University of Dayton Law Review

Volume 17
Number 3 *Copyright Symposium, Part II*

Article 4

4-1-1992

# Presentation by Marybeth Peters, Esq.

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## PRESENTATION BY MARYBETH PETERS, ESQ.

MS. PETERS: Good morning. I have been asked to address the role of the Copyright Office in all of this. It does play a significant role in the sense that it registers claims to copyright, and, in order for non-Berne Convention works to have access to our courts, you have to come through the Copyright Office. I thought it would be interesting to look back at the history of the Copyright Office and the various things that it does. The United States has always had a registration system. From the very first copyright act that went into effect on May 31, 1790, you registered with the district courts and copies went to the Department of State. Those functions now belong to the Copyright Office.

We are in the Library of Congress, which is the legislative branch of the government, not the executive branch. This is due to a foresighted librarian, Ainsworth Stauffer, who focused on the copyright system's requirement that all works that are published in the United States for which copyright protection is available had to come to a central depository. He also thought this was a great way to build the collection for the Library of Congress. That is really why the Copyright Office is in the Library of Congress. Sometimes the fact that we are in the legislative branch is good. We are basically seen as an arm of Congress in research areas. Sometimes, when the United States is taking a position on international matters, the fact that we are in the legislative branch of the government—we do not represent the "United States"—can be a little bit problematic. I thought I would go back and talk about our functions.

We mainly have divisions that are aimed at registering claims to copyright. That is the bulk of what the United States Copyright Office does. We have a staff of about 550 people; the bulk of that staff is aimed at the registration process. The key division is the examining division. It is headed by a chief who is a lawyer, and there are about 185 people in that division. I will be talking about what they do. To be an examiner you do not have to be a lawyer, and you can think about this when we talk about what they do. We look for people who have good analytical skills and who communicate well in writing and orally; we then teach them the law. The second thing we do, besides registering the claims to copyright, is record all the documents people send us involving transfers. For every registration, every document we get, we prepare records. Consequently, we probably have one of the world's largest catalogues because last year about 700,000 claims to copyright were registered. We have records that go back to 1870, so you can see why we have a very large catalogue. Another arm of the Copyright

Office acquires works for the Library of Congress. We are an accession of the Library. The other things include supplying information about our practices and setting out regulations on how claims should be registered. Finally, we advise Congress and give testimony about what the law in the United States should be. We prepare studies for Congress on difficult issues, and we work with the State Department and a lot of other government agencies on copyright policy. My focus is going to be on the registration of the claims.

If you go back and look at the registration process, you find that in the very beginning it was totally *pro forma*. People were hired in the early 1900s because of their typing ability; their title was typewriter. The typing was basically to catalogue the entries. Nobody really looked at the entries. Nobody really said anything about whether they were copyrightable; that was pretty much presumed.

I was told that in the forties and fifties, the Copyright Office got much more into looking at whether the work is copyrightable. The statute that was in effect at the time, the Statute of 1909, said that the certificate and the facts within it were prima facie evidence, but the registration was not prima facie evidence of the validity of the copyright. So there were a number of questions about the authority of the Copyright Office to refuse registration or to decide copyrightability.

Any doubts about the authority of the Copyright Office, I would argue, are taken away by the present statute because there is section 410(a) which directs the Register to register any claim that constitutes copyrightable subject matter and any claim that meets the other formal and legal requirements; those are the things that we set out by regulation. Conversely, it gives the Register the authority to reject when the copyrightable subject matter is not there and when the legal and formal requirements have not been met. So the Copyright Office, because of this, takes its responsibilities pretty seriously because there is a provision in the law that says that when the registration has been made, especially if it has been made within five years of publication, that the certificate of the registration is prima facie evidence of the validity of the copyright and the facts in it. So the question is what happens in the Copyright Office, and as academics you can argue whether this should happen.

The copies of the work and an application form will come to the Copyright Office with the fee. The fee is presently $20. These will be given to an examiner. We are divided into subject matter areas. There are two literary sections—they are the largest; they get the databases. We also have visual arts sections, and we have the performing arts section that does choreography, music, video games, and motion pictures. So those are the subject matter areas.

The only section that has a requirement that you have any knowledge of what you are looking at is music, for to be a music examiner you must have a degree in music. But in no other area do you have to have any subject matter specialty. I can give you no reason why that is the way it is. I was chief of that division for a number of years, and I was a music examiner who did not have a tremendous music background, and I thought I did okay. But tradition says that if you are a music examiner, you have to have a degree in music, but for all the other subject matters, you do not.

When the examiner gets the work, she is going to ask herself a number of questions. The very first one is pretty easy: When you look at the work you have got in front of you, does the work fall within the subject matter of copyright? For example, is it a literary work? Is it a pictorial, graphic, or sculptural work? So you are going through the categories that are spelled out in the law in section 102(a). In most cases they are going to fall within the subject matter of copyright. Sometimes they will not.

The second question is probably the more difficult question: If the material is copyrightable subject matter, or potentially copyrightable, is there enough original authorship there to register a claim? If you look at the practices of the Copyright Office, they talk about an appreciable amount of creative authorship. We all know, and the Copyright Office certainly knows, that "original" was defined in *Bell v. Catalda* as not copied from another. But you have to do a little more than that, and there is a test. You have to have a distinguishable variation of something, that is more than a trivial contribution, that is recognizable as the author's own.

There is no way in the world, generally, that an examiner is going to know whether the applicant, or the author who is listed, actually did what is in the deposit copy. You take all of this on faith.

The practices of the Copyright Office are in its regulations, Regulation 37, Code of Federal Regulations, and in practices. Most of those practices have been published in the Compendium of Copyright Office Practices, Volume I for the old law, and Volume II for the new law that was published in 1984 and has not been updated. Some of you who work in the database area know that there are section practices and there are literary practices on databases. These are generally not made available to the public, but technically that is what examiners are making their decisions on. So when an examiner is looking at a work, he has to take the word of the applicant as meaning that they did, in fact, write it. Then, when looking at it, I would argue that basically all they have to do is a quantity judgment: Assuming that the person wrote it, is there enough there to be copyrightable?

The Copyright Office works under what is called a rule of doubt, and it is in our practices. That rule is if a court could reasonably find that this work might be subject to copyright, then the office should register it. It was under that rule of doubt that white pages and things like them were registered as compilations of fact because many of the circuits recognized sweat of the brow, so the Copyright Office registered those claims.

When the Copyright Office registers a claim under the rule of doubt, a letter goes out. That letter says we have registered under the rule of doubt, and the correspondence box is checked so that any practicing attorney who sees a certificate that has the correspondence box checked, I would argue, should go and see what the Copyright Office said about it. "Registered under the rule of doubt" is not stamped on the certificate. The reason is that if the court looks and finds that it is copyrightable, you have got a certificate that has a cloud on it for the rest of its life; so we do not mark the certificates. So keep in mind that we do operate under a rule of doubt.

When we look at standards of originality and copyrightability, there are two sections of the law that guide us, sections 102(a) and 103. We make no distinction between derivative works and compilations. There are some cases that suggest that derivative works require a higher standard. The way we read the law is the test is pretty much the same, and that is the test we apply.

When we get to compilations of facts, most people look to the Compendium, and courts will pick up something that is there; I will try to explain it. We say that a compilation is registrable if its selection, coordination—and we had a discussion last night about coordination and that the Copyright Office does not know what it means—or arrangement constitutes an original work of authorship. We give guidelines like—the greater the amount of material from which to select, coordinate, or order, the more likely the compilation is to be registrable. Then it says, when there is not enough, the rule is not to register. Here comes the little paragraph that says—this is section 307.01 of the Compendium—any compilation consisting of less than four selections is considered to lack the requisite original authorship. So the argument goes the other way: If there are four, is it automatically registrable? The answer is not necessarily. This answer came from a segment in the House Report that says that if you take three plays by an author, and he only wrote three plays and each was published separately, and you put them together and publish them as a new compilation, that is not enough; that is not a copyrightable compilation.

So when you look at what the Copyright Office did, three is not enough; legislative history says three is not enough, so all that we can

say is if it is less than four it is not enough. But that makes it very difficult. I spent a whole year of my life when I was chief of the examining division on the registration of the OCLC database with all the competing claims that came in from other libraries, and sometimes there were five entries, sometimes there were six, and sometimes there were two, and it is a very difficult kind of thing.

I noticed in one of the cases that was discussed yesterday with regard to the slogans that there was a warning from the Copyright Office that five selections maybe was a little doubtful and problematic. I guess that comes from the fact that the examiner looked at the fact that they were short phrases and that there were not very many of them there. So the examiner took it upon himself or herself to send a warning.

That is the other thing that should be a part of the discussion. The individual examiner is the one who makes the decisions generally, and, therefore, it is up to the examiner to decide whether they believe it is registrable and whether they should send a letter suggesting that there is a problem. I know it is not official Copyright Office practice to say that five should get, if all you have there is five, a warning letter. So there was judgment involved in that case.

When the examiners are looking at the work, we do not ask them to turn off their brains. Anything that they happen to know they can use in making their decisions with regard to copyrightability, but they are not supposed to go back and research it. It is not a patent kind of examination. So if you get a second edition or a third edition, you are not supposed to go back and get the first and second and research and ask what, in fact, did they do. You are more or less supposed to take it on the fact that it is in front of you; since they say that they edited it, it is enough. However, if you happen to have a music examiner who knows the melody and she knows that all that has been added are two measures, she can use that knowledge. So my point is what is in the examiner's head can be used.

So, sometimes we make mistakes is what I am getting at. We registered without knowing it, or the examiner did not know it. When the symbol for the World's Fair had been published without our noticing it, some people came to us and asked how we could do something so stupid; everybody knows that it was a symbol for the World's Fair and there was no notice. Well, the examiner who got it did not know—looked like a nice flame to him, and so he registered it. The way the system works then is if somebody uses it and they happen to be sued, part of the defense is the Copyright Office made an error in making that registration, but it is not a patent kind of an examination.

Let me just point out that we do have a couple of practices in the Compendium about compilations of facts, and it does say telephone directories and price lists—and this was all done in 1984 before *Feist*—may be registered if they contain a sufficient amount of authorship, and, if they do not, they will be turned down. They do have the examples, i.e., if it is less than four, it is automatically turned down.

Before *Feist* we registered a number of things under the rule of doubt. I gave an example in the paper where we registered the Republican National Committee list that was turned into the Federal Election Committee. It included everyone who gave $250 or more arranged alphabetically within zip code order. At the time we registered it, we had a great doubt about it, but considering the sweat of the brow test that was involved in a number of circuits, we would register it begging for judicial guidance. We argue that *Feist* has given us that guidance.

After the *Feist* case, and this is very typical of what happens in an office like the Copyright Office, a committee got together to look at how we should change the practice. That committee in regard to databases is made up of the general counsel, assistant general counsel, a policy planning advisor—since I was chief of the examining division, I got to be the policy planning advisor—the examining division chief, and one of the section heads, and we looked at all the stuff that we registered before and asked what changes, if any, have to be made? Our conclusion is that not very many works that were registered before will be rejected today.

We read *Feist* as saying that most works will still be protected. White pages of telephone directories, if that is all they are, will get rejected. If all you have in a directory is business names and addresses, and they are organized in a practical or an obvious way, they will get rejected.

A lot of people are getting letters from the Copyright Office, and a person who is here, Jack McDonald from Dun & Bradstreet, got one of the letters. In many cases the Copyright Office is not sure what was involved, so many publishers of databases are getting letters from the Copyright Office that say a problem with the test for originality has been straightened out in the *Feist* case, and here is the test, and now we want you to tell us whether you believe your work is copyrightable and to answer these questions. Now if you do not believe it is copyrightable, I think you are just not going to answer the questions, and the library may be very unhappy because it is not going to be getting the deposit copies anymore. But the questions we are asking include: What selection was involved? And as they know the practices, if you select everything out of the universe, you are out on selection grounds. So they say describe the selection and authorship. Is this an exhaustive list-

ing or are others available, and if some were used and others were not, what kind of a judgment criteria did you use in making that judgment?

The second thing they are asking is whether there is any particular originality in the way that you have arranged the entries. I think this is really difficult in an automated database because we are asking if there is any conscious system, a conscious order of presentation. Now, maybe what we should do after yesterday is to ask in an automated database is there any way in which you have coordinated it? But I will tell you, that is not in our letter. Maybe people who get those letters ought to tell us that something is missing.

If we refuse registration, I think that does have a very significant effect. When we refuse registration, people can appeal, and it goes to a section head and then ultimately to the division chief. If parties go to court and there is a letter from the Copyright Office that says it is not registrable, in general, courts give that great weight. Most of the other courts basically say that the expertise is in the Copyright Office; they do this day in and day out, and the standard that those courts are using is whether there was an abuse of discretion.

I think that is a good question. Is that the right question? I mean is that the standard that should be used or does the court have the right to decide on its own? The Southern District of New York in a case where we actually registered mannequins—and we did it knowing full well that this was going to go to court so we did it very carefully—said we know as well as the Copyright Office what is copyrightable, and this is not. And so here was a case where we had registered, and the court said it is not registrable. After that, the Copyright Office changed its practice to armless and/or legless mannequins are not registrable.

But I think that in some of the cases, what they do is look at the Register, thinking it might have decided this otherwise, but the court is looking at whether it can find any reasonable basis for the Register coming out this way. The court will answer: Yes, we believe that it was not arbitrary, and, therefore, we uphold the decision of the Copyright Office.

So I think that there is a lot of power in the registration or nonregistration ability of the Copyright Office. There even has been a case where it went through the appeal process within the office; a court basically said it is entitled to heightened efforts because the office looked at it so many times. The court looked at it by the original examiner. It looked at it by the section head, and, my God, it looked at it up here. So this decision not to register is a decision that should be taken very seriously and is entitled to heightened weight.

I think maybe that what I am going to do is stop here so that Steve [Metalitz] can come in, and we can have some discussion. But I

guess the issue that people look at today is—this came up when the United States was joining the Berne Convention—that we basically allowed Berne Convention works to have access to our courts without stopping off at the Copyright Office to register. We decided that with regard to works of United States authors and works that are not Berne Convention works, that the registration system in the United States serves a great public purpose, creates a database showing what has been registered and who owns it, and aids in judicial economy.

It is kind of the first go-round for the courts, and to the extent that the Copyright Office says it is not registrable, it saves the public from paying for things that they really should not be paying for. It also creates a record; it asks questions that the court can then use. I think the question is going to come up again with regard to the registration system—whether it should be mandatory as an entry into the court system for works of United States citizens. The Taiwanese, who cannot join the Berne Convention because they are not a country, have said that they need to be treated the same as Berne Convention countries and that they want legislation that exempts them from registration too. The technical answer from the United States is when you have a law that is Berne level law, we will consider introducing legislation to give you an opportunity to have entrance into our courts without registration. If that happens, I think the whole registration question is going to come up again for United States works, so it is something that people should be thinking about. Is this something good that assists the courts, or should there be entry into the court system without stopping off at the Copyright Office? Thank you.