
Copyright Law—Southern District of Texas Still Has Dial-Up and Holds Uploaded Webpages Not Published or Accessible—*Rogers v. Better Business Bureau of Metropolitan Houston, Inc.*, 887 F. Supp. 2d 722 (S.D. Tex. 2012)

In order to bring a copyright infringement suit before a court, the work must first have been registered with the United States Copyright Office (Copyright Office).¹ In addition to permitting copyright infringement actions, a copyright's registration "constitute[s] prima facie evidence of the validity of the copyright."² The certificate of registration is usually held valid unless a defendant can prove that the claimant presented inaccurate information to the Copyright Office with the intent to commit fraud.³ In *Rogers v. Better Business Bureau of Metropolitan Houston, Inc.*,⁴ the United States District Court for the Southern District of Texas analyzed whether uploading webpages to the internet constituted "publication" under copyright law, an act that would invalidate a certificate of copyright registration covering an unpublished collection of webpages.⁵ Rulings from district courts in other circuits regarding whether uploading a work constitutes publication were examined, but ultimately the *Rogers* court deviated from the trend of other courts and declined to find the webpages published as a matter of law by deferring to the decisions made by the author and Copyright Office.⁶

On December 24, 2001, the defendant contracted with the plaintiff to create webpages for the defendant's member businesses.⁷ The contract was for a one-year term and automatically renewed afterwards on a month-to-month basis

1. See 17 U.S.C. § 411(a) (2012) (explaining copyright registration process). "[N]o 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." *Id.* See generally Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-810 (2012)).

2. 17 U.S.C. § 410(c) (detailing presumption of validity). "In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate." *Id.*; see *Gen. Universal Sys., Inc. v. Lee*, 379 F.3d 131, 141 (5th Cir. 2004) (reiterating registration as prima facie evidence of validity and registrant's ownership of copyright).

3. See *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (explaining fraud exception to validity presumption). "The presumption [of validity] generally is not overcome by an 'innocent misstatement'. It may be overcome, however, by proof of deliberate misrepresentation." *Id.*

4. 887 F. Supp. 2d 722 (S.D. Tex. 2012).

5. See *id.* at 722, 728-29 (outlining defendant's argument against registration of publicly available websites as unpublished works). The defendant contended that uploading the webpages in question equated to publication as a matter of law, and thus, granting registration was a legal error. See *id.*

6. See *id.* at 730-33 (explaining analysis and holding).

7. See *id.* at 724 (providing case's factual background). The contract between the two required the plaintiff to create individual webpages for the defendant's members, all hosted at the same uniform resource locator (URL)—reliabilitymall.com—to maintain the webpages, and to license the URL to the defendant's members. See *id.* at 724-25.

with the defendant, who passed on the expense of the plaintiff's creation and maintenance fees to its member businesses.⁸ Between 2001 and 2009, the plaintiff created these webpages for the defendant with each webpage being hosted and displayed at www.reliabilitymall.com—owned by the plaintiff—in exchange for an annual licensing fee.⁹ In early 2010, the plaintiff applied for a certificate of registration from the Copyright Office for the webpages of www.reliabilitymall.com and registered it as an unpublished, nondramatic literary work; the certificate issued on January 31, 2010.¹⁰ In October 2010, the plaintiff filed suit against the defendant for copyright infringement, claiming the defendant's continued use of the webpages after the contract terminated infringed on his copyright.¹¹

Two days after filing suit, the plaintiff applied for supplementary registration for the webpages created.¹² In this supplemental registration, the plaintiff cited reasons to support his argument that the webpages were unpublished, including:

Claimant created the registered Web pages between 2001-2009 to be displayed online. Each of Claimant's Web pages has a unique "Reliabilitymall.com" URL and was created independently for companies and individuals. Each Web page, or "site," was displayed on the www.ReliabilityMall.com [website] for one year in exchange for an annual licensing fee.¹³

The Copyright Office granted the supplemental registration and the defendant later filed for summary judgment on the issue of copyright infringement.¹⁴ In its motion for summary judgment, the defendant argued that the plaintiff's claim of copyright protection on the webpages was invalid as a matter of law because uploading webpages to the internet constituted

8. See 887 F. Supp. 2d at 725 (discussing details of contract between plaintiff and defendant).

9. See *id.* (providing details of nature of arrangement between plaintiff and defendant). On March 18, 2009, the defendant terminated the contract with the plaintiff subject to the terms of their agreement. See *id.*

10. See *id.* at 725 (explaining procedural history for plaintiff's copyright registrations).

11. See *id.* at 724-25 (detailing plaintiff's claims of copyright infringement). The plaintiff also alleged violations of the Digital Millennium Copyright Act (DMCA), 17 U.S.C. §§ 1201-1322. See 887 F. Supp. 2d at 725.

12. See *id.* at 725-26 (explaining supplemental action).

13. See *id.* (detailing plaintiff's supplemental copyright registration of webpages). The plaintiff pointed to the language of the Copyright Act of 1976 as evidence of legislative intent to support the notion that his webpages had not been published, noting "any form or dissemination in which a material object does not change hands—performances or displays on television, for example—is not a publication no matter how many people are exposed to the work." *Id.* (quoting H.R. REP. NO. 94-1476, at 138 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5754); see Copyright Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2541, 2543 (codified as amended at 17 U.S.C. § (2012)) (defining publication as including "distribution . . . of a work to the public by sale or other transfer of ownership").

14. See 887 F. Supp. 2d. at 726, 728-29 (detailing process of registration for webpages and procedural history of case).

publication.¹⁵

Under the power of the Intellectual Property Clause in Article I of the U.S. Constitution, Congress passed the first Copyright Act in 1790 (1790 Act), which Congress most recently amended in 1998 (current Copyright Act) to extend the protection period of copyrights.¹⁶ Congress originally passed the 1790 Act with the intent to stimulate education through narrow protection for an author's maps, charts, and books only.¹⁷ Congress has amended the 1790 Act over the years by expanding the period of time a copyright is protected, increasing the types of works protected under the statute to keep up with new technologies, and relaxing the formalities to which a potential rights holder must adhere to benefit from protection under the current Copyright Act.¹⁸ Under the current Copyright Act, authors are granted a copyright for their works that fall within certain enumerated categories if the works are original and "fixed in any tangible medium of expression."¹⁹ Congress, however, never intended to have all works protected under copyright laws; instead, the intent was to protect the expression of the author and not the facts and ideas presented in the work.²⁰ Copyright protection also does not extend to works that are

15. *See id.*

16. *See* U.S. CONST. art. I, § 8, cl. 8 (enumerating constitutional copyright purpose). This clause intended "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." *Id.*; *see* Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified as amended in scattered sections of 17 U.S.C.) (amending Copyright Act of 1976); Act of May 31, 1790, ch. 15, 1 Stat. 124 (providing copyright protection to limited works under 1790 Act).

17. *See* Act of May 31, 1790, ch. 15, 1 Stat. 124 ("For the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned."). Originally, copyrights received protection only if the rights holder complied with stringent procedures. *See id.* §§ 3-4.

18. *See* Sonny Bono Copyright Term Extension Act § 102 (increasing copyright protection period to author's life plus seventy years); Copyright Act of 1976 § 302 (extending protection period to life of author plus fifty years); Act of Mar. 4 1909, ch. 320, 35 Stat. 1075, 1075-80 (expanding works protected and extending protection to twenty-eight years). Copyright protection now covers literary works, musical works, dramatic works, pantomimes and choreographic works, pictorial, graphical, and sculptural works, motion pictures and other audiovisual works, sound recording, and architectural works. *See* Copyright Act of 1976 § 102. Under current law, a copyright vests in the author when the work is fixed in a tangible medium of expression. *See id.* §§ 102, 201.

19. *See* Copyright Act of 1976, Pub. L. No. 94-553, § 102(a), 90 Stat. 2541, 2544-45 (codified as amended at 17 U.S.C. § 102(a) (2012)). "Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." *Id.*; *see* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 546-47 (1985) ("Under the Copyright Act, these rights—to publish, copy, and distribute the author's work—vest in the author of an original work from the time of its creation.").

20. *See* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co. 499 U.S. 340, 360 (1991) (holding facts and ideas not copyrightable material); Baker v. Selden, 101 U.S. 99, 102 (1879) (holding ideas not copyrightable); *see also* 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03 (2013) (explaining borrowing ideas from material does not constitute copyright infringement). In *Feist Publications, Inc. v. Rural Telephone Service Co.*, the Court noted that "facts [and ideas] do not owe their origin to an act of authorship." Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 347 (1991). "This distinction," the Court continued, "is one

functional; the current Copyright Act states, “the design of . . . useful article[s] . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”²¹ The expression of an author is, therefore, protected under copyright law while that expression’s functionality lies within patent law’s protection.²²

In order for rights holders to maximize the protection of their copyrights, they must register or preregister the copyright under § 411(a) of the current copyright act before they may take civil action in court.²³ The Supreme Court ruled in *Reed Elsevier, Inc. v. Muchnick*²⁴ that a valid copyright registration is a statutory claims-processing requirement and the defendant must waive the requirement or the registrations must be completed before a suit for the infringement of the exclusive rights a copyright holder has under § 106 of the current Copyright Act.²⁵ Having a valid registration for a copyright also presents “prima facie evidence of the validity of the copyright” to courts, which shifts the burden of proving invalidity of the copyright to the defendant in an infringement case.²⁶ In order for rights holders to attain a valid copyright

between creation and discovery: The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence.” *Id.*

21. 17 U.S.C. § 101 (2012).

22. See *Mazer v. Stein*, 347 U.S. 201, 214 (1954) (explaining useful works may still benefit from copyright protection); H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668 (stating intent to give copyright protection to aesthetic elements separable from utilitarian aspects); see also Beth F. Dumas, Note, *The Functionality Doctrine in Trade Dress and Copyright Infringement Actions: A Call for Clarification*, 12 HASTINGS COMM. & ENT. L.J. 471, 471 (1990) (providing overview of functionality as defense in infringement cases). Even if functional, a work may still be provided copyright if the aesthetics can be separated from the functional aspect; the copyright will then cover only the nonfunctional aspect of the work. See Dumas, *supra*, at 471.

23. See 17 U.S.C. § 411(a) (“[N]o 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.”); see also 1 HOWARD B. ABRAMS, THE LAW OF COPYRIGHT § 10:9 (2012) (stating valid copyright registration needed to bring infringement suit); Matthew J. Astle, *Help! I’ve Been Infringed and I Can’t Sue!: New Approaches to Copyright Registration*, 41 U. MEM. L. REV. 449, 451 (2011) (explaining § 411(a) requires registration before civil suit).

24. 559 U.S. 154 (2010).

25. See 17 U.S.C. § 106A (2012) (laying out visual authorship rights); *id.* § 411(a) (waiving need for registration to sue for authorship rights); Astle, *supra* note 23, at 453-54 (explaining Supreme Court held courts can hear infringement case if § 411(a) not met). Without a valid registration, a copyright holder may only bring an action for authorship rights—the right to claim authorship of a work, to prevent destruction of a work, and to prevent the use of an author’s name on a distorted or mutilated work. See 17 U.S.C. §§ 106A, 411. Also, even though the Supreme Court ruled the requirement for registration was not jurisdictional, § 411(a) still requires a plaintiff to register before bringing an infringement suit. See Astle, *supra* note 23, at 463. The main effect that the Supreme Court decision had on courts was to permit the waiver of the registration requirement if the defendant failed to raise the issue. See *id.*

26. See 17 U.S.C. § 410(c); *Gen. Universal Sys., Inc. v. Lee*, 379 F.3d 131, 141 (5th Cir. 2004) (stating timely registration constitutes prima facie evidence of copyright validity and registrant ownership of copyright); *Norma Ribbon & Trimming, Inc. v. Little*, 51 F.3d 45, 47 (5th Cir. 1995) (acknowledging registration prima facie evidence of valid copyright); *Masquerade Novelty, Inc. v. Unique Indus.*, 912 F.2d 663,

registration, they must send a form to the Copyright Office detailing the title, authors, creation, publication status, and derivative works, along with the filing fee, which is then reviewed by the Copyright Office to determine if the work submitted is copyrightable.²⁷ For a defendant to show a registration is invalid, the defendant must demonstrate that the plaintiff intended to commit fraud when filing the registration and that if the Copyright Office had been alerted to the false information the registration would not have been granted.²⁸

One affirmative defense against a copyright infringement claim is fair use, which is provided under § 107 of the current Copyright Act.²⁹ Section 107 lays out uses of copyrighted materials by certain parties that will not constitute infringement, including criticism, comment, news reporting, teaching, scholarship, or research.³⁰ When using a defense of fair use against a claim of infringement of an unpublished work, courts have taken the position that while a work being unpublished is not itself a reason to negate a fair-use defense, it is a key factor in the analysis.³¹ When dealing with a fair-use defense, courts

668 (3d Cir. 1990) (providing registration shifts issue of copyright validity from plaintiff to defendant).

27. See *Copyright Basics*, U.S. COPYRIGHT OFFICE (May 2012), <http://copyright.gov/circs/circ01.pdf> (explaining registration process and copyrightable works); *Form TX*, U.S. COPYRIGHT OFFICE (July 2012), <http://copyright.gov/forms/formtx.pdf> (detailing information required to acquire copyright registration).

28. See 17 U.S.C. § 411(b) (explaining registration with inaccurate information still potentially valid under statute). See also *Masquerade Novelty, Inc. v. Unique Indus.*, 912 F.2d 663, 667 (3d Cir. 1990); *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (evidence of “deliberate misrepresentation” may overcome presumption of validity by registration).

29. See 17 U.S.C. § 107 (laying out uses of copyrighted material not constituting infringement); Michael J. Madison, *A Pattern-Oriented Approach to Fair Use*, 45 WM. & MARY L. REV. 1525, 1549-51 (2004) (explaining history and codification of fair-use doctrine). While fair use had been a well-recognized element in common law as early as the 1800s, it was not until the Copyright Act of 1976 that it was codified. See Madison, *supra*, at 1550-51. Rather than enumerating all of the uses that do not constitute infringement, Congress instead left the language of the statute broad and the Supreme Court has held that fair use should be determined with a four-factor test, to be applied on a case-by-case basis. *Id.* at 1554.

30. See 17 U.S.C. § 107 (laying out uses not constituting infringement); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 539 (1985) (holding use of unpublished manuscript not fair use); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 456 (1984) (holding time shifting when using Betamax fair use); Madison, *supra* note 29, at 1569-70 (explaining judicial response to fair use). Courts have adopted a four-factor analysis that is applied to determine fair use. See David Nimmer, “*Fairest of Them All*” and *Other Fairy Tales of Fair Use*, 66 LAW & CONTEMP. PROBS. 263, 266 (2003). The four factors considered are: the purpose and character of the use, including whether such use is of commercial nature or is for nonprofit educational purposes; the nature of the copyrighted work; the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and the effect of the use upon the potential market for or value of the copyrighted work. See 17 U.S.C. § 107; *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994) (reiterating four factors).

31. See 17 U.S.C. § 107 (2012) (“The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.”); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 553 (1985) (stating unpublished nature of work to figure prominently in fair-use analysis). In *Harper & Row Publishers, Inc. v. Nation Enterprises*, the Court was determining the fair use of an unpublished manuscript. See 471 U.S. 539, 541-42 (1985); see also Jeff Alan Schlei, Case Note, *Copyright—The Unauthorized Use of Verbatim Quotes from a Public Figure’s Manuscript Prior to Its Publication for Use in a News Story Constituted an Appropriation of the Right of First Publication and Is Not Protected by the Fair Use Privilege of the Copyright Act—Harper & Row, Publishers, Inc. v. Nation Enterprises* (U.S. Sup. Ct. 1985), 35 DRAKE L. REV. 445, 445-46 (1986) (discussing *Harper & Row*). Though

have had to adapt copyright law due to ever-changing technology; in particular, courts are still determining whether uploading a work to the internet constitutes publication.³² Currently, courts are split on this matter, but the majority have determined that the issue of internet uploads as publication should be decided on a case-by-case basis.³³ For example, the District Court for the Southern District of Texas first looked at the language of the current Copyright Act to determine the effect that a registered copyright would have.³⁴ The *Rogers* court stated that the registration would be invalid because of inaccurate information only if the applicant submitted the inaccurate information knowing the Copyright Office would refuse registration if the correct information had been provided.³⁵ Next, the court said that even though a copyright registration does provide a presumption of copyright validity, the presumption is rebuttable if the defense can show that the applicant committed fraud when submitting the application.³⁶ The defense's argument, claiming the registration was invalid because of inaccuracy regarding the publication status of the webpages, was not persuasive enough to rebut the presumption of validity.³⁷ The court agreed that if the webpages had been registered using inaccurate information, this would be

the Court ruled the unpublished nature of a work is a "key, though not necessarily determinative, factor," the Court still held use of the unpublished manuscript was not fair use, and that the lower court erred by not taking into account the unpublished character of the work. *See Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 540, 569 (1985).

32. *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984) ("From its beginning, the law of copyright has developed in response to significant changes in technology."); *see also* *Erickson v. Blake*, 839 F. Supp. 2d 1132, 1134 (D. Or. 2012) (labeling YouTube video as published with no publication analysis); *Kernal Records Oy v. Mosley*, 794 F. Supp. 2d 1355, 1364 (S.D. Fla. 2011) (holding uploading music file to internet constituted publication), *aff'd*, 694 F.3d 1294 (11th Cir. 2012); *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002) (holding uploading website to internet constitutes publication). *But see Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 197 (S.D.N.Y. 2006) (holding uploading digital file of music performance to internet not publication).

33. *See Kernal Records Oy v. Mosley*, 794 F. Supp. 2d 1355, 1364 n.7 (S.D. Fla. 2011) (noting issue of publication determined on case-by-case basis), *aff'd*, 694 F.3d 1294 (11th Cir. 2012). Here the court stated that instead of using a fixed rule about publication, it should instead focus on the facts presented in that particular case to determine publication. *See id.*

34. *See* 17 U.S.C. § 411(c) (stating effect of copyright registration); 887 F. Supp. 2d at 727.

35. *See* 887 F. Supp. 2d at 727 ("[I]f the certificate contains 'any inaccurate information,' it satisfies the registration requirement, unless the applicant included the information with knowledge that it was inaccurate and the Register of Copyrights would have refused registration had she known of the inaccuracy."); *see also* 17 U.S.C. § 411(b)-(c) (providing effect of inaccurate information in registration); 887 F. Supp. 2d at 727.

36. *See* 887 F. Supp. 2d at 727-28 (explaining fraud long-held basis for invalidating copyright registration). The court also noted that providing evidence of the work being copied from other sources is another method of invalidating a copyright registration. *See id.* at 728.

37. *See id.* at 730-31 (explaining defense's argument and presumption of validity not overcome). Though the first crux of the defense's argument was that the registration was invalid due to inaccurate information, the defense also insinuated that fraud took place by showing the plaintiff would be able to register the webpages as a collection only if they were unpublished, and had they been published, the plaintiff would have had to register each webpage individually, costing the plaintiff \$465,290. *See* Defendant Better Business Bureau of Metropolitan Houston, Inc.'s Motion for Partial Summary Judgment at 13-14, *Rogers v. Better Bus. Bureau of Metropolitan Houston, Inc.*, 887 F. Supp. 2d 722 (S.D. Tex. 2012) (No. H 10 3741), 2011 WL 5925718, at *7-8 (providing additional motive for plaintiff's fraud).

grounds for the Copyright Office to review the registration under § 411(b) of the current Copyright Act.³⁸

The court then moved to the defense's second argument that the webpages were *published* as a matter of law.³⁹ First, the court looked to the language of the current Copyright Act, which 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" or "[t]he offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display."⁴⁰ Next, the court analyzed various district court cases to determine if there was a consensus on the issue of publication on the internet.⁴¹ The court recognized that some courts held uploading works to the internet did constitute publication, but noted that the analysis for finding publication was done on a basis that is "case-to-case and is fact dependent."⁴² The court looked to the Copyright Office's "long-standing practice to ask the applicant, who knows the facts surrounding distribution of copies of a work, to determine whether the work is published or not," and noted that while the practices of the Copyright Office are not legally binding, they do deserve deference.⁴³ The court then turned to the defendant's argument that the plaintiff's licensing of the webpages to the defendant constituted publication under the current Copyright Act and distinguished the case law brought before it by noting the licensing agreement in this case did not allow the defendant to reproduce the webpages.⁴⁴ Relying on the language of the statutes and giving deference to the practices of the Copyright Office, the court held the defendant did not overcome the presumption of validity and did not show as a matter of

38. See 887 F. Supp. 2d at 729. The *Rogers* court found there was no erroneous information in either the original or supplemental applications and thus there was no issue under § 411(b). See *id.*

39. See *id.* at 730 (addressing whether uploading webpage to internet counts as publication).

40. See 17 U.S.C. § 101 (2012); 887 F. Supp. 2d at 730 (analyzing definition of "publication"). The court noted both the Copyright Office and the Fifth Circuit were silent on the issue of uploading to the internet as publication. See 887 F. Supp. 2d at 730-31. While the court found the argument that uploading works to the internet constituted publication to be persuasive, it concluded that the registration presented a presumption of validity and that this presumption, considered in tandem with deference to the Copyright Office, presented two legal constructs that precluded summary judgment. See *id.* at 730.

41. See 887 F. Supp. 2d at 730-31.

42. See *id.* at 731. Because the court did not find a consensus as a matter of law on the issue of internet publication it decided not to negate the presumption of validity from the copyright registration. See *id.* at 731.

43. See *id.* at 731-32 (internal quotation marks omitted) (giving deference to Copyright Office practices); see also § 904: *General Policy Concerning Publication*, COMPENDIUM II OF COPYRIGHT OFFICE PRACTICES, available at http://ipmall.info/hosted_resources/CopyrightCompendium/chapter_0900.asp (stating discretion with author in determining whether publication occurred) (last visited Oct. 20, 2013).

44. See 17 U.S.C. § 101 (defining publication as leasing work to another party for public distribution); 887 F. Supp. 2d at 732-33 (distinguishing *Rogers* from cases presented in defendant's argument); see also *McLaren v. Chico's FAS, Inc.*, No. 10 Civ. 2481(JSR), 2010 WL 4615772, at *3 (S.D.N.Y. Nov. 9, 2010) (holding licensing mannequin designs for reproduction constituted publication). In *McLaren*, the mannequin designs in question had been licensed to be reproduced and sold, while in *Rogers*, the webpages had not been licensed for sale. Compare 887 F. Supp. 2d at 733, with *McLaren v. Chico's FAS, Inc.*, No. 10 Civ. 2481(JSR), 2010 WL 4615772, at *1 (S.D.N.Y. Nov. 9, 2010).

law that the webpages had been published.⁴⁵

In *Rogers*, the court could have stopped its analysis after it decided the defense did not present enough evidence to rebut the presumption of validity provided by the registration.⁴⁶ The court, however, did not address in its opinion the motive for fraud that the defendant presented in its memorandum—that the plaintiff only registered the works as unpublished so all of the webpages could be a collection and the plaintiff could avoid paying an individual fee for each page.⁴⁷ Instead of ending the opinion there, the court continued with an analysis on the issue of whether or not uploading to the internet constitutes publication by looking to other courts around the country to determine whether a consensus existed.⁴⁸ In all the cases the court looked at, the holdings arose out of a case-by-case analysis influenced by the fact patterns of each case, yet the *Rogers* court erred by failing to analyze the facts presented before it, and instead relied on the presumption provided by the copyright registration.⁴⁹ Had the court analyzed the effect uploading a work to the internet has, it may have found, as the court in *Getaped.com, Inc., v. Cangemi* did, that after uploading them to the internet, the plaintiff lost control over limiting the duplication or further distribution of the webpages, an act that constitutes publication.⁵⁰

Ruling that uploading webpages to the internet does not constitute publication also contradicts the idea that copyright law must evolve and advance when technology does.⁵¹ Although most of the other district courts

45. See 887 F. Supp. 2d at 733 (holding defendant did not overcome presumption of validity).

46. See 17 U.S.C. § 411(b) (2012) (explaining registration with inaccurate information still valid); 887 F. Supp. 2d at 729 (stating defendant failed to overcome presumption of validity); *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (“The presumption [of validity] generally is not overcome by an ‘innocent misstatement.’ It may be overcome, however, by proof of deliberate misrepresentation.”). Here, because this was a motion for summary judgment by the defendant, the court could have dismissed the motion due to the lack of any evidence of fraud. See 887 F. Supp. 2d at 726; see also *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (holding defendant had no valid copyright due to misrepresentations on registration).

47. See 887 F. Supp. 2d at 729 (stating no evidence of fraud presented before court); Defendant Better Business Bureau of Metropolitan Houston, Inc.’s Motion for Partial Summary Judgment at 13-14, *Rogers v. Better Business Bureau of Metropolitan Houston, Inc.*, 887 F. Supp. 2d 722 (S.D. Tex. 2012) (No. H 10 3741), 2011 WL 5925718, at *7-8 (speculating plaintiff registered as unpublished to avoid registration fees).

48. See 887 F. Supp. 2d at 730-31. Compare *Kernal Records Oy v. Mosley*, 794 F. Supp. 2d 1355, 1364 (S.D. Fla. 2011) (holding uploading music file to internet constituted publication), *aff'd*, 694 F.3d 1294 (11th Cir. 2012), and *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002) (holding uploading website to internet constitutes publication), with *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 197 (S.D.N.Y. 2006) (holding uploading digital file of music performance to internet not publication).

49. See 887 F. Supp. 2d at 730-33; see also, e.g., *Kernal Records Oy v. Mosley*, 794 F. Supp. 2d 1355, 1364 (S.D. Fla. 2011) (holding music published because downloading of file allowed), *aff'd*, 694 F.3d 1294 (11th Cir. 2012); *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 197 (S.D.N.Y. 2006) (holding no commercial component for publication); *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002) (holding website uploaded to internet published because publisher loses control of duplication).

50. See *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002) (“[W]hen a website goes live, the creator loses the ability to control either duplication or further distribution of his or her work.”).

51. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984) (“From its

have held that uploading works to the internet constitutes publication for various reasons, the *Rogers* court relied on the discretion of the author to determine publication.⁵² If such a determination will be left up to the author, then evidence of fraud to rebut the presumption of validity the registration brings becomes much more difficult, as such a determination is now based on an author's subjective intent.⁵³ The court in *Rogers* acknowledged another solution they chose not to follow, which included sending the registration back to the Copyright Office for further evaluation.⁵⁴ This alternate solution would have been more in line with the court's reasoning because the court gave heavy deference to Copyright Office practices; furthermore, this solution would have clarified the Copyright Office's stance on the issue of uploading to the internet as publication.⁵⁵

Holding that webpages uploaded to the internet are not published as a matter of law also affects an area of copyright law that the court failed to recognize—fair use.⁵⁶ As the Court in *Harper & Row, Publishers, Inc. v. Nation Enterprises* held, the unpublished nature of a work is a “key factor” in determining fair use.⁵⁷ Due to the ruling in *Rogers*, anyone wanting to fairly

beginning, the law of copyright has developed in response to significant changes in technology.”).

52. See 887 F. Supp. 2d at 730-31 (following Copyright Office's practice of deferring to author to determine publication); *Kernal Records Oy v. Mosley*, 794 F. Supp. 2d 1355, 1364 (S.D. Fla. 2011) (holding uploading to internet published), *aff'd*, 694 F.3d 1294 (11th Cir. 2012); *McLaren v. Chico's FAS, Inc.*, 2010 WL 4615772, at *3 (S.D.N.Y. Nov. 9, 2010) (holding licensing mannequin designs for reproduction constituted publication); *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002) (holding website uploaded to internet published because creator loses control of duplication). While some courts have found uploading to the internet is not publication, most courts have. Compare *Kernal Records Oy v. Mosley*, 794 F. Supp. 2d 1355, 1364 (S.D. Fla. 2011), *aff'd*, 694 F.3d 1294 (11th Cir. 2012), and *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002), with 887 F. Supp. 2d at 732. In *Erickson*, the court held a YouTube video published without any analysis of publication, implying that the issue of whether or not an uploaded video is published was not an issue. See *Erickson v. Blake*, 839 F. Supp. 2d 1132, 1134 (D. Or. 2012).

53. See 887 F. Supp. 2d at 730-31 (giving deference to Copyright Office practices); *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (declaring evidence of intentional misrepresentation may overcome presumption of validity); see also § 904: *General Policy Concerning Publication*, COMPENDIUM II OF COPYRIGHT OFFICE PRACTICES, available at http://ipmall.info/hosted_resources/CopyrightCompendium/chapter_0900.asp (last visited Oct. 20, 2013) (stating Copyright Office leaves decision of publication to author's discretion).

54. See 887 F. Supp. 2d at 727; see also 17 U.S.C. § 411(b)(2) (2012) (“In any case in which inaccurate information described under paragraph (1) is alleged, the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.”).

55. See 887 F. Supp. 2d at 729-31 (looking to Copyright Office practices for guidance).

56. See 17 U.S.C. § 107 (“The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.”); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 553 (1985) (stating unpublished nature of work figures prominently in fair-use analysis). In light of the court's ruling that the webpages are not published, any time defendants invoke a fair-use defense against the infringement of webpages, they will have to overcome the unpublished nature of the work. See 887 F. Supp. 2d at 733; see also *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 553-54 (1985) (stating unpublished nature of work key factor in negating fair-use defense).

57. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 553 (1985) (“Congress intended

use webpages uploaded to the internet will have this key factor used against them in the fair-use analysis.⁵⁸ Originally, the intent behind giving unpublished works more protection from fair use was that, “although [an unpublished] work is unavailable, this is the result of a deliberate choice on the part of the copyright owner,” and “the copyright owner’s ‘right of first publication’ would outweigh any needs of reproduction,” which would not apply to works on the internet as they are available to everyone.⁵⁹ Moreover, authors often label their works as unpublished to reserve rights of first publication; in *Rogers*, however, the work was made public on the internet and, as such, there would be no monetary value in first publication.⁶⁰

Even though some courts have concluded that uploading works to the internet is not considered publication, the majority of courts have held that works uploaded to the internet are indeed published. Courts moving in the direction that works uploaded to the internet constitute publication are directly in line with the notion that courts must adjust copyright law as technology continues to evolve. Though all the courts analyzed in *Rogers* held that the issue of publication is to be determined by the facts of the case, the District Court for the Southern District of Texas overlooked the fact pattern and instead relied on the deference it gave to the Copyright Office. In addition, when the court decided the issue of publication, it had more impact than the court anticipated because holding that webpages uploaded to the internet are not published as a matter of law also affects the analysis for fair use. The purpose of protecting unpublished works from fair use was to protect the economic right of first publication; that right no longer has any value when a work is uploaded to the internet because everyone has free access to such works. By deviating from the holdings of the other district courts and instead relying on the presumption provided by the registration, the *Rogers* court has unwittingly affected an entirely separate area of law and inconsistent rulings in the fair use of webpages will likely result.

R. Brice Turner

the unpublished nature of the work to figure prominently in fair-use analysis.”)

58. See 887 F. Supp. 2d at 733 (holding uploaded webpages unpublished); see also *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 553 (1985) (stating unpublished nature key factor in fair-use analysis).

59. S. REP. NO. 94-473, at 64 (1975); see also *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 553 (1985) (stating Congress’s intent for fair use); *Getaped.com, Inc. v. Cangemi*, 188 F. Supp. 2d 398, 402 (S.D.N.Y. 2002) (“[M]erely by accessing a webpage, an Internet user acquires the ability to make a copy of that webpage . . .”).

60. See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 553 (1985) (“[T]he copyright owner’s ‘right of first publication’ would outweigh any needs of reproduction.”); Schlei, *supra* note 31, at 447-48 (noting courts place emphasis on economic benefits of first publication).