

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK**

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MUENCH PHOTOGRAPHY, INC., :  
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Plaintiff, : Case No. 09–CV–2669 (LAP)  
:  
- against - : Hon. Loretta A. Preska  
:  
HOUGHTON MIFFLIN HARCOURT PUBLISHING :  
COMPANY AND R. R. DONNELLEY & SONS : ECF CASE  
COMPANY, :  
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Defendants. :  
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**MEMORANDUM OF LAW OF AMICUS CURIAE CORBIS CORPORATION  
IN SUPPORT OF PLAINTIFF’S MOTION FOR RECONSIDERATION OF  
COURT’S MAY 4, 2010 ORDER**

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## **I. STATEMENT OF INTEREST OF AMICUS CORBIS CORPORATION**

Corbis Corporation (“Corbis”) is a leading visual-solutions provider that licenses images and fine art to publishers, advertising and design agencies, filmmakers, and other creative professionals, who utilize the images in various ways. Corbis does so on behalf of more than 30,000 contributors whose works it represents, totaling more than 100 million images. Muench Photography, Inc. (“MPI”) (through Marc and David Muench) has been a Corbis contributor for many years. By virtue of that relationship, MPI has appointed Corbis to serve as the entity responsible for licensing many of its images, including many of the images at issue in this case.

In the years following Corbis’ founding in 1989, it primarily relied upon published print catalogues containing images available for license. As the use of technology in the image licensing industries became more prevalent and affordable, Corbis switched to distribution on CD-ROM, and, later, an online catalog.

In 1995, Corbis began offering its Copyright Registration Program as an additional service to its contributors. Like many other stock photography companies, Corbis is a member of the Picture Archive Council of America (“PACA”). As detailed in PACA’s amicus brief, the copyright registration program used by Corbis was developed by PACA in close cooperation with the United States Copyright Office during the 1990s.<sup>1</sup> Under this program, a contributor participating in Corbis’ Copyright Registration Program first transfers to Corbis legal title for the relevant images, enabling Corbis to serve as a copyright “claimant” with the authority to register the works under applicable Copyright Office regulations. *See* 37 C.F.R. 202.3(a)(3) & n.1.

Corbis then submits the images of different contributors for registration as part of a collective

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<sup>1</sup> On numerous occasions Corbis separately received advice directly from the Copyright Office that Corbis should register groups of images consistent with the procedures the Copyright Office had developed with PACA.

work submission to the Copyright Office. During the relevant period, Corbis made such registration applications quarterly or monthly and would include in each application the images Corbis added to its database since the last registration application. As the Court is aware, the plaintiff in this case participated in Corbis' Copyright Registration Program, so that some of plaintiff's images at issue were included in the registrations filed by Corbis.

Registration is a time consuming and expensive process, and the approach developed by the Copyright Office and PACA allows Corbis to relieve its contributors of the administrative and financial burden of registering their own images. Corbis is able to centralize the paperwork for this process and serves as a single point of contact for the Copyright Office—which could otherwise be overwhelmed by hundreds or thousands of additional submissions each month if contributors sought to register works on their own.

From Corbis' perspective (as well as that of its participating contributors), the primary goal of this registration system was to obtain registration of the underlying images included in each application. In contrast, the value of the *collection* of images included in a particular registration (the selection and arrangement of the thousands of images) is not substantial. It is the individual images that Corbis licenses to third parties—and that are frequently infringed by others (such as defendants here). As the Court is aware, registration of an infringed work is a precondition to suit, statutory damages, and attorneys' fees, in addition to deference to the validity of the copyright registration itself. This, in turn, renders infringement actions economically viable where, as here, the actual damages associated with the infringement of low cost imagery are relatively small.

Hence, the focus of Corbis' Copyright Registration Program has always been to find an effective and cost-conscious alternative to the separate registrations of hundreds of thousands of

individual photographs. The Court’s May 4, 2010 Order, Dkt. No. 38 (“May 4 Order”), threatens the entire basis of Corbis’ ability to remedy infringement of the images created by the contributors whom Corbis represents. Because the effect of the May 4 Order is to treat all of the individual photographs included in Corbis’ registrations as unregistered, the May 4 Order potentially gives a free pass to parties that use Corbis-represented images without authorization. Such parties can now engage in wholesale infringement, relying on the Court’s assurance that Corbis (or its participating contributors, such as the plaintiff here) are unlikely to bring a claim because statutory damages and attorney’s fees would be unavailable.

Corbis recognizes that one basis for the Court’s May 4 Order—its application of Section 409 of the Copyright Act—can be addressed on a going forward basis by ensuring that the names of all contributors whose images are included by Corbis in a single registration application are listed on the registration application.<sup>2</sup> However, the May 4 Order suggests that a collective registration such as those at issue here can *never* protect the individual images that are its constituent parts, even if Corbis owns the copyright in every individual image at the time registration is sought. Indeed, as discussed further below, the Court’s reasoning would mean that even a serial registration could not protect the constituent elements—so that, for example, registration of a magazine issue could only protect the selection and arrangement of the articles but not the articles themselves. Because the May 4 Order is contrary to copyright law in

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<sup>2</sup> Beginning in 2009, despite great resistance from the Copyright Office, Corbis began listing on the registration applications the names of each individual contributor whose work(s) was part of the collection of photographs being registered. The vast majority of Corbis’ present image archive, however, is affected by the Court’s May 4 Order and is the subject of this brief.

The Copyright Office recently informed Corbis that, in light of the Court’s May 4 Order, the Office believes that its historical practices may be insufficient and therefore asks that future registration applications include the names of authors of all constituent works where the claimant’s claim extends to different contributions by a large number of authors.



numerous respects and threatens the business and livelihood of thousands of Corbis' partner contributors and Corbis itself, Corbis submits this amicus brief in support of reconsideration.<sup>3</sup>

## **II. ARGUMENT**

The Court's May 4 Order discusses and appears to reach a conclusion as to two primary legal issues. The ultimate holding was that, for a collective work registration, Section 409 of the Copyright Act requires that the name of the author of a constituent part of the collective work be included on the copyright registration application form in order for the constituent part created by that author to be protected by the registration, and that the failure to include an author's name on the application cannot be cured by the "innocent error rule" of copyright law. May 4 Order at 20-23. Before reaching this conclusion, the Court also appeared to reason that, in the case of any collective work registration other than a serial work, registration can never extend to a constituent part of the collective work. *Id.* at 15-20. However, as the Court appeared to premise its ruling on Section 409, it is not clear if the discussion of the scope of collective work registrations was necessary for the Court's ruling or is dictum. In any event, Corbis believes that both portions of the Court's analysis were mistaken and should be reconsidered.

### **A. The Court's May 4 Order Misinterpreted the Nature and Scope of Collective Work Registrations As Applied To Serials and Automated Databases.**

In its May 4 Order, the Court discussed at some length the question of whether a collective work registration in the form of an automated database can protect the individual constituent elements where the party registering the collective work also owns the copyright in those constituent elements. May 4 Order at 15-20. The Court concluded, based on Section

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<sup>3</sup> Undersigned counsel understands that the Court has expressed a request that the briefs submitted by amicus curiae not make duplicative arguments. Accordingly, counsel for Corbis has communicated with counsel for amici PACA and the American Society of Media Photographers in an effort to minimize any duplication of arguments.

103(b) of the Copyright Act, that such a registration could never extend to the constituent parts of a collective work (that is, to the individual images included in the registration). *Id.* at 19-20. Although the May 4 Order distinguished a serial work registration from other collective work registrations (such as in automated databases), the Court’s interpretation of the possible scope of a collective work registration would logically apply to *all* collective registrations, and would logically mean that a serial registration can never extend to a constituent part of the serial (regardless of whether the owner of the serial copyright also owns all constituent parts at the time of registration). The Court should reconsider its reasoning that a collective work registration can never protect the individual elements.

**1. The Court’s Ruling Is Inconsistent With The Well-Established Rule, That Registration Of A Collective Work Extends To The Underlying Works Where The Owner Of The Copyright In The Collective Work Also Owns The Copyright In The Constituent Elements.**

As an initial and fundamental matter, the May 4 Order is contrary to the longstanding rule that copyright registration in a collective work extends to all constituent works when the owner of the copyright in the collective work also owns the copyrights in the constituent elements. In *Morris v. Business Concepts, Inc.*, 259 F.3d 65 (2d Cir. 2001), the Second Circuit was explicit that “[u]nder the law of this Circuit, where the *owner* of a copyright for a collective work also *owns* the copyright for a constituent part of that work, registration of the collective work is sufficient to permit an infringement action under §411(a) for the constituent part.” *Morris*, 259 F.3d at 68 (emphasis added). In its rehearing decision, the Second Circuit confirmed this rule, stating that “[i]f all rights have been transferred to the claimant, then the constituent work is included in the registration of the collective work.” *Morris v. Business Concepts*, 283 F.3d 502, 505 (2d Cir. 2002) (emphasis added); *see id.* at 506 (similar).

The May 4 Order incorrectly restricted this rule to apply only when the *author* of the collective work was also the *author* of the underlying works. *See* May 4 Order at 19-20. But the rule, as set out in *Morris* and numerous other decisions, is not so narrow. Certainly, the author of a work is, by operation of the Copyright Act, the initial owner of the copyright in that work. *See* 17 U.S.C. §201(a) (“Copyright in a work protected under this title vests initially in the author or authors of the work”). It should come as no surprise, then, that a common factual scenario before the courts is one in which the author is the copyright claimant as well as the owner of copyright in both the collective work and the underlying works. However, courts, recognizing the reality that authors often transfer ownership in their copyrights to another—who may then have rights in a collective work comprised of numerous underlying works—have consistently found that the rule is broader than just the “same author” situation assumed in the May 4 Order.<sup>4</sup>

Indeed, *Morris* itself makes clear that the Court erroneously limited this rule to circumstances where “the *author* of the collective work *authored* each of the individual works.” May 4 Order at 20 (emphasis added). There, *Morris* authored a series of articles for a column in a monthly publication. *Morris* did not transfer copyright in her articles to the publisher (Condé

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<sup>4</sup> *See, e.g., Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 747 (2d Cir. 1998) (registration of preexisting work sufficient for infringement action on derivative work when plaintiff was copyright owner of both); *Woods v. Universal City Studios, Inc.*, 920 F. Supp. 62, 64 (S.D.N.Y. 1996) (registration of copyright for collective work sufficient to permit action on constituent part when copyright owner was same for both); *Greenwich Film Prods. v. DRG Records, Inc.*, 833 F. Supp. 248, 251-52 (S.D.N.Y. 1993) (registration of motion picture extended to musical compositions contained on the soundtrack because copyright claimant was owner of both); *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 775 F. Supp. 544, 556-57 (E.D.N.Y. 1991), *aff'd in part and vacated in part on other grounds*, 982 F.2d 693 (2d Cir. 1992) (registration of derivative work—a computer program—was sufficient compliance with §411(a) to permit action for infringement of constituent work because registrant was “was the uncontested owner” of underlying work); *Howard v. Sterchi*, 725 F. Supp. 1572, 1574 (N.D. Ga. 1989) (“Perhaps a prudent author might obtain independent registrations for her derivative works in addition to a registration for the compilation containing them, but such a requirement is not mandated by the Act”), *aff'd*, 974 F.2d 1272 (11th Cir. 1992).

Nast), but instead granted it an exclusive license to print the articles. The publisher registered the publication as a whole, and Morris did not separately register the copyright in her articles. When Morris sought to sue a third party for infringement of her articles, the court held that her individual articles had not been registered as part of the publisher’s collective work registrations—because the publisher did not own the copyright in the individual article when it registered the copyright in the collective work. *Morris*, 259 F.3d at 71. But the Second Circuit was explicit that “if [Morris] can establish that Condé Nast owned the copyright in Morris’s articles at the time it registered the issues of *Allure* as collective works, then that registration was adequate to create subject matter jurisdiction pursuant to §411(a).” *Id.* at 69. Of course, Condé Nast was not and could not be the “author” of Morris’ article, only of the collective work in which the article appeared. Accordingly, there is no way to square the May 4 Order’s narrow interpretation of the scope of a collective work registration with the reasoning and holding of *Morris*.

Commentators are in accord that copyright registration of a collective work extends to any constituent works owned by the owner of the collective work. Nimmer explains that “[w]hen the same party owns the derivative or collective work plus the underlying elements incorporated therein, its registration of the former is ‘sufficient to permit an infringement action on the underlying parts, whether they be new or preexisting.’” NIMMER ON COPYRIGHT (“NIMMER”) §7.16[B][2][c] (*quoting Xoom v. Imageline, Inc.*, 323 F.3d 279, 283-84 (4th Cir. 2003)); *see In re Independent Serv. Orgs. Antitrust Litig.*, 964 F. Supp. 1469, 1473 (D. Kan. 1997) (“The leading commentator on copyright law and courts which have addressed this issue have stated that an owner of a registered copyright in a derivative work does not have to register separately the preexisting work before bringing an infringement action based on the derivative

work.”) (citing NIMMER). Similarly, Professor Goldstein explains that “[i]f the collective work copyright owner also owns the copyrights in constituent elements of the work, courts have allowed registration for the collective work to serve as registration for the constituent elements as well, at least for purposes of section 411(a)’s requirement of registration as a condition to suit.” GOLDSTEIN ON COPYRIGHT §3.15 (2005).

The Copyright Office also agrees that copyright registration in a collective work will extend to all constituent works when the owner of the copyright in the collective work also owns the copyrights in the constituent works. The *Compendium of Copyright Office Practices, Compendium II* (“*Compendium II*”) demonstrates the Copyright Office’s position on registration of collective works, and states that when “a collective work is being registered...[t]he registration may cover ... any other contributions *that the claimant of the collective work obtained by transfer.*” *Compendium II* §615.06 (emphasis added).

All these authorities are inconsistent with the reasoning of the May 4 Order that a collective registration can only extend to the underlying works when the underlying works and the constituent elements are *authored* by the same person. *See* May 4 Order at 19-20.

**2. The May 4 Order Did Not Offer Any Justified Basis For Treating Collective Works Registered As Automated Databases Differently From Other Collective Work Registrations.**

The Court should also reconsider its conclusion in the May 4 Order that the scope of registrations in automated databases should be applied differently from other collective registrations, such as for serials. *See* May 4 Order at 17-19. The Order suggests two reasons for this outcome, but neither supports the Court’s conclusion.

**a) Section 103(b) Of The Copyright Act Cannot Support The Court's Reasoning.**

The May 4 Order cited Section 103 of the Copyright Act as being inconsistent with “any argument that the registration of the automated databases, considered compilations, covers the individual works of the compilation” (May 4 Order at 19) because Section 103(b) states that “copyright in a compilation or derivative work extends only to the material contributed by the author.” 17 U.S.C. §103(b). There are two problems with this reliance on Section 103. The first is that if Section 103 means that the collective registration in an automated database cannot cover the individual works contained in the database, then Section 103 must also mean that a collective registration in a serial work cannot, as a matter of law, extend to the individual works constituting the serial. There is no principled way to apply the language of Section 103 to registration of an automated database, but not to registration of a serial work, such as a magazine or book of essays. The Court’s application of Section 103 is therefore contrary to the Second Circuit’s decision in *Morris v. Business Concepts, Inc.*, as well as the numerous other decisions cited above.

But Section 103 does not support the Court’s reasoning for another, more fundamental reason. Section 103(b) is part of Chapter One of the Copyright Act, which (aside from the definitions in Section 101) addresses only the creation and scope of copyrights, not the registration of copyrights. *See* 17 U.S.C. §§102-122. And by its terms, Section 103(b) refers only to the scope of *copyright*, as it states that “copyright in a compilation or derivative work extends only to the material contributed by the author.” 17 U.S.C. §103(b). The statute makes no reference to the scope of registration, and for good reason, as registration is governed by the separate provisions in Chapter Four of the Act. *See Christopher Phelps & Assocs., LLC v. Galloway*, 492 F.3d 532, 538 (4th Cir. 2007) (“a fundamental precept of copyright law [is] that a

copyright is independent of its registration.”); *see also* House Report on the Copyright Act of 1976, No. 94-1476, 94th Cong., 2d Sess. 153 (“It is important that the statutory provisions setting forth the subject matter of copyright be kept entirely separate from any classification of copyrightable works for practical administrative purposes.”).

Under the Copyright Act, a copyright is a right that arises automatically upon creation and fixation of the work. *See* 17 U.S.C. §102. Once fixation has taken place, the author owns a copyright in the work, and registration of that copyright with the Copyright Office only gives supplemental benefits. For example, registration provides evidence of the validity of a copyright (17 U.S.C. §410) and is prerequisite to bringing suit on a copyright (17 U.S.C. §411(a)). But “registration is not a condition of copyright protection.” 17 U.S.C. §408(a).

Given that copyright protection comes into existence with the creation of the work, Section 103(b) clarifies that copyright of a derivative work only covers the newly added material, as the copyright in any underlying preexisting works would have already come into existence by operation of Section 102 when those underlying works were first created and fixed. Section 103(b) therefore ensures that the author of a derivative work does not unfairly acquire a copyright over the underlying material, which *may* be owned by someone else or have already lapsed into the public domain. *Cf. In re Independent Serv. Orgs. Antitrust Litig.*, 964 F. Supp. 1469, 1473 (D. Kan. 1997) (noting with regard to Section 103(b) that “[t]he copyright statute does not address directly the distinction between preexisting material from other authors and preexisting material from the author of the derivative work”).

However, when the owner of the derivative work also owns copyrights in all the underlying works, this risk disappears, as the entire work (both newly added and preexisting elements) is owned by a single entity; there is then no possibility of commandeering the

copyright of another or pulling a work out of the public domain. It is therefore entirely consistent with Section 103(b) that while the *copyright* in a compilation work does not necessarily extend to the constituent parts, the *registration* of a compilation work can extend to the constituent parts—where the copyright in those parts is owned by the same person as the copyright in the compilation. And, in fact, Chapter Four of the Copyright Act explicitly contemplates “a single registration for a group of related works” and provides that the Register of Copyrights may promulgate regulations governing such registrations. 17 U.S.C. §408(c)(1).

For these reasons, Section 103(b) applies only to limit the *copyright* in a compilation work, and not to limit the scope of a *registration* of a compilation work. The Court should reconsider its conclusion that Section 103(b) circumscribes the scope of an automated database registration.

**b) There Is No Other Valid Basis For Treating The Scope Of Automated Database Registrations Differently From That Of Other Compilation Registrations, Such As Serials.**

As set out in the amicus brief of PACA, the fact that the collective work registrations at issue here are in the form of automated databases is a product of historical happenstance. These are modern day versions of catalogue updates, which could likely be considered serials except for their electronic form. The Court’s May 4 Order drew an unwarranted distinction between the registration of serials and of automated databases. *See* May 4 Order at 16. However, there is no principled reason for treating a registration for serials differently than other categories of collective work registrations, including automated databases.

As this Court recognized, “both serials and automated databases are considered collective works.” May 4 Order at 19; *see Corsearch, Inc. v. Thomson & Thomson*, 792 F. Supp. 305, 322 (S.D.N.Y. 1992) (databases may be copyrightable compilations). In articulating the general rule that registration of a collective work extends to constituent works owned by the same owner as



the collective work registration, courts have *not* included any limitation on the type of collective work. Rather, courts have applied this rule to a wide range of collective works, including serials, drawings, maps, motion pictures and soundtracks, architectural plan books, computer software and manuals, and databases.<sup>5</sup>

Indeed, no decision concerning a collective registration (other than the May 4 Order) has suggested that whether or not registration of a collective work can extend to the underlying works depends on the type of collective work at issue. To the contrary, in *Xoom v. Imageline, Inc.*, 323 F.3d 279 (4th Cir. 2003), the Fourth Circuit explicitly applied this rule to database registrations. There, the copyright holder (Imageline) had acquired clip art images from another company and included those images, along with a number of other images which Imageline authored, in two databases which it sold on compact disc. Imageline only registered the databases, and did not individually register the underlying images. Citing *Morris* and other decisions, the *Xoom* court held that “because Imageline owned copyright in [the two databases] and in the underlying works of each, its registration of [the databases] was sufficient to permit an infringement action on the underlying parts, whether they be new or preexisting.” *Xoom*, 323 F.3d. at 284; *see id.* (“If Xoom improperly used *any* copyrightable image contained in [the two databases], new or preexisting, that usage would give rise to potential statutory damages”) (emphasis in original).

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<sup>5</sup> See *Morris v. Business Concepts, Inc.*, 259 F.3d 65 (2d Cir. 2001) (serials); *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 747 (2d Cir. 1998) (maps); *Woods v. Universal City Studios, Inc.*, 920 F. Supp. 62, 64 (S.D.N.Y. 1996) (pencil drawing); *Greenwich Film Prods. v. DRG Records, Inc.*, 833 F. Supp. 248, 251-52 (S.D.N.Y. 1993) (motion picture and its soundtrack); *Xoom v. Imageline, Inc.*, 323 F.3d 279, 283-84 (4th Cir. 2003) (databases comprised of images); *Bean v McDougal Little, et al.*, 669 F. Supp. 2d 1031 (D. Ariz. 2008) (applying the rule to the same automated databases at issue here).

In its May 4 Order, the Court brushed aside this general rule and declined to follow *Bean v. McDougal Littell*, 669 F. Supp. 2d 1031 (D. Ariz. 2008), which had applied the rule to the exact same kind of automated database registrations as at issue here, because “the *Bean* court never explained why the registration of an automated database should be governed by the same rules that apply to the registration of serials.” May 4 Order at 18. But the *Bean* court was not required to provide such an explanation, because the established rule applies to *all* collective works registrations under the authorities cited above.

The only other authority cited by the Court to support its unwarranted distinction between serials and automated databases was a difference between Copyright Office Circular 62, which govern serials, and Circular 65, which govern automated databases. May 4 Order at 19. However, for the reasons set out in ASMP’s amicus brief, any difference in the language of the two circulars cannot support the weight the Court placed upon it. Notably, Section 408(c)(1) of the Copyright Act specifies that the “administration classification of works [adopted by the Copyright Office] has no significance with respect to the subject matter of copyright or the exclusive rights provided by this title,” so it is not clear why the different categories of registrations developed by the Office could or should lead to the dramatically different substantive rights created by the May 4 Order.<sup>6</sup>

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<sup>6</sup> While Circular 65 does not specifically state that the registration in an automated database will extend to the independently contributed works if all of the rights in the work are owned by the claimant to the automated database copyright, that is precisely what the Copyright Office has said elsewhere. *See Compendium II* §615.06; Declaration of Nancy E. Wolff at Ex. 2 (Petruzzelli Letter). Moreover, it is not clear why the absence of such a statement in Circular 65 should drive the Court’s analysis, given that the *Morris* court stressed—in considering this precise statement in Circular 62—that while it found the Copyright Office’s interpretation “persuasive,” it was not giving particular deference to the Office’s position on this point. *Morris*, 283 F.3d at 505.

**B. The Court’s Rigid Application Of Section 409 Should Be Reconsidered In Light Of The Liberal Requirements Of Section 411(b).**

As set out in the amicus brief of PACA, the language of Section 409 and the purposes of the Copyright Act do not support the rigid approach taken in the Court’s May 4 Order.

However, even if the Court’s ruling on Section 409 stands, Section 411(b) of the Act requires that the registrations here be upheld as to the individual images included in the registrations. The May 4, 2010 Order did not mention the statute, which should be applied on reconsideration.

**1. Immaterial And Innocent Omissions On A Copyright Application Do Not Invalidate A Registration Under Section 411(b).**

Section 411(b), enacted in October 2008, states in pertinent part:

A certificate of registration satisfies the requirements of this section and section 412, regardless of whether the certificate contains any inaccurate information, unless— (A) the inaccurate information was included on the application for copyright registration with knowledge that it was inaccurate; and (B) the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration.

17 U.S.C. §411(b)(1). Accordingly, omission of certain information (or, conversely, inclusion of erroneous information) does not render a registration incapable of supporting an action for infringement unless two criteria are both met: (a) the error was made knowingly, *and* (b) the error was material to whether the Copyright Office would otherwise grant the application.

The legislative history of Section 411(b) confirms that its purpose is to prevent infringers from taking unfair advantage of innocent registration mistakes:

While copyright registration benefits the public, it was never intended as a way for copyright pirates to evade prosecution . . . . It has also been argued in litigation that a mistake in the registration documents, such as checking the wrong box on the registration form, renders a registration invalid and thus forecloses the availability of statutory damages. To prevent intellectual property thieves from exploiting this potential loophole, the Act makes clear that a registration containing inaccuracies will satisfy the registration requirements of the Copyright Act unless the mistake was knowingly made and the inaccuracy, if known, would have caused the Register of Copyrights to refuse the registration.

H.R. Rep. 110-617, p. 24 (May 5, 2008) (citation omitted). This recent statute, therefore, was intended *precisely* to stop the growing and disturbing trend of allowing defendants such as those here from taking unfair advantage of purported errors in the registration process in order to escape liability for infringing the copyrights of others.

Portions of Section 411(b) appear to be a codification of the earlier “innocent error rule.”<sup>7</sup> See NIMMER §7.20[B][2]. The innocent error rule, applied by courts under both the 1909 and the 1976 Copyright Acts, is a principle of leniency that “a misstatement or clerical error in the registration application, if unaccompanied by fraud, should neither invalidate the copyright nor render the registration certificate incapable of supporting an infringement action.” *Id.* §7.20[B][1] & n.19 (citing cases). In *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984), the leading Second Circuit case interpreting this rule, the court found that a plaintiff’s failure to complete several portions of the copyright registration form was innocent and inadvertent. In concluding that the registration was valid, the court noted: “only the knowing failure to advise the Copyright Office of facts which might have occasioned a rejection of the application constitutes reason for holding the registration invalid.” 736 F.2d at 861-62.

Notably, several courts have concluded that where an error or omission has been caused because the copyright registrant was attempting to follow ultimately erroneous instructions given by the Copyright Office, the innocent error rule should allow enforcement of the registration. See *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 828 (11th Cir. 1982);

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<sup>7</sup> The few cases that have applied Section 411(b) since its recent enactment have each cited to earlier case law applying the innocent error rule. See *Bird Barrier America, Inc. v. Bird-B-Gone, Inc.*, No. 09-CV-0418, 2009 U.S. Dist. LEXIS 125475 at \*10-12 (C.D. Cal. March 1, 2009); *St. Luke’s Cataract & Laser Institute, P.A.*, 573 F.3d 1186, 1201-02 (11th Cir. 2009); *Pegasus Imaging Corp. v. AllScripts Healthcare Solutions, Inc.*, No. 8:08-CV-1770, 2010 U.S. Dist. LEXIS 15147 at \*26 (M.D. Fla. Feb. 9, 2010) (citing *St. Luke’s*).

*DBT Group, Inc. v. FMC Corp.*, 61 U.S.P.Q. (BNA) 1692 (N.D. Ill. 2001). Moreover, courts have routinely enforced registrations even where the names of an author or authors have been omitted or incorrectly identified on an application for registration. For example, the defendant in *Shady Records, Inc. v. Source Enterprises, Inc.*, 73 U.S.P.Q.2d (BNA) 1954 (S.D.N.Y. 2005), contended the plaintiff failed to include co-authors of a song on the registration application. The court held that even if the other individuals were co-authors of the work (and therefore should have been listed on the application), the omission of their names

would not have been material to the Copyright Office's disposition of the application, and therefore, as a matter of law, they do not invalidate Shady's copyright. Material facts on a copyright registration application are those which go toward the registrability of the materials themselves, such as originality, the nature of materials to be copyrighted, and contested claims of authorship and ownership.

*Id.* at 1966 (citations omitted). Similarly, another judge of this Court recently upheld as valid a registration fraught with numerous errors, including an erroneous author name. *R.F.M.A.S., Inc. v. Mimi So*, 619 F. Supp. 2d 39 (S.D.N.Y. 2009). Not only did the copyright registrant in *R.F.M.A.S.* incorrectly identify the author of the work, but the registrant also made errors as to the work-for-hire designation, nationality of the author, creation year, nation of publication, date of publication, and transfer information—yet the registration was still found sufficient for suit to proceed. *Id.* at 53. Numerous other decisions are in accord.<sup>8</sup>

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<sup>8</sup> See, e.g., *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821 (11th Cir. 1982) (omission of a co-author name without an intent to mislead did not render a registration invalid); *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 412 (2d Cir. 1970) (where copyright registrant incorrectly identified an author on application, error could not have affected the action that was ultimately taken by the Copyright Office and so did not invalidate the registration); *Morelli v. Tiffany and Co.*, 186 F. Supp. 2d 563, 566 (E.D. Pa. 2002) (error as to author name “could not have affected the action taken by the Copyright Office”); *Testa v. Janssen*, 492 F. Supp. 198, 201 (W.D. Pa. 1980) (inaccuracies as to authorship are immaterial and “in not way affects the validity of plaintiffs’ copyright”); *Urantia Foundation v. Burton*, No. K (continued...)

**2. The Errors in the Registrations At Issue Here Were Made Innocently, As Required by Section 411(b).**

Any errors by Corbis in submitting these registration applications present a textbook case of an innocent mistake, and could not possibly be knowing, as required by Section 411(b)(1)(A). Corbis had an objective good faith belief that it was complying with appropriate statutes and regulations by including the names of only three contributors on the applications for registrations of its automated database updates because Corbis, through PACA, had received affirmative guidance from the Copyright Office that the way in which the applications for registration at issue in this case were completed was appropriate. Corbis separately received advice on multiple occasions from Copyright Office personnel instructing Corbis how to register its images. The instructions for listing three authors are included in both the *Compendium II* and in communications from the Copyright Office to PACA and to Corbis. Corbis followed the precise

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75-255, 1980 U.S. Dist. LEXIS 16302 at \*10, 210 U.S.P.Q. (BNA) 217 (W.D. Mich. 1980) (“the copyright remains valid so long as the claimant has a legitimate claim of copyright, regardless of who is the actual author”).

Other sometimes more egregious and numerous errors have been forgiven under the innocent error rule. In *The Mortgage Market Guide v. Freedman Report*, No. 06-CV-140-FLW, 2008 U.S. Dist. LEXIS 56871 (D.N.J. July 28, 2008), for example, the plaintiff committed multiple errors in its original application, including failing to state the title of the work, failing to identify the correct publication date of the work, and failing to deposit copies of the work. *Id.* at \* 49. The court nevertheless held that the registration was enforceable. *Id.* at \*2. In *Gund v. Swank*, 673 F. Supp. 1233 (S.D.N.Y. 1987), another judge of this Court held that a copyright registration was valid even though the original registration included an erroneous year of creation and failed to identify the work in question as a derivative work. *Id.* at 1237.

While the May 4 Order relied on the discussion of the innocent error rule in *Morris v. Business Concepts, Inc.* (see May 4 Order at 23), that case was decided before the strict requirements of Section 411(b) were enacted. Moreover, as discussed above, *Morris* presented a very different situation where the collective work claimant *could not* register the copyrights in the constituent elements, as ownership in them had not been transferred. Whereas in *Morris* there was no evidence Condé Nast had sought to register the copyright in the underlying elements, here there is every reason to conclude that Corbis intended to register both the collective work and the constituent images. *Cf. Morris*, 259 F.3d at 72.

instructions of the Copyright Office in registering these copyrights and believed that it was accurately presenting the registrations to the Office for consideration.

Indeed, the Court's May 4 Order acknowledged that the registrations here had been submitted based on the Copyright Office's instructions (*see* May 4 Order at 23-24), but then did not consider this fact in light of Section 411(b). The statute, however, requires that the incorrect submission be made "with knowledge that it was inaccurate." 17 U.S.C. §411(b)(1)(A). There is simply no basis for the Court to conclude that Corbis' actions rise to the level of a knowing mistake, as required by Section 411(b)(1).

**3. Any Errors Or Omissions In The Registrations At Issue, If Corrected, Would Not Have Caused The Copyright Office To Refuse the Registrations.**

Section 411(b) also requires that a defective registration satisfies the requirements of Sections 411 and 412 *unless* the defect in the registration application "if known, would have caused the Register of Copyrights to refuse registration." 17 U.S.C. §411(b)(1)(B).

The record demonstrates that the Copyright Office in fact knew that Corbis had not included in its applications the names of all the authors of individual photographs in its automated database registrations—because the Copyright Office helped to develop the very procedure that PACA members such as Corbis ultimately used in registering these copyrights and repeatedly advised Corbis to follow the procedure developed with PACA in registering images. The Copyright Office therefore knew that all the contributors of individual images had not been listed on the applications—and yet the Office registered the copyrights anyway. It therefore follows that, had Corbis provided to the Copyright Office the information this Court has now held is required, the Copyright Office would not have refused the applications. Indeed, as evidenced by the cases cited above, the names of authors are not germane to the

copyrightability of the images at issue and could not be facts that would cause the Copyright Office to reject a registration application.

**4. Section 411(b) Requires That This Court First Seek The Advice Of The Copyright Office Before Finding The Registrations Ineffective.**

Finally, Section 411(b)(2) requires that “[i]n any case in which inaccurate information described under paragraph (1) is alleged, the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.” 17 U.S.C. §411(b)(2). The Court therefore could not find these registrations ineffective based on Section 409 without first seeking the advice of the Copyright Office on whether the inaccurate information (here, the omission of the Muench authors’ names) would have caused the Register of Copyrights to refuse registration.<sup>9</sup> As a matter of law, based on the undisputed facts before the Court, the omission of some authors’ names could not be material to whether the Copyright Office would have approved these registrations; had there been any question on this issue, however, the Court was required to seek advice from the Office to resolve the question.

**III. CONCLUSION**

For the foregoing reasons, Corbis respectfully suggests that the Court reconsider its May 4 Order and recognize that (a) a collective work registration may extend to protect the copyright in constituent elements that are owned by the same copyright claimant as the collective work itself, and (b) Section 411(b) requires that the collective work registrations at issue in this case

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<sup>9</sup> The Court did ask the Copyright Office to submit a statement of interest, but only to clarify the Office’s position as to whether automated database registrations effected the registration of independently authored works in the databases. *See* Dkt. No. 22. No request was made for the Copyright Office to offer its assessment of whether it would have refused these registrations had it known of the omission of the author names.



extend to protect the images of individual contributors included in those registrations for purposes of Sections 411 and 412, whether or not the contributors' names are listed on the registration applications.

Dated: New York, New York  
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Respectfully,

COVINGTON & BURLING LLP

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