GEOFFREY S. BERMAN
United States Attorney for the
Southern District of New York
By: DAVID S. JONES
Assistant United States Attorney
86 Chambers Street, 3rd Floor
New York, New York 10007
Telephone: (212) 637-2739
Facsimile: (212) 637-2750
E-mail: david.jones6@usdoj.gov

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

KING-DEVICK TEST INC.,

Plaintiff,

v.

NYU LANGONE HOSPITALS, NEW YORK UNIVERSITY, STEVEN L. GALETTA, and LAURA J. BALCER,

Defendants.

No. 17-cv-9307-JPO

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

The Register of Copyrights of the United States Copyright Office, by and through its undersigned counsel, hereby responds to the questions posed in the Court's Order dated September 4, 2019 (ECF No. 105).

This appears to be a copyright infringement action in which an issue has arisen regarding what effect, if any, allegedly inaccurate information would have had on the Copyright Office's issuance of a copyright registration. Under 17 U.S.C. § 411(b)(2), the Court is required to request the Copyright Office's advice on the questions posed in the Court's Order. The response

of the Register of Copyrights to the questions posed by the Court appear in the attachment hereto.

Dated: New York, New York
October 4, 2019

GEOFFREY S. BERMAN
United States Attorney for the
Southern District of New York

By: /s/ David S. Jones
DAVID S. JONES
Assistant United States Attorney
86 Chambers Street, Third Floor
New York, New York 10007
Tel: (212) 637-2739
Fax: (212) 637-2750
E-mail: david.jones6@usdoj.gov

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

KING-DEVICK TEST INC., Plaintiff, v. NYU LANGONE HOSPITALS, NEW YORK UNIVERSITY, STEVEN L. GALETTA, AND LAURA J. BALCER, Defendants.	Case No. 17-cv-9307 (JPO)

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

On September 4, 2019, pursuant to 17 U.S.C. § 411(b)(2), the Court requested advice from the Register of Copyrights (the "Register") on the following questions (the "Order"):

1. Would the Register of Copyrights have refused Copyright Registration No. TXu000134747 if it had known that, despite the application stating "No Publication" at the time of the filing of the application on August 23, 1983, each of the following events described in the Court's finding on page 15 of the Opinion and Order (Dkt. No. 97) had occurred:

    a. Devick, a co-author of the applied-for-work, had sent a copy of the K-D Test and Paper to an author of another eye movement test, the Pierce Saccade Test (Dkt. No. 83 at 32);

    b. the Illinois College of Optometry had made the K-D Test and Paper available for public viewing (Dkt. No. 83 at 38);

    c. Devick had sold copies of the K-D Test to people referred to him by the library (Dkt. No. 83 at 36–39);

    d. King, the other co-author of the applied-for work, had provided a copy of the K-D Test to one of his patients (Dkt. No. 83 at 17);

e. a group of third-party researchers had printed the K-D Test in the Journal of the American Optometric Association (Dkt. No. 74-10); and

f. King and Devick had entered into a licensing agreement with a company that wished to distribute the K-D Test (Dkt. No. 83 at 19–20, 50)?

2. Would the Register of Copyrights have refused Copyright Registration No. TXu000134747 if it had known — despite the application stating "none" in the spaces for "preexisting material" and "material added to this work" in the "Compilation or Derivative Work" section — that the Paper's Abstract acknowledged that the K-D Test was a "modification" of the Pierce Saccade Test (Dkt. No. 74-4 at 4) and one of the Paper's Appendices included the Pierce Saccade Test itself (Dkt. 74-4 at 37)?

3. If the Register of Copyrights opines that it would have refused Registration TXu000134747, would the Register of Copyrights in 1983 have accepted an amended application or corrected registration pursuant to the then-current Compendium of Copyright Office Practices?

4. If the Register of Copyrights opines that it would have refused Registration TXu000134747, would the Register of Copyrights accept a supplementary registration by King-Devick pursuant to § 1802 of the current Compendium of Copyright Office Practices?[1]

As the Copyright Office understands the dispute, Alan J. King and Steven D. Devick co-authored a study regarding the relationship between saccadic performance and reading ability. In the study, the authors evaluated two existing tests for measuring saccadic performance, the Pierce Saccade Test and the Vincett Saccade Test, including the demonstration and test cards used in those tests, and proposed use of a new test the authors had developed.

Defendants New York University, NYU Langone Hospitals, Steven L. Galetta and Laura J. Balcer (collectively, Defendants) allege that King and Devick's application to register the copyright for the study, which was entitled "King-Devick saccade test" on the copyright application, ("the Work") contained two errors. First, Appendix II of the Work consists of the new test that was developed by King and Devick ("the K-D Test"), which Defendants allege incorporates preexisting material from the Pierce Saccade Test, such that Plaintiff should have disclaimed the materials from that test as preexisting material on the copyright application. Additionally, Defendants allege that King and Devick knew the K-D Test had been published

[1] Order at 2–3 (Sept. 4, 2019).

before they applied to register the Work as unpublished. As such, Defendants allege that the registration for the Work is invalid.[2]

Plaintiff King-Devick Test Inc. responds that the Work was unpublished at the time the authors filed the application to register the Work and that any alleged instance of publication prior to that date was unauthorized. Plaintiff also argues that the K-D Test is not a derivative work of any prior existing tests, such that no material was required to be disclaimed on the application to register the Work.[3]

The Register hereby submits her responses to the Court's questions.

BACKGROUND

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

On August 23, 1983, the Office received an application to register a literary work titled "King-Devick Saccade Test." The application identified Alan J. King and Steven D. Devick as co-authors of the "entire work" and co-claimants of the copyright. The application stated that the Work was created in 1976 and that it was unpublished. In the "Compilation of Derivative Work" section where the applicant was asked to "[i]dentify any preexisting work or works that th[e] work is based on or incorporates," the application stated "[n]one." The Office registered the Work with an effective date of registration ("EDR")[4] of August 23, 1983, and assigned registration number TXu 134-747. Based on the information provided in the application, the Office had no reason to question the representations in the application and accepted them as true and accurate.

ANALYSIS

I. Relevant Statutes, Regulations and, Agency Practices

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. The principles that govern how the Office examines registration applications are found in the *Compendium of U.S. Copyright Office Practices*. The authors filed their application to register the Work in 1983. The governing principles the Office would have applied at that time are set forth in the *Compendium of U.S. Copyright Office Practices, Second*

[2] Defs.' Mem. of Law In Supp. of Their Mot. for the Issuance of a Req. to the Register of Copyrights Pursuant to 17 U.S.C. § 411(b)(2), at 12–20 (Jan. 25, 2019).

[3] Pl.'s Opp. to Mot. for Issuance of Req. to Register of Copyrights Pursuant to 17 U.S.C. § 411(b)(2), at 5, 12 (Feb. 8, 2019).

[4] The EDR is the date that the Office received a completed application, the correct deposit copy, and the proper filing fee. 17 U.S.C. § 410(d).

Edition (referred to as "*Compendium II*").[5] In this response, the Register cites the current, third edition of the *Compendium* (referred to as "*Compendium (Third)*"), which was released and became effective December 22, 2014, and was last updated in 2017, where the relevant practices have not materially changed and cites *Compendium II* if the relevant practices have materially changed or where helpful to further illustrate Office practices.

A. Publication

The Copyright Act defines "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.[6]

As the *Compendium II* explained, under the first sentence of this definition (the "distribution" prong), "[w]orks are published when copies or phonorecords are distributed by the copyright owner or under his or her authority to the public by sale or other transfer of ownership, or by rental, lease, or lending."[7] For example, "[s]elling copies of a textbook to a local school board constitutes publication of that work."[8] In contrast, a mere "public performance or display of a work does not of itself constitute publication."[9]

The Copyright Office recognizes, however, that distribution of a work may *not* constitute publication in certain narrow circumstances.[10] In particular, courts have recognized the doctrine of "limited publication" to account for situations where the author has restricted both the purpose and the recipients of the distribution. A limited publication generally occurs when copies of a work are distributed "to a definitely selected group with a limited purpose and without the right of diffusion, reproduction, distribution or sale."[11] For example, "[s]ending copies of a

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[5] U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES (2d ed. 1984) ("COMPENDIUM II"). The *Compendium II* was first published in 1984 and later revised in part in 1988, 1995, and 1998. The preface to the 1984 version of *Compendium II* states that it reflects the U.S. Copyright Office's general practices for registration, recordation, and other matters arising under the Copyright Act of 1976, which went into effect on January 1, 1978. COMPENDIUM II Preface. The Work was registered in 1983, which was after the effective date of the 1976 Copyright Act of 1976 but before the issuance of the *Compendium II*. Because the 1984 version of *Compendium II* reflects the Office's practices between 1978 and 1988, when a new version of *Compendium II* was published, the 1984 version of *Compendium II* is the best possible source regarding the Office's practices in 1983.

[6] 17 U.S.C. § 101 (definition of "publication").

[7] COMPENDIUM II § 905; *see also* H.R. REP. NO. 94-1476, at 138 (1976).

[8] COMPENDIUM (THIRD) § 1905.1.

[9] 17 U.S.C. § 101 (definition of "publication"); *see* COMPENDIUM II § 908.

[10] *See generally* COMPENDIUM II § 905.02; COMPENDIUM (THIRD) § 1905.1.

[11] COMPENDIUM (THIRD) § 1905.1.

manuscript to prospective publishers in an effort to secure a book contract does not constitute publication."[12]

The second sentence of the "publication" definition (the "offering to distribute" prong) provides that the mere "offering" of copies of a work to "a group of persons" for "further distribution, public performance, or public display," even without an actual distribution, constitutes publication.[13] The offering of a work to a *single* person for the enumerated purposes does not qualify as publication.[14] For example, publication occurs "when a motion picture is offered to a group of movie theaters or television networks for the purpose of exhibiting or broadcasting that work."[15]

Finally, publishing a portion of a work does not mean that the entire work has been published.[16] Generally, publication applies only to the specific portions of the work that have been distributed to the public or offered for distribution to a group of persons for the purpose of further distribution, public performance, or public display.[17] When various parts of a work are published separately, the applicant should prepare a separate application for each separately published part.[18]

B. Identification and Exclusion of Previously Published Works and Preexisting Material

In pertinent part, the statutory requirements for copyright registration dictate that an application for registration of a derivative work must include "an identification of any preexisting work or works that it is based upon or incorporates, and a brief, general statement of the additional material covered by the copyright claim being registered."[19] Identifying the new or revised material the author has contributed to a work and any material that is not claimed "is essential to defining the claim that is being registered" and "ensures that the public record will be accurate."[20]

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[12] COMPENDIUM (THIRD) § 1905.1.

[13] The Office understands the actual distribution of (in addition to the mere "offering to distribute") copies or phonorecords to a group of persons for the enumerated purposes also to constitute a publication under the statute. *See* PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT 3.3.2 (3d ed. Supp. 2011).

[14] COMPENDIUM II § 906.02 ("The offering to distribute copies or phonorecords must be to a group of persons.").

[15] COMPENDIUM (THIRD) § 1906.1.

[16] COMPENDIUM II § 910.05 ("Publication of a portion of a work does not necessarily mean that the work as a whole has been published."); COMPENDIUM (THIRD) § 1909.2.

[17] COMPENDIUM (THIRD) § 1909.2.

[18] COMPENDIUM II § 910.07; COMPENDIUM (THIRD) § 1909.3.

[19] 17 U.S.C. § 409(9).

[20] COMPENDIUM (THIRD) § 621.1.

Under the Copyright Act, a "derivative work" is defined as "a work based upon one or more preexisting works, such as [an] art reproduction, abridgment . . . or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a 'derivative work'."[21]

For a work to be considered a derivative work, the preexisting work that it recasts, transforms or adapts "must come within the general subject matter of copyright set forth in section 102."[22] If an author incorporates uncopyrightable elements of a preexisting work into his or her own work, the author is not required to disclaim the preexisting work in an application to register the new work.

In addition to asking applicants to disclaim material previously registered or published by the claimant, the *Compendium II* required applicants who sought to register derivative textual works to disclaim all material that had been previously registered or published, including by a third-party, or that was in the public domain.[23] Significantly, the requirement to expressly exclude preexisting material from the copyright claim only applied when the preexisting material was "substantial."[24] For example, in the context of registering derivative computer programs, the *Compendium II* defined "substantial" to mean that the preexisting material represents a "significant portion of the work."[25] Thus, the *Compendium II* required an applicant to disclaim all previously published or registered copyrightable material if that material constituted a significant portion of the work as a whole.[26]

C. Other Copyright Office Regulations and Practices

Copyright Office regulations require applicants to make "[a] declaration that information provided within the application is correct to the best of [the applicant's] knowledge."[27] Generally the Office "accepts the facts stated in the registration materials, unless they are contradicted by information provided elsewhere in the registration materials or in the Office's records."[28]

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[21] 17 U.S.C. § 101 (definition of "derivative work").

[22] COMPENDIUM (THIRD) § 311.1 (quoting H.R. Rep. No. 94-1476, at 57 (1976)).

[23] COMPENDIUM II §§ 306.01, 325.01.

[24] COMPENDIUM II § 306.01.

[25] COMPENDIUM II § 325.01(b).

[26] In contrast, the *Compendium (Third)* explicitly states that an applicant should identify material that "is owned by an individual or legal entity other than the claimant who is named in the application" if the work contains an *appreciable* amount of such material. COMPENDIUM (THIRD) § 621.

[27] 37 C.F.R. § 202.3(c)(2)(iii).

[28] COMPENDIUM (THIRD) § 602.4(C).

In responding to the Court's questions, the Office applies the foregoing governing statutory and regulatory standards and examining principles. The Office notes that it is not unusual for an examiner to correspond with an applicant about factual assertions if the assertions appear to conflict with other information provided in the application materials.[29] Accordingly, if the Office becomes aware of an error at the time of application, such as the omission of the statement regarding preexisting material, or has questions about facts asserted in the application, it provides the applicant an opportunity to correct the error or verify the facts within a specified period of time.[30] If the applicant responds in a timely fashion to the satisfaction of the Office, the Office can proceed with the registration. The Register's response herein is thus premised on the fact that any errors identified were not timely corrected through such a process.

II. Register's Responses to Court's Questions

Based on the foregoing statutory and regulatory standards, and its examining practices, the Register responds to the Court's questions as follows:

Question 1(a), (b), and (d)

Had the Office been aware, prior to registration, that (1) "Devick, a co-author of the applied-for-work, had sent a copy of the K-D Test and Paper to an author of another eye movement test, the Pierce Saccade Test," (2) "the Illinois College of Optometry had made the K-D Test and Paper available for public viewing," and (3) "King, the other co-author of the applied-for work, had provided a copy of the K-D Test to one of his patients," the Office would still have registered the copyright claim as reflected in the application for registration number TXu 134-747.

The distribution of a work to two professional acquaintances would be considered limited publication rather than a "publication" within the meaning of the Copyright Act.[31] Similarly, the deposition testimony of Mr. Devick indicates that a copy of the K-D Test was maintained by the Illinois College of Optometry that was "available to look at," but they "didn't let you make copies out of it."[32] This library was generally restricted to the school's students, faculty and staff and the copy of the test was kept in a locked filing cabinet behind the circulation desk.[33] To the extent the work was available for viewing by a certain number of people, the way in which it was

[29] COMPENDIUM (THIRD) § 602.4(C).

[30] Currently, when a registration specialist corresponds with an applicant, the applicant will be given 45 days to respond to the specialist's questions concerning issues in the application materials. COMPENDIUM (THIRD) § 605.6 (B), (D).

[31] COMPENDIUM II § 905.02.

[32] Dkt. No. 83 at 38.

[33] Dkt. No. 82 at 5–6.

made available is akin to a public display of a work, which does not constitute publication of that work.[34]

Question 1(c), (e), and (f)

Had the Office been aware, prior to registration, that (1) "Devick had sold copies of the K-D Test to people referred to him by the library," and (2) "King and Devick had entered into a licensing agreement with a company that wished to distribute the K-D Test," the Office would have considered the K-D Test to be previously published material. Sale of a work to members of the public without further restriction constitutes publication of that work.[35] Likewise, offering copies of a work to a group of persons for the purpose of licensing those copies for further distribution constitutes publication of that work.[36]

With respect to the request regarding the alleged printing of the K-D Test in the Journal of the American Optometric Association by "a group of third-party researchers," additional information is needed to determine if this constituted publication. The *Compendium II* provides that distributing copies of a work to the public "by the copyright owner or under his or her authority," constitutes a publication of that work.[37] Thus, if the printing of the K-D Test in a journal was done with authorization from one or more of the copyright owners, then the Office would have considered the K-D Test to have been previously published. But if the printing of the K-D Test in a journal was done without the knowledge or authorization of the copyright owners, that would not constitute publication.

As recognized by the parties, in 1983, the Copyright Act and Copyright Office regulations and guidance materials required all copies of publicly distributed materials from which a work could be visually perceived to contain a notice of copyright.[38] In analyzing the parties' claims and defenses, the Court should confirm whether all published copies of the K-D Test contained the required copyright notice.

Because the actions posed in Questions 1(c), (e), and (f) would constitute publication of the K-D Test, it was not possible for the applicants to register this previously published material and the unpublished portions of the Work using one application.

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[34] 17 U.S.C. § 101 (definition of "publication"); COMPENDIUM II § 908. The record provided also does not make clear whether the copyright owners were aware of or authorized the library's display of the work.

[35] 17 U.S.C. § 101 (definition of "publication"); COMPENDIUM II § 905.

[36] 17 U.S.C. § 101 (definition of "publication"); COMPENDIUM II § 906.

[37] COMPENDIUM II § 903.

[38] 17 U.S.C. § 401(a) (1982); COMPENDIUM II § 1003.

As such, had the Office been aware that the K-D Test had been previously published, the Office would have corresponded with the applicants to clarify that any registration issued by the Office for the unpublished material would not cover the previously published K-D Test.

Question 2

As discussed above, an applicant is generally required to disclaim preexisting material on which a work is based or which a work incorporates and identify what material the author added to the preexisting work. In 1983, applicants were required to disclaim material that had been previously registered or published or that was in the public domain if that material constituted a substantial or significant portion of the work. However, an applicant was not required to disclaim uncopyrightable elements of a preexisting work.

If an examiner became aware that a work was based on or incorporated a copyrightable preexisting work and that work constituted a substantial portion of the work that was the subject of the application, the examiner would have corresponded with the applicant to request that the applicant disclaim that material and clarify in the "material added" section of the application what material the author had added to the preexisting work.

Here, there are serious doubts about whether the Pierce Saccade Test, which is the preexisting material on which the K-D Test was based, contains copyrightable authorship.[39] If the Court finds that the Pierce Saccade Test contains copyrightable authorship and that it constituted a substantial part of the Work registered under copyright registration number TXu 134-747, then the applicants would have been required to disclaim this material in their application. In that case, the Office would have corresponded with the applicants to exclude this preexisting material. If the applicant refused to exclude this material, then the Office would have refused registration of the Work.

Questions 3 & 4

A supplementary registration could not have corrected the applicants' error in registering unpublished and published material with the same registration. A supplementary registration could have been used to disclaim preexisting material on which the Work was based and to clarify what material the applicants added to the preexisting work if such a disclaimer were required.

Under both the *Compendium II* and *Compendium (Third)*, a supplementary registration may be used to correct or amplify certain information set forth in a basic registration.[40] A

[39] *See* 17 U.S.C. § 102(b) (expressly excluding copyright protection for "any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work"); COMPENDIUM II § 305.06 ("Copyright does not protect either the general format or layout, or the idea expressed by either of these.").

[40] COMPENDIUM II § 1503.01; COMPENDIUM (THIRD) § 1802.3.

supplementary registration can be used to correct information regarding limitations of the copyright claim identified in the certificate of registration, including to identify any preexisting works on which the work is based.[41]

However, not all errors in a basic registration can be corrected using a supplementary registration. The *Compendium II* provides that if "various parts or installments of a work are first published separately, each part or installment is regarded as a separate work, and if registered, must be registered separately."[42] *Compendium (Third)* similarly states that an applicant should prepare a separate application (and filing fee and deposit) for each part of a work that is published separately.[43]

Thus, the copyright owners could have corrected any error relating to the failure to disclaim a preexisting work using a supplementary registration. However, because the K-D Test had been previously published, it could not in 1983 or now be registered using the same application that was used to register the remainder of the Work, which had not previously been published. The copyright owners would have been and would currently be required to file two separate applications to register both the unpublished portions of the academic paper and the previously published K-D Test.

If the copyright owners wanted to retain their registration for an unpublished work, they could have corrected their existing registration to exclude Appendix II (the K-D Test), which had previously been published.[44] In that case, the registration for the Work would not cover the K-D Test demonstration and test cards and the copyright owners would have been required to submit a new application to register the K-D Test.[45]

Alternatively, the copyright owners could have sought to correct their existing registration to exclude all content in the Work other than Appendix II (the K-D Test) and to

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[41] COMPENDIUM II § 1504.01; COMPENDIUM (THIRD) § 1802.6(J).

[42] COMPENDIUM II § 910.07.

[43] COMPENDIUM (THIRD) § 1909.3.

[44] The requirement to explicitly disclaim previously published and preexisting materials in an application only applies when the work that is the subject of the application contains a "substantial" or "appreciable" amount of previously published material. COMPENDIUM II § 306.01; COMPENDIUM (THIRD) § 621.4. Whether an application explicitly disclaims previously published materials or not, any registration for an unpublished work covers only the material in the deposit that has not been previously published.

[45] The Office considered the Work as a whole when it examined the application to register the Work, including when it determined whether the Work contained sufficient original authorship to be protectable by copyright. Because the applicants identified the Work as a literary work and the majority of the Work was textual in nature, the Office examined the Work as a whole and determined that the Work was sufficiently original to be protectable by copyright as a literary work. The Office did not examine the K-D Test by itself to determine if it contained sufficient original authorship to be protectable by copyright. If an application to register the K-D Test as a standalone work were submitted, the Copyright Office would analyze the copyrightability of the K-D Test, including whether it was a purely functional system or whether the elements identified by Plaintiff, including the selection and arrangement of the digits, the number of digits, the spatial arrangement of the digits, and the spacing of the reading lines, were sufficiently creative to warrant copyright protection.

designate Appendix II as published. However, a supplementary registration generally cannot be used to rectify the situation in which a published work was incorrectly registered as unpublished because the deposit requirements will ordinarily not have been met.[46]

Dated: October 4, 2019

Karyn A. Temple
Register of Copyrights

[46] COMPENDIUM II § 1507.07(a). Additionally, as discussed above, had the copyright owners attempted to register the K-D Test as an independent work, the Examiner would have examined the K-D Test as a standalone work to determine if it contained sufficient original authorship to be protected by copyright.