

COPYRIGHT PUBLICATION ON THE INTERNET

Deborah R. Gerhardt[†]

INTRODUCTION

This Article tackles the important question of when a work distributed over the Internet is published as a matter of copyright law. Copyright publication doctrine retains significant practical importance and can have a dispositive impact on the economic value of a work or whether a court has jurisdiction over a copyright claim. For many twentieth century works, publication with observance of formalities was required if copyrights were to attach to creative works at all.¹ Publication remains relevant in determining the length of copyright protection, but duration is far from the only copyright issue that turns on this concept. The federal copyright act repeatedly references publication for many other purposes as well. As the works of the twentieth century enter the public domain, the issue of copyright publication will fade from importance for purposes of duration analysis, and the relative impact of the doctrine will be experienced more forcefully with respect to other issues. Therefore, it is time for research on the copyright publication doctrine to shift its focus.

Practical decisions about copyright publication must be decided by everyone trying to optimize creative rights. Every time authors, musicians,

[†] Deborah R. Gerhardt is an Associate Professor of Law at the University of North Carolina School of Law. I am grateful to Ann Bartow, Jim Gibson, Alfred Chueh-Chin Yen and other participants at the 2019 University of New Hampshire Redux Conference and the 2019 Intellectual Property Scholars Conference. I am also grateful to R. Taylor Townes for excellent research assistance.

¹ For those seeking clarity on this question, I conducted an empirical study to identify the variables that lead courts to determine whether a work is published. Both focus primarily on duration. The first of two articles, *Copyright Publication: An Empirical Study*, reviews over a century of copyright publication decisions decided between 1849 and 2009 and provides an overview of how publication doctrine affects many significant issues in copyright law. Deborah R. Gerhardt, *Copyright Publication: An Empirical Study*, 87 NOTRE DAME L. REV. 135 (2011). It explains how the meaning of copyright publication affects a variety of different copyright issues including the citizenship of the author, the duration of the copyright term, the availability of statutory damages, infringement and fair use. The second piece, *Copyright at the Museum: Using the Publication Doctrine to Free Art and History*, focuses on how copyright publication determines whether original art, documents, photographs and other cultural treasures are in the public domain. Both studies provide clarity on how courts analyze the publication doctrine and how practitioners should apply it to determine whether works have entered the public domain.

comedians, advertising agencies, artists, software engineers and corporations apply to register a copyright, they must specify if and when each work was published.² Pinpointing the moment of copyright publication also remains significant because it triggers the availability of statutory damages and attorney's fees.³ Consequently, the date of publication significantly impacts the economic value of every copyrighted work.

Because so many works are distributed on the Internet, it is important to understand when such distribution constitutes publication. Unfortunately, copyright law can appear hopelessly unclear on this issue. The federal statutory definition of publication was enacted in 1976, before the Internet existed, and therefore does not address online distribution. The Copyright Office guidelines raise the question without answering it.⁴ Judicial efforts to clarify the issue are a mixed bag of conflicting interpretations. This piece provides needed clarity on the issue of when Internet distribution constitutes publication.

Part I begins by summarizing the copyright publication doctrine and explaining the roots of the doctrine's ambiguities. Part II seeks to reframe perception of the doctrine as one related primarily to the duration of twentieth century works. Year by year, works dependent on the publication doctrine for their duration are entering the public domain. As publication fades from importance for duration purposes, its import is increasing for other purposes, such as the availability of statutory damages and attorney's fees, the validity of registrations, country of origin, and fair use. Part III focuses on the question of copyright publication on the Internet and explains why this issue creates repeated daily challenges for applicants seeking to register their works. Recent decisions provide conflicting authority on whether online sharing constitutes publication. This Part reviews those decisions and provides a principled basis on which the ambiguity can be resolved. Part IV sets forth a standard for determining whether an online distribution constitutes publication for copyright purposes. While the proposed standard does not answer this fact-based question for all scenarios, it gives a much-needed framework for determining whether the publication question can be answered as a question of law, and if not, where the factual inquiry should focus. The Article concludes with an appeal to the U.S. Copyright Office, treatise writers and other leading copyright voices to apply the proposed standard and share it

² 17 U.S.C. § 409(8) (2012).

³ *See Id.* § 412.

⁴ Copyright Office, *Circular 66: Copyright Registration for Online Works*, p. 3; *see also Compendium II: Copyright Office Practices*, § 904(1).

with those seeking to register copyrights in creative work in order to clarify the recurrent issue of copyright publication whenever possible.

I. AMBIGUITIES LATENT IN COPYRIGHT PUBLICATION DOCTRINE

Copyright was conceived for textual works sold in hard printed copies.⁵ The first U.S. copyright statute applied only to books, maps, and charts.⁶ It was then extended to visual works of fine art and sheet music.⁷ Later, protection was expanded to sound recordings and architectural works.⁸ Before passage of the 1976 Act, publication marked the beginning of protection.⁹ Even before the Internet further complicated publication issues, the definition created all kinds of doctrinal ambiguity.¹⁰ In deciding whether Martin Luther King Jr.'s widely publicized "I Have a Dream" speech was published and therefore in the public domain, the Court of Appeals for the Eleventh Circuit observed that "publication is a legal word of art, denoting a process much more esoteric than is suggested by the lay definition of the term."¹¹ There were, however, two points of clarity. Multiple sales of authorized copies were clearly deemed publication.¹² Mere display or performance, with no distribution of any hard copy version of the work, did

⁵ Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, 124 (repealed 1831) ("An Act for the encouragement of learning, by securing the copies of maps, Charts, And books, to the authors and proprietors of such copies . . .")

⁶ *Id.*

⁷ Act of Feb. 3, 1831, ch. 16, § 2, 4 Stat. 436, 436 (repealed 1870).

⁸ Act of Oct. 15, 1971, Pub. L. No. 92-140, 85 Stat. 391, 391 (adding copyrights "To reproduce and distribute to the public by sale or other transfer of ownership, or by rental, lease, or lending, reproductions of the copyrighted work if it be a sound recording"); Act of Dec. 1, 1990, Pub. L. No. 101-650, 104 Stat. 5089, 5133 (adding "architectural works" to copyright subject matter under section 102(a) of title 17, United States Code).

⁹ *Acad. of Motion Picture Arts & Scis. v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1452 (9th Cir. 1991); *Letter Edged in Black Press, Inc. v. Public Bldg. Comm'n of Chicago*, 320 F. Supp. 1303, 1308 (N.D. Ill. 1970); See 17 U.S.C. § 302(a) ("Copyright in a work created on or after January 1, 1978, subsists from its creation . . .").

¹⁰ See *Werckmeister v. Am. Lithographic Co.*, 134 F. 321, 324 (2d Cir. 1904) ("Publication of a subject of copyright is effected by its communication of dedication to the public. Such a publication is what is known as a 'general publication.' There may be also a 'limited publication.' The use of the word 'publication' in these two senses is unfortunate and has led to much confusion."); Thomas F. Cotter, *Toward a Function Definition of Publication in Copyright Law*, 92 MINN. L. REV. 1724, 1770 (2008) ("[T]he meaning of publication remains, in many circumstances, fuzzy").

¹¹ *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 194 F.3d 1211, 1214 n. 3 (11th Cir.1999). For a more in-depth discussion of the other two decisions deciding whether this speech was in the public domain as well as the underlying facts, see Deborah R. Gerhardt, *Copyright Publication: An Empirical Study*, 87 NOTRE DAME L. REV. 135, 143-5 (2011).

¹² 17 U.S.C. § 101; 1 Melville B. Nimmer & David Nimmer, NIMMER ON COPYRIGHT § 4.03[A] at 4-24 (2011).

not amount to publication.¹³ Any factual scenario that did not fit neatly into one of those two extremes was not easily resolved.¹⁴ Mark Twain once wrote that, “Only one thing is impossible for God: to find any sense in any copyright law on the planet.”¹⁵ The publication doctrine reflects the frustration many experience in trying to make practical sense of copyright law.

In the 1976 Copyright Act, Congress attempted to clarify the doctrine developed by courts, defining publication as:

*the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.*¹⁶

One complexity inherent in the definition is that many of its terms have defined meanings particular to copyright law. All of the italicized terms in the definition reprinted above are also defined by the 1976 Copyright Act and further interpreted by federal courts and the U.S. Copyright Office.¹⁷ As if this mesh of overlapping defined terms weren’t enough, judicial interpretations of the definition created additional complexities.

The definition had some gaping holes that courts had to fill. For example, section 101 did not clarify whether distribution by someone other than the copyright owner would result in publication. That left open the

¹³ 17 U.S.C. § 101 (defining “copies,” “phonorecords,” “public display,” “public performance,” “transfer of ownership” and “works.”)

¹⁴ *McLaren v. Chico's FAS, Inc.*, No. 10 CIV. 2481 JSR, 2010 WL 4615772, at *4 (S.D.N.Y. Nov. 9, 2010) (holding that the “claim that images composing [Plaintiff’s] Collection were posted on her website would not in any event suffice to plead ‘publication.’” as a matter of law); *Rogers v. Better Bus. Bureau of Metro. Houston, Inc.*, 887 F. Supp. 2d 722, 733 (S.D. Tex. 2012) (“... the court cannot hold, as a matter of law, that the webpages were published unless public distribution occurred. The court’s finding with regard to Defendant’s failure to prove as a matter of law that posting the webpages on [a] . . . website constituted a distribution at all, rendering the issue of selling or licensing immaterial.”); *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 197 (S.D.N.Y. 2006) (“Making the work available [by posting it on the Internet], even assuming it constituted ‘distribution,’ did not involve ‘sale or other transfer of ownership, or by rental, lease or lending.’”).

¹⁵ Mark Twain, *MARK TWAIN’S NOTEBOOK*, 381 (Albert Bigelow Paine, ed., Harper & Brothers 1st ed., 1935).

¹⁶ 17 U.S.C. § 101.

¹⁷ *Id.*

questions of whether (and if so, under what circumstances) an unauthorized use or distribution can result in publication of a copyrighted work. Such questions resulted in complex balancing of many variables.

Even in places where the statute is crystal clear, judicial interpretations muddied its impact. The statute states that publication occurs when one merely “offers to distribute” copies.¹⁸ Literal application of this portion of the definition might have resulted in publication of all works made available to the public if the work was deposited in any kind of public archive. This plain meaning suggested by the statute was ignored by many federal courts, creating a conflict between the words of the statute and many judicial interpretations.

Part of the problem resulted from an omission that could have been foreseen. If Congress intended to hold a mirror to the judicially created publication doctrine,¹⁹ it did so only in part; as its definition failed to address whether publication included or excluded a discrete “limited publication” to a particular person for a specific purpose, without the right of distribution to the public, amounted to publication. The statute seemed to suggest all such distributions may be publications because even a rental, lease, or loan was now a publication. If courts had applied the plain language of the definition in this way, there would have been a clear rule. All temporary transfers of ownership, in the form of rental, lease, lending, or licensing would amount to publication. Instead courts doubled down on the limited publication doctrine creating a conflict with the plain meaning of the statute.

Before 1976, all authors who published their works without affixing a copyright notice lost their copyrights upon publication.²⁰ The harsh consequences of the statute fed the public domain, but also resulted many unwary authors unintentionally losing their copyrights.²¹ In an effort to

¹⁸ *Id.*

¹⁹ Cotter, *supra* note 9 at 1771 (“[The 1976 Act’s] definition [of publication] is said to largely track the meaning of the term as developed in the pre-1976 case law.”); W. Russel Taber, *Copyright Déjà Vu: A New Definition of “Publication” Under the Copyright Act of 1909*, 58 VAND. L. REV. 857, 875 (2005) (“[The 1976 Act’s] definition [of publication] is generally considered a codification of common law.”); 1 Nimmer & Nimmer, *supra* note 10, § 4.03 (“[T]he 1976 definition [of publication] has been held to constitute a codification of the definition evolved by case law prior to adoption of the current act.”).

²⁰ In the 1976 Act, Congress softened the consequences, and created the ability to cure a deficient notice, and did away with the notice requirement completely when the copyright statute was revised to comply with the Berne treaty in 1989; *See* 17 U.S.C. § 405(a).

²¹ *See* Act of Mar. 4, 1909, ch. 320, § 9, 35 Stat. 1075, 1077 (repealed 1976) (providing “[a]ny person entitled thereto by this Act may secure copyright for his work by

minimize the harsh consequences of the formality requirements, courts developed the doctrine of limited publication.²² If a work was distributed only to a discrete group of people for a limited purpose by means that did not permit further distribution to the public, such a “limited publication” did not divest a claimant of his or her copyright.²³ Broader distributions to the public, deemed “general publication” were still equated with publication, but a work distributed in a “limited publication” was treated as though it had not been published at all.²⁴ Development of this paternalistic doctrine

publication thereof with the notice of copyright required by this Act; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor”); *See* 17 U.S.C. § 102 (2012) (expanding copyright protection to “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated”); *See* 17 U.S.C. § 106 (bestowing unto the copyright owner the exclusive rights to “reproduce the copyright work,” “prepare derivative works based upon the copyrighted work,” “distribute copies . . . to the public,” “perform the copyrighted work publicly,” “display the copyrighted work publicly,” and to “perform the copyrighted work publicly by means of digital audio transmission” in the case of a sound recording); *See* 17 U.S.C. § 302(a) (extending copyright term to the “life of the author and 70 years after the author’s death”); *See Righting Copyright*, TIME MAGAZINE, Nov. 1, 1976, at 82 (“All in all,’ says Barbara Ringer, the U.S. Register of Copyrights, [the Copyright Act of 1976] ‘is a balanced compromise that comes down on the authors’ and creators’ side in almost every instance.’”).

²² *See Ladd v. Oxnard*, 75 F. 703, 731 (C.C.D. Mass. 1896) (“The determinations of various courts that, under some circumstances, the delivery of lectures, or the representation of plays, to such of the public as may attend, do not constitute publication, must be regarded as rather of an incidental character, arising undoubtedly to some extent from tenderness for authors, and not establishing any general rule.”); *Keene v. Wheatley*, 14 F. Cas. 180, 199 (C.C.E.D. Pa. 1861) (No. 7,664) (“A limited publication of it is an act which communicates a knowledge of the contents to a select few, upon conditions expressly or impliedly precluding its rightful ulterior communication, except in restricted private intercourse.”); *See* Jane C. Ginsburg, *The U.S. Experience with Mandatory Copyright Formalities*, 33 COLUM. J.L. & ARTS 311, 323 (“‘Unpublished,’ however, did not mean unexploited or undivulged. Public performance of a work did not ‘publish’ it, and therefore did not subject it to formalities, even if the performed work had been widely seen. Borrowing from old English decisions holding that a public performance was not a ‘publication,’ U.S. courts elaborated a parallel universe of ‘unpublished’ works. The rather strained notion of publication was motivated in large part by courts’ awareness that, were the work to be deemed ‘published,’ and had the author not complied with all applicable federal statutory formalities, the work would go into the public domain, and all protection, state or federal, would be lost.” (citations omitted)).

²³ *White v. Kimmel*, 193 F.2d 744, 746-47 (9th Cir. 1952) (Limited publication “communicates the contents of a [work] ... to a definitely selected group and for a limited purpose, and without the right of diffusion, reproduction, distribution or sale ... [and] does not result in loss of the author's common-law right to his [work] [T]he circulation must be restricted both as to persons and purpose, or it cannot be called a private or limited publication.”).

²⁴ *Id.*

was designed to protect authors and artists from the harsh consequences of the formality requirements, which it did.²⁵ But it further complicated the publication doctrine, defanging some portions of the statute and pulling many works back from falling into the public domain.

The limited publication doctrine resulted in precedent that contradicted the plain language of the statutory definition. The distribution of feature films provides one example. Before digital distribution, studios would send theaters a hard copy of a film with the requirement that the work be returned after the run.²⁶ According to the statute, one might conclude that such a distribution amounts to publication. This result would not be due to the public showing of the film in theaters because the statute unambiguously states that public performance is not publication.²⁷ However, the statute also states that “rental, lease or loan” or “transfer ownership” amounts to publication.²⁸ Based on this language, the studio’s temporary transfer of film reels to movie houses would amount to publication. And if the studio failed to affix a copyright notice, those films would be part of the public domain. Given the clear statutory implications of this fact pattern, courts devised the “limited publication” doctrine to soften the effects of the statute and save these works from the consequences of inadvertent publication.²⁹ The contradictory signals from the statute and the case law, not uncommon in copyright law, added to the publication doctrine’s lack of clarity.

²⁵ See *Am. Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1026-27 (9th Cir. 1981) (“Case law has created a distinction between general and limited publication, holding that only the former operates to divest common law copyright and subject a work to the federal statutory scheme.”); Theresa Gue, *Triggering Infection: Distribution and Derivative Works Under the Gnu General Public License*, 110 UNIV. OF ILL. J. OF L., TECH. & POL’Y 95 (2012) (“If [an author] published a work without proper notice, he lost both common law and federal copyright protection, and the work was placed into the public domain. Courts differentiated between limited publication and general publication in order to mitigate the harshness of this rule.”)

²⁶ See *Am. Vitagraph, Inc.*, 658 F.2d at 1025 (“In December of 1975 Vitagraph delivered to Levy a print of their initial version of the film . . . That print was screened to the public for one week . . . and subsequently returned to Vitagraph for additional editing.”)

²⁷ 17 U.S.C. § 101.

²⁸ *Id.*

²⁹ *Soc’y of the Holy Transfiguration Monastery v. Gregory*, 689 F.3d 29, 44-46 (1st Cir. 2012) (holding that distribution of translations of religious texts to other parishes for use in worship and for editorial feedback was limited publication); *Am. Vitagraph*, 659 F.2d at 1027-28 (holding that a temporarily screening of a film reel for the purposes of audience feedback followed by the theater returning the reel was limited publication); *Swatch Grp. Mgmt. Servs., Ltd. v. Bloomberg L.P.*, 756 F.3d 53, 87-89 (2d Cir. 2014) (holding that a recording of a conference call between a corporation’s management and 132 invited analysts was statutorily unpublished).

The complexities only worsen in the age of the Internet. If distribution in cyberspace merely constitutes a public performance or display, it will not be considered publication. Under this portion of the definition, works distributed over the Internet may still be unpublished. However, if the Internet permits anyone to access copies or phonorecords of the work, the copyright owner who posts a work online is providing the public with access to copies, and therefore, the statutory definition indicates that the work has been published.

II. THE ENDURING SIGNIFICANCE OF COPYRIGHT PUBLICATION

Some may question whether publication remains worthy of attention for contemporary works. Any work created after 1989 is not vulnerable to losing its copyright protection through publication without a properly constructed copyright notice.³⁰ Nonetheless, copyright publication remains critically significant at multiple moments in the life of a copyrighted work. As more distributions occur in cyberspace, determining whether Internet dissemination amounts to publication retains practical significance for many issues tied to the economic value of creative works.

Pinpointing the moment of copyright publication is a practical necessity for everyone seeking to secure copyright. Hundreds of thousands of copyright registration applications are filed each year. Although the U.S. Copyright office does not provide access to bulk data as the U.S. Patent and Trademark Office does, Dotan Oliar, Nathaniel Patteson, and K. Ross Powell collected five years of data, and found that 2.3 million copyright registrations were granted between 2008 to 2012.³¹ For U.S. authors, registration is required before a federal court has jurisdiction to decide an infringement claim.³²

An understanding of publication is necessary to register a work because publication is one of the questions of fact that must be entered on each application.³³ For example, a photographer may save on filing fees by registering a group of works for \$55 instead of paying \$35 to register each

³⁰ 17 U.S.C. § 405(a).

³¹ Dotan Oliar, Nathaniel Patteson, & K. Ross Powell, *Copyright Registrations: Who What When Where and Why*, 92 TEX. L. REV. 2211, 2213 (2014).

³² See 17 U.S.C. § 411(b); *Reed Elsevier, Inc. v. Muchnik*, 130 S. Ct. 1237, 1241 (2010); *PRC Realty, Sys., Inc. v. Nat'l. Ass'n of Realtors, Inc.*, 766 F. Supp. 453, 461 (E.D. Va. 1991) (“The registration is, after all, merely the plaintiff’s ‘ticket’ to court; the protection of the copyright arises at the time of the creation of the work.”).

³³ See 17 U.S.C. § 409(8).

work.³⁴ In order to do so, all photos in the group must have identical publication data. They must all be either published or unpublished—and if published, they all must have been published in the same calendar year.³⁵

Given the importance of publication to the registration process, one might expect the Copyright Office to give applicants meaningful guidance on whether internet distribution constitutes publication. Unfortunately, the Copyright Office does not currently provide this service. Instead, it continues its “long-standing practice” of leaving it up to “the applicant, who knows the facts surrounding distribution of copies of a work, to determine whether the work is published or not.”³⁶ If anything in the statement of facts contradicts a publication conclusion in the Application, the Copyright Office will not register the work.³⁷ Mistakes often pass through the ministerial copyright registration process and can come back to haunt authors later.

This practice would not be problematic if the publication doctrine tracked the lay understanding of the word. The copyright meaning of publication is counterintuitive in many respects. Copyright publication does not occur each time the public gains access to a work. Public performance and display are expressly excluded from amounting to publication. Conversely, relatively private conduct such as the unconditional sale of a single copy, the offering to sell copies to the public or loans of copies, may amount to publication. Given these anomalies, more guidance is necessary. The standard set forth in Section IV begins to fill this gap and assist applicants in making correct publication conclusions about internet distribution.

Copyright registration applications may be completed without the assistance of counsel. Given the counterintuitive meaning of publication in copyright law, it would be most helpful if the copyright office provided user-friendly FAQ’s or instructional videos on this issue. At a minimum, the office could identify sales and common internet distributions that would or would not constitute publication.

Federal copyright registration, when done correctly, can confer substantial benefits at minimal cost. Normally, federal copyright registration constitutes prima facie evidence of the validity of all the facts found in the certificate, including, the validity of the copyright, the date of first publication, and ownership. An erroneous publication date can have

³⁴ 37 C.F.R. § 202.4(i)(6) (2018); <https://www.copyright.gov/about/fees.html>

³⁵ *Id.* § 202.4(h)-(i).

³⁶ Copyright Office, *Circular 66: Copyright Registration for Online Works*, p. 3; see also *Compendium II: Copyright Office Practices*, § 904(1).

³⁷ *Compendium II: Copyright Office Practices*, § 904(5).

dire consequences including the loss of the presumption, an invalidated registration, and the dismissal of a federal infringement action. The following case shows that getting the publication date wrong can ruin an otherwise strong copyright claim. In *JMAS Enterprises, Inc. v. Kassir Import-Export Co.*,³⁸ the plaintiff claimed a first publication date of 2009. That date was wrong. Plaintiffs admitted to the court they did not create their website until 2010 and did not begin marketing the work until January 2011, well after the first publication date of 2009 claimed in their copyright application. Plaintiffs did not have evidence to support creation of the original work in 2009. They lost the presumption in an otherwise strong copyright claim and consequently, did not obtain a preliminary injunction—all because they were not able to substantiate their claimed publication date.³⁹

Another important mistake to avoid in the registration process is grouping works that were published in different years. The Copyright Office regulations permit authors to register a group of works together and avoid paying multiple registration fees only if the entirety constitutes “a single unit of publication.”⁴⁰ All works in the group must have been published in the same calendar year.⁴¹ In *McLaren v. Chico’s FAS, Inc.*, a designer attempted to benefit from this provision by registering a group of twenty-four drawings.⁴² Two years before the claimed publication date, she sold some of the drawings.⁴³ The court determined that this prior sale amounted to publication. Because all the drawings were not published in the same year as claimed in the application, the registration for the group was invalidated, and an otherwise viable copyright claim was dismissed.⁴⁴ Getting the publication dates right, and paying the additional modest registration fees are a small price to pay to preserve the economic value of such copyrightable works. Compliance with this provision requires understanding the particular meaning of copyright publication.

³⁸ *JMAS Enterprises, Inc. v. Kassir Imp.-Exp. Co.*, No. CV1106258SVWPJW, 2011 WL 13221007 (C.D. Cal. Aug. 24, 2011).

³⁹ *Id.* at *5 (“Assuming that Plaintiffs are able to establish a valid copyright, they likely could establish infringement.”)

⁴⁰ *U.S. Copyright Office, Compendium of U.S. Copyright Office Practices* §§ 1107-1107.1 (3d ed. 2017).

⁴¹ *Compendium (Third)* § 1107.1.

⁴² *McLaren v. Chico’s FAS, Inc.*, No. 10-cv-2481 (JSR), 2010 WL 4615772, at *1 (S.D.N.Y. Nov. 9, 2010).

⁴³ *Id.*

⁴⁴ *Id.* at *3-4.

The timing of publication and registration may also dramatically impact the economic value of a copyrighted work. A copyright owner who gets the timing right can obtain statutory damages and attorney's fees in an infringement suit.⁴⁵ Statutory damages can be as high as \$150,000 per act of infringement.⁴⁶ In addition to heightening the potential economic recovery of winning an infringement claim, the settlement value of a copyright claim may significantly increase if heightened damages are available. Registration before infringement or within three months of first publication dictates whether such extraordinary remedies are available.⁴⁷

A copyright owner who understands these remedies will see that there is a powerful economic incentive to register within three months of publication. Even if actual damages may exceed the statutory damages amount, the litigation costs of proving the economic value of damages combined with the possibility of obtaining attorney's fees may make it more cost efficient to claim the statutory remedies. Yet, many applicants appear to be unaware of the benefits. Hundreds of thousands of works are registered each year—many for groups of works.⁴⁸ From 2008-2012, 45% of registrations occurred more than three months after publication.⁴⁹ Many of these applicants could have substantially increased the economic value of their copyrights by registering within three months of first publication.

In order to successfully plead a claim for statutory damages and attorney's fees, a copyright plaintiff must identify the dates of (1) first publication (2) copyright registration, and (3) the alleged infringement, and

⁴⁵ 17 U.S.C. § 412.

⁴⁶ 17 U.S.C. § 504(c)(2) (“In any action under this title . . . no award of statutory damages or of attorney’s fees, as provided by sections 504 and 505, shall be made for— (1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or (2) any infringement of copyright commenced after first *publication* of the work and before the effective date of its registration, unless such registration is made within three months after the first *publication* of the work.” (emphasis added)).

⁴⁷ *Alaska Stock, LLC v. Houghton Mifflin Harcourt Pub. Co.*, 747 F.3d 673, 678 (9th Cir. 2014) (citing 17 U.S.C. § 412) (“Registration prior to infringement or, if the work is published, within three months of publication, is necessary for an owner to obtain statutory damages and attorneys’ fees.”).

⁴⁸ See 2018 U.S. Copyright Office Ann. Rep. Reg. Copyright, 21 (showing an average of 527,380 registrations per year dating back to 2008. However, Oliar, Patteson and Powell note that it is important to remember “that there is no simple one-to-one relationship between the number of registrations and the number of works registered therein.”). Oliar, Patteson, & Powell, *supra* note 29 at 2243.

⁴⁹ Oliar, Patteson, & Powell, *supra* note 29 at 2230 (54.6% are registered within three months of publication, while only .02% are registered while still unpublished).

the registration must precede publication or be effective⁵⁰ within three months of first publication.⁵¹ If the dates are not properly pled or if the timing does not fit the requirements of the statute, a defendant may obtain dismissal of the claim for statutory damages and attorney's fees, defanging the economic threat of the suit and substantially increasing the cost of litigation for the plaintiff.⁵²

Publication is also important in identifying a work's nation of origin, and whether compliance with U.S. formalities is necessary. For example, registration is required prior to litigation sometimes if the subject is a "United States work."⁵³ Owners of foreign works need not bother with this formality.⁵⁴ While a "United States work" must be registered before a copyright infringement suit is filed, this requirement is waived for foreign works. "Thus, to proceed with a copyright infringement action, a plaintiff that claims his published work is exempt from the registration requirement must prove that the first publication occurred abroad."⁵⁵ The timing and place of first publication must be determined before a work can be classified

⁵⁰ 17 U.S.C. § 410(d) (The effective date of registration is "the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.").

⁵¹ *Id.* § 412(2).

⁵² *Olivares v. Univ. of Chicago*, 213 F. Supp. 3d 757, 772–73 (M.D.N.C. 2016) (granting Defendants' motion to strike and dismissing Plaintiff's requests for statutory damages and attorney's fees for failure to state a claim upon which relief can be granted because the infringement occurred before registration); *Hoffman v. 0 Three Media, LLC*, No. CV 12-60-GW(JEMX), 2012 WL 12886181, at *3 (C.D. Cal. Nov. 27, 2012) (Granting summary judgment on "unavailability of statutory damages or attorney's fees for this copyright claim "because the photograph "was unpublished at the time the alleged infringement occurred, and the alleged infringement occurred prior to the copyright registration.").

⁵³ *See* 17 U.S.C. § 101 (For purposes of section 411, a work is a "United States work" only if— (1) in the case of a published work, the work is first published— (A) in the United States); *See* 17 U.S.C. § 411(a) (2017) ("no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title."); *See Moberg v. 33T LLC*, 666 F. Supp. 2d 415, 420 (D. Del. 2009) (holding that "because plaintiff's photographs did not originate in the United States, they are not subject to the registration requirement, and such a formality is not a prerequisite to suit.").

⁵⁴ *Moberg*, 666 F. Supp. 2d at 420. ("The effect of the United States' accession to the [Berne] Convention 'is to exempt works the country of origin of which is not the United States from the registration requirement.'" (quoting Cotter, *supra* note 9 at 1743).

⁵⁵ *Kernel Records Oy v. Mosley*, 694 F.3d 1294, 1304-5 (11th Cir. 2012) (citing 17 U.S.C. §§ 101, 411(a)); *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1233 (11th Cir. 2010); *BUC Int'l Corp. v. Int'l Yacht Council, Ltd.*, 489 F.3d 1129, 1141–42 (11th Cir. 2007).

as a U.S. work or foreign work.⁵⁶ As the creative world becomes increasingly international, the publication doctrine will trigger whether a creative piece is considered a “United States work” which may be subject to different copyright formality requirements.

If an applicant gets the publication date wrong in its application to register the copyright, its entire registration may be invalidated.⁵⁷ Such a result can be fatal to an otherwise strong copyright infringement claim because registration is a prerequisite for federal jurisdiction. Accordingly, without a valid registration, a federal court must dismiss the claim.

Similarly, while a United States work permanently enters the public domain for failure to observe formalities, certain foreign works can recover their copyright protections.⁵⁸ Pursuant to this provision, many popular musical works such as Prokofiev’s *Peter and the Wolf*, can no longer be played by orchestras without seeking a license or risking infringement. The timing and place of first publication triggers whether the work is considered a “United States work” or a work from another source country.⁵⁹

⁵⁶ *Kernel Records Oy*, 694 F.3d at 1304 (“Determining whether a work was first published domestically or abroad adds an additional level of complexity. Because the statutory definition of “United States work” contains strict temporal and geographic requirements (e.g., ‘first,’ ‘simultaneously,’ ‘in the United States,’ ‘foreign nation,’ and ‘treaty party’)”).

⁵⁷ *KEMA, Inc. v. Koperwhats*, No. C-09-1587 MMC, 2010 WL 3464737, at *3 (N.D. Cal. Sept. 1, 2010) (“A copyright plaintiff will not satisfy the registration requirement where the allegedly infringed work was published before the date of first publication identified in the registration, unless such registration identifies the registered work as derivative of, or a compilation containing, the allegedly infringed work.”)

⁵⁸ 17 U.S.C. § 104A(h)(6) (2012).

The term “restored work” means an original work of authorship that--

(A) is protected under subsection (a);

(B) is not in the public domain in its source country through expiration of term of protection;

(C) is in the public domain in the United States due to--

(i) noncompliance with formalities imposed at any time by United States copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements;

(D) has at least one author or rightholder who was, at the time the work was created, a national or domiciliary of an eligible country, and if published, was first published in an eligible country and not published in the United States during the 30-day period following publication in such eligible country; and if published, was first published in an eligible country and not published in the United States during the 30-day period following publication in such eligible country; and

(E) If the source country for the work is an eligible country solely by virtue of its adherence to the WIPO Performances and Phonograms Treaty, is a sound recording.

⁵⁹ See 17 U.S.C. § 101.

The importance of understanding copyright publication should not be underestimated. Publication triggers many important moments in the life of a creative work. Because so many works are shared online, the following section explains how these ambiguities may be resolved for online distributions.

III. INTERNET PUBLICATION

Once one appreciates the significance of publication, it becomes apparent why it is so important to confront whether Internet distribution amounts to publication or should be considered mere display or performance. The Copyright Office effectively dodges the question. The Copyright Office Compendium suggests that online works may be published or unpublished and leaves it to the applicant to make that distinction.⁶⁰ In short, it raises the question of whether distribution on the Internet constitutes publication but does not answer it.

After hunting through the Compendium's labyrinth for guidance, applicants may ultimately think they've found the answer when they arrive at a subsection on "websites and website content" titled, "What Constitutes Publication?" When they begin reading that section, they will see the unsatisfying guidance that "while technological developments have blurred this traditional concept, the U.S. Copyright Office interprets publication in a manner consistent with congressional intent and with appreciation for the current factual and legal distinctions that may inform the assessment of this issue."⁶¹

In some sections the Compendium may lead one to wonder whether dissemination of mere digital copies can amount to publication. For example, one section states that "any form or dissemination in which a material object does not change hands... is not a publication no matter how many people are exposed to the work."⁶² This statement is outdated, and should be removed because it is currently misleading. It quotes words from legislative history that were articulated before the Internet existed. For decades, it has been well-settled that digital duplicates of a work constitute

⁶⁰ *U.S. Copyright Office, Compendium of U.S. Copyright Office Practices* § 1008.6(A)-(B) (3d ed. 2017).

⁶¹ *Id.* § 1008.3(A).

⁶² *Id.* § 1905.2 (quoting H.R. Rep. No. 94-1476, at 138 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5754.)

“copies” within the meaning of copyright law.⁶³ A physical material object need not exist.

Other sections of the Compendium confirm that it is not necessary for the public to actually put hands on physical copies for publication to occur. It offers the following examples of digital distribution that constitute publication:

a book is published when copies of the work are distributed online or in book-stores. A newspaper is distributed when copies are sold at newsstands or delivered to subscribers’ doorsteps. A song is distributed when print copies or phonorecords are sold (*e.g.*, on sheet music or in mp3 format). Software is distributed when copies are distributed by purchase or license, whether in CD-ROM format or online (provided that the copies are actually downloaded and not merely accessed online).⁶⁴

Nonetheless, the Compendium leaves room for the possibility that distribution on the Internet may not amount to copyright publication. For example, it tracks the publication definition by stating that if “the content was placed online solely for the purpose of public display or public performance, the work may be deemed unpublished.”⁶⁵ The guidelines also track the doctrine of limited publication, indicating that “a draft dissertation or other manuscript that is sent [presumably by email or some other electronic method] to a dozen people for peer review with a note stating that the copy should not be shared with other parties is not considered publication.”⁶⁶

That leaves an open question about how to treat works when Internet access is provided even though a copy of the work is not sold. Is such content merely displayed and performed and not published? The statute indicates that any transfer—even a loan—may constitute publication, which indicates that the price tag alone should not dictate the answer. The Compendium and the publication definition do not adequately explain how to determine if a work was published if it was distributed but not sold on the

⁶³ See, *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 928–29 (2005) (basing its decision on the factual foundation that digital sharing is tantamount to infringement); *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 519 (9th Cir. 1993) (holding that “it is generally accepted that the loading of software into a computer constitutes the creation of a copy under the Copyright Act”).

⁶⁴ *Id.* § 612.2.

⁶⁵ *Id.* § 1108.6(B).

⁶⁶ *Id.* § 612.2.

Internet, such as photographs uploaded to Instagram, videos one can view on YouTube, or articles shared for no charge on Facebook. And what about content that is made available only if one first becomes a member of a password-protected website?

The ambiguity of whether such works are published has confounded courts as well.⁶⁷ In 2002, the Southern District of New York was the first to confront this issue directly in *Getaped.com, Inc. v. Cangemi*.⁶⁸ Getaped created a website to sell motorized scooters. The site went live in July of 2000, and a month later, the company registered its copyright in the code for the site. The defendants, who were competitors in the scooter market, copied the code for their own site. They did not appear to defend on liability, and default judgment was entered for Getaped. However, they did hire counsel to dispute the issue of damages. A magistrate judge held that the source code was merely displayed on the site, not published, and therefore, recommended that the district court enter only \$1,050 in actual damages based on a theory of lost licensing revenue.

The district court thoughtfully considered whether the code was merely displayed and identified the critical distinction. It indicated that when one can merely view a work, it is displayed. But when one can obtain a copy, it is not merely displayed but is published. The court reasoned:

By accessing a webpage, the user not only views the page but can also view—and copy—the code used to create it. In other words, merely by accessing a webpage, an Internet user acquires the ability to make a copy of that webpage, a copy that is, in fact, indistinguishable in every part from the original. Consequently, when a website goes live, the creator loses the ability to control either duplication or further distribution of his or her work. A webpage in this respect is indistinguishable from photographs, music files or software posted on the web—all can be freely copied. Thus, when a webpage goes live on the Internet, it is distributed and “published” in the same way the music files in *Napster* or the photographs in the various *Playboy* decisions were distributed and “published.”⁶⁹

⁶⁷ See *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002); See *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 197 n. 5 (S.D.N.Y.2006).

⁶⁸ *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398 (S.D.N.Y. 2002).

⁶⁹ *Id.* at 402.

More than a century of publication precedent is consistent with the conclusion in *Getaped*. My empirical study indicated that the existence of copies authorized by the copyright owner is a significant variable that often leads to a conclusion of publication.⁷⁰ Digital files have been deemed to be copies.⁷¹ Accordingly, one might conclude that digital distribution by the copyright owner will generally lead to a conclusion that the work has been published. Other courts have questioned whether distribution on the Internet constitutes publication,⁷² but a close look at the facts of each of them, indicates that their reasoning does not undermine the basic conclusion of *Getaped*.⁷³

The decision in *McLaren v. Chico's FAS, Inc.*,⁷⁴ has been cited repeatedly in footnotes as an example of a court that reached a conclusion contrary to *Getaped*. Although the court questioned in dicta whether Internet distribution always amounts to publication, it was decided on a different issue. Chesley McLaren sued Chico's, claiming the retailer of women's clothing displayed mannequins that infringed her copyrighted designs.⁷⁵ Prior to filing the complaint, she registered copyrights in her drawings.⁷⁶ Some drawings in the group registered as a single work had been sold years prior to the alleged publication date of the entire group. Based on these facts, the court correctly concluded that they did not have identical publication histories, and on that basis invalidated the registration. The designer's counsel argued that before the sale, she had published the

⁷⁰ Deborah R. Gerhardt, *Copyright Publication: An Empirical Study*, 87 NOTRE DAME L. REV. 135, 184-92 (2011) ("The principal factor driving the publication determination turns out to be whether copies are authorized for distribution. Whatever impact the public availability of copies may appear to have on its own, that influence is subsumed by the presence of authorized copies. In short, district court judges are relying principally upon the copyright owner's consent, not the availability of copies to the general public, when rendering their judgments.").

⁷¹ 17 U.S.C. § 1001; *London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153, 171 (D. Mass. 2008) ("any object in which a sound recording can be fixed is a 'material object.' That includes . . . electronic files."). Sara Steetle, *UMG Recordings, Inc. v. MP3.Com, Inc.: Signaling the Need for a Deeper Analysis of Copyright Infringement of Digital Recordings*, 21 LOY. OF L.A. ENT. L. REV. 31, 40 (2000) ("Works in digital form are considered 'copies' under the Copyright Act.").

⁷² See generally *Moberg v. 33T LLC*, 666 F. Supp. 2d 415, 422 (D. Del. 2009); *Kernel Records Oy v. Mosley*, 694 F.3d 1294, 1308 (11th Cir. 2012); *Rogers v. Better Bus. Bureau of Metro. Houston, Inc.*, 887 F. Supp. 2d 722, 730 (S.D. Tex. 2012).

⁷³ See *McLaren v. Chico's FAS, Inc.*, No. 10-cv-2481 (JSR), 2010 WL 4615772, at *4 (S.D.N.Y. Nov. 9, 2010).

⁷⁴ *McLaren v. Chico's FAS, Inc.*, No. 10-cv-2481 (JSR), 2010 WL 4615772 (S.D.N.Y. Nov. 9, 2010).

⁷⁵ *Id.*

⁷⁶ *Id.*

whole collection by posting it online, but no date or documentation were provided to substantiate this conclusory allegation. Accordingly, the court explained:

the amended complaint provides no indication of when that website was posted and gives no details regarding how the images from the Collection were displayed, thus rendering this allegation little more than conclusory. Moreover, even if the factual aspect of this allegation were credited, this claim that images composing the Collection were posted on her website would not in any event suffice to plead “publication.” Furthermore, even assuming *arguendo* that website posting can amount to publication, there is no basis to conclude that this alleged publication represented the first time that any of the illustrations in the Collection was published, and for that reason, this new allegation fails to alter the conclusion that the Collection does not qualify for a “single work” registration.⁷⁷

Before citing this precedent for the principle that Internet distribution does not constitute publication, litigants should be mindful of the fact that the court stated it did not have the factual predicate to decide the case on this issue and based its conclusion on the failure to prove that all the drawings had the same publication date based on facts involving the sale of only some of the drawings before the claimed publication date for the entire set. In alluding to the issue of Internet publication, the court cites *Einhorn v. Mergatroyd Productions*, which does address the issue of when Internet distribution may constitute publication.

In *Einhorn*, the director of an “Off Off Broadway show” titled *Tam Lin* claimed to have created copyrightable “blocking and choreography” for a production of Defendant’s play that was performed eight times.⁷⁸ He claimed he was promised \$1,000 for his work, but was fired before the show opened, and did not get paid for the work he did.⁷⁹ He attempted to register his copyright in his contributions, using an edited copy of the playwright’s script, but he failed to identify exactly what his original

⁷⁷ *Id.* at *4 (citing *Einhorn v. Mergatroyd Prods.*, 426 F.Supp.2d 189, 197 n. 5 (S.D.N.Y.2006) for the proposition that “‘merely posting a digital file’ on the Internet does not amount to ‘publication’ under the Copyright Act”).

⁷⁸ *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 191-93 (S.D.N.Y. 2006).

⁷⁹ *Id.*

contributions were.⁸⁰ Before addressing the motion to dismiss, Judge Kaplan began the opinion with his overall impression of the matter. He wrote, “We speak of ‘making a federal case’ out of something to express the sentiment that someone is blowing something out of proportion. Plaintiff Edward Einhorn, represented by his attorney brother, has made this federal case out of a dispute over \$1,000.”⁸¹

Plaintiff sought statutory damages claiming that publication of his work occurred when the Defendants performed the play and posted images of the show on their website.⁸² The court easily disposed of the first claim based on the statutory definition of publication that expressly excludes public performance.⁸³ That portion of the conclusion is indisputably correct.

The court then proceeded to determine whether posting the performance on the Internet, by the Defendant, amounted to publication. The court determined that it did not. It reasoned:

The same definition dooms Einhorn's claim that the posting of performances of the show on the Internet constituted publication, even assuming *arguendo* that Einhorn may rely upon defendants' actions, some of which are said to have infringed his alleged rights, to establish publication. Making the work available in that way, even assuming it constituted “distribution,” did not involve “sale or other transfer of ownership, or by rental, lease or lending.” Indeed, this result follows directly from the principle that “the projection or exhibition of a motion picture in theaters or elsewhere does not in itself constitute a publication.”⁸⁴

The court in *Einhorn* arrived at the correct conclusion, but its reasoning is problematic. The court should have clarified that distribution by the *Defendants* could not amount to publication because, generally, only distributions authorized by the copyright owner constitute publication, and this distribution was clearly not authorized. That would have been a sounder basis for its conclusion. To the extent that the court suggests that Internet distribution does not amount to transfer of ownership of a copy, the decision

⁸⁰ *Id.*

⁸¹ *Id.* at 191.

⁸² *Id.* at 196.

⁸³ 17 U.S.C. § 101.

⁸⁴ *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 197 (S.D.N.Y. 2006) (quoting 1 Nimmer & Nimmer, *supra* note 10, § 4.11[A]).

contradicts *Getaped*. The *Einhorn* court suggested, that for publication purposes, Internet distribution of a film was equivalent to the screening of a film in a theater.⁸⁵ But that is a false equivalency. When a film is merely shown, it falls under the public performance exception to publication. When copies of the film are distributed—in hard copies or digitally—such distribution does constitute publication.⁸⁶

Perhaps the court was not directed to the settled precedent indicating that digital versions of copyrightable works are “copies” as defined by federal copyright law.⁸⁷ Posting digital copies online does result in a “transfer of ownership” as defined under the Act.⁸⁸ Contrary to the *Einhorn* court’s suggestion, no sale is required for publication to occur.⁸⁹

To the extent that *Einhorn* contradicts *Getaped*, it is the *Getaped* decision that is consistent with decades of publication precedent, demonstrating that when a copyright owner authorizes unrestricted distribution of copies to the public, the work will be deemed published. Therefore, unless something in the factual history of a work shows that distribution was restricted or unauthorized, Internet distribution will generally be deemed to constitute publication.

Given the divergent conclusions about digital distribution regarding publication, it remains critically important to identify and plead facts to support the publication status of a work. A plaintiff claiming publication online should identify the date on which the work was placed on a *publicly* accessible site. One court has found that an allegation that a work was distributed online is insufficient to allege that the work was publicly

⁸⁵ *Id.*

⁸⁶ *Am. Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1027 (9th Cir.1981) (“An oft quoted modern definition of general publication is that ‘publication occurs when by consent of the copyright owner, the original or tangible copies of a work are sold, leased, loaned, given away, or otherwise made available to the general public, or when an authorized offer is made to dispose of the work in any such manner even if a sale or other such disposition does not in fact occur.’”) (quoting 1 Nimmer & Nimmer, *supra* note 10, § 4.04 at 4-18, 4-19).

⁸⁷ See 17 U.S.C. § 1001; See *London-Sire Records, Inc. v. Doe I*, 542 F. Supp. 2d 153, 171 (D. Mass. 2008).

⁸⁸ *Getaped.Com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 401 (S.D.N.Y. 2002) (“ . . . the ability of the Internet user to download a file containing a copyrighted work and thereby gain control of it, that is, gain a proprietary or possessory interest in the copyrighted work.”)

⁸⁹ See 17 U.S.C. § 101.

accessible unless the claimant specifies that the site was visible to the general public.

In *Kernal Records Oy v. Mosley*, a Norwegian citizen composed a musical arrangement titled “Acidjazzed Evening.” Plaintiff claimed the work was first published in Australia, and therefore fit the definition of a foreign work that did not require the plaintiff to register its copyright under U.S. law. The defendant alleged that Internet publication constituted simultaneous publication in the U.S., and therefore, the work did not qualify for the registration exemption. The court’s jurisdiction to hear the case turned on whether the online distribution of the composition amounted to publication in the United States.

Based on the record indicating the work was posted on the Internet, the district court presumed simultaneous, worldwide publication and dismissed the case finding it lacked jurisdiction given that there had been no registration.⁹⁰ On appeal, the Eleventh Circuit indicated that the presumption that Internet distribution amounts to publication was erroneous.⁹¹ The court explained:

the terms “Internet” and “online” include alternatives to the use of a public website, including a restricted website, e-mail, or a peer-to-peer network. Such general and ambiguous deposition testimony, without the inclusion of specific facts, is insufficiently probative to demonstrate that there was no

⁹⁰ *Kernal Records Oy v. Mosley*, 794 F. Supp. 2d 1355, 1368 (S.D. Fla. 2011) (“We hold that publishing AJE on a website in Australia was an act tantamount to global and simultaneous publication of the work, bringing AJE within the definition of a ‘United States work’ under § 101(1)(C) and subject to § 411(a)’s registration requirement. Gallefoss elected to publish AJE on the Internet and the legal consequences of that decision must apply. Plaintiff was therefore required to register AJE prior to seeking judicial enforcement of its copyright rights.”)

⁹¹ *Kernal Records Oy v. Mosley*, 694, F.3d 1294, 1305-06 (11th Cir. 2012) (“Although it may be possible to presume simultaneous worldwide availability of a public website, . . . such a presumption could not apply to restricted websites, peer-to-peer networks, and e-mail. A restricted website is only available to those willing to pay a fee or who meet specified criteria; a peer-to-peer network is only available to those who have downloaded the required software; and an e-mail only goes to the addresses input by the sender. Thus, unlike public websites on the World Wide Web, each of these other methods of online distribution would be inconsistent with a presumption of simultaneous worldwide availability. . . . The district court then erroneously assumed all ‘Internet publication’ results in simultaneous, worldwide distribution. As outlined below, a proper separation of the terms yields a very different analysis.”) (citations omitted).

dispute of material fact.⁹²

Despite this fundamental criticism of the district court’s reasoning, its summary judgment decision was affirmed because Plaintiff “failed to produce sufficiently probative evidence of *Acidjazzed Evening* being a foreign work exempt from registration.”⁹³ An important lesson can be drawn from this decision: future litigants must plead and prove that posting the work on the Internet made it publicly available worldwide. Although the defendant offered evidence that the work was posted online, the evidence did not unequivocally show that the sites were publicly accessible.

As illustrated above in *Einhorn*, authorization by the copyright owner is an important piece of the publication puzzle.⁹⁴ When a copyright owner itself distributes a work or authorizes a distribution, the authorization is an important factor leading to a conclusion of publication. The question of authorization was a significant factor leading to the determination that the song “Happy Birthday” belongs to the public domain.⁹⁵ The district court correctly noted that “if the publication was authorized, that could make it a general publication . . . divesting the Hill sisters of their common law copyright” due to the lack of notice required at the time of publication.⁹⁶ When a public distribution has not been authorized, it will not weigh as heavily in favor of publication.⁹⁷ A defendant cannot prove publication based solely on its act of infringement.⁹⁸ However, if a copyright owner, permits obvious public distribution without doing anything to control it, a general publication may occur notwithstanding a lack of express permission.⁹⁹

⁹² *Id.* at 1308.

⁹³ *Id.* at 1311.

⁹⁴ *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 191-93 (S.D.N.Y. 2006).

⁹⁵ *Marya v. Warner/Chappell Music, Inc.*, 131 F. Supp. 3d 975, 990–91 (C.D. Cal. 2015).

⁹⁶ *Id.*

⁹⁷ *Id.* at 990.

⁹⁸ *Neri v. Monroe*, No. 11-CV-429-SLC, 2014 WL 793336, at *10 (W.D. Wis. Feb. 26, 2014), *aff’d*, 567 F. App’x 465 (7th Cir. 2014) (“For purposes of statutory damages and attorney fees under the Copyright Act, ‘publication’ refers to the *copyright owner’s* actions, not those of the alleged infringer. Stated another way, “an act that commences infringement does not publish an otherwise unpublished work.” *Zito v. Steeplechase Films, Inc.*, 267 F. Supp. 2d 1022, 1026 (N.D. Cal. 2003). *See also* 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 4.04 at 4–22 to 4–23 (2002) (“Congress could not have intended that the various legal consequences of publication under the current Act would be triggered by an unauthorized act of an infringer or other stranger to the copyright.”))

⁹⁹ *Letter Edged in Black Press, Inc. v. Pub. Bldg. Comm’n of Chi.*, 320 F. Supp. 1303, 1311-13 (N.D. Ill. 1970).

When a copyright owner posts a work on a publicly available internet site, the posting constitutes copyright publication because the general public has unrestricted access to digital copies. Courts should no longer have to throw up their hands in frustration or avoid the publication issue by deferring to the ministerial decision of registration made without access to all the relevant facts.¹⁰⁰ Therefore, the moment a work is posted on social media or a public website, it has been published as a matter of copyright law. The court in *Wright v. BuzzFeed* correctly concluded that a copyright owner's posting of its work on Instagram constitutes publication.¹⁰¹ Courts and the U.S. copyright office should not hesitate to draw this conclusion that is compelled by decades of precedent. Whether the distribution constitutes limited publication or no publication at all raises a legitimate question of fact only if (1) someone other than the copyright owner posted the work, (2) the site was not publicly available and the content was not authorized for further distribution, or (3) members of the public could view the content but not download digital copies.¹⁰² The following section provides a standard to help future copyright registrants and litigants decide when online distribution does and does not amount to copyright publication.

IV. INTERNET PUBLICATION INDICATORS

The following standard should be used to determine whether a work has been published through distribution on the internet:

For copyright purposes, a work placed on the internet is published if the facts reflect all of the following three factors:

¹⁰⁰ *Rogers v. Better Bus. Bureau of Metro. Houston, Inc.*, 887 F. Supp. 2d 722, 733 (S.D. Tex. 2012).

¹⁰¹ *Wright v. BuzzFeed, Inc.*, No. 218CV02187CASA FMX, 2018 WL 2670642, at *3 (C.D. Cal. June 4, 2018) (Concluding that plaintiff is not entitled to statutory damages or attorneys' fees on two of her claims because (1) the alleged infringement pre-dated her copyright registration; and (2) the copyright was not registered within three months of first publication).

¹⁰² *Nimmer & Nimmer*, *supra* note 10, § 4.07[B]; *Palmer/Kane LLC v. Gareth Stevens Publ'g*, No. 1:15-CV-7404-GHW, 2017 WL 3973957, at *12 (S.D.N.Y. Sept. 7, 2017) (“At the very least, the question of whether the appearance of the Images on stockmarketphoto.com prior to May 28, 1999 constituted ‘publication’ of the Images requires resolution of factual disputes regarding the extent to which the website was available to the general public and the purpose for which the Images were posted.”).

1. The work was posted by the copyright owner (or with the owner's permission);
2. the site was publicly accessible; and
3. the public could freely download copies of the work.

Use of this standard will make it clear that internet posts on many websites will constitute publication if the work was posted by the copyright owner or with the owner's consent. When a copyright owner posts content on a website or social media sites such as Facebook or Instagram that permit users to create or download copies, the work should be deemed published.

It is also important to remember that none of these elements will independently establish that a work is published. Take, for example, the first element involving permission from the copyright owner. Such authorization is important and generally leads to a finding of publication, but it does not always do so.¹⁰³ If the second two elements are not present in the factual scenario, the authorized distribution may be only a limited publication which is equivalent to no publication at all. An authorized posting of a work on a site that is not publicly accessible will likely amount to only limited publication as such a distribution would be made to a limited group for a limited purpose. If a work is posted on a site that the site is password-protected, encrypted or otherwise closed to the public, the second element cannot be established. Although publication of the work may still be proven based on other facts, the technological protection measures will weigh against such a finding.

Similarly, posting a work on a publicly accessible site is not by itself sufficient to constitute publication, especially if the first element is not proven. If the post was made without copyright owner authorization, the facts may not support a finding of publication, especially if the distribution was made by the defendant in the case being decided.¹⁰⁴ Conversely, a series of unauthorized distributions may amount to publication especially when the copyright owner does nothing to stop them.¹⁰⁵ Therefore, authorization alone is insufficient to drive the publication conclusion.

¹⁰³ Deborah R. Gerhardt, *Copyright Publication: An Empirical Study*, 87 NOTRE DAME L. REV. 135, 199 (2011).

¹⁰⁴ *Neri v. Monroe*, No. 11-CV-429-SLC, 2014 WL 793336, at *10 (W.D. Wis. Feb. 26, 2014), *aff'd*, 567 F. App'x 465 (7th Cir. 2014).

¹⁰⁵ *Letter Edged in Black Press v. Public Building Comm'n of Chicago*, 320 F. Supp. 1303, 1309 (N.D.Ill. 1970).

The third factor is useful for filtering out public displays and performances where the public does not obtain copies. Here is where the lay meaning of publication must be set aside. Although performance and display permit the public to access and view works, they are expressly excluded from the statutory definition of publication. In applying the third factor, the facts can get tricky. Before drawing any conclusions, one must remain mindful that digital copies are “copies” within the meaning of federal copyright law. If the technology permits public users to download digital copies, the distribution cannot be excused as mere display or performance. The copyright definition may seem odd to those who do not think they possess digital copies of content existing on the internet. But, according to copyright law, they often do.

The Copyright Act defines a copy as “material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”¹⁰⁶ This definition has been held to include digital versions if they are stable enough to be perceived for more than a transitory duration even if the aid of a machine, such as a computer, is necessary.¹⁰⁷ For example, if an original painting is shown in a gallery, it is merely displayed.¹⁰⁸ It will not be deemed published unless the public can photograph it, making their own copies.¹⁰⁹ If the same painting is displayed in a digital gallery, it may also be deemed published if viewers can make or download digital copies of it.¹¹⁰ Therefore, using current internet technology typical of most public websites, a visual work distributed on the internet will generally satisfy the third element unless the photo is technologically protected so that consumers may view but not make digital copies of the images. For example, streaming technology that passes through a computer without leaving a copy may be deemed a mere performance or display instead of the distribution of a copy.¹¹¹

¹⁰⁶ 17 U.S.C. § 101.

¹⁰⁷ *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121, 130 (2d Cir. 2008) (finding that a copy had not been made because data is not fixed for more than a transitory duration when data resided in a buffer for 1.2 seconds and was then automatically overwritten with new data).

¹⁰⁸ *Werckmeister v. Am. Lithographic Co.*, 134 F. 321, 330 (2d Cir. 1904).

¹⁰⁹ *Id.*

¹¹⁰ *See Id.*

¹¹¹ *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121, 130 (2d Cir. 2008).

CONCLUSION

The publication doctrine retains significant practical importance as well as legal ambiguity. Creators, their counsel, the U.S. Copyright Office and federal courts will continue to be challenged by this notoriously troublesome doctrine. However, where experts can add clarity to these issues, they should. Posting works on the internet sometimes raises difficult publication questions, but often it does not. Using the standard set forth above, the Copyright Office, the Nimmer Treatise and other leading copyright authorities should clarify that when an author posts a work on a public site so viewers can easily access copies, the work has been published. The copyright office can provide a needed public service to low wealth entrepreneurs, software engineers, writers, designers, photographers, architects, musicians and artists by offering greater clarity on this basic point. Armed with this knowledge, the next generation of creators will better understand this significant issue so that they can time publication and registration accordingly in order to optimize the economic value of their works.

* * *