

Beware the US deposit requirement

Ed Komen and Matt Clanton caution against overlooking the benefits and drawbacks of this system

Litigating copyright infringement cases in the US is often fraught with peril. Aside from the obvious challenge of prevailing on the merits, a plaintiff cannot bring a lawsuit in US federal court without first registering its copyright with the US Copyright Office. This requirement is often considered (and even more often, frantically addressed) only after litigation is imminent instead of: at or near the time that the work was first created. Also, even though pre-litigation registration is not required for many foreign works, the procedural and evidentiary benefits often make registration a practical necessity even for foreign copyright claimants.

Registration requires, among other things, the deposit of the original work or a *bona fide* copy with the Copyright Office. Unfortunately, clients often do not register their works when first created. When registration is finally attempted, neither the original work nor an actual 'bona fide' copy may be available. Relying on a 'reconstructed' work, however, risks dooming the plaintiff's suit long before trial – much to the disappointment of clients who may blame the lawyer for failing to warn them of this possible outcome.

The reasoning

The US deposit requirement for registration distinguishes the US from many other countries (many of whom lack a registration process, much less a deposit requirement). Under the US system, the deposit process has two key functions: to present objective evidence that the work is copyrightable and to build a reliable evidentiary record that can be used to test infringement claims. A third function, unrelated to copyright enforcement, is to provide free copies of works for the Library of Congress.

Accordingly (and particularly because of the evidentiary function), not just any deposit will do. Only the original work or a *bona fide* copy of the original is allowed. The Copyright Office does not normally delve into questions of whether the work is an original, a *bona fide* copy, or even a reconstructed copy. In theory, reconstructing a work from memory *may* allow the claimant to complete the registration process (assuming the deposit is filed in good faith) thus satisfying the jurisdictional requirements for suit. When the discovery

process reveals that the deposit copy was reconstructed from memory, however, the case may ultimately die prematurely^{1,4}.

A similar rule was laid down by the Sixth Circuit, relying on both *Seiler* and *Kodadek*, in affirming summary dismissal of an infringement claim based on a reconstructed musical composition. *'While the rule we adopt may seem harsh, it avoids the factual disputes over creation dates... (by) encouraging artists to either register copyrights upon creation of a new work or, at least, to retain copies of their work.'*

This rule was applied most recently, in still a different jurisdiction, by the Eastern District of Virginia in *Tavory v NTP Inc*⁵, involving plaintiff's reconstructed software used to satisfy the copyright deposit requirement since the original software code, dating from 1990, was unavailable. Unsurprisingly, the deposited source code failed to perform in the same way as the 1990 version. In granting summary judgment, the Court sternly rebuked the plaintiff by stating that it was, *'...deeply troubled by these circumstances. There are few coincidences in life, and the timing of Tavory's assertions is far too convenient to avoid suspicion.'*

Protecting the system

Courts are increasingly reluctant to accept reconstructions because of an underlying concern for protecting the integrity of the US copyright system. Basing a copyright case on the claimant's 'memory' of the salient facts in the case (the characteristics of the work that allegedly has been infringed) is generally viewed as too imprecise – especially when reconstruction occurs after the claimant views the alleged infringing work. At worst, courts distrust after-the-fact reconstructions as inviting fraudulent or deceitful claims.

In truth, not all reconstructions will be held invalid. A reconstructed copy may serve as a valid deposit if the claimant can prove that it was reproduced from a *bona fide* copy of the original work. The reconstructed copy must be made by directly referring to the *bona fide* copy of the original⁶. In that event, it could serve as a valid deposit even if it contains minor errors or discrepancies from the *bona fide* copy⁶. But as pointed out by the court in *Tavory*, *'there must first be a bona fide copy from which to effect reproduction'*. If there is not, the proffered deposit and resulting

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copyright registration will be deemed invalid and the court will dismiss the action for lack of jurisdiction.

Register promptly to prevent problems

Fortunately, this scenario can easily be avoided if copyright owners promptly register their copyrights after creation. Doing so will entitle the claimant to an assortment of potential benefits – not the least of which is to preserve the ability to bring a claim against future infringers. If not, and registration is delayed until a dispute arises, counsel should investigate whether the claimant is capable of satisfying the deposit requirement.

At the very least, copyright creators and owners should retain one original copy of every work as part of their normal 'business records' which can then be used to make supportable copyright filings at a later date should litigation or other business needs arise. These critical facts relating to copyright deposits should not be overlooked when assessing the strengths and weaknesses of a case. Failing to properly analyse this critical evidentiary deposit issue may put the client and the attorney at risk. ☹

Notes

1. See *Seiler v Lucasfilm, Ltd et al*, 808 F.2d 1316 (9th Cir. 1987). Summary judgment affirmed against plaintiff who alleged that the Imperial Walker battle machines in George Lucas' 'Empire Strikes Back' infringed on plaintiff's science fiction creatures called Garthian Striders – plaintiff's reconstructions of his works after release of the second Star Wars film failed to satisfy the 'best evidence' rule).
2. *Kodadek v MTV Networks Inc*, 152 F.3d 1209, 1211 (9th Cir. 1998). Summary judgment affirmed against plaintiff who alleged 'Beavis and Butt-Head' series infringed on plaintiff's characters where plaintiff reconstructed his works by drawing them from memory after seeing the series.
3. *Coles v Wonder*, 283 F.3d 798, 802 (6th Cir. 2002).
4. *Tavory v NTP Inc*, 2007 US Dist. LEXIS 51686 (ED Va 2007).
5. *Kodadek*, 152 F.2d at 1212.
6. *Three Boys Music Corp v Bolton*, 212 F.3d 477, 486-77 (9th Cir. 2000).