br. 27-31. But even the United States acknowledges, “district courts should enforce th[e] requirement *sua sponte*, and should decline to adjudicate an infringement suit on the merits when the plaintiff has not complied with the statutory prerequisite.” U.S. Br. 11. Indeed, every brief before this Court takes the further position that section 411(a) bars an infringement action with respect to United States works where *the parties* have raised the issue at the trial level.

**A. In the Courts Below, Petitioners Repeatedly Acknowledged the Subject Matter Jurisdictional Basis for Section 411(a).**

The record refutes the theory that the Second Circuit ventured, uninvited, into the question of subject matter jurisdiction. As Francois de la Rochefoucauld observed: “There is nothing more horrible than the murder of a beautiful theory by a brutal gang of facts.” *See Negrón v. Rivera*, 433 F. Supp. 2d 204, 207 (D.P.R. 2006), *aff’d*, 504 F.3d 151 (1st Cir. 2007). The brutal gang of facts in this case demonstrates that the Petitioners had, from the inception of the case, regarded section 411(a) as involving subject matter jurisdiction, and had so argued before the district court *and* the court of appeals. The first time Petitioners took the position that section 411(a) does not act as a subject matter limitation on the courts

was *after* this Court granted certiorari and had squarely presented that issue. Even in the Petition for Certiorari, Petitioners did not deny the subject matter jurisdictional basis for section 411(a), and for a very good reason: compliance with section 411(a) is the basis for the settlement.

**1. The Settlement is Predicated on Section 411(a).**

Defendants (Petitioners here) and the so-called Class A and Class B plaintiffs (those who had registered) used the lack of compliance with section 411(a) by the Class C plaintiffs (those who had not registered) as the hammer by which the Class C plaintiffs were to be given the smallest possible award, and possibly zero. Unless section 411(a) deprives the federal courts of subject matter jurisdiction, the entire basis for the settlement fails.

Section 411(a) was thus the heart and wallet of the proceedings before the district court: liability was already established by this Court in *New York Times v. Tasini*, 533 U.S. 483 (2001), and thus the only battles were over money. Having chosen to divide the money based solely on compliance with section 411(a), rather than, say, the fair market value of the articles, the parties cannot now claim that the provision was raised for the first time at the court of appeals by the court of appeals. Indeed, as explained below, flatly contrary to what Petitioners have told this Court, in their merits brief to the Second Circuit Petitioners themselves took the position that section 411(a)

limited courts' subject matter jurisdiction, *before* the Second Circuit asked for supplementary briefing. It seems very likely that it was Petitioners' own brief taking that position which caused the Second Circuit to ask for additional briefing. And even in their letter brief to the court of appeals, Petitioners continued to argue that section 411(a) limited the courts' subject matter jurisdiction. It was only after the court of appeals threw out the settlement that the Petitioners changed their position before this Court; yet, their need to retain section 411(a) as the foundation for the settlement remains, which explains why Petitioners' proposed questions for certiorari were so convoluted, leading this Court to write its own question.

Given Petitioners' strategic decision to use section 411(a) to drive a hard economic bargain in the settlement, it is no wonder those negotiations are described as having been heated and intense: section 411(a) was used to push down the value of the settlement for unregistered authors potentially to zero, leading those authors to cry foul. The proposed settlement caps the potential payments for the 36 major corporations who make up the Petitioners at the *maximum* figure of \$18 million; the minimum figure is \$10 million.

What do the Category C authors – those who did not comply with section 411(a) receive in the settlement? The answer is not much, maybe nothing; but whatever it is, the amount is small relative to those authors who did comply with section 411(a): Class A

authors will receive payments from \$875 to \$1,500 per infringed work. J.A. 122-23. Class B authors will receive payments in the amount of the “greater of \$150 or 12.15% of the original sale price.” J.A. 123. Class C authors will receive \$5 to \$60 per work, *unless* the proposed overall payment cap of \$18 million would otherwise be breached due to number of claims by Class A and B authors. In that event, rather than simply raise the payments made to authors whose works have been infringed above \$18 million to compensate authors fairly for Petitioners’ admitted infringement, payments to Class C authors would be reduced, J.A. 124. Payments to Class A and B authors would be reduced “only if necessary,” that is, only after payments to all Class C authors are reduced to *zero*. Pet. App. 9a.

This is why the issue of section 411(a) as a subject matter jurisdictional bar was raised by the parties before the district court: section 411(a) was the device by which unregistered authors were squeezed. As such, the record below alone rebuts the arguments of the parties and their *amici*.

## **2. Petitioners Argued the Subject Matter Jurisdictional Basis for Section 411(a) Before the Mediator.**

From the outset, Petitioners took the position that the settlement was impossible if it included unregistered works, and repeatedly characterized section 411(a) as involving subject matter jurisdiction

before the district court.<sup>4</sup> On February 15, 2002, the Petitioners submitted a memorandum to the mediator which devoted an entire subsection to explaining that section 411(a) is jurisdictional and thus bars class certification of unregistered works. *See* Defendants’ Joint Mem. of Feb. 15, 2002, at 18-19, *reprinted in* Second Circuit J.A. 1601-02. The Petitioners’ memo quoted section 411(a), saying that this provision, “whose language could hardly be clearer, precludes the certification of any class respecting works in which copyright has not been registered.” *Id.* The Petitioners also explained that “[e]xtensive authority suggests that registration before institution of the claim is required.” *Id.* (listing citations including *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452, 453 (2d Cir. 1989) (registration is prerequisite to copyright infringement claim)).

### **3. Petitioners Argued the Subject Matter Jurisdictional Basis for Section 411(a) Before the Trial Court.**

By working out a cap for their payments based on section 411(a), Petitioners painted themselves into a corner: they needed the subject matter jurisdictional bar of section 411(a) to justify the settlement’s three-tiered payment system, which disadvantaged certain authors based entirely on non-compliance with section 411(a), but they needed the settlement to be

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<sup>4</sup> For other examples, *see* Merritt Br., Appx. A.

approved despite the presence of unregistered works in the class. They attempted to reconcile these conflicting positions in a September 2005 submission to the district court. That submission attempted to redefine subject matter jurisdiction as applying to the author, but in doing so repeatedly made fatal concessions. The Petitioners admitted that “[b]ecause the Copyright Act confers jurisdiction only for claims concerning registered works and precludes any infringement action for an unregistered work, *the Court would lack subject matter jurisdiction* over any person whose ‘claims’ all involve unregistered works. 17 U.S.C. § 411(a); *Morris v. Bus. Concepts Inc.*, 259 F.3d 65, 68 (2d Cir. 2001) (emphasis added).” Second Circuit Joint Appendix, J.A. 1554. The Petitioners also acknowledged that the plaintiffs’ inability to establish liability was “*because a huge proportion of the claims were for works in which copyright had never been registered, and which were not, therefore, within the court’s subject matter jurisdiction.*” J.A. 1550 (emphasis added). Additionally, the Petitioners argued that “the law appeared to foreclose certifying any class action that would have encompassed claims respecting unregistered works . . .” J.A. 1551.

#### **4. Petitioners Argued the Subject Matter Jurisdictional Basis for Section 411(a) Before the Court of Appeals.**

Before the Second Circuit, Petitioners repeated arguments from the above submission, but also added:

Because the Copyright Act confers *jurisdiction* over suits for infringement of United States works only if those works are registered – and requires every infringement plaintiff to allege registration – *the district court would have lacked subject matter jurisdiction* over any complaint for infringement of articles in U.S. newspapers and periodicals filed by a person whose “claims” all involved unregistered works. 17 U.S.C. §411(a).

Brief for Plaintiffs-Appellees before the Second Circuit at 22 (emphases added).

This passage likely precipitated the Second Circuit’s allegedly “*sua sponte*” request for supplementary briefing. But even after the Second Circuit asked for supplementary briefing, Petitioners continued to describe section 411(a) as a limitation on the courts’ subject matter jurisdiction. Given, however, the need to get the settlement approved with unregistered claims, they could not directly answer the question posed by the Second Circuit’s request – “whether the District Court had subject matter jurisdiction over claims concerning the infringement of unregistered copyrights.” They chose not to answer, instead formulating and answering a question aimed at obtaining settlement approval. The Petitioners’ letter brief to the court of appeals professed them to be:

constrained to rephrase the question, because the question posed implicitly assumes

that the District Court exercised “subject matter jurisdiction over claims concerning the infringement of unregistered copyrights.” We do not understand that the District Court did so. Rather, it asserted jurisdiction over a lawsuit in which each and every claim of each and every named plaintiff concerned a properly registered work, consistent with 17 U.S.C. §411(a), and then exercised its power to approve a class action settlement pursuant to Fed. R. Civ. P. 23(e), as to which §411(a) plays no role.

*17 U.S.C. §411(a) is phrased and has been understood as a pre-condition to the exercise of subject matter jurisdiction conferred by 28 U.S.C. §1338. It provides that “no action for infringement of the copyright in any United States copyright work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title.” That requirement was literally and completely satisfied here. The actions in the District Court were not instituted until registration of the works named in suit was made in accordance with §411(a).*

Merritt Br., Appx. A, 72a-73a (emphases added, citations omitted). Nothing in section 411(a), however, distinguishes between unregistered claims that are not part of a class action and those that are.

If there remained any ambiguity regarding the position of Petitioners’ (defendants below) on the subject matter jurisdiction constraint posed by section 411(a), however, it was certainly erased by their

petition for rehearing before the Second Circuit. In that petition, they declared that “[t]he court below did not assume jurisdiction to adjudicate infringement claims or grant damages regarding unregistered works – powers that defendants agree the court lacked.” *See Merritt Br.*, Appx. A, 78a.

**5. Petitioners Appear to Concede the Subject Matter Jurisdictional Basis for Section 411(a) Even in the Petition for Certiorari.**

Before this Court, Petitioners’ prior endorsement of section 411(a) as limiting courts’ subject matter jurisdiction is not even mentioned, and Petitioners’ sensitivity to their prior position is reflected in their proposed questions for certiorari, the first of which refers to “the usual power of lower courts to approve a comprehensive settlement releasing claims that would be outside the courts’ subject matter jurisdiction to adjudicate”. *See Cert. Pet.* at i. This question admits to Petitioners’ prior views that section 411(a) indeed limits the courts’ subject matter jurisdiction by acknowledging that the claims in question – claims for unregistered works – are outside the courts’ subject matter jurisdiction. Petitioners are seeking approval of the settlement nonetheless, but on other grounds, relying on the non-copyright case of *Matsushita Elec. Indus. Co. v. Epstein*, 516 U.S. 367 (1996). Nowhere in their brief in support of the Petition for Certiorari do Petitioners state section 411(a) is non-jurisdictional.

## 6. Comparison of Petitioners' Brief in Support of their Petition for Certiorari and their Merits Brief.

This Court's restated Question wisely forced the issue: "Does 17 U.S.C. § 411(a) restrict the subject matter jurisdiction of the federal courts over copyright infringement actions?" Unable to rewrite the question as they did before the court of appeals, Petitioners now abandon their prior unequivocal position that section 411(a) does limit federal courts' subject matter jurisdiction.

Petitioners' reversal of position between the petition and merits brief is cast into greater relief by the otherwise similar nature of these submissions. While both briefs' Statements of the Case begin quite similarly, they then diverge radically.<sup>5</sup> Petitioners' Brief now claims that the Second Circuit "erected a jurisdictional bar to the inclusion of unregistered works in any settlement . . . [and] relied almost exclusively on its own precedents to reach that conclusion", whose holdings it dismisses as "'drive-by jurisdictional' characterizations". When petitioning for certiorari, on the other hand, Petitioners claimed that the "Second Circuit ignored decades of decisions by this Court, federal appellate courts, and state courts, which had uniformly held that in the interests of settling disputes courts may release claims *that they lacked jurisdiction to adjudicate.*" Compare Pet.

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<sup>5</sup> Compare Cert. Pet. 2 para. 2 with Pet. Br. 2 para. 2.

Br. 2, 3 *with* Cert. Pet. 2-3. Even in their first brief to this Court, Petitioners concede that section 411(a) is jurisdictional. Additionally, Petitioners' description of the Second Circuit's ruling in the Petition Brief focused on the court of appeals' holding on 28 U.S.C. § 1367, and argued that Petitioners had complied with the subject matter jurisdictional requirements of section 411(a) by virtue of the named plaintiffs' registrations. *See* Cert. Pet. 8-9. In Petitioners' current Brief, the Second Circuit's sins are recast as relying on dicta in two earlier circuit decisions that section 411(a) is jurisdictional, decisions that Petitioners had themselves relied upon before the trial court. Pet. Br. 8-9.

### **7. The Significance of Petitioners' Prior Position that Section 411(a) is a Subject Jurisdictional Limitation.**

The importance of Petitioners' flip-flops on section 411(a) lies in the fact that no one, including Petitioners, denies that where a party does raise what has been mischaracterized as a "mandatory provision" before the trial court, the court must enforce that provision. The brief for the United States makes this point explicit in section IIA, entitled "Section 411(a) Is a Mandatory Prerequisite to Suit That Should Be Strictly Enforced When Raised By A Party," U.S. Br. 20-24. As outlined above, Petitioners repeatedly raised section 411(a).

According to this Court's Rule 10, "[a] petition for a writ of certiorari will be granted only for compelling reasons." Indeed, the Court has stated:

it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal.

*Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U.S. 387, 393 (1923) (internal quote marks omitted). Not only is there admittedly no circuit split in this case, but as in *Layne & Bowler*, close examination of the record reveals facts which render the dispute a non-dispute; there is simply no case or controversy before the Court since Petitioners raised the jurisdictional bar posed by section 411(a) before the district court. They continued to do so before the court of appeals. Under arguments espoused by the parties themselves, the judgment below was sound. Accordingly, the writ should be dismissed.

### **B. There Is No Circuit Split.**

Every court of appeals to have decided the issue has held that section 411(a) concerns the court's

subject matter jurisdiction,<sup>6</sup> as have hundreds of district courts, *see* Merritt Br., Appx. A, 81a; *see also* William Patry, 5 PATRY ON COPYRIGHT § 17:64.50 (2007) (cataloguing cases) (2009 update available on Westlaw at PATRYCOPY). According to Petitioners, every single one of these opinions, including those issued decades before *Kontrick v. Ryan*, 540 U.S. 443 (2004) were “drive-by” discussions. Pet. Br. 43. Many decisions all going one way look instead like a well-ridden highway. In *Bowles v. Russell*, 551 U.S. 205 n.2 (2007), this Court observed:

Regardless of this Court’s past careless use of terminology, it is indisputable that time limits for filing a notice of appeal have been treated as jurisdictional in American law for well over a century. Consequently, the dissent’s approach would require the repudiation of a century’s worth of precedent and practice in American courts. Given the choice between calling into question some dicta in our recent opinions and effectively overruling a century’s worth of practice, we think the former option is the only prudent course.

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<sup>6</sup> In a per curiam opinion, *Brooks-Ngwenya v. Indianapolis Public Schools*, 564 F.3d 804 (7th Cir. 2009) the Seventh Circuit held that the requirement in section 411(a) that where an application has been rejected, notification to the Register must be given of the filing of an infringement suit by the rejected applicant is “nonjurisdictional, but is still a prerequisite to the institution of the infringement suit.” The court also noted the grant of certiorari in this case. The court of appeals did not reach the issue posed in this case because it was not before it.

In the case of section 411(a) and its predecessors, there is an unbroken federal legislative line going back 219 years.<sup>7</sup> The line of case law in the Second Circuit alone goes back to 1912, a mere three years after passage of section 12, section 411(a)'s predecessor. In *New York Times Co. v. Star Co.*, a case not cited by the parties, Circuit Judge Lacombe held:

The subject of statutory copyright being one wholly within the powers of Congress, it had full power to restrict in any way it chose the maintaining of such actions or proceedings in the courts as are concerned with the subject of infringement of the rights secured by such statute. A prohibition so broad as this goes to the *jurisdiction* of the courts to entertain such action or proceedings, and if the prohibition were operative when the injunction was served, the latter would be void, because made in an action which could not be maintained, and of which, *therefore, the court could not have jurisdiction.*

195 F. 110, 112 (C.C.S.D.N.Y. 1912) (emphasis added). The following year, in another case also not cited by

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<sup>7</sup> The statutory history of the registration as a prerequisite to bringing an infringement action may be traced further back, to the English 1710 Statute of Anne and the U.S. state statutes passed prior to the Constitution. See 5 PATRY ON COPYRIGHT § 17:64.10, at 195-96. Petitioners also invoke this history, but conclude that by failing to disavow 19th century English precedents in 1976, Congress should be charged with having adopted their meaning. See Pet. Br. 37 n.17.

the parties or their *amici*, the Second Circuit expressly endorsed Judge Lacombe's opinion. With respect to registration, it stated:

Manifestly the statute refers to precisely such an action as this, otherwise the language is meaningless. We are not concerned here with the wisdom or necessity of the provision. Congress was conferring a special privilege upon authors and could limit that privilege in any manner it saw fit. In order to secure a valid copyright or a valid patent, it is necessary to comply with every requirement of the law and a discussion of the wisdom or unwisdom of such requirements is wholly irrelevant. If a change in the law be needed, recourse should be had to the legislative and not to the judicial branch of the government.

*New York Times Co. v. Sun Printing & Publishing Association*, 204 F. 586, 587 (2d Cir. 1912).

In 1921, in affirming a decision by then district judge Learned Hand, the Second Circuit, in construing section 12 held: "The parties cannot by agreement, expressed or implied, alter the statute." *Lumiere v. Pathé Exchange*, 275 F. 428, 430 (2d Cir. 1921). Such a holding of course is inconsistent with treating the provision as non-jurisdictional.

In 1966, two years after section 411(a) was drafted, a district judge in the Southern District of New York, in dismissing a copyright infringement action for lack of jurisdiction for failure to comply

with section 12 wrote: “Plaintiffs have not cited, nor have I found any case in which *jurisdiction* was retained after dismissal under these circumstances and I see no justification for doing so here.” *G. P. Putnam’s Sons v. Lancer Books, Inc.*, 251 F. Supp. 210, 214 (S.D.N.Y. 1966) (emphasis added). The Patry treatise, in its exhaustive examination of the case law, found none after that date. See 5 PATRY ON COPYRIGHT § 17:64.40, at 202.

The legislative reports to the 1976 Act express an intent to continue this unbroken line of case law:

The first sentence in section 411(a) restates the present statutory requirement that registration be made before a suit for copyright infringement is instituted. Under the bill, as under the law now in effect, a copyright owner who has not registered his claim can have a valid cause of action against someone who has infringed his copyright, but he cannot enforce his rights in court until he has made registration.

S. Rep. No. 94-473, 94th Cong., 1st Sess. 139 (1975); H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 157 (1976).

In a recent amendment to the Copyright Act, the House of Representatives, in discussing sections 411(a) and 412, also described them as “jurisdictional and remedial provisions,” H.R. Rep. No. 110-617,

110th Cong., 2d Sess. 39 (2007).<sup>8</sup> The parties below do not cite to a single court of appeals opinion holding that the registration requirement is not jurisdictional. Accordingly, the writ should be dismissed.

## **II. THE SECOND CIRCUIT CORRECTLY INTERPRETED SECTION 411(A) TO BE JURISDICTIONAL.**

### **A. The Plain Words of the Statute Support the Judgment Below.**

There is an air of unreality in the parties' briefs about how Congress drafts statutes and how courts interpret them. According to those briefs, Congress engages in "jurisdiction-speak" only when it places the provision in question in a chapter of a statute that is (1) clearly demarcated as jurisdictional, *and* (2) where the language employed uses the word "jurisdiction" or a very close analogue in every sentence in the provision in question. *See* Pet. Br. 12; 17; Muchnick Respondents' Br. 12.

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<sup>8</sup> In attempting to play down the importance of this passage, Petitioners complain that Congress "did not clarify the sense in which either section was 'jurisdictional,' nor explain whether it used that term precisely or in the loose fashion reflected in the lower courts' recent case law." Pet. Br. 32 n.14. Petitioners apparently want Congress in drafting not only legislative language but also committee reports to include a preface along the lines of "We are using language precisely and not loosely like some of those errant lower courts do."

Conspicuously, the parties must propose a conjunctive test in order to overcome the embarrassing fact that section 411(a) *does* use the word “jurisdiction.”<sup>9</sup> But according to the parties, the word jurisdiction was not placed in the correct part of the Copyright Act, nor in the correct sentence, even though section 411(a) in its entirety is only three sentences long and the sentence in which the word jurisdiction is used concerns the identical question as the other two sentences: the power of the federal courts to hear a case where a registration has not been obtained. So fatal to Petitioners’ appeal is section 411(a)’s use of the word jurisdiction that the

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<sup>9</sup> The provision reads:

“(a) 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 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. 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 an action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party to the action with respect to the issue of registrability of the copyright claim by entering an appearance within sixty days after such service, *but the Register’s failure to become a party shall not deprive the court of jurisdiction to determine that issue.*”

(emphasis added).

brief for the American Intellectual Property Law Association, in support of Petitioners, conspicuously omits the offending sentence from its quotation of the provision. AIPLA Br. 11.<sup>10</sup>

This Court has repeatedly emphasized that statutory interpretation takes place contextually, *Niken v. Holder*, 129 S. Ct. 1749, 1756 (2009); *Regions Hosp. v. Shalala*, 522 U.S. 448, 460 n.5 (1998); *Robertson v. Shell Oil Co.*, 519 U.S. 337, 341 (1997). The context of section 411(a) is plain: no suit for infringement may be instituted unless registration has been obtained or rejected; the failure to comply deprives the court of jurisdiction, but the failure of the Register of Copyrights to join does not. Section 411(a) is of a piece, and should not be sliced-and-diced into fragments so that the parts are less than its whole.

The *Kontrick* Court did not suggest that *Congress* must use magic words for a provision to be deemed to involve subject matter jurisdiction. Congress's intent in this regard should be determined by long-standing and conventional tools of statutory interpretation: Unlike Article III jurisdictional issues, which are Constitutionally-dependent, the issue in this case is one of simple statutory interpretation. To resolve this issue, there is "no more persuasive evidence of the purpose of a statute than the words by which the

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<sup>10</sup> AIPLA also proposes two interpretative categories for section 411(a): narrow and broad. See AIPLA Br. 4. *Amici* are unaware of any basis for the categories.

legislature undertook to give expression to its wishes.” *United States v. Trucking Ass’n*, 310 U.S. 534, 543 (1940). Read plainly in its context, and buttressed by over two hundred years of history, section 411(a) clearly acts as a subject matter jurisdictional limitation on the federal courts to hear claims of copyright infringement where no registration has been obtained from or rejected by the Copyright Office. That was Congress’s intent, and that is how the lower courts have interpreted Congress’s intent, through hundreds of decisions. See *Merritt Br.*, Appx. C, 81a-125a; 5 PATRY ON COPYRIGHT § 17:24. Nothing more can be asked of Congress than that it make its meaning plain, as it has done with section 411(a) and its predecessors.<sup>11</sup>

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<sup>11</sup> We dispute the suggestion, drawn from the treatise by one of Petitioners’ counsel, that copyright registration is analogous to a filing fee in civil actions. See U.S. Br. 29 n.17 (making unsourced analogy); Pogrebin Respondents’ Br. 12 n.10 (making analogy, crediting source). The clerk’s receipt of a filing fee involves no exercise of expert discretion. A proper registration requires not only a fee, but also a proper application, a proper deposit copy, and most importantly, expert examination by the Register to determine whether the work as embodied in the deposit copy and the claim made in the application conform to the requirements of the Copyright Act. We also note that those who have received a registration or have been refused must as well pay the civil filing fee.

## **B. Petitioners Propose a Presumption That Does Not Exist.**

Not content to slice-and-dice section 411(a) into three unrelated sentences in an effort to render meaningless its explicit reference to jurisdiction, Petitioners assert that this Court has established a presumption or “especially strong inference” that Congress must “use[ ] the language of jurisdiction” to “deprive federal courts of jurisdiction.” Pet. Br. 12-13 (citing *Rockwell Int’l Corp. v. United States*, 549 U.S. 457, 468 (2007); *Arbaugh v. Y & H Corp.*, 546 U.S. 500, 515-16 (2006)). Wholly apart from the fact that Congress cleared this tautological hurdle by using the word “jurisdiction” in section 411(a), the opinions of this Court cited do not use the words “presumption” or “inference,” and do not stand for the proposition for which they are cited.<sup>12</sup> Petitioners would require Congress to have not only used the word “jurisdiction” in all three sentences of section 411(a) – using the word in the final sentence is, according to Petitioners, insufficient – but also in 28 U.S.C. § 1338(a). *See* Pet. Br. 23, 33. This is absurd. Section 1338(a) covers not only copyrights, but also patents, plant variety protection, and trademarks. Under Petitioners’ theory of statutory interpretation, Congress must

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<sup>12</sup> The “exception” theory proposed by Petitioners and their *amicus* (Pet. Br. 18; AIPLA Br. 8-10), which asserts that the presence of “exceptions” in section 411(a) constitutes proof that the provision is not jurisdictional, is similarly baseless. The briefs do not cite this Court’s jurisprudence for the “exception” theory, and it is supported by neither *Arbaugh* nor *Rockwell*.

not only cross-reference in section 1338(a) every jurisdictional copyright, patent, plant variety protection, and trademark statute to which it applies, but it must also ensure that every jurisdictional intellectual property statute in turn cross references section 1338(a).<sup>13</sup> Such clumsy, burdensome drafting protocols are not required.

### **C. Petitioners’ “Withdrawal” Theory Overlooks the Statutory Nature of Copyright.**

Copyright is entirely a creation of Congress. “As the text of the Constitution makes plain, it is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors or to inventors in order to give the public appropriate access to their work product.” *Sony*, 464 U.S. at 431. Congress need not grant copyright – the Constitution permits Congress to enact copyright legislation, but does not mandate it.<sup>14</sup> As permissive, Congress can decide not only the scope of the right,

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<sup>13</sup> The Muchnick Respondents assert that the federal courts “obtain subject matter jurisdiction over copyright infringement actions not from Section 411(a),” but rather from 18 U.S.C. §§ 1131 or 1338(a). Muchnick Respondents’ Br. 24. However, the question in this case is not *how* district courts may exercise subject matter jurisdiction where it properly lies, but rather when they may *not* exercise it. Congress has made clear in section 411(a) that subject matter jurisdiction does not exist if section 411(a) is not complied with.

<sup>14</sup> Art. 1, § 1, cl. 8.

but jurisdictional issues for the right as well. The first Copyright Act, the Act of 1790, did not give federal courts the right to hear copyright cases, which were instead heard by state courts. It was not until 1819 that the federal courts were given original, but not exclusive jurisdiction to hear copyright cases. *See* 1 PATRY ON COPYRIGHT § 1:22. It was not until 1873, that the federal courts were granted exclusive jurisdiction over copyright cases. *See* 1 PATRY ON COPYRIGHT § 1:34.

Since 1790, for the entire history of federal copyright, there has been a limitation on all courts that they lack jurisdiction to hear infringement actions unless the registration has been complied with: unfettered jurisdiction could hardly ever have been “withdrawn,” as Petitioners suggest, *see* Pet. Br. 25-26, since it never existed. Chronologically, moreover, the direct predecessor to section 411(a), section 12 of the 1909 Act predated 28 U.S.C. § 1338(a) by 38 years<sup>15</sup> and could thus hardly be considered to have withdrawn jurisdiction from that later section.

As with Petitioners’ frog-like dissection of section 411(a), the “withdrawal” theory ignores the inconvenient fact that the 1976 Copyright Act was a complete revision of the law. The 1976 Copyright Act was an omnibus repeal of the 1909 Act. Section 411(a) was drafted as part of Congress’s rethinking of various

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<sup>15</sup> It predated sections 24 and 256 of the Judicial Code of 1911, 36 Stat. 1087 by two years.

fundamental aspects of copyright law. One aspect from previous law surviving the general revision with little alteration was the requirement that courts had no jurisdiction to hear infringement claims unless registration had first been obtained, except when registration had been sought, but refused. This caveat was new, a result of the Register of Copyright's dissatisfaction with prior law which had required a mandamus action be brought before an infringement action be brought where registration had been refused, *see* 5 PATRY ON COPYRIGHT § 17:64.50, at 203-06. In making this change, Congress wanted to ensure that the failure of the Register to join the parties' private suit did not deprive the court of jurisdiction. H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 157 (1976); S. Rep. No. 94-473, 94th Cong., 1st Sess. 139 (1975). Had Congress not considered section 411(a) to be jurisdictional, it would not have required the language "but the Register's failure to become a party shall not deprive the court of jurisdiction to determine that issue." This Court has repeatedly held that words in a statute are to be given meaning and not treated as surplusage. *TRW, Inc. v. Andrews*, 534 U.S. 19, 31 (2001); *Duncan v. Walker*, 533 U.S. 167, 174 (2001). The parties' approach to section 411(a) does precisely that.

**D. The Section 205(d) Recordation Requirement Supports the Conclusion that Section 411(a) is Jurisdictional.**

In what seems like a throw-away point, Petitioners state that former 17 U.S.C. § 205(d), enacted as

part of the 1976 Act, and repealed as part of the Berne Convention Implementation Act of 1988,<sup>16</sup> supports Petitioners' argument that the word "institute" in sections 205(d), 411(a), and 501(b) indicated the word referred to a precondition, not a subject matter jurisdictional requirement.<sup>17</sup> In a footnote, Petitioners claim: "Former §205(d) expressly required recordation of a transferee's chain of title as a 'prerequisite to [an] infringement suit.' No appellate court ever held it jurisdictional." Pet. Br. 46 n.24. Petitioners overlook *Lloyd v. Schlag*, 884 F.2d 409 (9th Cir. 1989), however, where the court of appeals affirmed a Rule 11 award of attorney's fees against an attorney who had failed to comply with section 205(d), resulting in the district court granting a motion to dismiss for lack of subject matter jurisdiction. The court held "that a reasonable attorney admitted to practice before the district court would have discovered that a copyright infringement suit cannot be brought unless

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<sup>16</sup> Pub. L. No. 100-568, §§ 5(1), (2), 13, 102 Stat. 2857, 2861 (Oct. 31, 1988).

<sup>17</sup> As enacted, section 205(d) read:

No person claiming by virtue of a transfer to be the owner of copyright or of any exclusive right under a copyright is entitled to institute an infringement action under this title until the instrument of transfer under which such person claims has been recorded in the Copyright Office, but suit may be instituted after such recordation on a cause of action that arose before recordation.

The origins of the term "institute" in section 411(a), is discussed at 5 PATRY ON COPYRIGHT § 17:64.40 n.3, at 200-01.

and until the copyright transfer has been properly recorded, and ascertained that the recordation has been accomplished.” 884 F.2d at 412 (citing 17 U.S.C. § 205(d)). Similarly, in *Forry, Inc. v. Neundorfer, Inc.*, 837 F.2d 259 (6th Cir. 1988), the issue was raised before the Sixth Circuit, but not reached, although the court of appeals appears not to have disputed the jurisdictional nature of the requirement. *Id.* at 262 (“Under 17 U.S.C. § 205(d) the owner of a transferred copyright must record the transfer in order to institute an infringement action. It has been held that recordation of the transfer of a copyright is a jurisdictional prerequisite to suit.”) (citing *Nation’s Choice Vitamin Co. v. General Mills, Inc.*, 526 F. Supp. 1014, 1017 (S.D.N.Y. 1981)).<sup>18</sup> *Amici* have found no district court opinion holding section 205(d) was *not* jurisdictional<sup>19</sup> (nor do

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<sup>18</sup> *Nation’s Choice* itself held that “Plaintiff’s failure to comply with this condition precedent strips this court of subject matter jurisdiction over plaintiff’s copyright claim.” *Nation’s Choice Vitamin Co. v. General Mills, Inc.*, 526 F. Supp. 1014, 1017 (S.D.N.Y. 1981).

<sup>19</sup> The court in *Dae Han Video Productions, Inc. v. Neko-hyang Oriental Market, Inc.*, 1987 WL 8327 (E.D. Pa. 1987) referred to the provision as a “mandatory prerequisite” without explaining what was meant by the term, but defendant, as noted by the court, challenged the court’s subject matter jurisdiction. The court did not disagree with that characterization in its brief order. The court in *Quincy Cablesystems, Inc. v. Sully’s Bar, Inc.*, 650 F. Supp. 838, 850-51 (D. Mass. 1986) referred to both section 205(d) and section 411(a) as a condition precedent and jurisdictional. In *Meta-Film Associates, Inc. v. MCA, Inc.*, 586 F. Supp. 1346, 1351 (C.D. Cal. 1984), the court in addressing defendant’s

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Petitioners offer any), and numerous courts have held that it is.<sup>20</sup>

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jurisdictional argument, referred to the section as a condition precedent for the purpose of permitting a plaintiff who received and recorded an assignment after the suit was filed to proceed. To the same effect is *Co-opportunities, Inc. v. National Broadcasting Co., Inc.*, 510 F. Supp. 43, 48-49 (N.D. Cal. 1981). This is the approach taken in *Northern Songs, Ltd. v. Distinguished Productions, Inc.*, 581 F. Supp. 638, 641 (S.D.N.Y. 1984) which took the same approach and treated the section as jurisdictional.

<sup>20</sup> *Basic Books, Inc. v. Kinko's Graphics Corp.*, 758 F. Supp. 1522, 1541 (S.D.N.Y. 1991); *Yamate USA Corp. v. Sugerman*, 1991 WL 274854, at \*4 (D.N.J. Mar. 7, 1991); *Wales Industries, Inc. v. Hasbro Bradley, Inc.*, 612 F. Supp. 510, 514 (S.D.N.Y. 1985) (in a section entitled "Subject Matter Jurisdiction"); *H.K. Co., Inc. v. Mori Lee Associates, Inc.*, 1989 WL 297953, at \*2 (S.D.N.Y. June 28, 1989) ("recordation of the transfer of a copyright is a jurisdictional prerequisite to maintenance of a copyright infringement action, and failure to comply strips a court of subject matter jurisdiction over the action under the plain language of 17 U.S.C. § 205(d)"); *Editions Groupe i v. SRO Promotions, Inc.*, 1989 WL 54118 (S.D.N.Y. May 16, 1989) ("This copyright infringement dispute was previously dismissed by this Court (Metzner, J.) for lack of jurisdictional standing *after a jury trial*) (emphasis added) (*see also Editions Groupe i v. Anheuser-Busch*, 1988 WL 70218 (S.D.N.Y. June 30, 1988) involving the same plaintiff and same result); *Kenbrooke Fabrics, Inc. v. Soho Fashions, Inc.*, 690 F. Supp. 298, 302 (S.D.N.Y. 1988), 1989 WL 117704 (S.D.N.Y. Oct. 2, 1989); *Hulex Music v. Santy*, 698 F. Supp. 1024, 1027 (D.N.H. 1988); *Raffoler, Ltd. v. Peabody & Wright, Ltd.*, 671 F. Supp. 947, 952 (E.D.N.Y. 1987); *McNabb Bennett & Associates, Inc. v. Terp Meyers Architects*, 1987 WL 7817, at \*3 (N.D. Ill. Mar. 10, 1987) ("From the plain language of this section and the previous holdings of other courts, it is clear that an allegation of recordation is a jurisdictional prerequisite necessary for filing a copyright-infringement action where such an assignment is the basis of the plaintiff's claim. [citations

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The cases interpreting section 205(d), which even according to Petitioners is structurally identical to section 411(a), provides further, compelling proof that section 411(a) acts as a limitation on the courts' subject matter jurisdiction.

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## CONCLUSION

The Petitioners, having painted themselves into a corner, propose to escape by knocking down copyright's jurisdictional walls as constructed by Congress. They threaten that unless they have their way, "the nation's electronic databases and archives will be permanently depleted. . . ." Pet. Br. 3. The Court has heard the same before from Petitioners, in the first go-around in the *Tasini* case, and rejected it. *New*

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omitted]. MBA's failure to comply with this condition precedent strips this court of subject-matter jurisdiction over MBA's copyright claim."); *Techniques, Inc. v. Rohn*, 592 F. Supp. 1195, 1997 (S.D.N.Y. 1984) ("17 U.S.C. § 205(d) mandates that recodation of the transfer is a jurisdictional prerequisite to an infringement action. Failure to comply with that provision deprives the court of subject matter jurisdiction."); *Northern Songs, Ltd. v. Distinguished Productions, Inc.*, 581 F. Supp. 638, 641 (S.D.N.Y. 1984); *Patch Factory, Inc. v. Broder*, 586 F. Supp. 132, 133 (N.D. Ga. 1984); *Skor-Mor Products, Inc. v. Sears, Roebuck and Co.*, 1982 WL 1264, at \*2 (S.D.N.Y. May 12, 1982); *Swarovski America Ltd. v. Silver Deer Ltd.*, 537 F. Supp. 1201, 1203 (D. Colo. 1982); *Ruskin v. Sunrise Management*, 506 F. Supp. 1284, 1288-89 (D. Colo. 1981); *Burns v. Rockwood Distributing Co.*, 481 F. Supp. 841, 846-47 (N.D. Ill. 1979).

*York Times Co. v. Tasini*, 533 U.S. 483, 486 (2001). The Court followed the will of Congress in *Tasini*, and the sky did not fall. Nor will the sky fall this time if the Court again follows the will of Congress. The writ should be dismissed and the judgment of the United States Court of Appeals for the Second Circuit should be permitted to stand.

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August 26, 2009