March 17, 2020

Ms. Maria Strong  
Acting Register of Copyrights and Director of Policy and International Affairs  
United States Copyright Office  
Library of Congress  
101 Independence Ave., S.E.  
Washington, D.C. 20559

RE: INTA Response to USCO Notification of Inquiry on Online Publication

Dear Acting Register Strong:


INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property to foster consumer trust, economic growth, and innovation. Copyrights are an increasingly important subject for INTA. INTA’s members include many of the most prolific creators, authors, and publishers of copyrightable content in the fields of movies, television, short-form videos, music, photography, software, books and magazines, other printed and downloadable matter, and other visual and auditory arts, as well as the in-house and outside counsel who represent these entities and individuals. INTA values its growing relationship with the Office in recent years, including our recent discussions on the intersection of trademark and copyright law.

In this spirit, INTA respectfully offers its response to the NOI (the “Response”).

1. **What type of regulatory guidance can the Copyright Office propose that would assist applicants in determining whether their works have been published and, if so, the date and nation of first publication for the purpose of completing copyright applications?**

   **Determining whether a work has been published**

   While it is not regulatory, we recommend that the Office provide guidance by adding case citations and summaries to the COMPRENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES
§ 1905.1 (3d ed. 2017) (the “Compendium”) regarding when a work is distributed to the public is considered “published”. Such citations and summaries will offer useful guidance to copyright applicants and their counsel. Currently, Chapter 19 of the Compendium includes more than 25 examples of what is or is not publication, but they are not sufficiently supported or amplified by current case citations.

Further, because USCO policy receives some deference from the courts, more detailed guidance from the Office may help to resolve inconsistent interpretations of the publication requirement in case law. See Rogers v. Better Business Bureau of Metropolitan Houston Inc., 887 F. Supp. 2d 722 (S.D. Tex. 2012) (summarizing conflicting cases).

We would also like to take this opportunity to request guidance to clarify that a work is published when delivered to a client (digitally or physically) pursuant to a license, whether express or implied, authorizing further exploitation of the work. Without such guidance, an author may mistakenly register their works as unpublished (believing that publication occurs when the client includes the work in a final product) and then must attempt to correct this through a Supplementary Registration, to avoid a finding of a defective registration on the eve of litigation.

A series of Southern District of New York cases have clarified holding that a publication of a copyrighted work occurs upon delivery of that work to a client pursuant to a license, especially where further distribution of the work by the client is authorized in the license. See McLaren v. Chico’s FAS, Inc., 2010 U.S. Dist. LEXIS 120185, at *6 (S.D.N.Y. 2010) (applying the distribution definition and holding, “[b]y licensing the mannequin illustration to Pucci so that it could produce and sell mannequins based on that drawing, McLaren ‘published’ the drawing ….”). See also, Archie MD, Inc. v. Elsevier, Inc., 261 F. Supp. 3d 512, 517 (S.D.N.Y. 2017):

Here, Archie provided Elsevier with a copy of Work along with "a worldwide . . . license to use, reproduce, publish, transmit, and distribute the [Work] . . . in any format or medium, in whole or in part, in and in connection with [Elsevier’s] Publications and otherwise." While Elsevier had not yet undertaken further distribution of the Work at the time Archie sought registration, the initial transfer of a copy in anticipation of further distribution may nonetheless amount to publication.

Further, see Sohm v. Scholastic Inc., 2018 U.S. Dist. LEXIS 53490, at *7 (S.D.N.Y. 2018) (“With respect to at least some of the unpublished registrations in question, it is undisputed that Sohm licensed certain photographs to Scholastic before registering them as ‘unpublished.’ In other words, these photographs were published before they were registered as ‘unpublished.’")

1 We understand that circuit court guidance is preferable. But until we have it, these cases are useful additions to the examples and commentary in sec. 1905.1 of Compendium (Third) and will help to clear up a widespread misunderstanding of when publication occurs.
**Date and nation of first publication**

Guidance should be provided regarding the nation of first publication when a work is published on the Internet at the same time in many different countries. As discussed below, having certainty as to the nation of first publication is important to ascertain the “country of origin” for the purposes of the Berne Convention to determine, among other things, the term of protection afforded the copyright.

Publication of a work online should not be considered an immediate worldwide publication. Immediate worldwide publication over the Internet would negatively affect the author’s rights and ability to “control the first public distribution of an authorized copy or phonorecord of his work”. 17 U.S.C. § 101; H.R. Rep. No. 94-1476, at 138 (1976), reprinted. If the posting of a work online were treated as a simultaneous publication in every jurisdiction in which the website is accessible, authors in all countries would be subject to the formalities of U.S. copyright law which would be contrary to the purpose of the Berne Convention. Moberg v. 33T, LLC, 666 F. Supp. 2d 415, 422 (D. Del. 2009) (Swedish photographer’s posting of copyrighted works on a German website did not constitute simultaneous, global publication); McLaren v. Chico’s FAS, Inc., at *4 (a collection of drawings posted on a website were insufficient to plead that the drawings were published). A large majority of INTA’s membership would be severely and negatively impacted by such a bright line rule.

2. **Specifically, should the Copyright Office propose a regulatory amendment or provide further detailed guidance that would apply the statutory definition of publication to the online context for the purpose of guiding copyright applicants?**

Yes, the Office should provide detailed guidance applying the statutory definition of publication to the online context. In addition to the issues identified below, we wish to reiterate that a work is not published when posted or displayed on a publicly available website or social media platform without a license (transferrable or to otherwise redistribute) granted by the user. Whether the website or social media platform’s features or terms of service allow copying or re-posting of the content, it does not meet the statutory definition of publication because it does not involve distribution “by sale or other transfer of ownership, or by rental, lease, or lending.”

i. **How a copyright owner demonstrates authorization for others to distribute or reproduce a work that is posted online.**

We agree with the Compendium that publication can be accomplished by offering to distribute copies of a work to a group of persons for the purpose of further distribution, public performance or public display. Compendium§ 1905.2, 1906.

**Generally**

The Office explains that “[a] public performance or display of a work does not of itself constitute publication.” 17 U.S.C. § 101. The terms “performance” and “display” mean to recite, render, play, dance, act or show a work, “either directly or by means of any device or process.” Id. (emphasis added). The legislative history explains that a public performance or a display includes “the initial rendition or showing” of a work, as well...
as “any further act by which that rendition or showing is transmitted or communicated to the public.” H.R. Rep. No. 94-1476, at 63, reprinted in 1976 U.S.C.C.A.N. at 5676.

“[F]or example, a sing[er] is performing when he or she sings a song; a broadcasting network is performing when it transmits [that] performance (whether simultaneously or from records); a local broadcaster is performing when it transmits the network broadcast; a cable television system is performing when it retransmits the broadcast to its subscribers; and any individual is performing whenever he or she plays a phonorecord embodying the performance or communicates the performance by turning on a receiving set.”

Id., reprinted in 1976 U.S.C.C.A.N. at 5676-77; see also Compendium § 1908.3.

The online environment is no different in form than the specific examples of broadcasting network, local broadcaster, or cable television system accepted as public performances by the legislative history. In the online context, the owner performs or displays the work, the website operator displays the work, the website host broadcasts the work, the Internet Service Provider broadcasts the work to the world and any individual is displaying or performing the work by receiving the work on her phone, tablet or computer. The legislative history accepted that these performances and displays were by themselves not publication or distribution. To be sure, the phrase “by any device or process whereby images or sound are received beyond the place from which they are sent” in the definition of public performance was intended to be “broad enough to include all conceivable forms and combinations of wired or wireless communications media, including but by no means limited to radio and television broadcasting as we know them.” H.R. Rep. No. 94-1476, at 64, reprinted in 1976 U.S.C.C.A.N. at 5676 (emphasis added). Arguably, Congress intended the public performance exception to include performance or displays through new technology, like the Internet.

**No requirement for affirmative reservation of rights**

Publication is the distribution of copies of a “work to the public by sale or other transfer of ownership, or by rental, lease, or lending” with “no explicit or implicit restrictions with respect to [the] disclosure of [the] contents [of that work].” 17 U.S.C. § 101; H.R. Rep. No. 94-1476, at 138 (1976), reprinted in 1976 U.S.C.C.A.N. at 5754 (emphasis added).

Similarly, the Compendium contemplates that a work is unpublished when the author places a statement on copies of a work limiting or restricting distribution, particularly when the distribution is limited to a selected group and for a limited purpose. Compendium § 1905.1.

**No implication of intent to distribute**

Congress explained that any “unauthorized public distribution of copies would be an infringement.” 17 U.S.C. § 101; H.R. Rep. No. 94-1476, at 138 (1976), reprinted. Nimmer goes further, suggesting that “Congress could not have intended that the various legal consequences of publication under the current Act would be triggered by
the unauthorized act of an infringer or other stranger to the copyright.” David Nimmer & Melville Nimmer, 1 Nimmer on Copyright sec. 4.03 (2019).

The very nature of “public” in “public performance and displays” indicates that there is the obvious opportunity for copying whether it be taking a picture of the poster in a museum, (H.R. Rep. No. 94-1476, at 64 (1976), reprinted in 1976 U.S.C.C.A.N. at 5677), recording a performance of a concert (Compendium § 1908), or videotaping a television program (Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (1984)). Similarly, in the Internet and social media context, the end user’s ability to copy does not necessarily imply that the author intended their work to be distributed and published.

**Buttons associated with the work**

If a work posted to a website (whether public or restricted) or peer-to-peer network and has a “download”, “print”, “add to cart” button (or other options with similar intent) associated with the work, then it should be deemed published as the author’s intent is for the work to change hands. Compendium § 1008.3(F).

However, if the author posts a PDF, podcast, or similar file with an “open” button then this work should be deemed unpublished as the author has not communicated the intent for the work to change hands. Although, if the “open” button saves a copy of the PDF/podcast file on the user’s local drive then the work should be deemed published as it has changed hands.

If the author posts a work with a “share” button, such as the use of social media, email, or another type of widget, then this work should be deemed published if by sharing it creates a copy to be further distributed. However, if the “share” functionality simply provides a link and an abstract to direct future users to the work, then the work should not be deemed published as no copies were made and the location of the public display of the work has not moved.

**Email**

If the work is contained in the body of the email and the email message also communicates a message that encourages the reader to further distribute the email, then the work should be deemed published. If no such encouragement, then the work should be deemed unpublished.

If the work is emailed as an attachment, it would be opened on the user’s local drive and would therefore have changed hands, however, this can be likened to physical correspondence when the work has changed hands but does not constitute publication. However, if the email message encourages further distribution, then it should be considered published as described above.

**Streaming**

Posting a work for public display online does not create publication. The Copyright Act suggests that ‘the public’ consists of a large group of people outside of a family and
friends,” such as “a large number of people who are unrelated and unknown to each other.” *American Broadcasting Companies, Inc. v. Aereo, Inc.*, 134 S. Ct. 2498, 2509-10 (U.S. 2014). ‘[T]he public’ need not be situated together, spatially or temporally” for a public performance or public display to occur. *Id.* at 2510. Moreover, “when an entity communicates the same contemporaneously perceptible images and sounds to multiple people, it transmits a performance to them regardless of the number of discrete communications it makes.” *Id.* at 2509. For instance, when an entity “streams the same television program to multiple subscribers, it ‘transmit[s]... a performance’ to all of them,” regardless of whether the entity makes the transmission “from the same or separate copies” or from “user-specific copies.” *Id.* (quoting 17 U.S.C. § 101 (definition of “perform or display a work ‘publicly’”)).

As with works posted with a “share” button, audio/visual works posted online should only be deemed published by streaming if it creates a copy of the work to be further distributed.

**Social media and other platforms terms of use**

The terms of use of social media and other online platforms used to post works online are binding on the author when used to post their work. Excerpts from prominent social media platforms terms of use:

**Facebook:** “You own the intellectual property rights (things like copyright or trademarks) …However, …, when you share, post, or upload content that is covered by intellectual property rights on or in connection with our Products, you grant us a non-exclusive, *transferable*, *sub-licensable*, royalty-free, and worldwide license to host, use, *distribute*, modify, run, copy, publicly perform or display, translate, and *create derivative works* of your content.” (Emphasis added.)

**Twitter:** “What’s yours is yours” but “you grant us a worldwide, non-exclusive, royalty-free license (*with the right to sublicense*) [that]... authorizes us to make your *Content available to the rest of the world and to let others do the same.*”) (Emphasis added.)

**Snapchat:** [Y]ou retain whatever ownership rights in that content you had to begin with. But you grant us a... worldwide, royalty-free, *sublicensable*, and *transferable* license to host, store, use, display, *reproduce*, modify, adapt, edit, publish, and *distribute* that content. (Emphasis added.)

By using the platform, the author is agreeing to the terms of use and if those terms of use grant a license from the author to the platform and that license is transferrable, sublicensable, grants the rights of reproduction or distribution, then the author has published the work.
ii. **The timing of publication when copies are distributed and/or displayed electronically.**

Assuming the online work meets the statutory definition of published, then the date of first publication should be the date the work was first posted online in a manner that met the definition of publication.

iii. **Whether distributing works to a client under various conditions, including that redistribution is not authorized until a “final” version is approved, constitutes publication and the timing of such publication.**

We agree with the Compendium that the doctrine of limited publication applies to draft documents when the author restricts both the purpose and recipients to a distribution, and we believe that distributing works to a client under various conditions, including that redistribution is not authorized until a “final” version is approved, does not constitute publication. Compendium § 1905.1. A “limited publication” is the distribution of copies of a work to a select group for a limited purpose. *Id.* A “limited publication” is distinguished from a “general publication” to avoid the divestive consequences of publication without notice when it was clear the author (or copyright proprietor) restricted both the purpose and the recipients of the distribution. *Id.; see also White v. Kimmell, 193 F.2d 744, 746-47* (9th Cir. 1952) (explaining that a publication is limited if it “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 is] restricted both as to persons and purpose.”). For example, sending a manuscript to prospective publishers or distributing copies of a research paper for a seminar or a speech are not publication. Similarly, we believe the limited distribution of a work before the work is “final” does not constitute publication.

iv. **Whether advertising works online or on social media constitutes publication.**

We believe that the public performance or display of works online or on social media does not constitute publication, whether advertising a portion of a work or otherwise posting or making a work available on social media. Whether the author demonstrates authorization for others to distribute or reproduce the work should determine whether the work was published online, as discussed in section 2(i).

**No implication of surrendering control**

Congress explained that the owner’s exclusive right to publication is “the right to control the first public distribution of an authorized copy or phonorecord of his work” and explains that any unauthorized public distribution of copies would be an infringement.” 17 U.S.C. § 101; H.R. Rep. No. 94-1476, at 138 (1976), *reprinted.* That control was not surrendered by displaying a painting in a gallery (H.R. Rep. No. 94-1476, at 64 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5677), displaying an online advertisement offering to sell an app directly to the public (Compendium § 1906.01) or when posting a digital file of a performance of a theatrical production on the Internet (*Einhorn v. Mergatroyd Productions, 426 F. Supp. 2d 189, 197* (S.D.N.Y. 2006)). The online environment does not change the author’s right to control the public
performance or display of her work. To put another way, the author does not lose control over distribution due to the online environment.

v. Any other issues raised in section I(C) above.

We have no other issues regarding section I(C).

3. Can and should the Copyright Office promulgate a regulation to allow copyright applicants to satisfy the registration requirements of section 409 by indicating that a work has been published “online” as the nation of first publication, without prejudice to any party subsequently making more specific claims or arguments regarding the publication status or nation(s) in which a work was first published, including before a court of competent jurisdiction?

INTA agrees that the Office should propose regulations to make it easier for applicants to satisfy the registration requirements of Section 409.

The unintended consequence of the lack of definition of “publication” particularly in the online context, as well as the technical constraints of the USCO forms, is the author's loss of rights. See Gold Value International Textile, Inc. v. Sanctuary Clothing, LLC, 925 F.3d 1140 (9th Cir. 2019) (affirming dismissal of a complaint based on the lack of a valid registration, as well as the award of over $120,000 in attorneys’ fees to defendants as the prevailing parties due to error in determining publication of a work). To minimize the risk of a registration being invalidated or rights being lost through mistaken interpretation of the term “publication,” the Office should allow the author to indicate that a work has been published “online” and to identify the nation from which the work was posted online as the nation of first publication. These changes should be allowed without prejudice to any party subsequently making more specific claims or arguments regarding the publication status or nation(s) in which a work was first published, including before a court of competent jurisdiction.

4. Should the Copyright Office alter its practices to allow applicants who pay a fee to amend or supplement applications to partition the application into published and unpublished sections if a work (or group of works) the applicant mistakenly represented was either entirely published or unpublished in an initial application is subsequently determined to contain both published and unpublished components?

INTA believes that the Office should allow applicants to amend or supplement applications which mistakenly identify works as entirely published or unpublished, when the applicant subsequently determines that the application contained both published and unpublished components.

Section 408(c)(1) authorizes the Register of Copyrights to establish administrative classes into which works are to be placed for purposes of deposit and registration. The Register may also, among other things, permit the single registration of a group of related works. 17 U.S.C. § 408(c)(1). When Congress amended the Copyright Act in 1976, it determined that “allowing 'a number of related works to be registered together as a group represent[ed] a needed and important liberalization of the law.'” Compendium § 1104.1 (quoting H.R. Rep. No. 94-1476 at 154 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5770). Congress sought to alleviate
unnecessary burdens and expenses” on copyright owners resulting from multiple applications to register related works, which might cause copyright owners to “forego registration altogether.” Id. This would create gaps in the public registration record, as well as in the Library of Congress repository.

USCO regulations currently permit the group registration of a variety of types of published works, including published photographs. The regulations also permit the registration of a collection of unpublished works. Moreover, the regulations permit a registrant to correct or amplify certain types of records.

The regulations do not, however, permit the registration on a single application of both published and unpublished works. Nor do the regulations permit a supplementary registration to reclassify multiple-work registrations into different registration accommodations. The Office reasons that such changes “would alter the fundamental nature of the claim, and would undermine the legal presumptions afforded to the initial examination of the works. And it would be inconsistent with the statutory and regulatory provisions stating that a supplementary registration augments – but does not supersede – the basic registration.” Compendium § 1802.4.

Section 411(b) provides that a copyright registration is invalid if the copyright owner knowingly included inaccurate information in the application and the inaccuracy, if known, would have caused the Register of Copyrights to refuse registration. 17 U.S.C. § 411(b). As a result, a copyright owner’s misclassification of a work as published or unpublished in a multiple-work application risks a harsh forfeiture. A recent Ninth Circuit opinion illustrates the danger. In Gold Value Int’l Textile, Inc. v. Sanctuary Clothing, LLC, 925 F.3d 1140 (9th Cir. 2019), the plaintiff sued for alleged infringement of a textile design. The plaintiff had registered the asserted design as part of an unpublished collection comprising 34 fabric designs. Id. at 1142. Before filing the application, the plaintiff had sold samples of the asserted design to a “limited group of existing and potential customers for the limited purpose of securing full production contracts” for the sale of large quantities of the fabric. Id. The plaintiff asserted that such limited sales did not constitute “publication.” Id. at 1145. The district court disagreed, entering summary judgment in favor of the defendant, and the Ninth Circuit affirmed, holding that because the asserted design “was distributed to the public by sale or other transfer of ownership, it was published within the meaning of the Copyright Act.” Id. The plaintiff knew that it had sold copies of the asserted design before filing the copyright application, and “provide[d] no reasonable basis for this belief.” Id. at 1147. At the district court’s request, the Register of Copyrights furnished a letter opining that if the Copyright Office had known that the asserted design was previously published, it would have refused registration of the work as part of an unpublished collection. Gold Value Int’l Textile, Inc. v. Sanctuary Clothing, LLC, No. LA CV16-00339 JAK (FFMx), Dkt. No. 122-1. Having found both elements of Section 411(b) satisfied, the district court entered summary judgment, and then exercised its discretion to award attorneys’ fees to the defendant as the prevailing party.

With one narrow exception, the Office’s decision to provide registration options for groups of related works rests within its discretion. Compendium § 1104.2. Based on its experience, the Office has concluded that examining multiwork applications “imposes administrative costs and burdens on the Office.” Id. § 1104.3. The Office will need to take these costs and burdens into account in assessing the potential for allowing supplemental registrations to correct misidentification of works as entirely published or unpublished. However, INTA believes that
administrative burdens should not outweigh the risk of the type of harsh forfeiture seen in the *Gold Value* case. Courts would need to address whether such a supplemental registration would undermine the legal presumptions afforded to the initial examination of the works.

5. **For certain group registration options, should the Copyright Office amend its regulations to allow applicants in its next generation registration system to register unpublished and published works in a single registration, with published works being marked as published and the date and nation of first publication noted?**

For the reasons identified in Section 4, the Office should not allow applicants to include both unpublished and published works in a single registration.

6. [omitted]

7. **Is there a need to amend section 409 so that applicants for copyright registrations are no longer required to identify whether a work has been published and/or the date and nation of first publication, or to provide the Register of Copyrights with the regulatory authority to alter section 409(8)’s requirement for certain classes of works?**

INTA does not support the amendment of 17 U.S.C. § 409 to eliminate the requirement that applicants identify whether a work has been published and/or the date and nation of first publication. These requirements serve important procedural and evidentiary functions. For example, the publication status, and if published, publication date can determine whether a prevailing plaintiff is entitled to seek statutory damages and attorneys’ fees in litigation. 17 U.S.C. § 412. A prevailing plaintiff is eligible to seek such damages and fees for the infringement of a published work if the alleged infringement began after first publication of the work and before the effective date of its registration, unless such registration is made within three months after first publication of the work. 17 U.S.C. § 412(2). Additionally, in judicial proceedings a registration made within five years of first publication of the subject work constitutes *prima facie* evidence of the validity of the copyright and of the facts stated in the registration certificate. 17 U.S.C. § 410. And the nation of first publication of a work can determine whether the owner must first register it before instituting an infringement action in the United States. 17 U.S.C. § 411(a); *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, 139 S.Ct. 881 (2019).

Identifying the date and nation of first publication thus serves important procedural and evidentiary functions, and INTA does not support their elimination.

8. **Is there a need for Congress to take additional steps with respect to clarifying the definition of publication in the digital environment?**

While INTA is not recommending that Congress take additional steps to clarify the definition of publication, INTA has analyzed below three possible options, namely: 1) retaining the current definition, 2) amending the statutory definition to explicitly apply to digital content, and 3) replacing the statutory definition.
Retaining the definition

Creative regulatory and court interpretation of statutory meaning is a large part of what allows U.S. statutory language to remain the same over time while retaining sufficient flexibility to accommodate future developments not anticipated when first enacted.

The Act defines “publication” both by what it is and what it is not: “A public performance or display of a work does not of itself constitute publication.” The phrase “of itself” could be a key to making the definition relevant to the digital economy. “Of itself” could allow further differentiation of what works should be considered published or unpublished despite public performance or display.

According to Nimmer, the current statutory definition requires that an “exchange” (presumably of consideration/value) must occur to constitute publication. If the requirement for publication is interpreted to require that the title to (i.e. ownership of) a physical object embodying the work must be impacted, via sale or lease, it is difficult to see how any ephemeral broadcast, stream, or display could ever constitute publication.²

On the other hand, it could be argued that the download of a digitized version of a work, or a downloadable update to previously purchased software, should constitute publication, even if the downloads are automatic and/or are available for no charge. This latter approach could also influence whether government taxing, financial, and enforcement authorities, including U.S. Customs and Border Protection (“CBP”), treat digital downloads or digital “copies” embodied in hard storage media (such as DVDs and CDs) are viewed as individual “goods” subject to CBP’s detention and seizure as counterfeit products under the Lanham Act, in addition to whatever sanctions are available via the 1976 Act.

It is possible, then, to retain the publication definition as it exists in the Act. But the two interpretations could yield dramatically different results: one that brings all digital works within the ambit of publication, the other which does not.

Amending the statutory definition to explicitly apply to digital content

An intermediate option between no change and wholesale replacement would be to amend the definition of publication to explicitly cover and apply to digital content. Numerous legal journal articles have been written on this option, some focusing on specific contexts, and others expressing a more general concern.

Julia Marter, in When and Where Does an Internet Posting Constitute Publication? proposes a modification, at least in the Internet posting context. 21 Fordham Intell. Prop. Media & Ent. L.J. 495. Though modification seems less burdensome than a complete replacement of the statutory definition, Marter is in fact asking for a lot by changing only a little. She writes that “[a]ny workable solution must be comprehensive in nature—addressing the definition of publication, the copyright formalities, and jurisdictional questions all together. Such a solution should grant authors the appropriate protection, but should also require them to be

² We deem weak the argument that a portion of a subscriber’s fee could be allocated to “rental” of streamed audio-visual content. This would involve a real “stretch” of the ordinary and customary meaning given to the terms “lease” or “rental”.


accountable through some formality. The solution must be international in scope, and must include cheap and easy access to registration."

In *Copyright Publication: An Empirical Study*, Deborah R. Gerhardt writes: “The question of publication is a daily challenge for anyone who must make decisions about whether works in our museums and libraries may be used and digitized.” 87 Notre Dame L. Rev. 135. The 1976 Act is just one of the many facets of copyright law Gerhardt examines – her focus is on federal court decisions interpreting the Act. The definition of publication, she writes, is “ambiguous” in light of these decisions – and consistency of application is certainly not helped by the various definitions courts have developed.

**Replacing the statutory definition**

The third primary option is to replace the statutory definition of publication entirely, either as a separate amendment, or as part of a more comprehensive revision or replacement of the 1976 Act. The rationale may be that the first-ever statutory definition of publication in federal copyright law is simply incapable of encompassing the unanticipated breadth and depth of the digital economy.

In *Getaped.Com, Inc. v. Cangemi*, 188 F.Supp.2d 398 (SDNY 2002), the court had to determine whether Internet transmissions constituted publication. The court concluded “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.’” In *Rogers v. Better Business Bureau of Metropolitan Houston, Inc.*, 887 F. Supp.2d (SD Tex 2012), the court disagreed with that conclusion. The *Rogers* court found that uploading webpages to the internet did not constitute publication as defined by copyright law, but also observed that “the reason for finding publication varies from case to case.”

It is this last statement that is so troubling. Case-by-case analyses, which lend themselves to subjectivity and inconsistency, should not be required based purely on supposedly ambiguous language in the statute itself.

As Gerhardt concluded in her study,

“…[C]ourts use their own nuanced view of what constitutes publication, and rely heavily on the copyright owner's intent with respect to authorized copies. When the facts show that they are distributed freely, it weighs in favor of publication. When the work is made accessible in a way that demonstrates that the copyright owner is retaining control over the copies, publication is less likely to be found. Although these data looking at past decisions allow for statistical prediction, they are not a crystal ball. One cannot guarantee that future publication decisions will follow the patterns of the past.”

9. Any additional considerations regarding online publication.

There is little doubt that the current definition of “publication” has created ambiguities and discrepancies in the law. In the “Digital Age”, with the American economy dependent on digital works and technologies in order to function well, it is important that the definition of publication align with U.S. copyright law and policy and with current and foreseeable technologies.
Authors, creators, regulators, and consumers ought to have the benefit of a clear definition that accounts for copyright works as we now find them, and not just those which existed at the time the 1976 Act was adopted.

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This concludes INTA’s Response to the NOI. Please do not hesitate to contact INTA’s Director for Government Relations, Jennifer McDowell (jmcdowell@inta.org) the Office has any questions about our comments, or if we can provide additional information or be of further service.

Respectfully submitted,

Sincerely yours,

Etienne Sanz de Acedo
Chief Executive Officer
International Trademark Association