Criminal Prosecution for Copyright Infringement of Unregistered Works: A Bite at an Unripe Apple

Aaron B. Rabinowitz
CRIMINAL PROSECUTION FOR COPYRIGHT INFRINGEMENT OF UNREGISTERED WORKS: A BITE AT AN UNRIPE APPLE?

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I. INTRODUCTION

By one estimate, copyright infringement costs American businesses each year $58 billion in output, 373,375 lost jobs, and $16 billion in lost employee earnings, and costs the United States government each year more than $2.6 billion in lost taxes. The severe penalties for criminal copyright infringement amply demonstrate that Congress has recognized the harm posed by such activity.

The proliferation of interconnected computer networks has enabled infringers to copy and distribute authors' works more quickly than ever before. In some cases, infringers distribute copies of works before those works are even

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2. First-time criminal copyright offenders face up to a five-year felony conviction, with successive offenses resulting in incarceration of up to ten years. 18 U.S.C § 2319(b) (2006).

publicly released—in one 2003 case, an incomplete version of the motion picture “The Hulk” was illegally uploaded to the Internet before the final version of the film was released in theatres.⁴

In response to the increase in pre-release infringement, Congress modified the copyright laws to provide greater protections for authors and greater deterrents for would-be infringers.⁵ In particular, because the existing laws did not permit civil actions for infringement of works that had not been formally registered with the Copyright Office,⁶ Congress created a preregistration scheme under which authors may submit an application and fee to the Copyright Office in return for a grant of “preregistered” status to the work.⁷ While a preregistered work does not enjoy all of the same legal protections as a registered work,⁸ a preregistered work may still serve as the basis for a civil infringement action.⁹

Broadening the availability of civil infringement actions expands the remedies available to authors who have not formally registered their works and helps address infringement as early and as aggressively as possible. Whether criminal proceedings are similarly available to address infringement of works that are not formally registered or are merely preregistered is another issue entirely, and is an issue the courts have not addressed.¹⁰

⁶. Formerly, a civil infringement action could only be instituted if the work in question were registered.
⁷. “Preregistration is a service intended for works that have had a history of prerelease infringement. It focuses on the infringement of movies, recorded music, and other copyrighted materials before copyright owners have had the opportunity to market fully their products.” See Preregister Your Work, http://www.copyright.gov/prereg/ (last visited Jan. 6, 2009); see also 37 C.F.R. § 202.16 (2008) (Copyright Office rules for preregistration).
⁸. For example, while registration of a work serves as prima facie evidence of copyright ownership, preregistration does not. 37 C.F.R. § 202.16(c)(13).
¹⁰. As of the date of this writing, no court case has squarely addressed the question whether registration is a prerequisite to bringing a criminal infringement action. See infra Part III.A.
Nevertheless, the United States Department of Justice and several leading commentators\(^{11}\) suggested, based on the then-existing statute,\(^{12}\) that—unlike a civil infringement action\(^{13}\)—a criminal infringement proceeding does \textit{not} require that the work at issue be formally registered with the Copyright Office.\(^{14}\)

This suggestion, however, was misplaced. While such prosecutions would provide an additional deterrent to would-be infringers, criminal prosecutions for infringement of unregistered or preregistered works are in fact legally improper. Through a review of relevant statutes—including the recent amendments to the Copyright Act—and past and

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\item An amended version of § 411(a) was signed into law on October 13, 2008—several months \textit{after} this article was accepted for publication—to make clear that registration is a prerequisite for civil actions. See Prioritizing Resources and Organization for Intellectual Property Act, Pub. L. No. 110-403, 122 Stat. 4256, 4257-58 (2008). While the amended § 411(a) arguably supports the position that registration is \textit{not} a prerequisite for criminal prosecutions, the amendments also raise a statutory ambiguity that arguably supports the position that registration is \textit{a} prerequisite for a criminal infringement prosecution. See \textit{infra} Part II.B.2.

\item See 17 U.S.C. § 411(a) (2006) (barring civil infringement action unless work at issue is registered or preregistered).


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present case law, this article argues that allowing such prosecutions (1) fails to consider past and present statutory ambiguity that must be construed in defendants' favor under the rule of lenity, (2) ignores the established linkage between civil copyright law and criminal law, and (3) fails to accord proper deference to the administrative role of the Copyright Office. This article also proposes several solutions to the problem of infringement of unregistered works, which solutions account for the basic administrative principles underlying copyright law while also providing clear guidance for authors and prosecutors alike concerning the reach of criminal infringement actions.15

II. BACKGROUND

To properly address whether there is a proper legal basis for criminal prosecutions of unregistered or preregistered works, a general overview of copyright infringement, copyright registration, and copyright preregistration is helpful.

A. Copyright Infringement

1. Civil Copyright Infringement

Copyright attaches to any original creative work once that work is fixed in a "tangible medium of expression."16 While not all works are sufficiently original to qualify for copyright protection, the originality bar is nevertheless a low one.17

Civil copyright infringement has only two elements: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original."18 Civil copyright infringement considers only whether unauthorized copying took place and does not account for the infringer's intent.19

15. See infra Part IV.
2. Criminal Copyright Infringement

Criminal copyright infringement has the same basic elements as civil copyright infringement, but with some additional requirements. In addition to proving ownership and copying of original constituent elements, the prosecution must also prove that the infringement was willful, and either (1) the defendant acted for commercial advantage or private financial gain; (2) the defendant reproduced or distributed, including by electronic means, during any 180-day period, one or more copies or phonorecords of one or more copyrighted works,\(^2\) which have a total retail value of more than $1000; or (3) the defendant distributed a work being prepared for commercial distribution, by making it available on a computer network accessible to members of the public, if the defendant knew or should have known that the work was intended for commercial distribution.\(^2\)

The penalties for criminal copyright infringement are severe. A defendant convicted of for-profit infringement under 17 U.S.C. § 506(a)(1)(A), of non-profit infringement under 17 U.S.C. § 506(a)(1)(B), or of pre-release infringement under 17 U.S.C. § 506(a)(1)(C) may face incarceration for up to five years,\(^2\) depending on the number and value of the works infringed.

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20. Infringement may occur by violation of any of the copyright owner's exclusive rights, which rights include the rights:

1. to reproduce the copyrighted work in copies or phonorecords;
2. to prepare derivative works based upon the copyrighted work;
3. to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
4. in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
5. in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
6. in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.


B. Registration

Copyright registration is a "ministerial" process\(^{23}\) in which an applicant supplies to the Copyright Office certain information about his or her work, along with a fee. The Copyright Office then reviews the work and the author's supporting information.\(^{24}\) A granted registration is presumptive evidence that the copyright is valid,\(^{25}\) and also entitles the registrant to (1) institute a civil action for infringement of the work\(^{26}\) and (2) recover statutory damages and attorneys' fees in such an action.\(^{27}\) Critically, the copyright laws do not allow institution of an infringement suit unless the owner of the work has preregistered or sought to register the work with the Copyright Office.\(^{28}\)

C. Preregistration

As described supra, Congress created a preregistration scheme under which authors can obtain "preregistered" status for their works upon filing an application and a fee.\(^{29}\) A preregistered work can be a basis for a civil infringement action.\(^{30}\) The Copyright Office does not, however, perform any substantive review or evaluation of works submitted for preregistration.\(^{31}\) Thus, in the broadest sense, the

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24. See 17 U.S.C. § 408 (2006); see also 17 U.S.C. § 410(a) (2006) (registration granted if Register of Copyrights determines that deposited work "constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met").
28. 17 U.S.C. § 411(a). Denial of a registration application does not, however, foreclose the owner from filing an infringement suit:

Where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute an action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.

Id.
31. "[T]he online [preregistration] application form will not be examined except to ascertain that all the necessary information has been provided by the applicant." See U.S. Copyright Office, Preregistration Information, http://www.copyright.gov/prereg/help.html (last visited Jan. 8, 2009) (emphasis
preregistration scheme allows authors to purchase administrative agency recognition of their work, although the depth of this recognition is limited because the recognition is not based on an actual evaluation of the work’s merits.

Preregistration is available only for those types of works the Copyright Office considers vulnerable to being copied and distributed before the work’s planned release or publication. These types of works include movies, musical compositions, sound recordings, computer software, video games, literary works, and various kinds of photographs. These types of works may be preregistered if they are unpublished but are “being prepared for commercial distribution,” which means that the owner has a reasonable expectation that the work will be commercially distributed to the public, and that the work, if not finished, has at least been commenced.

After the author submits an application and fee, the Copyright Office undertakes a clerical review of the application. If approved, the Copyright Office will preregister the work and issue a certificate. A preregistered work may serve as a basis for a civil infringement action, but preregistration—unlike registration—does not serve as prima facie evidence of the validity or ownership of a copyright.

III. DISCUSSION

The copyright laws clearly require that a work be registered or preregistered before the owner institutes a civil infringement action, and before the most recent amendments, the relevant laws were ambiguous regarding whether a work must be registered or preregistered before a criminal infringement action could be initiated. While the most recent amendments arguably resolve that ambiguity in

33. Id.
34. See id. at § 202.16(b)(2).
35. See supra note 31.
37. 37 C.F.R. § 202.16(c).
39. As of the time of this writing, no recent case had squarely addressed this issue.
some part, the amendments nevertheless fail to fully resolve the ambiguity surrounding whether criminal infringement prosecutions require that the underlying work be registered. Further, in light of relevant case law, the amendments can be read as confirming that registration is a prerequisite to a criminal infringement prosecution. In any event, even putting statutory language and controlling case law aside, criminal prosecutions based on unregistered works are additionally improper because such prosecutions fail to recognize fully the role of the Copyright Office.

A. No Recent Case Has Addressed Whether Copyright Registration Is a Precondition to a Criminal Infringement Action

Despite the increasing prevalence of prerelease infringement, no recent court case had squarely addressed—under the previous version of the statute—whether registration was a prerequisite for instituting a criminal prosecution. Because of this lack of recent case law guidance, the leading case on the question whether registration of a work with the Copyright Office is a prerequisite for a criminal infringement action is the Second Circuit's 1943 decision in United States v. Backer.

In Backer, the defendant appealed his conviction for willful infringement of copyright designs for various figurines. The defendant appealed his conviction on the grounds that (1) the government failed to prove that his infringement was "willful" and (2) that the registrations on the copyrighted figurines were invalid. The Second Circuit, however, rejected each of these arguments.

First, the Backer court concluded that because the defendant had asked a third party to replicate the figurines

41. See infra Part III.C.2.
42. Because the amended version of § 411(a) took effect on October 13, 2008, no case as of the time of this writing has applied the as-amended version of the statute.
43. United States v. Backer, 134 F.2d 533 (2d Cir. 1943) (Hand, J., on panel).
44. Id. at 534.
45. Id. at 535.
as closely as possible, the infringement had been willful.\textsuperscript{46} The court stated, however, that the defendant's argument that the copyright registrations were invalid posed "a more difficult issue" that was "of vital importance."\textsuperscript{47} Reviewing the language of the then-existing Copyright Act, the court concluded that the statute made registration "a condition precedent to the maintenance of any action for infringement."\textsuperscript{48} Because the author of the works at issue had properly registered the works, the court upheld the defendant's conviction.\textsuperscript{49}

Although \textit{Backer} was decided sixty-six years ago, no other, more recent case has squarely addressed the registration issue. In 2007, the First Circuit in \textit{United States v. Beltran}\textsuperscript{50} noted—but did not resolve—whether criminal prosecution for infringement of unregistered works was permissible under the then-existing version of 17 U.S.C. § 411(a).

In \textit{Beltran}, the defendants appealed from their conviction for criminal copyright infringement on the ground that the government had failed to offer into evidence any certificates of copyright registration.\textsuperscript{51} Acknowledging that it was unclear whether or not registration was a condition precedent to a criminal infringement prosecution, the First Circuit nevertheless affirmed the defendants' conviction on the ground that the defendants had stipulated to the certificates of registration.\textsuperscript{52} Thus, because the defendants had stipulated to the registration, the \textit{Beltran} court did not need to address whether the government's failure to produce such registrations deprived the court of jurisdiction over the matter.\textsuperscript{53}

\textsuperscript{46} \textit{Id.}\textsuperscript{47} \textit{Id.}\textsuperscript{48} \textit{Id.} The then-existing version of the Copyright Act made clear that the term "action" included both civil infringement actions and criminal infringement proceedings. \textit{Id.}\textsuperscript{49} \textit{United States v. Backer}, 134 F.2d 533, 535 (2d Cir. 1943) (Hand, J., on panel).\textsuperscript{50} \textit{United States v. Beltran}, 503 F.3d 1 (1st Cir. 2007).\textsuperscript{51} \textit{Id.} at 2.\textsuperscript{52} \textit{Id.}\textsuperscript{53} Another case that raised the question of whether registration of a work is a prerequisite to a criminal infringement case is \textit{United States v. Stevens}, 543 F. Supp. 929 (N.D. Ill. 1982). In that case, the defendants argued that their indictment should be dismissed on the ground that the indictment erroneously
Accordingly, there is no recent guidance from the courts that precisely addresses whether registration is a precondition to a criminal infringement action. Leading commentators have identified the issue and note that while Backer concluded that registration was not necessary at the time of that decision,54 the registration question remains open.55

B. The Copyright Laws—Past and Present—Are Ambiguous Regarding Whether Registration Is a Prerequisite to Criminal Infringement Prosecution

The copyright laws have been unclear regarding whether registration was a prerequisite to criminal infringement prosecutions, and this ambiguity required that the laws be construed in favor of requiring registration before a criminal prosecution. Although Congress recently amended the copyright law to clarify that a civil infringement action requires that the underlying work be registered or preregistered with the Copyright Office, that amendment failed to clarify whether criminal prosecutions do not require registration, and the rule of lenity again arguably applies to require registration before a criminal prosecution can be initiated.

stated that a work had been registered with the Copyright Office as of the date of the alleged infringement. *Id.* at 949. While the Stevens court denied the defendants' motion, the court did so without acknowledging the Second Circuit's conclusion in Backer that copyright registration was a prerequisite to a criminal infringement proceeding, and without engaging in any statutory or case law analysis of the issue.

54. See Goldstein, supra note 11, § 11.4.1 ("The requirement that the copyright owner obtain a valid registration before an infringement action can be instituted . . . may apply to criminal proceedings under the 1976 [Copyright] Act.") (citing Backer, 134 F.2d at 535); 4 David Nimmer, Nimmer on Copyright § 15.01[A][2] (2005) ("The requirement of registration as a condition to bringing an infringement action has been held applicable to criminal actions.") (citing Backer, 134 F.2d 533).

55. For example, Goldstein notes that while 17 U.S.C. § 411(a) provides that no "action" for infringement shall take place until a work is registered or preregistered, other sections of the Copyright Act distinguished between "civil actions" and "criminal proceedings." Goldstein supra note 11, § 11.4.1 n.15. Goldstein thus suggests the reference to "action" in § 411(a) "would appear to exempt criminal proceedings from the registration requirement." *Id.*; see DuBose, supra note 11, at 486–89. As described later in Part III, this argument is flawed for several reasons.
1. Because Earlier Copyright Laws Were Ambiguous Regarding Certain Distinctions Between Civil and Criminal Matters, the Rule of Lenity Mandated That the Ambiguity Be Construed in Defendants' Favor to Require Registration Before a Criminal Proceeding

As discussed, certain leading commentators and the Department of Justice have suggested that copyright registration was not necessary—under the previous version of § 411(a)—to maintain a criminal infringement action. These suggestions were premised on the argument that the copyright laws distinguished between civil and criminal matters so as to imply that pre-action registration is only necessary in the civil context. This argument was misplaced, however, because the Copyright Act was ambiguous regarding the distinction between civil and criminal cases. Further, because the rule of lenity requires that an ambiguity in a criminal statute be construed in favor of defendant, this previous ambiguity in the Copyright Act further supported the conclusion that registration was necessary to the maintenance of a criminal infringement prosecution.

Goldstein, among others, noted that while unamended § 411(a) of the Copyright Act provided that no “action” for infringement shall take place until a work is registered or preregistered, the Copyright Act’s treatment of the statute of limitations in 17 U.S.C. § 507 distinguished between “civil actions” and “criminal proceedings.” Because of this alleged distinction between “civil actions” and “criminal proceedings,” Goldstein suggested that the reference to “action” in § 411(a) “would appear to exempt criminal proceedings from the registration requirement.” This suggestion, however, was flawed because it did not consider the title of § 507, and “the

56. See United States Dep't of Justice, supra note 11, at 22–24; DuBose, supra note 11, at 488–89; see also Goldstein, supra note 11, § 11.4.1.
57. See United States Dep't of Justice, supra note 11, at 22–24; DuBose, supra note 11, at 488–89; see also Goldstein, supra note 11, § 11.4.1.
58. See DuBose, supra note 11, at 488–89
59. Goldstein, supra note 11, § 11.4.1.
60. See Goldstein, supra note 11, § 11.4.1; see also United States Dep't of Justice, supra note 11, at 22–24.
61. In full, 17 U.S.C. § 507 reads: §507. Limitations on actions (a) Criminal proceedings. Except as expressly provided otherwise in
title of a statute and the heading of a section" are "tools available for the resolution of a doubt about the meaning of a statute." 62

The ambiguity in § 507 is shown through careful examination of that section and its title. 63 While § 507 specifies limitations periods for both "civil actions" and "criminal proceedings," 64 § 507 is nevertheless itself titled "Limitations on actions," not "Limitations on actions and proceedings." Given that the title of § 507 refers only to "actions" but that § 507 addresses both "civil actions" and "criminal proceedings," the term "actions" may plausibly be construed to encompass both "civil actions" and "criminal proceedings" and thus does not necessarily refer exclusively to civil actions. 65 Thus, the Act itself is ambiguous regarding whether civil actions and criminal prosecutions are distinct from one another and always governed by different rules, or whether civil and criminal matters are, at least in some instances, grouped together as "actions" and are governed by the same rules.

Under the rule of lenity, this ambiguity required that the unamended statute be construed to require registration in order to maintain a criminal prosecution; "[w]hen choice has to be made between two readings of what conduct Congress has made a crime, it is appropriate, before we choose the harsher alternative, to require that Congress should have

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63. Almendarez-Torres, 523 U.S. at 234. The legislative history regarding whether registration is a prerequisite to a criminal infringement action is ambiguous at best. See supra note 14.
64. 17 U.S.C. § 507 (prescribing a three-year limitations period for civil actions and a five-year limitations period for criminal proceedings).
65. Almendarez-Torres, 523 U.S. at 234 (reiterating that analysis of statutory language must include review of section title).
spoken in language that is clear and definite.” 66 Because “ambiguity concerning the ambit of criminal statutes should be resolved in favor of lenity,” 67 the fact that the resolution of the ambiguity in this aspect of the copyright laws could be the difference between a defendant facing a civil penalty or facing incarceration required that the statute be construed in favor of requiring registration before a criminal action can be maintained—“without explicit congressional authorization, courts will not impose criminal penalties for conduct within the ban of the Copyright Act.” 68 Thus, the ambiguity between § 411(a) and § 507 must be construed in favor of defendants to require registration in criminal cases. Accordingly, the commentors’ and the Department of Justice’s interpretation of pre-2008 § 411(a) was flawed because that interpretation did not fully consider the entirety of the Copyright Act.

2. While the October 2008 Amendments to § 411(a) Require That a Work Be Registered Before a Civil Infringement Action, the Amendments Do Not Fully Resolve the Ambiguity Surrounding Whether Criminal Infringement Prosecutions Require Registration

As mentioned, § 411(a) was amended to require that a work must be registered before that work can be the subject of a civil infringement action. While these amendments make clear the underpinnings of a civil infringement action, the amendments nevertheless create a new ambiguity that warrants that the same registration prerequisite applies to criminal prosecutions.

Although no court had ever undertaken to resolve the existing ambiguity in the copyright law regarding registration and criminal infringement prosecutions, § 411(a) was amended on October 13, 2008 69 to clarify that registration


68. ROBERT A. GORMAN & JANE C. GINSBURG, COPYRIGHT 781 (2002) (citing Dowling v. United States, 473 U.S. 207 (1985)). The fact that the Department of Justice proposed legislation that would clearly criminalize infringement of unregistered works strongly suggests that the present laws do not criminalize such infringement. See supra note 14.

69. October 13, 2008 was after this article was written and accepted for publication.
was a prerequisite to civil infringement actions as follows (amendments shown with **bold underlining**):

Registration and **Civil** Infringement Actions

(a) Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), no **civil** action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.°

The statute now makes plain that registration is necessary for "civil actions." Given that Congress made clear that civil infringement actions require registration, it is arguable that because Congress knew how to make registration a prerequisite for *civil infringement* actions, Congress did not intend for that prerequisite to apply to *criminal infringement* prosecutions.1

At the same time, however, the title of amended § 411(a) makes clear that the section addresses only civil actions, and Congress did not in 2008 create or amend another statutory section to address the parallel issue of criminal infringement prosecutions. Given that Congress addressed civil infringement actions but declined to provide any guidance—other than implication-by-silence—regarding criminal infringement prosecutions, the rule of lenity should apply to require that criminal prosecutions be based on registered works when the choice between what is a crime and what is not turns on the uncertain implication of congressional silence;72 "when interpreting a criminal statute that does not

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71. *E.g.*, Cent. Bank v. First Interstate Bank, 511 U.S. 164, 176–77 (1994) (while "Congress knew how to impose aiding and abetting liability when it chose to do so," because Congress did not use the words "aid" and "abet" in the statute, Congress did not impose liability for aiding and abetting); Franklin Nat'l Bank v. New York, 347 U.S. 373, 378 (1954) (observing "no indication that Congress intended to make this phase of national banking subject to local restrictions, as it has done by express language in several other instances").

72. *Jones v. United States*, 529 U.S. 848, 858 (2000) ("When choice has to be made between two readings of what conduct Congress has made a crime, it is appropriate, before we choose the harsher alternative, to require that Congress should have spoken in language that is clear and definite.") (emphasis added); United States v. Granderson, 511 U.S. 39, 54 (1994) (where prosecution's position is not "unambiguously correct—we apply the rule of lenity and resolve
explicitly reach the conduct in question, we are reluctant to base an expansive reading on inferences drawn from subjective and variable 'understandings.'”

C. Registration Is Necessary to Maintain Criminal Prosecution for Copyright Infringement

1. Because Civil Copyright Law Guides Criminal Copyright Law, the Civil Requirement of Registration Should Apply to Criminal Infringement Proceedings

As several courts have noted, criminal copyright law looks to civil copyright law for guidance: “In order to understand the meaning of criminal copyright infringement, it is necessary to resort to the civil law of copyright.” Hence, because registration is necessary to maintain a civil infringement action, the linkage between civil and criminal copyright law mandates that registration is likewise a condition precedent to jurisdiction over criminal copyright cases.

While an unregistered work may be infringed, no civil action for copyright infringement may be maintained until the author has attempted to register her work. Several courts have in fact held that copyright registration is a prerequisite to jurisdiction over an infringement suit. Some
of these courts have gone so far as to hold that a prospective plaintiff must have an actual certificate of registration before filing their infringement suit.\textsuperscript{77} Because of the dependency of criminal copyright law on civil copyright law,\textsuperscript{78} the fact that registration is necessary for court jurisdiction over a civil infringement suit suggests registration is likewise necessary to jurisdiction over a criminal proceeding.

Several court decisions illustrate the lockstep linkage between civil and criminal copyright principles. In \textit{United States v. Manzer},\textsuperscript{79} for example, the defendant appealed his criminal copyright conviction on the ground that there was insufficient evidence that his infringement of a particular computer program was willful.\textsuperscript{80} His appeal was unsuccessful. The court of appeals noted that the plastic module containing the computer program at issue had a legible copyright label, and the program itself contained a copyright notice that would have been easily read with a standard debugging program.\textsuperscript{81} The court concluded that had the case been a civil suit for damages only, either of these notices would have given the defendant sufficient knowledge of the copyright so as to rebut a possible defense of innocent infringement.\textsuperscript{82} Thus, because the evidence would not have supported the \textit{civil defense} of innocent infringement, the Eighth Circuit concluded that the evidence likewise did not

\textsuperscript{77} Strategy Source, 233 F. Supp. 2d at 6–7.
\textsuperscript{78} United States v. Cross, 816 F.2d 297, 303 (7th Cir. 1987); see also United States v. Wise, 550 F.2d 1180, 1189 n.14 (9th Cir. 1977) (noting "the general principle in copyright law of looking to civil authority for guidance in criminal cases").
\textsuperscript{79} United States v. Manzer, 69 F.3d 222 (8th Cir. 1995).
\textsuperscript{80} Id. at 227.
\textsuperscript{81} Id.
\textsuperscript{82} Id.
support Manzer's *criminal defense* of no willfulness.\(^9\)

Other courts have similarly applied civil copyright analyses to the criminal copyright context.\(^8\) In *United States v. Moran*,\(^5\) the court applied the civil copyright definition of "willful" to a criminal case, reasoning that criminal cases should be no less strict than civil ones; "since Congress used 'willful' in the *civil damage copyright context* to mean that the infringement must take place with the defendant being knowledgeable that his/her conduct constituted copyright infringement, there is *no compelling reason to adopt a less stringent requirement in the criminal copyright context.*"\(^6\) Thus, the *Moran* court concluded that it would be illogical to apply a different—and less demanding—standard to criminal prosecutions than to civil actions where there was no congressional suggestion to do so. Likewise, in *United States v. Cross*,\(^7\) the Seventh Circuit upheld the use of the civil definition of "willful" in the jury instructions in a criminal case, noting that courts had previously found constitutional the use of the Copyright Act's civil definition of "infringement" to criminal actions.\(^8\) These cases make plain that courts do not hesitate to apply civil copyright principles to criminal cases.

Hence, because criminal copyright law draws directly from civil copyright law,\(^9\) the civil requirement of registration\(^9\) likewise demands registration in the criminal context. Courts have made clear that criminal copyright law should not include activity that would not also support a civil infringement action,\(^1\) which in turn makes clear that works must be registered before a criminal infringement action may

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83. Id.
84. E.g., Kelly v. L.L. Cool J., 145 F.R.D. 32, 39 (S.D.N.Y. 1992) ("[C]onduct that does not support a civil action for infringement cannot constitute criminal conduct.").
86. Id. at 1050 (emphasis added).
87. United States v. Cross, 816 F.2d 297 (7th Cir. 1987).
88. Id. at 303 (citing United States v. Wise, 550 F.2d 1180, 1185–86 (9th Cir. 1977)).
89. Cross, 816 F.2d at 303; Wise, 550 F.2d at 1189 n.14.
90. 17 U.S.C. § 411(a) (2006); e.g., La Resolana Architects v. Clay Realtors Angel Fire, 416 F.3d 1195, 1205 (10th Cir. 2005).
commence. Given that the courts have made clear that criminal copyright law follows civil copyright law, the fact that Congress recently amended § 411(a) to require registration for civil infringement actions further establishes that registration is likewise necessary for criminal infringement prosecutions.

2. Registration Is a Purely Administrative Determination That Must Be Pursued and "Exhausted" Before Seeking Relief in Court

A third reason that the copyright laws do not authorize criminal prosecution for infringement of unregistered works is that allowing such actions would effectively permit criminal prosecution of a defendant for violating a right that had not yet been fully recognized as enforceable by the relevant administrative agency. The Supreme Court has noted that "[a] copyright, like other intellectual property, comprises a series of carefully defined and carefully delimited interests to which the law affords correspondingly exact protections." But because the copyright holder cannot enforce these "carefully delimited interests" until the Copyright Office has had the opportunity to review the work, it follows that such administrative review should be a prerequisite to criminal enforcement because, as a general rule, judicial relief is not available until the relevant administrative remedy has been exhausted.

That administrative agencies should exercise their own expert judgment before a criminal case is allowed to proceed was addressed by the Supreme Court in McKart v. United States. In that case, the petitioner had been convicted of failing to report for duty in the Armed Services. The petitioner challenged in court the draft classification given to him by the Selective Service Board court without first

93. Cross, 816 F.2d at 303; Wise, 550 F.2d at 1189 n.14 (noting "the general principle in copyright law of looking to civil authority for guidance in criminal cases"); L.L. Cool J., 145 F.R.D. at 39; Moran, 757 F. Supp. at 1050.
95. An author must preregister or attempt to register her work before initiating a civil infringement suit. 17 U.S.C. § 411(a).
98. Id. at 197–98.
exhausting his administrative remedies in the Selective Service System.  

The McKart Court concluded that the petitioner need not have exhausted his administrative remedies in that case because the question of his proper draft classification was purely one of statutory interpretation. The Court reasoned that unless a case involved purely legal issues that did not require any particular expertise on the part of the agency, administrative remedies had to be pursued before resort to the courts. The Court went on to observe that "it is well to remember that use of the exhaustion doctrine in criminal cases can be exceedingly harsh," and concluded that because the dispositive issue in a case was one of statutory interpretation, there was no need to wait for an agency to exercise its discretion or apply its expertise.

By contrast, the question whether a work is copyrightable is the essence of agency expertise; "the question of whether the technical requirements for registration have been met is the province of the Copyright Office," and it is up to the Copyright Office "to determine in the first instance whether a filer has complied with the technical requirements for a registration certificate." Given that copyrights carry with them valuable, "carefully delimited interests," and because it is the Copyright Office in the first instance that determines whether a work qualifies for all the legal protections afforded to a copyrighted work—which determination is purely a matter of the Copyright Office's agency expertise—the Copyright Office should be given the

99. Id.
100. Id.
101. Id. at 197–98.
102. Id. at 197.
105. Fonar, 105 F.3d at 105; see also Mays & Assoc.s v. Euler, 370 F. Supp. 2d 362, 368 (D. Md. 2005) ("[T]his Court should not exercise its jurisdiction prematurely and 'prejudge' a [registration] determination to be made by the Copyright Office.").
107. See Syntek Semiconductor Co. v. Microchip Tech., 307 F.3d 775, 781 (9th Cir. 2002) (yielding to the Copyright Office on the question whether that office had properly followed its own regulations in granting registration).
opportunity to determine whether the copyright attaches to a particular work before criminal proceedings for infringement can be initiated.

Copyright cases addressing the situation where a plaintiff who has registered a version of a work brings an infringement action for alleged infringement of a different, unregistered version of the work further support the principle that infringement actions may only be based on what the Copyright Office has actually considered. These numerous cases do not allow actions based on infringement of the unregistered version to proceed, concluding that registration of the earlier version of a work does not grant jurisdiction over the related—but unregistered—version of that same work. As Judge Selya wrote in Johnson v. Gordon, "elements distinct to an unregistered work cannot draw protection from a registered work even though the latter may contain the seminal idea that inspired both works." Accordingly, cases that arise in this analogous context support the argument that there is no federal court jurisdiction over an infringement action based on a work the Copyright Office has not formally reviewed.

Further support for the concept that review by an administrative agency is necessary to maintenance of a criminal action is also found in the analogous context of criminal trademark infringement proceedings. In the trademark context, criminal proceedings for copying a mark cannot be maintained unless the infringing mark is identical with, or substantially indistinguishable from a registered mark. More specifically, "criminal liability can only occur 'if a spurious mark is used on or in connection with goods or services for which the genuine mark is actually registered . . .

108. See Johnson v. Gordon, 409 F.3d 12, 20 (1st Cir. 2005) (infringement action based on elements present only in later, unregistered version of song could not proceed based on registration of earlier, registered version of song); Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp., 354 F.3d 112, 115–16 (2d Cir. 2003) (registration for earlier, smaller version of toy did not provide jurisdiction over claim of infringement of later, larger version of toy). The Eleventh Circuit, however, held to the contrary in Montgomery v. Noga, 168 F.3d 1282 (11th Cir. 1999). In that case, the court concluded that registration of an earlier version of a work supported jurisdiction over a claim that a later, unregistered version of work had been infringed. Id. at 1292–93.
and is in use."  Hence, no criminal proceedings can take place unless the mark's owner registers the mark for use in the specific field in which the infringer operates; an alleged infringer's use of that mark in a different field is not infringing. Thus, in the trademark context, criminal penalties only attach to the unauthorized use of a mark in the field where the mark was registered, not anywhere else. Applying this principle to the copyright context, criminal penalties likewise attach to the unauthorized use (i.e., infringement of a work) only when the work has been registered.

Patent law likewise embraces the principle that full administrative acknowledgement of the originality of the work at issue is necessary to support infringement actions. Under the patent laws, a patent holder can recover damages for infringement of her patent before the patent is issued by the United States Patent and Trademark Office, but these backward-looking damages only apply to the period between when the patent application was made publicly available and when the Patent Office actually grants the patent. Thus, copyright, trademark, and patent law all embrace the concept that administrative review is required for full, legal protection of an intellectual property right.

The preregistration scheme set forth in the recent amendments to the Copyright Act does not resolve this issue.

112. Giles, 213 F.3d at 1251-52.
113. See id. (vacating conviction for defendant's use of registered mark on clothing where mark registered only for use on handbags, wallets, gloves, and other similar accessories).
The court in Playboy Enter., Inc. v. Universal Tel-a-Talk, Inc., No. CIV. A. 96-CV-6961, 1998 U.S. Dist. LEXIS 8231 (E.D. Pa. June 3, 1998), reached the same conclusion. In that case, the defendants operated a website featuring certain images that included some of Playboy's trademarks—including the well-known Playboy rabbit head emblem—to highlight specific links to particular images. Id. at *4. The court concluded, however, that the plaintiffs had failed to make out a claim because the plaintiffs had not registered their marks for use on websites: "[A] claim for trademark counterfeiting lies only against a defendant's counterfeit uses of a mark on the same goods or services as are covered by the plaintiff's registration of that mark." Id.
114. 35 U.S.C. § 154(d) (2006). Patent applicants may also seek expedited review of their applications by alleging that there is a device or method available on the market that would infringe the patent claims under review by the Patent Office. See 1 MANUAL OF PATENT EXAMINATION PROCEDURE § 708.02.II (8th ed. 2006).
Because the Copyright Office does not review a preregistration application, there is no determination of whether the underlying work is worthy of registration, and the mere fact that a work is preregistered is no guarantee that the work will ever in fact be registered.\textsuperscript{115} It would be inequitable to permit a criminal prosecution premised on a property right that the rights holder cannot themselves exercise.

Accordingly, without explicit recognition by the Copyright Office, any elements of a work that are not registered—which logically includes elements that were never registered—cannot serve as the basis for an infringement action. If, on the other hand, registration were not a requirement for commencing a criminal infringement action, prosecutors could initiate prosecutions for infringement of works whose privileged status as copyrighted was not enforceable at the time of indictment. Allowing such prosecutions would be analogous to giving the government—which effectively acts as the plaintiff in criminal cases—a property interest in something (i.e., a copyright infringement action) that was not yet fully in existence.\textsuperscript{116}

D. Preregistration Does Not Serve as a Substitute for Registration

While some commentators suggest that a criminal action may be brought for infringement of a preregistered work,\textsuperscript{117} preregistration does not provide a proper legal basis for a criminal infringement prosecution. As previously described, a preregistration application does not give the Copyright Office the chance to fully evaluate the merits of the work, which evaluation is necessary to provide full protection for the copyright.\textsuperscript{118} Moreover, there is no guarantee that the

\textsuperscript{115} "The fact that a work has been preregistered does not mean that the Copyright Office necessarily will register the work when an application for registration is submitted." See U.S. Copyright Office, \textit{supra} note 31.

\textsuperscript{116} United States v. O'Dell, 247 F.3d 655, 685 (6th Cir. 2001) (concluding that defendant in criminal forfeiture case who failed to comply with conditions of existing escrow agreement could not have complete, matured interest in property and had no standing to challenge forfeiture).

\textsuperscript{117} See \textit{UNITED STATES DEPT OF JUSTICE}, \textit{supra} note 11, at 22–24; DuBose, \textit{supra} note 11, at 488–89.

\textsuperscript{118} See \textit{supra} Part III.C.2.
preregistered work will actually be registered,\textsuperscript{119} and it would be illogical to allow criminal prosecution based on a violation of an intellectual property right that was not yet fully enforceable.

\textbf{E. Solutions}

As discussed, the copyright laws currently fail to provide for criminal actions for infringement of unregistered or preregistered works. But because the harm from such infringement is undeniable—and because infringement of an unregistered work may be equal to the harm caused by infringement of a bona fide registered work—the issue must nevertheless be addressed.

\textbf{1. Solution 1}

One possible solution to the shortcomings would simply be to amend 17 U.S.C. § 411(a) to state that criminal prosecutions could be initiated based on infringement of unregistered or preregistered works. This solution is imperfect, however, because it effectively grants full copyright protection and enforcement to a work that has not actually achieved such recognition from the Copyright Office. Thus, this solution merely codifies the suggestion by certain commentators that criminal proceedings should be available for infringement of \textit{any} work, provided that the infringement meets the criteria of the relevant criminal statute. As described earlier in Part III of this article, however, these suggestions are based on a failure to fully consider the import of the registration process, and such an amendment would accordingly be legally unsound.

\textbf{2. Solution 2}

As mentioned, Congress amended § 411(a) to clarify that registration of the underlying work is a prerequisite for a civil infringement action. But, as discussed above, those amendments only clarify the law regarding civil infringement actions and do not settle the uncertainty regarding the role of registration in criminal infringement prosecutions. To do so, 17 U.S.C. § 411(a) could be amended to state:

\textsuperscript{119} See \textit{supra} note 115.
Registration and Civil Actions and Criminal Proceedings

“(a) Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title, and no criminal proceeding shall be instituted until registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, a civil action or criminal proceeding the applicant is entitled to institute an action for infringement may be instituted if notice thereof, with a copy of the complaint, criminal information, or indictment, is served on the Register of Copyrights[.1” (Suggested additions and deletions shown.)

These amendments to 17 U.S.C. § 411(a) would clarify that while civil actions may be based on registered or preregistered works, criminal actions may only be maintained for infringement of registered works. These amendments would preserve the intended effect of the preregistration scheme—i.e., to broaden the availability of civil infringement actions—while ensuring that criminal actions could only be instituted once a work had properly been subjected to complete Copyright Office review through the registration process.

3. Solution 3

One solution that occupies a middle ground between Solutions 1 and 2—i.e., somewhere between allowing criminal infringement actions for all works and allowing criminal infringement actions for only registered works—would be to alter the preregistration rules such that the Copyright Office makes some determination regarding the merits of the work during the preregistration process that entitles the owner to less protection than a fully registered copyright but nevertheless provides a basis for a criminal infringement
proceeding. This would provide for criminal prosecution of infringement of preregistered works while also avoiding the problem of lack of administrative review previously described. This solution, however, is impractical in that (1) the solution would burden the Copyright Office with having to perform quasi-registration reviews of works submitted for preregistration, and (2) the solution would elevate preregistration to a level it has not previously occupied.

Of these solutions, Solution 2 rests on the soundest legal basis. The amended statute suggested there would permit criminal infringement proceedings only for works that had achieved full administrative protection from the Copyright Office. Furthermore, Solution 2 would not impose any new burdens on the Copyright Office, as would Solution 3. Thus, by amending the statute to clarify that criminal prosecutions—at least under the current registration scheme—are not available for infringement of unregistered or preregistered works, the precise boundaries of the copyright laws can be better clarified for those who author copyrightable works and for those who criminally prosecute—and defend—their infringement.

CONCLUSION

With the spread of interconnected computers and their sophisticated users has come an attendant increase of unauthorized copying and distribution of authors’ original works. To address this ongoing problem, Congress amended the copyright laws to expand federal courts’ jurisdiction over civil infringement actions for infringement of works that are merely preregistered and have not attained full registered status with the Copyright Office. While courts now have jurisdiction over certain infringement actions based on preregistered works, the suggestion that formal, full registration is not necessary to support a criminal infringement action is misplaced, even in light of the recent amendments to the copyright laws.

First, because registration is a condition precedent to a civil action, the established link between civil copyright law

120. Goldstein, supra note 11, § 11.4.1; United States Dept. of Justice, supra note 11, at 22–24; DuBose, supra note 11, at 488–89.
121. See supra Part III.
and the criminal copyright context counsels in favor of requiring registration before initiation of a criminal prosecution. As discussed, because the copyright laws were ambiguous regarding whether the term "actions" includes both civil suits and criminal prosecutions, or only addresses civil suits, the rule of lenity required that this ambiguity be construed in favor of the defendant to require registration before initiation of a criminal infringement proceeding.

While the recent amendments arguably resolve some of this statutory ambiguity, the amendments address only civil infringement suits. While it is at least arguable that Congress's choice to address registration only in the civil context implies that Congress did not intend registration in the criminal context, the amendments are nevertheless silent regarding criminal matters. The rule of lenity cautions against reading Congress's silence regarding criminal prosecutions as going so far as to approve such prosecutions in the absence of registration.

Finally, copyright, trademark, and patent law all acknowledge the basic principle that administrative review is required before an intellectual property right is fully protected. Logically, then, this full protection and any subsequent enforcement cannot occur unless the Copyright Office has the opportunity to evaluate an author's registration application for her work. This acknowledgement of the importance of administrative review further emphasizes that the Copyright Office must pass on the merits of a particular work through the formal registration process before that work can serve as the basis for a criminal infringement action.

There will always be those with the willingness and the ability to distribute authors' work, and the injury that infringement of both registered and unregistered works causes is undeniable. Although it is tempting to use criminal prosecutions to address infringement of works regardless of their registration status, the legal basis for such prosecutions is unsound, and the copyright laws should be

124. See supra Part III.C.2.
125. See SIWEK, supra note 1, at 14.
126. See supra Part III.
amended to allow criminal infringement prosecutions only for formally registered works. Despite the harm that infringement of unregistered works may cause and general public policy against letting infringement go unpunished, combating such infringement with criminal prosecutions that lack a proper legal basis creates its own set of problems.