



supreme court holds section 411(a) requiring pre-suit registration is not jurisdictional

MSK Client Alert

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On March 2, 2010, in *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. __ (2010), the Supreme Court (8-0) held that the Copyright Act's requirement in section 411(a) that copyright owners register (or attempt to register) their works before filing a claim for copyright infringement does not otherwise restrict a federal court's subject-matter jurisdiction over claims involving unregistered works. This ruling is important, not just for the settlement of class action matters involving registered and unregistered works - which can proceed (for example, Google Book Settlement) - but also for all infringement actions where courts now clearly have the jurisdiction to enjoin future infringements (*i.e.*, of unregistered works) - an important remedy for some rights holders.

The *Muchnick* case is, in essence, a continuation of prior proceedings: *New York Times Co. v. Tasini*, 533 U.S. 483 (2001). In *Tasini*, the Supreme Court held that owners of online databases and print publishers had infringed the rights of freelance authors of newspaper and magazine articles by digitally reproducing their works (beyond the scope of section 201(c)). Numerous suits stayed during *Tasini*, involving similarly-situated freelance authors, were resumed after that 2001 ruling and were consolidated in the District Court for the Southern District of New York. After mediation, the parties in those cases reached a settlement agreement in March 2005. The District Court certified the settlement class and approved the settlement, but some freelance authors, including Irvin Muchnick, objected to it, and appealed to the Second Circuit. The Second Circuit then raised *sua sponte* the issue of subject matter jurisdiction over the numerous authors of unregistered works among the consolidated authors, finding that the district court lacked jurisdiction to certify a class of authors that included claims of infringement pertaining to unregistered works.

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The Supreme Court reversed, holding that section 411(a)'s registration requirement was not jurisdictional for three reasons: (1) despite its use of the word "jurisdiction," it did not "clearly statell" that its registration requirement is jurisdictional - generally, noting a distinction between "jurisdictional conditions" and "claim-processing rules" (such as a pre-condition to filing a suit); (2) section 411(a) is located in a different section of the Copyright Act than those provisions granting federal courts subject matter jurisdiction over copyright infringement claims; and (3) section 411(a) contains exceptions which *do* allow for subject matter jurisdiction over certain claims of infringement of unregistered works (for example, for foreign works, or works for which an attempted registration has been denied).

The Court left unresolved two matters in this case: (1) whether the district court had authority to approve the settlement even under its erroneous reading of section 411(a); and, more importantly, (2) whether section 411(a)'s registration requirement is a mandatory precondition to suit that district courts may enforce *sua sponte* by dismissing copyright infringement claims involving unregistered works. The decision also leaves unresolved the split in the circuits regarding when the precondition to suit is met: simply by filing for a registration with the Copyright Office before filing a complaint, or whether the registration process, including the issuance of a completed certificate (or a rejection), has to be completed before bringing suit.