

What You Need to Know Before You File: Legal Requirements for Bringing a Copyright Infringement Lawsuit

The modern trend in copyright law has been to relax certain “formalities” that had the unfortunate effect of divesting all too many authors and owners of the ability to enforce their copyrights. Over the past decades, and consistent with international norms, Congress has amended the law to diminish the importance of formal requirements for copyright protection, such as having to publish a work with the proper copyright notice affixed. Any copyright owner who seeks to enforce his or her copyrights in court, however, must still satisfy specific legal requirements. While these requirements, for the most part, are not formalities *per se*, they all have the potential – much like the formalities of days gone by – to trap unwary copyright owners and preclude any meaningful copyright protection. This article discusses the key legal requirements that a potential plaintiff should consider to ensure that the copyright infringement claim can go forward and be heard on the merits.

As an initial matter, it is essential for any such plaintiff to determine what body of law would govern the dispute. The federal 1976 Copyright Act, codified in Title 17 of the United States Code, applies to works created on or after January 1, 1978, though the Act also contains provisions applicable to pre-1978 works (for example, covering the terms of protection and termination rights for such works). The federal 1909 Copyright Act covers works created and published before January 1, 1978.¹ Moreover, while federal law has preempted most state law protections, state law continues to apply to works not within the subject

matter of copyright (including unfixed works like improvised performances or extemporaneous speeches²) and sound recordings fixed before February 15, 1972. The rules may differ depending on which law applies, and this article highlights some of the significant differences among the applicable bodies of law.

I. Standing

One of the first questions any person contemplating an infringement lawsuit should ask is whether he or she has standing to sue. Only the “legal or beneficial owner” of an exclusive right under copyright is allowed to bring an action for copyright infringement.³ There are a number of considerations a potential plaintiff should take into account.

A. Authors

Initial ownership in a work vests in the person who creates it,⁴ and by default the author of the copyrighted work has exclusive standing to sue for infringement. There are three important considerations to note, however.

First, if the author has transferred ownership of the copyright to another party, the author no longer owns the exclusive right in question and accordingly lacks standing to sue for infringement of the transferred right. However, a beneficial owner retains standing. A beneficial owner is a person or entity who has a substantial interest in the exploitation of an exclusive right in a copyrighted work, and includes an author



Stefan Mentzer
White & Case

¹ This is subject to exceptions, as a few classes of works, such as musical compositions, could be protected under federal law as unpublished works if they were registered with the Copyright Office.

² Federal law also prohibits the unauthorized fixation of certain unfixed music performances; these federal protections do not preempt similar state law protections. *See* 17 U.S.C. § 1101.

³ 17 U.S.C. § 501(b). As a matter of timing, the owner has the right to sue for any infringement of that right while he or she was the owner of it. *Id.*

⁴ 17 U.S.C. § 201(a).

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who may have transferred legal title to the copyright in exchange for a percentage of royalties based on sales or license fees.⁵ Accordingly, before an author initiates an infringement lawsuit, it is crucial to check whether rights in the works are subject to any prior transfer agreements and, if so, if any beneficial ownership interest remains.

Second, whether the work is a “work made for hire” is essential in determining whether a potential plaintiff has standing. In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author and, unless there is an agreement to the contrary, owns all of the rights comprised in the copyright and has exclusive standing.⁶ There are two possible ways a work can be deemed a work made for hire: (1) it was prepared by an employee within the scope of his or her employment; or (2) it was specially ordered or commissioned for use as one of nine types of works enumerated in the statute, if the parties expressly agreed in writing that the work was to be a work made for hire.⁷ Accordingly, if the potential plaintiff is an individual, he or she should confirm that the works are not works made for hire (and if they are, whether there is an agreement under which he or she would have standing). Conversely, if the potential plaintiff is an employer (or other person or entity for whom the work may have been prepared), he or she should confirm that the work qualifies as a work made for hire.

Third, it is often the case that a work was created by two or more authors working together. Where two or more authors prepare a work with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole, the work is a joint work and the authors are coowners of the copyright in that work.⁸ Unless there is an agreement to the contrary between them, each coowner has standing to sue for infringement (and need not obtain the permission of the other coowners to sue).

B. Transferees

A party to whom an ownership interest in a copyrighted work has been transferred has standing to sue for infringement. Assignments and exclusive licenses are considered “transfers” that convey exclusive rights, and thus assignees and exclusive licensees have standing to sue for infringement.⁹ Ownership may also be

transferred to heirs by bequest or through the applicable laws of intestate succession.¹⁰ Nonexclusive licenses of rights, however, are not considered transfers and do not confer standing.

Transfers raise a number of considerations that a potential plaintiff should consider. First and foremost, for a copyright assignment or exclusive license to be a valid transfer, it must be in writing and signed by the owner of the rights conveyed (or the owner’s duly authorized agent).¹¹ Where the assignment or exclusive license is not in writing or signed, a plaintiff may lack standing to sue for infringement.

As a matter of timing, transfer of only the title in the copyright generally is not sufficient to give the transferee standing to sue for infringements arising *before* the transfer. However, if a transferor assigns all of its assets to the transferee, that will convey any accrued causes of action.¹²

Courts are divided on whether the purported transfer of an accrued cause of action – when not accompanied by the transfer of title in the copyrighted work – is sufficient to establish standing.¹³ Recently, a company has found itself in hot water for pursuing copyright claims when all it possessed was a right to sue. Righthaven LLC is a company that has brought numerous infringement lawsuits against website operators for allegedly infringing copyrighted newspaper articles. In one of these suits, the court found that even though Righthaven had entered into an agreement that purported to assign copyrighted works from a publisher, Righthaven and the publisher subsequently entered into a “Strategic Alliance Agreement” under which Righthaven granted the publisher an exclusive license to use the assigned works and retained no right to receive royalties from the exploitation of those works other than to receive amounts recovered in a lawsuit.¹⁴ The court rejected Righthaven’s argument that the Strategic Alliance Agreement did not change the unambiguous language of the initial assignment or limit the rights conferred in the assignment.¹⁵ As a result, Righthaven lacked standing to sue and was dismissed from the case.

Finally, where the rights in a copyrighted work have been transferred to another party, the author or his or her heirs may, upon satisfying certain statutory requirements, recapture ownership of the rights (and by extension, standing).¹⁶ These termination rights cannot

5 See 3 Paul Goldstein, *Copyright* § 15.5.1.2 (3d ed. & 2011 Supp.) (citing H.R. Rep. No. 94-1476, at 159 (1976)).

6 17 U.S.C. § 201(b).

7 17 U.S.C. § 101 (definition of “work made for hire”). Under the first prong, the existence of an employment relationship should be made by reference to general common law of agency and turns on whether the hiring party had the “the right to control the manner and means by which the product is accomplished.” *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 740-41, 751 (1989). The nine types of works eligible for treatment as works made for hire under the second prong are contributions to collective works, parts of a motion picture or other audiovisual works, translations, supplementary works, compilations, instructional texts, tests, answer materials for tests, and atlases.

8 17 U.S.C. §§ 101, 201(a).

9 See 17 U.S.C. §§ 101 (definition of “transfer of copyright ownership”).

10 17 U.S.C. § 201(d)(1).

11 17 U.S.C. § 204(a).

12 See 3 Copyright § 15.5.1.1.

13 See *id.* § 15.5 (comparing *Prather v. Neva Paperbacks, Inc.*, 410 F.2d 698 (5th Cir. 1969) with *Silvers v. Sony Pictures Entm’t, Inc.*, 402 F.3d 881 (9th Cir. 2005)).

14 *Righthaven LLC v. Democratic Underground, LLC*, 2:10-cv-01356-RLH-GWF, 2011 WL 2378186, at *2 (D. Nev. June 14, 2011).

15 *Id.* at *3.

16 See 17 U.S.C. §§ 203(a), 304(c).

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be waived. Transfer terminations are increasingly the subject of litigation as more works become eligible for termination under the statute.¹⁷

II. Valid Copyright

The existence of a valid copyright is an essential element of any copyright infringement claim. Several considerations are relevant for determining if a valid copyright exists.

A. Original Work of Authorship

The touchstone of copyright protection is originality. Only “original” works of authorship are protected by copyright.¹⁸ There is no bright-line rule for what makes a work sufficiently original, though the standard for proving originality is relatively low. Novelty is not the standard; rather, a work must “possess some creative spark, no matter how crude, humble or obvious it might be.”¹⁹ While a compilation of unprotectable facts may possess the requisite creativity if the compilation itself rises to the level of an original work of authorship, courts reject the argument that the “sweat of the brow” – the mere labor expended in compiling the facts – is sufficient to give rise to copyright protection where originality in the compilation is otherwise lacking.²⁰ Thus, an alphabetical listing of names, towns, and telephone numbers in a telephone directory lacks the requisite creativity to be protected by copyright.²¹

Proving originality can be one of the more challenging aspects of a copyright infringement lawsuit. Any potential plaintiff should be thinking about the issue and, where the requisite originality is missing, not file an infringement claim.

B. Fixed in a Tangible Medium of Expression

A work must be “fixed” for it to be protected by copyright.²² What this means is that the work must be put down in some tangible medium of expression – for example, written or printed on paper; recorded on CD, DVD, videotape, or audiotape; or saved on hard disk or other computer memory – from which it can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.²³ Works that are not fixed – such as

extemporaneous or improvised speeches or performances – are not protected by federal copyright, though they may be protected by state copyright laws and there may be additional federal protections outside of copyright for such creations.²⁴

C. Under the Term of Protection

Copyright protection subsists for a limited amount of time, and it is crucial for a potential plaintiff to make sure that the work he or she is seeking to protect is still under the term of copyright.

Copyright protection runs a long time. For works created on or after January 1, 1978 the term of protection is the life of the author plus 70 years, the life of the last surviving joint author plus 70 years (for joint works), and the earlier of 95 years from publication or 120 years from creation (for works made for hire and for anonymous and pseudonymous works where the author’s true identity is unknown).

Given the length of protection for works created on or after 1978, the question of whether a work is still under the term of protection really only arises in the context of older works. The duration provisions of the law that apply to pre-1978 works are complex, and a potential plaintiff should read the statute carefully.²⁵ For works published or registered before January 1, 1978, the basic term of copyright protection is an initial term of 28 years, followed by a renewal term of 67 years, for a total of 95 years of protection.²⁶ For works first published or registered before 1964, the copyright owner was required to register the renewal with the Copyright Office in the last year of the initial term. If such renewal was not made, the work fell into the public domain. For works first published or registered from 1964 through 1977, renewal is automatic, but in the last year of that initial term an application for renewal of copyright may be filed in the Copyright Office which will provide certain benefits to the renewal claimant.²⁷ For works in existence but not published or registered before January 1, 1978, copyright duration is generally computed the same way as works created on or after January 1, 1978, provided however that if the work was published before January 1, 2003, the term of copyright does not expire before December 31, 2047.²⁸ Finally, no copyright protection exists for works published in the United States before January 1, 1923.

17 See, e.g., *Marvel Worldwide, Inc. v. Kirby*, 777 F. Supp. 2d 720 (S.D.N.Y. 2011) (finding that works created by Jack Kirby containing such comic book characters as Spider-Man and the Incredible Hulk were works made for hire by Marvel not eligible for terminations of transfers).
18 17 U.S.C. § 102(a). Ideas, procedures, concepts, or discoveries are not protected by copyright. 17 U.S.C. § 102(b).
19 *Feist Publ’n’s, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (internal quotations omitted).
20 *Id.* at 351-54.
21 *Id.* at 361-64.
22 17 U.S.C. § 102(a).
23 *Id.*
24 See 17 U.S.C. § 1101 (prohibiting unauthorized fixation of and trafficking in sound recordings and music videos). Works being transmitted live that simultaneously are being recorded with the copyright owner’s permission, such as a television broadcast of a concert or sporting

event, are considered to be fixed. 17 U.S.C. § 101 (definition of “fixed” under the Copyright Act).
25 See 17 U.S.C. §§ 303, 304. A good treatment of copyright duration can be found on the Copyright Office website at <http://www.copyright.gov/circs/circ15a.pdf>.
26 See 17 U.S.C. § 304(a).
27 The statute also provides for a complicated provision governing the rights of heirs in the renewal term. Generally, renewal rights do not vest until the last year of the initial term, and then vest in the following individuals: the author; if the author is dead, the author’s surviving spouse and children, as a class; if there are no surviving spouse or children, the author’s executor; and if the author did not leave a will, the author’s next of kin under applicable state law. 17 U.S.C. § 304(a).
28 17 U.S.C. § 303.

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D. Proof of a Valid Copyright

While it is not necessary to register a work with the Copyright Office in order to obtain copyright protection in works created in or after 1978, registration provides a number of benefits to the copyright owner. Relevant here, a registration certificate, if secured within five years after first publication, is *prima facie* evidence of the facts stated in it. Thus, timely registration provides the plaintiff a rebuttable presumption on two of the essential elements of a copyright claim discussed above – that the work is owned by the plaintiff and that the copyright in it is valid.²⁹ Where the potential exists that a work will have commercial value or that the copyright owner will want to enforce his or her rights in court, it is advisable to register the work with the Copyright Office within five years of its first publication.³⁰

A timely registration does not end the inquiry, however. The presumption afforded by registration is rebuttable, and the defendant may come forward with contrary evidence establishing that the work is not protected by copyright or that the plaintiff is not the owner of it. Thus, even with the presumptions provided by timely registration, any potential plaintiff should perform some diligence to determine that the work is sufficiently original, that the plaintiff actually owns the work, and that the work remains under the term of protection. This article discusses other aspects of copyright registration below.

III. Registration

A. Registration and Copyright Protection

Today, it is not necessary to register a newly-created work with the Copyright Office to obtain copyright protection, as such protection arises upon fixation of the work in a tangible medium. Registration is permissive for any work created on or after the effective date of the current Copyright Act – January 1, 1978 – and the failure to register the copyright in such a work does not cause it to lose copyright protection or fall in the public domain.³¹ Registration for such works nevertheless is advisable for any copyright owner who foresees that the work will have economic value or who has an interest in possibly enforcing rights in the work. If a work is registered before the infringement commenced, then that owner will be eligible to recover statutory damages (which can range from \$750 to \$30,000 per work infringed, and up to \$150,000 per

work infringed if the infringement is willful) and attorneys fees (which, while awarded in the court's discretion, can be significant and ultimately influence a copyright owner's decision to pursue an infringement lawsuit).³²

The general rule that registration is permissive is subject to one significant caveat. As discussed above, works created before January 1, 1978 enjoy protection for an initial term of 28 years followed by a renewal term. For a certain class of these pre-1978 works – works first protected under federal law before January 1, 1964 – registration had to be made during the last (*i.e.*, 28th) year of the initial term, and failure to register and renew in a timely manner would throw the work into the public domain. Accordingly, where such works may be at issue, it is essential for the copyright owner to obtain all necessary documentation (including a search of Copyright Office records if necessary) to ensure that there was compliance with registration and renewal formalities.

B. Registration as a Prerequisite for Filing Suit

Copyright registration is a precondition for bringing an infringement lawsuit. The Copyright Act provides that “no action for infringement of the copyright in any United States work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title.”³³ Until recently, many courts referred to the lack of a registration as a defect in subject matter jurisdiction, but the Supreme Court has clarified that the statute's registration requirement is a claim-processing rule that does not restrict a federal court's subject matter jurisdiction.³⁴

Courts are divided on whether a registration certificate must issue from the Copyright Office to satisfy the registration requirement, or if it is sufficient for the Copyright Office to have received a complete registration application. The plain language of the statute, which says that no action can be instituted “until” copyright registration “has been made” certainly suggests that a completed registration is a necessary precondition to filing suit. Such a reading would also comport with the statute's policy to encourage timely copyright registration, as evidenced by the Copyright Act's incentives of making statutory damages and attorneys' fees available only to those who register their works prior to the commencement of infringement. Along these lines, a number of courts have adopted what is sometimes termed the “registration approach” which

²⁹ 17 U.S.C. § 410(c).

³⁰ Recordation with the Copyright Office of transfers and other documents is also advisable, as this helps ensure that the copyright owner will have priority over any conflicting transfers and licenses. *See* 17 U.S.C. § 205.

³¹ *See* 17 U.S.C. § 408(a).

³² *See* 17 U.S.C. § 412. The statute provides a three-month grace period to register from the time of publication for published works. *Id.*

³³ 17 U.S.C. § 411(a). There are a number exceptions to this rule, including (1) where the work is not a United States work; (2) where the infringement claim concerns rights of attribution and integrity under Section 106(A); and (3) where the copyright holder attempted to register the work and registration was refused. *Id.*

³⁴ *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010) (holding that Section 411(a) does not deprive a federal court of subject matter jurisdiction to adjudicate claims involving unregistered works).

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requires issuance of a complete registration in order to file suit.³⁵ Other courts have adopted an “application approach,” deeming that the work registered at the time the application is received by the Copyright Office.³⁶ Most recently, the Ninth Circuit endorsed the application approach.³⁷ The court concluded that, while the language of the Copyright Act was indeterminate, a number of considerations favored the application approach, such as avoiding unnecessary delay in litigation, the statute’s disfavor of needless formalities, and the risk that a copyright holder might forfeit his or her rights if the limitations period has run.³⁸

A further note on registration. While there is authority that a copyright owner of an underlying work can rely on a registration certificate for a derivative work (*i.e.*, a work derived from the underlying work) to bring a claim for infringement of the *underlying* work,³⁹ the courts are split on whether registration of an underlying work will support an action for infringement of an unregistered *derivative* work that is based on it.⁴⁰ Accordingly, a plaintiff who seeks to enforce rights in a derivative work should ensure that the registration is of that same derivative work. Similarly, a plaintiff should make sure that the proof of infringement it elicits at trial actually pertains to the registered work. In a recent decision, the First Circuit granted summary judgment dismissing a plaintiff’s claims that versions of its source code were infringed where the plaintiff’s only evidence of copying – an essential element of an infringement claim – related to an updated version of the source code that was not registered.⁴¹

IV. Copyright Notice

Many copyrighted works bear the ubiquitous copyright notice: the symbol © or the word “Copyright,” followed by the year of first publication and the name of the copyright owner.⁴² Placing a copyright notice on a work is not required for works that were first publicly distributed on or after March 1, 1989, and failure to place

a notice on such works will not risk the loss of copyright protection.⁴³

There are, however, specific requirements that apply to pre-March 1, 1989 works that could jeopardize an infringement claim if not complied with. For works published before January 1, 1978, each copy of a published work must bear a copyright notice in proper form and position. This notice formality is strict and inflexible, and the failure to comply with it strictly could result in the complete loss of copyright protection.⁴⁴ Thus, a potential plaintiff who seeks to enforce rights in works first published before January 1, 1978 should investigate compliance with the 1909 Copyright Act’s notice requirements.

For works published on or after January 1, 1978 and before March 1, 1989, the Copyright Act somewhat relaxed – but did not entirely abandon – the strict notice requirement. The unintentional omission of copyright notice would not always result in divesting copyright protection. For example, there is no loss of copyright if the notice were omitted from no more than a relatively small number of copies, or registration had been made within five years of publication and a reasonable effort was made to cure the omission, or the omission was in violation of an express written requirement that notice be included.⁴⁵ Again, for this class of works, a potential plaintiff must carefully investigate the facts concerning the copyright notice.

V. Infringement

While this article does not explore in depth the substantive law that governs the merits of an infringement claim, it highlights some key issues that any potential plaintiff should consider before filing suit.

As an initial matter, the alleged infringement must concern one of the exclusive rights owned by the potential plaintiff: reproduction, distribution, preparation of derivative works (also called adaptation), public display, and public performance.⁴⁶ A defendant must violate

35 See *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1202-04 (10th Cir. 2005); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1489 (11th Cir. 1990); *Specific Software Solutions, LLC v. Inst. of Workcomp Advisors*, 615 F. Supp. 2d 708, 715-16 (M.D. Tenn. 2009); *Mays & Assocs., Inc. v. Euler*, 370 F. Supp. 2d 362, 370 (D. Md. 2005); *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1112 (W.D. Wash. 2004); *Corbis Corp. v. UGO Networks, Inc.*, 322 F. Supp. 2d 520, 521-22 (S.D.N.Y. 2004); *Strategy Source, Inc. v. Lee*, 233 F. Supp. 2d 1, 3-4 (D.D.C. 2002); *Gerig v. Krause Publ’ns, Inc.*, 33 F. Supp. 2d 1304, 1306 (D. Kan. 1999); *Kregos v. Associated Press*, 795 F. Supp. 1325, 1331 (S.D.N.Y. 1992), *aff’d*, 3 F.3d 656 (2d Cir. 1993); *Demetriades v. Kaufmann*, 680 F. Supp. 658, 661 (S.D.N.Y. 1988).

36 See *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386-87 (5th Cir. 1984); *Chi. Bd. Of Educ. v. Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003); *Tri-Mktg., Inc. v. Mainstream Mktg. Servs., Inc.*, No. CV-09-13, 2009 WL 1408741, at *3 (D. Minn. May 19, 2009); *Precision Automation, Inc. v. Technical Servs., Inc.*, 628 F. Supp. 2d 1244, 1248 (D. Or. 2008); *Prunté v. Universal Music Group*, 484 F. Supp. 2d 32, 39-40 (D.D.C. 2007); *Phoenix Renovation Corp. v. Rodriguez*, 403 F. Supp. 2d 510, 514-15 (E.D. Va. 2005); *Iconbazaar, L.L.C. v. America Online, Inc.*, 308 F. Supp. 2d 630, 633-34 (M.D.N.C. 2004); *Forasté v. Brown Univ.*, 248 F. Supp. 2d 71, 77-78 (D.R.I. 2003); *Well-Made Toy Mfg. Corp. v. Goffa Int’l Corp.*, 210 F. Supp. 2d 147, 157 (E.D.N.Y. 2002), *aff’d*, 354 F.3d 112 (2d Cir. 2003); *Havens v. Time Warner, Inc.*, 896 F. Supp. 141, 142-43 (S.D.N.Y. 1995); *Sebastian Int’l, Inc. v. Consumer Contact (PTY) Ltd.*, 664 F. Supp. 909, 912 (D.N.J. 1987).

37 *Cosmetic Ideas, Inc. v. IAC/InteractiveCorp.*, 606 F.3d 612 (9th Cir. 2010).

38 *Id.* at 619-21.

39 This “effective registration doctrine” allows a derivative work registrant to sue for infringement of copyright in the underlying work as well as the derivative work. 1 Copyright § 3.15.

40 *Id.*

41 *Airframe Sys., Inc. v. L-3 Comm’ns Corp.*, Nos. 10-2001, 11-1169, 2011 WL 4058676 (D. Mass. Sept. 14, 2011). “Having presented no evidence sufficient to prove the content of its registered source code versions, [plaintiff] cannot show that any of its registered works is substantially similar to the allegedly infringing . . . program, and [plaintiff] has failed to create a genuine issue of material fact as to its claim of copyright infringement.” *Id.* at *4.

42 17 U.S.C. § 401(b) sets forth the appropriate form of copyright notice.

43 There is a small legal benefit to affixing notice: a defendant may not seek to mitigate statutory damages on the basis of innocent infringement where the work bears a copyright notice. 17 U.S.C. §§ 401(d), 402(d).

44 See, e.g., *Booth v. Haggard*, 184 F.2d 470 (8th Cir. 1950).

45 17 U.S.C. § 405(a).

46 See 17 U.S.C. § 106.

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one or more of these exclusive rights to be liable for copyright infringement.⁴⁷

To establish infringement, a plaintiff must also prove that (1) the defendant “copied” from the plaintiff’s work (or otherwise made use of an exclusive right – there being no “copying” when the performing or display rights are infringed, for example), and (2) the elements copied or otherwise used were an “improper appropriation.”⁴⁸ Copying is proved either directly – with evidence that the defendant actually copied from or otherwise used the work – or, far more frequently, through circumstantial evidence – by showing that the defendant had access to the work and that infringing work is substantially similar to the copyrighted work.⁴⁹ Improper appropriation generally is proved by showing that the defendant appropriated protected expression from the copyrighted work, and that audiences will perceive substantial similarities between the defendant’s work and the protected expression (also known as the “audience” or “ordinary observer” test).⁵⁰

Much of the proof required to establish infringement turns on facts to be developed in the course of litigation (discovery, expert opinions, trial testimony, etc.). Nevertheless, a copyright owner should keep these elements in mind from the beginning and tailor his or her case to the facts as they are learned in the course of litigation.

Finally, it is worth noting that copyright infringement is a strict liability tort. The defendant’s excuse that he or she inadvertently or unintentionally copied a work is not a defense to liability, though it may impact the amount of damages awarded and whether a court will award attorneys’ fees.

VI. Temporary Relief

The Copyright Act allows for a number of temporary remedies for infringement before an ultimate decision on the merits, including preliminary injunctions, temporary restraining orders, and impoundment of infringing articles.⁵¹ Applying for such relief may be desirable where a copyright owner requires immediate relief that is not otherwise available in a drawn-out litigation.

A copyright owner seeking a preliminary injunction must be prepared to make specific showings for the court. The standard for granting preliminary injunctions in copyright cases has changed recently in light of the Supreme Court decisions in *eBay, Inc. v.*

MercExchange, 547 U.S. 388 (2006) and *Winter v. Natural Resources Defense Council*, 555 U.S. 7 (2008). In 2010, the Second Circuit held that a district court in the circuit should now undertake the following inquiry in determining whether to grant a preliminary injunction:

1. Whether the plaintiff has demonstrated either (a) a likelihood of success on the merits or (b) sufficiently serious questions going to the merits to make them a fair ground for litigation and a balance of hardships tipping decidedly in the plaintiff’s favor;
2. Whether the plaintiff has demonstrated that it is likely to suffer irreparable injury in the absence of an injunction;
3. The balance of hardships between the plaintiff and the defendant and whether the balance of hardships tips in the plaintiff’s favor; and
4. Whether the public interest would not be disserved by the issuance of a preliminary injunction.⁵²

Significantly, the Second Circuit departed from the established rule that presumed irreparable harm to the plaintiff upon a finding that the plaintiff was likely to prevail on the merits of a copyright claim. “Instead, the court must actually consider the injury the plaintiff will suffer if he or she loses on the preliminary injunction but ultimately prevails on the merits, paying particular attention to whether the remedies available at law, such as monetary damages, are inadequate to compensate for that injury.”⁵³ In other words, “plaintiffs must show, on the facts of their case, the failure to issue an injunction would actually cause irreparable harm.”⁵⁴ The Ninth Circuit recently has adopted similar rulings,⁵⁵ and parties to copyright infringement actions can expect that other circuits will follow suit as well.

Temporary restraining orders are also available to copyright owners, and their requirements follow the Federal Rules of Civil Procedure applicable to other federal causes of action. The court may issue such a restraining order without notice to the adverse party if the movant is able to show that immediate and irreparable injury or damage will result before the adverse party can be heard, and if the movant’s attorney certifies any efforts made to give notice and the reason why it should not be required.⁵⁶ Such an order expires within fourteen days, and may be extended without the adverse party’s consent for up to another fourteen days for good cause.⁵⁷ Issuance

47 17 U.S.C. § 501. As discussed above, the plaintiff must be the legal or beneficial owner of the exclusive right allegedly infringed in order to have standing to bring a copyright infringement claim.

48 See 2 Copyright § 9.1.

49 See *id.* § 9.2. Some courts dispense with the need to prove access where the works are identical or strikingly similar, as access can be inferred from those facts. See *id.* § 9.2.1.2.

50 See *id.* §§ 9.3.1, 9.3.1.2. Courts have developed their own variants of the improper appropriation test. See *id.* § 9.3.2.

51 See 17 U.S.C. §§ 502, 503.

52 *Salinger v. Colting*, 607 F.3d 68, 79-80 (2d Cir. 2010).

53 *Id.* at 80 (internal quotations omitted).

54 *Id.* at 82.

55 See *Flexible Lifeline Sys., Inc. v. Precision Lift, Inc.*, No. 10-35987, 2011 WL 3659315 (9th Cir. Aug. 22, 2011); *Perfect 10, Inc. v. Google, Inc.*, No. 10-56316, 2011 WL 3320297 (9th Cir. Aug. 3, 2011).

56 Fed. R. Civ. P. 65(b)(1).

57 Fed. R. Civ. P. 65(b)(2).

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of a temporary restraining order (and also a preliminary injunction) requires the movant to give security to cover the costs and damages sustained if the adverse party is found to have been wrongfully restrained or enjoined.⁵⁸

VII. Jurisdiction and Venue

A. Jurisdiction

Jurisdiction is the power of a court to hear and adjudicate a dispute. As in any action, a plaintiff should only file a copyright infringement lawsuit in a court that has jurisdiction over the matter.

1. Subject Matter Jurisdiction

Before filing an action in federal court, a copyright owner should confirm that the court would have subject matter jurisdiction over the case. Subject matter jurisdiction refers to the power of a particular court to hear a case of the type in question.⁵⁹ Federal courts have exclusive subject matter jurisdiction over actions “arising under” the United States Copyright Act.⁶⁰ For that reason, federal courts are the only courts in which the vast majority of copyright infringement actions can be brought. Such exclusive federal jurisdiction applies where the copyright owner and the alleged infringer are complete “strangers” to each other, and also where the owner and the infringer may have a license agreement between each other but the alleged infringement was due to use of the copyrighted work that was not authorized by the terms of the agreement or where the licensee’s breach of another provision of the contract resulted in termination of the license.⁶¹ While the latter two examples turn on state law questions – *i.e.*, the scope of the license or what constitutes a breach – nevertheless federal courts will have subject matter jurisdiction over such infringement actions.⁶²

The statute’s wording that jurisdiction over actions “arising under” the Copyright Act is “exclusive of the courts of the states”⁶³ is somewhat confusing, as there are actions that frequently arise in connection with copyrighted subject matter over which federal courts have no jurisdiction. For example, where a claim is for breach of a license agreement and payment of royalties concerning a copyrighted work and no alternative copyright infringement claim is stated, the action does not “arise under” the Copyright Act and (absent diversity or supplemental jurisdiction) a federal court would

not have jurisdiction to hear such a breach of contract dispute.⁶⁴ Cases depending entirely on contract construction or enforcement, or property ownership or transfer, generally are reserved for state courts.⁶⁵ Thus, where a claim has state law components, a plaintiff should consult the case law to confirm whether the “arising under” requirement of the statute would be met when considering whether to file the action in federal or state court.

There is an additional caveat. State laws may continue to provide copyright protection for certain types of works. Section 301 of the Copyright Act expressly preempts state law protection for works that are fixed in a tangible medium of expression and that come within the subject matter of copyright.⁶⁶ Conversely, state common law and statutory rights remain in effect with regard to two types of works: (1) works not within the subject matter of copyright, including unfixed works like improvised performances or extemporaneous speeches;⁶⁷ and (2) sound recordings fixed before February 15, 1972, which was when the first federal law protecting sound recordings took effect.⁶⁸ Disputes regarding such works do not “arise under” the Copyright Act, and as federal courts do not have subject matter jurisdiction over them, state courts instead are the appropriate forum.⁶⁹ The laws of each state differ, and it is essential to research the statutes and common law of the particular state to determine what protection, if any, a state may provide for such works.

The bottom line is that before filing an infringement claim in federal court, a copyright owner must ensure that the claim “arises under” the Copyright Act, and absent that, should determine if the infringed works are of a type for which a state claim, to be filed in state court, is appropriate.

2. Personal Jurisdiction

A court must also have personal jurisdiction over a defendant in order to adjudicate the matter. Personal jurisdiction in copyright infringement actions generally follows the same rules as in federal cases, meaning that federal courts apply the personal jurisdiction rules of the forum state, provided that those rules are consistent with the requirements of the due process clause of the United States Constitution.⁷⁰

Having an understanding of a state’s jurisdictional rules is crucial in

⁵⁸ Fed. R. Civ. P. 65(c).

⁵⁹ A court has no authority to adjudicate a matter over which it has no subject matter jurisdiction. Parties and courts cannot waive defects in subject matter jurisdiction, and parties cannot agree to confer subject matter jurisdiction on the court.

⁶⁰ 28 U.S.C. §§ 1331, 1338(a).

⁶¹ 3 Copyright § 15.2.1.1.

⁶² *Id.*

⁶³ 28 U.S.C. § 1338(a).

⁶⁴ 3 Copyright § 15.2.1.

⁶⁵ *Id.* § 15.2.1.2.

⁶⁶ 17 U.S.C. § 301(a).

⁶⁷ 17 U.S.C. § 301(b). However, as discussed above, works being transmitted live that

simultaneously are being recorded with the copyright owner’s permission, such as a television broadcast of a concert or sporting event, are considered to be fixed and thus fall within the exclusive scope of federal copyright protection. *See* 17 U.S.C. § 101 (definition of “fixed” under the Copyright Act).

⁶⁸ 17 U.S.C. § 301(c). The Copyright Act provides that state protection for pre-February 15, 1972 sound recordings will be preempted on and after February 15, 2067. *Id.*

⁶⁹ One carve-out to this, however, is an action arising under federal anti-bootlegging legislation, which prohibits unauthorized reproduction, distribution, and transmission of live musical performances. *See* 17 U.S.C. § 1101. While creating a federal cause of action under the Copyright Act for such violations, this provision does not preempt state laws prohibiting similar conduct. *Id.* § 1101(d).

⁷⁰ *See, e.g., Penguin Group (USA) Inc. v. Am. Buddha*, 609 F.3d 30, 35 (2d Cir. 2010).

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matters where the defendant is not a resident of the forum. In such instances, the plaintiff must show that the defendant is subject to personal jurisdiction under the state's long-arm statute.⁷¹

From a due process standpoint, a defendant must have an appropriate connection with the state for the court to exercise personal jurisdiction over that defendant. Traditionally, only a party's consent to jurisdiction (such as appearing in court) or physical presence or domicile in the state was sufficient to give rise to personal jurisdiction.⁷² Under modern jurisprudence, regardless of whether there is such presence in the forum, a defendant's minimum contacts with the forum will give rise to personal jurisdiction if they do not offend traditional notions of fair play and substantial justice.⁷³ Minimum contacts cannot exist unless there is some act by which the defendant purposefully avails itself of the privilege of conducting activities within the forum State, thus invoking the benefits and protections of its laws.⁷⁴ Under this framework, courts have articulated two types of personal jurisdiction: general and specific.⁷⁵ This article does not delve into the complexities of these two forms of jurisdiction as they have evolved over time, but this much is clear: any party contemplating bringing a copyright infringement lawsuit should be prepared to show that (1) the defendant is amenable to personal jurisdiction in accordance with the laws of the forum state – and in particular under the state's long-arm statute where the defendant does not reside in the forum; and (2) exercise of personal jurisdiction over a defendant would satisfy due process concerns.

Online copyright infringement often poses new and complex questions about when it is appropriate to subject a defendant to personal jurisdiction. A recent line of decisions in *Penguin Group (USA) Inc. v. American Buddha* is illustrative. There, the plaintiff Penguin Group (USA), a large trade book publisher based in New York, sued American Buddha, an Oregon not-for-profit corporation whose principal place of business was in Arizona and which operated two websites hosted on servers located in Oregon and Arizona. Penguin filed its lawsuit in federal district court in New York and alleged that American Buddha copied, uploaded, and made available on its websites complete copies of Penguin's copyrighted books.

Notably, American Buddha's infringing conduct was not alleged to have occurred in New York (as the copying and uploading was done in Oregon and Arizona), and aside from its websites being accessible in New York, American Buddha conducted no business in and had no contacts with New York.⁷⁶ American Buddha moved to dismiss for lack of personal jurisdiction, and Penguin argued that jurisdiction was established under a provision of the New York long-arm statute that confers jurisdiction over out-of-state residents who commit tortious acts outside of the state if the resulting injury occurs in, and it was foreseeable to the prospective defendant that the injury would occur in, New York.⁷⁷ The district court granted American Buddha's motion to dismiss, finding that the injury from the alleged infringement did not occur in New York.⁷⁸ On appeal, the Second Circuit certified the question to the New York State Court of Appeals, which found that the situs of injury for purposes of determining jurisdiction under the state long-arm statute was the location of the copyright holder.⁷⁹ The Court of Appeals was persuaded for two reasons. First, the court found that while it may make sense in traditional tort cases to equate a plaintiff's injury with a place where business is lost or threatened, that concept does not extend to online copyright infringement where the place of uploading is inconsequential and it is difficult if not impossible to correlate lost sales to a particular area.⁸⁰ Second, given the multifaceted exclusive rights given to copyright owners, the injury to the intangible property interest of a New York copyright holder, while difficult to quantify, is not as remote as a purely indirect financial loss in non-internet cases.⁸¹

The inquiry, however, does not end there. The Court of Appeals rejected American Buddha's assertion that the decision would "open a Pandora's box allowing any nondomiciliary accused of digital copyright infringement to be haled into a New York court when the plaintiff is a New York copyright owner," as the court would still have to determine whether the requisite minimum contacts with the forum were present.⁸² As that was beyond the scope of the appeal, the case was remanded to the district court to determine, among other things, if these due process requirements have been satisfied.⁸³

71 Long-arm statutes typically take two forms: statutes that direct the court to exercise jurisdiction on any basis not inconsistent with the state's and the United States constitutions, and so-called "enumerated act" statutes that direct the court to exercise jurisdiction over any defendant who commits one of several enumerated acts in the forum state. See 16 James Wm. Moore et al., *Moore's Federal Practice* § 108.60 (3d ed. 1997).

72 See *Pennoyer v. Neff*, 95 U.S. 714 (1877).

73 See *Int'l Shoe Co. v. Washington*, 326 U.S. 310, 316 (1945).

74 *Hanson v. Denckla*, 357 U.S. 235, 253 (1958).

75 General jurisdiction refers to jurisdiction to hear claims that do not arise from the defendant's contacts with the forum state; allows a state to exercise jurisdiction over the defendant based on any claim; and ordinarily exists only when the defendant's forum connections are continuous, systematic, and substantial (for example, where the defendant is domiciled in the state), though one key exception is that general jurisdiction may arise over a non-domiciliary if the defendant was served with process within the forum state. Specific jurisdiction is jurisdiction to adjudicate claims arising from the defendant's contacts with the forum state, even where a defendant is not amenable to general jurisdiction, and may apply when the

defendant has limited contacts with the forum if the claim arises directly from the contact, such as where a nonresident defendant has committed a tort (like copyright infringement) within the state. *Moore's Federal Practice* § 108.40.

76 *Penguin Group (USA)*, 609 F.3d at 33. Penguin made no allegation that persons downloading material from the websites infringed its copyrights, and therefore potential injury for personal jurisdiction purposes would have to be the result of American Buddha's and not any downloading user's infringement. *Id.* at 33 n.2.

77 *Id.*

78 *Penguin Group (USA) Inc. v. Am. Buddha*, No. 09 Civ. 528 (GEL), 2009 WL 1069158, at *3-4 (S.D.N.Y. Apr. 21, 2009).

79 *Penguin Group (USA) Inc. v. Am. Buddha*, 16 N.Y.3d 295, 301-02 (2011).

80 *Id.* at 305.

81 *Id.* at 305-06.

82 *Id.* at 307.

83 *Penguin Group (USA)*, 640 F.3d 497, 501 (2d Cir. 2011).

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B. Venue

While a defendant may be subject to personal jurisdiction in the courts of a territory or territories, venue rules establish which courts within those territories are the proper ones to hear the action. Venue rules give the defendant a privilege not to be sued in a forum other than one designated as proper, but they do not affect the court's authority over the defendant in question.⁸⁴

Civil suits arising under the Copyright Act may be brought in the district where the defendant "resides or may be found."⁸⁵ As a general matter, a defendant is "found" in any district in which it is subject to personal jurisdiction.⁸⁶ Accordingly, a copyright owner should ensure that personal jurisdiction exists in the particular district where the suit is to be filed. Even where venue is appropriate, it can be transferred to any other district where the action might have been brought if the party seeking transfer can prove that such transfer is appropriate for the convenience of the parties and witnesses and in the interest of justice.⁸⁷

VIII. Other Parties

Given the possibility that multiple persons or entities may own an interest in a copyrighted work, the Copyright Act provides that a plaintiff must serve written notice of the action along with a copy of the complaint on any person who has an interest in the copyright that is likely to be affected by a decision in the case.⁸⁸ This, together with the mandatory and permissive joinder provisions of the Federal Rules of Civil Procedure,⁸⁹ works to protect the interests of third parties that may be in a position to enforce their copyrights in the same work.

As with all actions in federal courts, the Federal Rules set the requirements for when additional parties must or may be added to a copyright infringement lawsuit. A person who is subject to service of process and whose joinder will not deprive the court of subject matter jurisdiction *must* be joined as a party if (1) the court cannot accord complete relief among existing parties in that person's absence, or (2) that person claims an interest relating to the subject of the action and is so situated that disposing of the action in the person's absence may (a) as a practical matter impair or impede the person's ability to protect the interest or (b) leave an existing party subject to a substantial risk of incurring double, multiple, or otherwise inconsistent obligations because of the interest.⁹⁰ In practice, it is rare that a defendant will be able to have a party joined as a necessary or indispensable party plaintiff given the protections built into the Federal Rules.⁹¹

With regard to permissive joinder, parties may join or be joined in one action as *plaintiffs* if they assert any right to relief jointly, severally, or with respect to or arising out of the same transaction or occurrence, and any question of law or fact common to all plaintiffs will arise in the action.⁹² Similarly, parties may join or be joined in one action as *defendants* if any claim is asserted against them jointly, severally, or with respect to or arising out of the same transaction or occurrence, and any question of law or fact common to all defendants will arise in the action.⁹³ The latter requirement governing permissive joinder of defendants has proved thorny in cases where copyright owners have sued large numbers of defendants for online infringement. In recent years, a number of record companies and movie studios have tried to combat the surge in unauthorized downloads of their content on the internet by filing lawsuits against thousands of individual defendants who allegedly uploaded or downloaded such content using peer-to-peer networks. Filing one lawsuit against a thousand defendants is much more economical for a plaintiff than filing a thousand individual lawsuits against those same defendants, but also raises significant joinder concerns.

This question was recently considered in one lawsuit brought by a plaintiff against nearly 200 "John Doe" defendants who allegedly downloaded a copyrighted video via a peer-to-peer network using a BitTorrent protocol.⁹⁴ Instead of relying on a central server to distribute data directly to individual users, BitTorrent allows individual users to distribute data among themselves by exchanging pieces of the file with each other to eventually obtain a whole copy of the file. A user who is looking to download a file logs into the BitTorrent client, which connects to peers (other BitTorrent users) to begin downloading data from and distributing data to other peers. When the download is complete, the BitTorrent client continues to distribute data to other peers until disconnected.⁹⁵ The plaintiff, who was able to identify each of the defendants only by their IP addresses, alleged that joinder of the John Doe defendants was proper because the nature of the BitTorrent protocol required concerted action and even if the defendants were not engaged in distributing the file at the same time, they contributed to the chain of data distribution due to their prior involvement.⁹⁶ The court noted that several decisions involving pre-BitTorrent peer-to-peer technologies held that the mere use of a peer-to-peer network by a group of defendants to download infringing files was not sufficient to allow permissive joinder.⁹⁷ Moreover, subsequent decisions are split on whether use of the BitTorrent protocol is sufficient to allow joinder under Rule 20(a), with some courts finding joinder proper⁹⁸

⁸⁴ 16 Moore's Federal Practice § 108.04[4].

⁸⁵ 28 U.S.C. § 1400(a).

⁸⁶ See 3 Copyright § 15.3.2.

⁸⁷ 28 U.S.C. § 1404(a).

⁸⁸ 17 U.S.C. § 501(b).

⁸⁹ Fed. R. Civ. P. 19, 20.

⁹⁰ Fed. R. Civ. P. 19(a). This requirement is subject to limitations when joinder would result in improper venue or where joinder is not feasible. See Fed. R. Civ. P. 19(a)(3), (b).

⁹¹ 3 Copyright § 15.5.2.

⁹² Fed. R. Civ. P. 20(a)(1).

⁹³ Fed. R. Civ. P. 20(a)(2).

⁹⁴ *Hard Drive Prods., Inc. v. Does 1-188*, No. C-11-01566 JCS, 2011 WL 3740473 (N.D. Cal. Aug. 23, 2011).

⁹⁵ *Id.* at *1.

⁹⁶ *Id.* at *2.

⁹⁷ *Id.* at *7 (citing *Laface Records, LLC v. Does 1-38*, 2008 WL 544992 (E.D.N.C. Feb. 27, 2008); *Elekra Entm't Group, Inc. v. Does 1-9*, 2004 WL 2095581 (S.D.N.Y. Sept. 8, 2004); *Fonovisa, Inc. v. Does 1-9*, 2008 WL 919701 (W.D. Pa. Apr. 3, 2008)).

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and others finding it not.⁹⁹ The court here sided with those decisions finding joinder improper, concluding that the defendants “did not participate in the same transaction or occurrence, or the same series of transactions or occurrences” as mandated by the Federal Rules.¹⁰⁰ This was because it is not necessary that each of the defendants participated or contributed to the downloading of each others’ copies of the work at issue, or participated in or contributed to the downloading by any of their co-defendants. Any pieces of the work by an individual defendant may have gone to a co-defendant or, as the court emphasized, to any of the potentially thousands of other users who participated.¹⁰¹ The court then exercised its discretion to sever all but one of the defendants from the case to avoid prejudice and unfairness to the defendants and in the interest of justice.¹⁰² With courts divided on the question, significant uncertainty remains on whether joinder of multiple defendants is permitted in such cases.

IX. Possible Defenses

Before filing suit, a potential plaintiff should consider whether the defendant would be able to prevail on any defenses to copyright infringement. This article does not delve into the many complexities of infringement defenses, but highlights several points that merit further study by any copyright owner who is thinking about bringing a lawsuit.

A. Statute of Limitations

A plaintiff should file an infringement suit within the limitations period. A civil action for copyright infringement must be filed within three years after the claim accrued.¹⁰³ Courts are divided on when a claim “accrues.” Some courts have followed the “injury rule,” under which the three-year statute of limitations starts running at the moment the infringement occurs.¹⁰⁴ Other courts follow the “discovery” rule, under which the statute of limitations begins to run when the copyright owner knows or has reason to know of the infringement.¹⁰⁵ A copyright owner should become familiar with the rule followed in the jurisdiction if there is any question that the claim may be time-barred.

B. Fair use

A potential plaintiff should consider whether the allegedly infringing use is permitted as fair use. The Copyright Act allows the unauthorized use of a copyrighted work “for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research.”¹⁰⁶ Fair use is a case-by-case inquiry, and courts will consider and weigh a number of factors in determining if fair use applies.¹⁰⁷

C. First Sale

A copyright owner should also consider whether the first sale doctrine would allow the unauthorized use. The Copyright Act provides that, with certain exceptions, the owner of a lawfully made copy of a work may sell or otherwise dispose of possession of that copy without having to obtain permission of the copyright owner.¹⁰⁸ This explains why, for example, a person can give or resell his or her lawfully obtained copy of a book or music recording to others. An end-user typically may not resell a computer software, however, because software companies ordinarily license and do not sell copies of their software to end-users and thus the doctrine does not apply.

D. License

A person who uses a work under license from a copyright owner cannot be held liable for uses of the work within the terms of the license. Accordingly, a potential plaintiff should investigate, where feasible, whether the possible infringer is acting under license from another party – for example, a sub-licensee or a co-owner – that has a right to license the work.

E. DMCA Safe Harbors

Where infringement on the internet is concerned, the Copyright Act limits the liability of eligible service providers under certain circumstances and also provides for “notice and takedown” procedures that copyright owners should follow.¹⁰⁹ A potential plaintiff should be aware of these provisions, which can be quite complex, where infringement claims against service providers may be at issue.

98 *Id.* at *9 (citing *MCGIP, LLC v. Does 1–18*, 2011 WL 218160 (N.D. Cal. June 2, 2011); *Voltage Pictures, LLC v. Does 1–5,000*, 2011 WL 1807438 (D.D.C. May 12, 2011); *Call of the Wild Movie, LLC v. Does 1–1,062,770*, F. Supp. 2d 332 (D.D.C. Mar. 22, 2011)).

99 *Id.* at *10–11 (citing *Diabolic Video Prods. v. Does 1–2099*, 2011 WL 3100404 (N.D. Cal. May 31, 2011); *Pac. Century Int'l Ltd. v. Does 1–101*, 2011 WL 2690142 (N.D. Cal. July 8, 2011); *Millennium TGA, Inc. v. Does 1–21*, 2011 WL 1812786 (N.D. Cal. May 12, 2011)).

100 *Id.* at *13.

101 *Id.* The court also found that the plaintiff’s declaration appeared to contradict the assertion that the defendants named in the action were part of the same “swarm” that was involved in downloading or distributing a particular file. *Id.* at *14.

102 *Id.*

103 17 U.S.C. § 507(b).

104 *See Auscape Int'l v. Nat'l Geographic Soc'y*, 409 F. Supp. 2d 235, 244–47 (S.D.N.Y. 2004); *CA, Inc. v. Rocket Software, Inc.*, 579 F. Supp. 2d 355, 360 (E.D.N.Y. 2008).

105 *See, e.g., Warren Freedendfeld Assocs., Inc. v. McTigue*, 531 F.3d 38, 44–46 (1st Cir. 2008); *William A. Graham Co. v. Haughey*, 568 F.3d 425 (3d Cir. 2009); *Lyons P'ship, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789, 796 (4th Cir. 2001); *Roger Miller Music, Inc. v. Sony/ATV Publ'g, LLC*, 477 F.3d 383, 390 (6th Cir. 2007); *Gaiman v. McFarlane*, 360 F.3d 644, 653 (7th Cir. 2004); *Comcast of Ill. X v. Multi-Vision Elecs., Inc.*, 491 F.3d 938, 944 (8th Cir. 2007); *Polar Bear Prods., Inc. v. Timex Corp.*, 384 F.3d 700, 705–07 (9th Cir. 2004).

106 17 U.S.C. § 107.

107 Courts will consider (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. *Id.*

108 17 U.S.C. § 109.

109 *See* 17 U.S.C. § 512.

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F. Other Possible Statutory Exceptions

The Copyright Act sets forth a number of limitations on copyright owners' exclusive rights and exceptions to infringement of those rights, concerning for example reproductions by libraries and archives, certain performances and displays, secondary transmissions, ephemeral recordings, compulsory licenses for sound recordings and musical works, and use of computer programs.¹¹⁰ These provisions can be quite complicated and a copyright owner should become familiar with any relevant provisions before filing suit.

X. Conclusion

While the law has moved away from strict compliance with many of the formalities that once were preconditions for copyright protection, there remain numerous legal requirements that a plaintiff must satisfy. It is essential that a potential plaintiff understand these requirements before filing an infringement suit to ensure that a court or jury can decide the claim on the merits.

Stefan Mentzer is a member of the Firm's Intellectual Property group and has counseled and represented clients in copyright, trademark, and complex civil litigation matters. Mr. Mentzer has practiced in federal and state courts and in proceedings before the United States Copyright Office and United States Patent and Trademark Office. His experience includes bench and jury trials, discovery, motion practice, appellate briefing, and client counseling on a variety of copyright and trademark issues.

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¹¹⁰ See 17 U.S.C. §§ 108, 110-122.