THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF IOWA
CENTRAL DIVISION

CHRIS A. WILLIAMS, Plaintiff, v. HY-VEE, INC. and DOES 1-10, Defendants.	No. 4:22-CV-25 Honorable Rebecca Goodgame Ebinger, District Judge

NOTICE OF FILING

THE RESPONSE OF THE REGISTER OF COPYRIGHTS

The undersigned counsel of the Department of Justice appear on behalf of the Register of Copyrights (Register) for the purpose of filing the Register's response to the Court's *Request to Register of Copyrights*, Dkt. No. 124 (Mar. 31, 2023). *The Response of The Register of Copyrights To Request Pursuant To 17 U.S.C. § 411(b)(2)* is attached.

Respectfully submitted,

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RESPONSE OF THE REGISTER OF COPYRIGHTS TO REQUEST PURSUANT TO 17 U.S.C. § 411(b)(2)

On March 31, 2023, pursuant to 17 U.S.C. § 411(b)(2), the Court requested advice from the Register of Copyrights (the "Register") on the following questions:

1. Would the Register of Copyrights have refused Copyright Registration Number VAu001359660 to [Mr. Chris A.] Williams if the Register had known that:

    a. Williams entered into an agreement providing for the transfer of both ownership of the physical applied-for work and copyright in the applied-for work from Williams to a non-profit entity, as described in the [Court's] Order;
    b. Williams knowingly provided inaccurate information on his registration application by stating one person owned all rights in the applied-for work;
    c. The applied-for work is publicly displayed within the meaning of the Copyright Act, 17 U.S.C. § 101.[1]

The Register hereby responds that, based on the information provided by the Court and the examining practices of the U.S. Copyright Office (as described here), had the Office known that Mr. Williams had (a) entered into an agreement transferring the copyright in "UNTITLED CAW" (the "Work") to a third party prior to submitting the Work for registration, and/or (b)

[1] Req. to Register of Copyrights 1–2 ("Request"), ECF No. 124.

knowingly provided inaccurate information by stating that one person owned all rights in the Work, it would not have registered the work under the Single Application. Instead, the Office would have communicated with the applicant to direct him to register the claim using the Standard Application. Even if he had transferred ownership of the Work, Mr. Williams would have been entitled to register the Work using the Standard Application, naming himself as the author and copyright claimant. However, the fact that the work was publicly displayed within the meaning of 17 U.S.C. § 101 would not have affected the Office's registration decision. The owner of a lawfully made copy of a work may publicly display the work without obtaining any exclusive rights in the work. 17 U.S.C. § 109(c). Therefore, public display of the work by someone other than the applicant would not have been relevant to the Office's evaluation of the application.

BACKGROUND

I. Examination History

A review of the Copyright Office's records shows the following:

On June 26, 2019, the Office received an application to register a mural titled "UNTITLED CAW." The application was filed using the Single Application, a registration option that allows a single author to register a claim in one work that is solely owned by the same author and is not a work made for hire. The application identified "Christopher CAW Williams" as the sole author and claimant of the Work. The application stated that the Work was completed in 2018 and that it was unpublished. Based on the information in the application, along with Mr. Williams'[2] representations that the Work was created by one individual who owned all rights in it, the Office registered the Work with an effective date of registration

[2] The registration application was submitted by Jeff Gluck of the Gluck Law Firm on Mr. Williams' behalf. Mr. Gluck identified himself as the "Authorized agent of [the] Author/Owner."

("EDR") of June 26, 2019,[3] and assigned it registration number VAu001359660 (the "Registration"). The Office had no reason to question Mr. Williams' representations in the application and accepted them as true and accurate.

II. The Court's Request

Mr. Williams commenced this action on February 3, 2022, alleging, among other claims, infringement of the copyright in the Work.[4] In response, defendant Hy-Vee, Inc. ("Hy-Vee") brought a counterclaim for declaratory judgment invalidating the Registration.[5] Hy-Vee asked the Court to issue a request to the Copyright Office to advise whether the Office would have refused the registration if it had known that certain information included in the registration application was inaccurate.[6]

The Court granted Hy-Vee's summary judgment motion as to Mr. Williams' copyright infringement claim after determining that Mr. Williams did not own a valid copyright in the Work because he had transferred the copyright to an entity named 6th Avenue Corridor.[7] With respect to Hy-Vee's counterclaim, the Court found that "Hy-Vee . . . met its burden of demonstrating the statutory criteria for a mandatory referral to the Copyright Office."[8] First, based on its finding that Mr. Williams did "not possess ownership of copyright in the mural" prior to registering the Work, the Court concluded that Hy-Vee adequately alleged that Mr. Williams provided inaccurate information on his application, namely that "the author and the

[3] The EDR is the date the Office received a completed application, correct deposit copy, and the proper filing fee. 17 U.S.C. § 410(d).
[4] Compl., ECF No. 1.
[5] Defs.' Am. Answer, Affirmative Defenses, and Countercl., ECF No. 12.
[6] *Id.*
[7] Order Granting in Part Def.'s Mot. for Summ. J. at 2, 12 ("Order"), ECF No. 113. Nothing in this Response should be read to suggest that the Register agrees with the Court's substantive determination that Mr. Williams transferred his rights in the Work to 6th Avenue Corridor. The transfer of a copy of the work, even its original fixation, does not by itself transfer the copyright, or any exclusive rights, in the work. 17 U.S.C. § 202. For purposes of this Response, however, the Office addresses only the questions the Court has provided to us.
[8] Order at 19.

owner of copyright in the mural were the same person, and second, that this person owned all rights in the mural."[9] Next, the Court determined that Hy-Vee "sufficiently alleged Williams knowingly provided inaccurate information on his registration application by stating one person owned all rights in the mural."[10] Additionally, the Court determined that Mr. Williams "either knew or was willfully blind at least to the necessity of transferring the right to publicly display the mural to 6th Avenue Corridor," "along with physical ownership of the mural" when he "signed a contract transferring 'ownership of the Work' to 6th Avenue Corridor."[11] The Court therefore requested that the Register advise the Court regarding whether, if the Office had known of the inaccurate information provided in the application, it would have refused to register the Work.

ANALYSIS

I. Relevant Statutes, Regulations, and Agency Practice

An application for copyright registration must comply with the requirements of the Copyright Act set forth in 17 U.S.C. §§ 408(a), 409, and 410. Regulations governing applications for registration are codified in title 37 of the Code of Federal Regulations at 37 C.F.R. §§ 202.1 to 202.24. Further, the principles that govern how the Office examines registration applications are set out in the *Compendium of U.S. Copyright Office Practices,* an administrative manual that instructs agency staff regarding their statutory and regulatory duties and provides expert guidance to copyright applicants, practitioners, scholars, courts, and members of the general public regarding Office practices and related principles of law. The Office publishes regular revisions of the *Compendium of U.S. Copyright Office Practices* to

[9] *Id.* at 23.
[10] *Id.* at 26.
[11] *Id.* at 25–26.

provide additional guidance where necessary and to reflect changes in the law and/or Office practices, which are provided for public comment prior to finalization. Because Mr. Williams filed his application in 2019, the governing principles the Office would have applied when evaluating his application are set forth in the *Compendium of U.S. Copyright Office Practices, Third Edition* (referred to as "COMPENDIUM (THIRD)") that was first released in September 2017.[12] The analysis below also reflects the practices in effect in 2019—including updates made to the Single Application and relevant examination procedures in December 2017.[13]

A. Who May File a Registration Application

The Copyright Act provides that "the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim" if he or she provides the requisite deposit, application, and fee.[14] An application for registration must include "the name and address of the copyright claimant," "the name . . . of the author or authors," and "if the copyright claimant is not the author, a brief statement of how the claimant obtained ownership of the copyright."[15]

Copyright Office regulations define a claimant as either the "author of a work" or "[a] person or organization that has obtained ownership of all rights under the copyright initially belonging to the author."[16] At the time of Williams' application, COMPENDIUM (THIRD) explained that "[t]he author may always be named as the copyright claimant, even if the author has transferred the copyright or one or more of the exclusive rights to another party, or even if

[12] The Copyright Office published a new version of the COMPENDIUM (THIRD) in January 2021. The 2017 version cited in this Response is available at https://www.copyright.gov/comp3/2017version/docs/compendium.pdf.
[13] *See* U.S. COPYRIGHT OFFICE, ECO UPDATES (Feb. 4, 2011–Nov. 30, 2020), https://copyright.gov/eco/updates/eco-updates.pdf (last visited May 30, 2023); U.S. COPYRIGHT OFFICE, CIRCULAR 11: USING THE SINGLE APPLICATION at 1 (Dec. 2017), https://web.archive.org/web/20171218224125/https://copyright.gov/circs/circ11.pdf.
[14] 17 U.S.C. § 408(a).
[15] *Id.* § 409(1), (2), (5).
[16] 37 C.F.R. § 202.3(a)(3); *see also* COMPENDIUM (THIRD) § 404 (discussing eligible copyright claimants).

the author does not own any of the rights under copyright when the application is filed."[17] This policy is consistent "with the fundamental thrust of the [Copyright Act of 1976] in identifying copyright, and the origin of all rights comprised in a copyright, with the author."[18] Accordingly, COMPENDIUM (THIRD) provided that only certain parties, namely "[t]he author of the work[,] [t]he owner of all the exclusive rights in the work[,] [t]he owner of one or more—but less than all—of the exclusive rights in the work[,][19] or [a] duly authorized agent of any of the foregoing parties," may submit a registration application to the Office.[20]

B. Works Eligible for the Single Application

The Copyright Act gives the Register the authority to create registration application forms and to specify the information that should be included in the application.[21] Pursuant to this authority, the Office has created different versions of its online application and paper forms. To obtain a basic registration[22] using the online registration system, an applicant can use a Standard Application or a Single Application. The Office created the Single Application for "administratively simple" claims.[23] The regulations state:

> The Single Application may be used only to register one work by one author. All of the content appearing in the work must be created by the same individual. The work must be owned by the author who created it, and the author and the claimant must be the same individual.[24]

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[17] COMPENDIUM (THIRD) § 619.7. *See generally Registration of Copyright: Definition of Claimant*, 77 Fed. Reg. 29257, 29258 (May 17, 2012); *Registration of Claims to Copyright*, 43 Fed. Reg. 965, 965 (Jan. 5, 1978).
[18] *Applications for Registration of Claim to Copyright Under Revised Copyright Act*, 42 Fed. Reg. 48944, 48946 (Sept. 26, 1977).
[19] A party who owns one or more—but less than all—of the exclusive rights in the work can apply for—and receive—a registration, but cannot be named as a copyright "claimant" in the registration application unless he or she is the author of the work. *See* COMPENDIUM (THIRD) §§ 619.5, 619.7.
[20] *Id.* § 402.
[21] *See* 17 U.S.C. § 409.
[22] A "basic registration" is "[a] registration issued on or after January 1, 1978." COMPENDIUM (THIRD) Glossary.
[23] *Single Application Option*, 78 Fed. Reg. 38843 (June 28, 2013).
[24] 37 C.F.R. § 202.3(b)(2)(i)(B)(1).

At the time Mr. Williams submitted his application to register the Work, the online registration system directed applicants to select a link from a list of registration options, one of which was "Register One Work by One Author." If the applicant selected this link, the next screen titled "Registration Process Overview" asked the applicant to confirm that the work being registered met a number of eligibility requirements, including that "[t]he author and the owner/claimant of th[e] work must be the same person, and that person must own all of the rights in th[e] work."[25]

If the applicant submitted the Single Application to register a work that did not satisfy all of the criteria, the instructions for the Single Application stated that the application "may be refused or there may be delays in the examination of your claim that could require the payment of an additional fee and a later effective date of registration for your claim."[26] If the application was refused, the Office would have directed the applicant to resubmit the claim on the Standard Application and pay the full filing fee.[27]

C. The Public Display Right

Section 106(5) of the Copyright Act grants the owner of a copyright the exclusive right to publicly display a work.[28] However, this right is subject to certain limitations, including the limitation contained in Section 109(c) of the Copyright Act, which provides:

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[25] U.S. COPYRIGHT OFFICE, SINGLE APPLICATION VIDEO TUTORIAL (Dec. 2017), https://www.copyright.gov/eco/single.mp4. On December 16, 2017, the Office updated the user interface for the electronic registration system, which included design updates to the online registration application options. U.S. COPYRIGHT OFFICE, ECO UPDATES (Feb. 4, 2011–Nov. 30, 2020), https://copyright.gov/eco/updates/eco-updates.pdf (last visited May 30, 2023). Because Mr. Williams applied to register the Work after December 16, 2017, he would have used the updated interface and instruction, even though they were not reflected in the 2017 version of the COMPENDIUM (THIRD). Between 2017 and 2019, when he submitted his application, the Office did not make changes to the eligibility criteria for the Single Application.

[26] U.S. COPYRIGHT OFFICE, SINGLE APPLICATION VIDEO TUTORIAL (Dec. 2017), https://www.copyright.gov/eco/single.mp4.

[27] U.S. COPYRIGHT OFFICE, CIRCULAR 11: USING THE SINGLE APPLICATION at 1 (Dec. 2017), https://web.archive.org/web/20171218224125/https://copyright.gov/circs/circ11.pdf.

[28] 17 U.S.C. § 106(5).

> Notwithstanding the provisions of section 106(5), the owner of a particular copy lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to display that copy publicly, either directly or by the projection of no more than one image at a time, to viewers present at the place where the copy is located.[29]

As used in this section, the term "copy" refers to the material object on which a work is fixed, including where, as here, there is only a single copy comprising the original fixation of the work.[30] Therefore, regardless of who owns the copyright in a work, the owner of the original or any other lawfully made copy may display it publicly without infringing the copyright owner's public display right.

II. Register's Response to Court's Request

Applying the foregoing governing statutory and regulatory standards, and the Office's examining practices, the Register responds to the Court's questions as follows:

Question 1(a)

Had the Office been aware that Mr. Williams entered into an agreement transferring the copyright in the Work to a third party prior to submitting the Work for registration, it would not have registered the Work through a Single Application. Instead, the registration specialist would have refused registration of the Work and directed Mr. Williams to resubmit the claim using the Standard Application.

As discussed above, even if Mr. Williams did not own the copyright in the Work at the time he filed the application, he was a proper claimant as the author of the Work.[31] COMPENDIUM (THIRD) states that "[t]he author . . . may be named as the copyright claimant even if the author has transferred the copyright or one or more of the exclusive rights to another party,

[29] *Id.* § 109(c).
[30] *Id.* § 101 (definition of "copies") ("The term 'copies' includes the material object, other than a phonorecord, in which the work is first fixed.").
[31] COMPENDIUM (THIRD) § 402.

or even if the author does not own any of the rights at the time the application is filed."[32] Therefore, even if Mr. Williams transferred all of the exclusive rights in the Work to a third party, he could have registered the Work if he submitted his claim on the Standard Application, naming himself as both the author and copyright claimant.

However, the Single Application may not be used to register a work for which the author transferred the copyright or any exclusive rights to a third party, either by written agreement or by operation of law.[33] Had the Office known that Mr. Williams had transferred ownership of the copyright, the Office would have refused to register the Work through the Single Application and directed Mr. Williams to resubmit the claim using the Standard Application. The EDR would be the date that the Office received the Standard Application, deposit, and fee.

Question 1(b)

Had the Office been aware that Mr. Williams knowingly provided inaccurate information by stating that the author owned all rights in the Work, it would not have registered the Work under the Single Application. As explained above, ownership of all of the rights in the work by the author is a criterion only for use of the Single Application, not a requirement for registration generally. As the author of the Work, Mr. Williams could have registered the Work but would have been required to use the Standard Application to do so.

Question 1(c)

The fact that the Work was publicly displayed by someone other than Mr. Williams would not have affected the Office's decision as to whether to register the Work. As noted above, the owner of a lawfully made copy of a work may publicly display that copy without the

[32] *Id.* § 405; *see* 37 C.F.R. § 202.3(a)(3)(i).
[33] *See* 37 C.F.R. § 202.3(b)(2)(i)(B); COMPENDIUM (THIRD) § 609.1(B).

authorization of the copyright owner.[34] The creation of a mural on another's wall does not require a transfer of the exclusive right to publicly display the mural.[35] The owner of a lawfully made copy of the mural, including its original fixation, may publicly display it without obtaining the copyright or any exclusive rights in the work.[36]

Accordingly, 6th Avenue Corridor's public display of the Work prior to Mr. Williams' filing of the application to register it would not have impacted whether the Work was eligible for registration.

CONCLUSION

After review of the Court's findings in this action and application of the relevant law, regulations, and the Office's practices, the Register advises the Court that the Office would not have permitted registration of the Work through the Single Application had it known that Mr. Williams had entered into an agreement that transferred the copyright in the Work to another entity. Rather, the registration specialist would have instructed Mr. Williams to register the claim using a Standard Application. The public display of the Work, however, would not have affected the Office's registration decision. Section 109(c) of the Copyright Act permits the owner of a lawfully made copy of a work to publicly display the copy without obtaining the copyright or any exclusive rights in the work. Therefore, had the Office known that 6th Avenue Corridor publicly displayed the Work prior to Mr. Williams' filing of the application to register it, that fact alone would not have made the Work ineligible for registration. Unless the application indicated that Mr. Williams had transferred an exclusive right to 6th Avenue Corridor, the Office would have granted the registration through a Single Application.

[34] 17 U.S.C. § 109(c).
[35] In this regard, the Register's view differs from the Court's underlying order. *See* Order at 24.
[36] *See* 17 U.S.C. § 109(c).

In any case, Mr. Williams would have been entitled to register the Work as its author and copyright claimant.

Dated: May 31, 2023

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