

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
JACKSONVILLE DIVISION

MATTRESS BY APPOINTMENT LLC,

Plaintiff,

v.

Case No. 3:20-cv-222-MMH-PDB

DANIEL ADAMS,

Defendant.

_____ /

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

On September 13, 2021, the Court requested advice from the Register of Copyrights (the "Register") pursuant to 17 U.S.C. § 411(b)(2) on the following questions:

- 1) Would the Register of Copyrights have refused to register Copyright Registration No. TXu 2-156-964 if the Register had known that the graphics and photographs in the Deposit Materials were preexisting materials authored by someone other than Daniel Adams?

- 2) a. Would the Register of Copyrights have refused to register Copyright Registration No. TXu 2-156-964 if the Register had known that an appreciable amount of the text in the Deposit Materials is based on and incorporates preexisting materials authored by

someone other than Daniel Adams, specifically the documents identified herein as “the Playbook”?

- b. Would the Register of Copyrights have refused to register Copyright Registration No. TXu 2-156-964 if the Register had known that the Deposit Materials contain a limited number of individual words or phrases authored by someone other than Daniel Adams?
- 3) Using the online registration application, in response to the prompt "Year of Completion (year of Creation)," Daniel Adams answered "2014." Adams maintains that he "created" the materials in 2014, but it is undisputed that the Deposit Materials were not "completed" until 2017. If the Register of Copyrights had known the foregoing information, would she have refused to register Copyright Registration No. TXu 2-156-964, which has an effective date of August 26, 2019?
- 4) Would the Register of Copyrights have refused to register Copyright Registration No. TXu 2-156-964 if the Register had known that the registered work contained text that Daniel Adams did not author?
- 5) Would the Register of Copyrights have refused to register Copyright Registration No. TXu 2-156-964 if the Register had known that the registered work contained text that Daniel Adams authored jointly with someone else?¹

The Register hereby submits her response. Based on the legal standards and examining practices set forth below, had the U.S. Copyright Office

¹ Request to the Register of Copyrights Pursuant to 17 U.S.C. § 411(b)(2) at 4–5, ECF No. 85 (“Request”).

("Copyright Office" or "Office") known that the deposit material submitted with Copyright Registration No. TXu 2-156-964 contained preexisting material authored by a third party, the Office would not have refused registration unless it found that the deposit material contained an appreciable amount of unclaimable material and the applicant failed to exclude that material from the claim. If the deposit material contained an appreciable amount of unclaimable material, the Office would have communicated with the applicant to obtain appropriate disclaimers before issuing a registration.

Additionally, had the Office known that the application for Copyright Registration No. TXu 2-156-964 stated the incorrect year of completion for the accompanying deposit material, or discovered that the deposit material was jointly authored, the Office would not have registered the claim. The Office would have communicated with the applicant to seek to resolve the inaccuracies before issuing a registration.

BACKGROUND

I. Examination History

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

On August 26, 2019, the Copyright Office received an application, deposit, and fee to register a literary work titled “Mattress By Appointment Business Plan.” The application identified Daniel Adams (“Defendant”) as the sole author and the claimant for the copyright and described the authorship as “text.” The application stated that the work was completed in 2014 and that it was unpublished. The application did not identify the work as a derivative work or disclose that the work incorporated any preexisting material.

Based on the information provided in the application, the Office had no reason to question the representations in the application and accepted them as true and accurate. The Office registered the claim in “text” with an effective date of registration (“EDR”) of August 26, 2019, and assigned registration number TXu002156964. To clarify the scope of Defendant’s claim to copyright, the Office appended an annotation to the registration certificate that states: “Regarding authorship information: Methods and systems not copyrightable. 17 USC 102(b). Registration extends to text contained in deposit.”²

² See generally U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 604 (3d ed. 2017) (“COMPENDIUM (THIRD)”) (“An annotation is a statement that the U.S. Copyright Office adds to the registration record to clarify the facts underlying the claim or to identify legal limitations on the claim.”).

On February 19, 2021, Defendant submitted an application for supplementary registration to amend his basic registration by changing the year of completion from 2014 to 2017, adding “photograph(s), artwork” to the “material excluded” field, and adding “text” to the “new material included” field. Due to the pending litigation and because the proposed changes appear to be directly at issue in the dispute, the Office informed Defendant that his application would be suspended until the dispute was resolved.³

II. The Court’s Request

Mattress By Appointment LLC (“Plaintiff”) has alleged that Defendant’s application contained three inaccuracies: 1) an assertion that Adams is the sole author of the work, 2) an assertion that Adams completed the work in 2014, and 3) a failure to disclose that the work was based on preexisting training materials Plaintiff refers to as “the Playbook.”⁴ Defendant denies that the application contains any material misrepresentations.⁵

³ See *id.* § 1802.9(G) (“If the [Office] is aware that there is actual . . . litigation . . . involving a basic registration, the Office may decline to issue a supplementary registration until the applicant has confirmed in writing that the dispute has been resolved.”).

⁴ Request at 3–4.

⁵ *Id.* at 4.

Finding that Plaintiff's allegations satisfied the conditions of 17 U.S.C. § 411(b)(2),⁶ the Court requested that the Register consider whether any of the identified inaccuracies, if known, would have caused the Register to refuse Defendant's registration. While the Court "has declined to make factual findings" as to the veracity of Plaintiff's allegations, it asked the Register to consider the following facts: "a) the Application identified one author, Daniel Adams, b) the Application identified the author's creation as 'text,' and c) the applicant did not otherwise limit the copyright claim."⁷

ANALYSIS

I. Relevant Statute, Regulation and Agency Practice

An application for copyright registration must comply with the requirements of the Copyright Act set forth in 17 U.S.C. §§ 408(a), 409, and 410. Regulations governing applications for registration are codified at 37 C.F.R. §§ 202.1 to 202.24. The principles that govern how the Office examines registration applications are found in the *Compendium of U.S. Copyright Office Practices*, an administrative manual that instructs agency staff regarding their statutory and regulatory duties and provides expert guidance to copyright

⁶ *Id.* at 2 n.1.

⁷ *Id.* at 2 n.1, 4.

applicants, practitioners, scholars, courts, and members of the general public regarding Office practices and related principles of law. The Office publishes regular revisions of the *Compendium of U.S. Copyright Office Practices* to reflect changes in the law and/or Office practices, which are made available for public comment prior to finalization. Defendant filed the relevant application for registration in 2019. Therefore, the governing principles the Office would have applied at that time are set forth in the version of the *Compendium of U.S. Copyright Office Practices, Third Edition* (“COMPENDIUM (THIRD)”) that was first released in September 2017.⁸

A. Limitation of Claim and Derivative Works

Under the Copyright Act, a “derivative work” is defined as “a work based upon one or more preexisting works, such as . . . [an] art reproduction, abridgment . . . or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a ‘derivative work’.”⁹ The statutory requirements for copyright registration

⁸ The Copyright Office published a new version of the COMPENDIUM (THIRD) in January 2021. The 2017 version cited in this Response is available at <https://www.copyright.gov/comp3/2017version/docs/compendium.pdf>.

⁹ 17 U.S.C. § 101 (definition of “derivative work”).

provide that an application for registration for a derivative work must include “an identification of any preexisting work or works that it is based on or incorporates, and a brief, general statement of the additional material covered by the copyright claim being registered.”¹⁰

The COMPENDIUM (THIRD) explains that “[a] claim should be limited if the work contains an appreciable amount of material that was previously published, material that was previously registered, material that is in the public domain, and/or material that is owned by an individual or legal entity other than the claimant who is named in the application.”¹¹ It further provides that “[i]f the work . . . contains an appreciable amount of unclaimable material,¹² the applicant should identify the unclaimable material that appears in that work and should exclude that material from the claim [by providing] . . . a brief, accurate description of the unclaimable material in the appropriate field/space of the application.”¹³

¹⁰ *Id.* § 409(9).

¹¹ COMPENDIUM (THIRD) § 621.

¹² Unclaimable material is “(i) previously published material; (ii) previously registered material; (iii) material that is in the public domain; and/or (iv) copyrightable material that is not owned by the claimant named in the application.” *Id.* Glossary.

¹³ *Id.* § 621.1.

The COMPENDIUM (THIRD), however, provides several scenarios where exclusions and disclaimers are not required. First, “[i]f the applicant intends to register a work that contains a minimal amount of unclaimable material, the applicant need not identify or disclaim that material in the application.”¹⁴ Second, there is no need to exclude “uncopyrightable material, such as facts or mere ideas,” or “attributions, citations, or direct quotations,” which may be indicated by “the quotation marks themselves,” “blocks of text that have been indented and set aside from the rest of the text,” or “attributions, citations, or other bibliographic references.”¹⁵ Finally, “[i]f it is clear that the claimant is not asserting a claim to copyright in the unclaimable material that appears in the work,” and the applicant does not identify the unclaimable material in the appropriate field/space of the application, “the registration specialist may register the claim without communicating with the applicant.”¹⁶ In certain cases, the registration specialist may annotate the registration record to clarify the extent of the claim and to identify material that is excluded from the claim.¹⁷

¹⁴ *Id.* § 621.2; *see also id.* § 621.9(A)(1).

¹⁵ *Id.* § 621.2.

¹⁶ *Id.* § 621.9(A)(2).

¹⁷ *Id.* § 621.9.

The Copyright Office will register a claim in a derivative work where the deposit material contains new authorship with “a sufficient amount of original expression, meaning that the derivative work must be independently created and it must possess more than a modicum of creativity.”¹⁸ The amount of creativity required for a derivative work is the same as that required for a copyright in any other work. The author must have “contributed something more than a ‘merely trivial’ variation.”¹⁹ Thus, “the key inquiry is whether there is sufficient nontrivial expressive variation in the derivative work to make it distinguishable from the [preexisting] work in some meaningful way.”²⁰ A claim to register a derivative work that adds only non-copyrightable elements, such as merely changing the size of the preexisting work, is not entitled to copyright registration.²¹ Ultimately, whatever the addition is, it must be independently protectable for the derivative work to be registered.

A registration for a derivative work only covers the new creative expression added by the author, not the expression in the preexisting work.²²

¹⁸ *Id.* §§ 311.1, 311.2 (citing *Waldman Publ’g Corp. v. Landoll, Inc.*, 43 F.3d 775, 782 (2d Cir. 1994)).

¹⁹ *Id.* (citing *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102–03 (2d Cir. 1951)).

²⁰ *Id.* (citing *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 521 (7th Cir. 2009)).

²¹ *Id.*

²² *Id.* § 507.2.

The registration will not cover “any previously published material, previously registered material, public domain material, or third party material that appears in the work.”²³

If there is an error in the registration concerning the claim to copyright, a supplementary registration may be used to correct or amend the information that appears in the fields/spaces describing and/or limiting the copyright claim.²⁴

B. Year of Completion

Under the Copyright Act, an application must include “the year in which creation of the work was completed.”²⁵ In defining when a work is “created,” the statute states: “[W]here a work is prepared over a period of time, the portion of [the work] that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.”²⁶ Under the governing regulation, “year of completion” means “the latest year in which the creation of any copyrightable

²³ *Id.*

²⁴ *Id.* § 1802.6(J); *see* 17 U.S.C. § 408(d) (permitting supplementary registration “to correct an error in a copyright registration or to amplify the information given in a registration”); 37 C.F.R. § 202.6(d)(2) (noting that “*correction* is appropriate if information in the basic registration was incorrect at the time that basic registration was made).

²⁵ 17 U.S.C. § 409(7).

²⁶ *Id.* § 101; *see also* COMPENDIUM (THIRD) §§ 611.1(B), 721.9(D).

element was completed.”²⁷ Thus, “[i]f a work is unpublished and if the author created the work over an extended period of time, the applicant should provide the year of completion for the most recent iteration of the work.”²⁸

If there is an error in the registration concerning the year of completion, the correct year may be added to the registration record with a supplementary registration.²⁹ The year provided in the application for supplementary registration must be the same as or predate the year given as the effective date of registration for the original registration.³⁰

C. Identifying the Author

An application for registration must include “the name . . . of the author or authors,” unless the work is anonymous or pseudonymous.³¹ The Supreme Court has explained that, other than in the case of work made for hire, “the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.”³²

²⁷ 37 C.F.R. § 202.3(c)(4).

²⁸ COMPENDIUM (THIRD) § 611.1(A).

²⁹ *Id.* § 1802.6(G).

³⁰ *Id.*

³¹ 17 U.S.C. § 409(2).

³² *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989); see also COMPENDIUM (THIRD) § 613.1.

A work is considered a “joint work” if it is “prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”³³ A person must “contribute a sufficient amount of original authorship to the work” to be considered a joint author.³⁴ An author may satisfy this requirement even if his contribution to the work is less significant than the contributions made by another author, but the author must contribute more than a *de minimis* amount of copyrightable expression.³⁵ Each joint owner owns the copyright in the entire work.³⁶

When completing the “author” field in a registration application, “the applicant should only provide the name(s) of the author(s) [or work made for hire author] who created the copyrightable material that the applicant intends to register”³⁷ “[T]here is no need to provide the name of any person(s) who created material that is *de minimis* or uncopyrightable.”³⁸ Likewise, the applicant should not provide “the name of any person who created material that is not owned by

³³ 17 U.S.C. § 101 (definition of “joint work”).

³⁴ COMPENDIUM (THIRD) § 505.2.

³⁵ *Id.*

³⁶ 17 U.S.C. § 302(b); H.R. REP. NO. 94-1476, at 121, *reprinted in* 1976 U.S.C.C.A.N. at 5736, at 104 (joint authors are “treated generally as tenants in common, with each co-owner having an independent right to use or license the use of a work”).

³⁷ COMPENDIUM (THIRD) § 613.3.

³⁸ *Id.*

the copyright claimant or material that the applicant does not intend to register.”³⁹ Indeed, “if the applicant fails to mention an author who is named in . . . the registration materials, the registration specialist will not communicate with the applicant if it is clear that the claimant does not own the copyright in that author’s contribution or if it is clear that the applicant does not intend to register that contribution.”⁴⁰ To illustrate this point, COMPENDIUM (THIRD) provides the example of an application submitted for a 500-page biography and a separately authored foreword that names only the author of the biography as the author of “text.” In this case, the registration specialist will register the claim because it is clear that the applicant intends to register only the text of the biography, rather than the text of the foreword.⁴¹

II. Other Copyright Office Regulations and Practices

The Copyright Office’s regulations require applicants to make a “declaration . . . that the information provided within the application is correct to the best of [the applicant’s] knowledge.”⁴² Generally, the Office “accepts the facts stated in the registration materials, unless they are contradicted by

³⁹ *Id.* § 613.10(C).

⁴⁰ *Id.*

⁴¹ *Id.*

⁴² 37 C.F.R. § 202.3(c)(3)(iii) (2019).

information provided elsewhere in the registration materials or in the Office's records."⁴³ The Office "generally does not compare deposit copy(ies) to determine whether the work for which registration is sought is substantially similar to another work."⁴⁴ Nor does the Office inquire about a work's creation or publication dates without an apparent omission, inconsistency, or contradiction.

When the Office determines that all of the "legal and formal requirements" of title 17 have been met, it will register the copyright claim and issue a certificate of registration under the seal of the Copyright Office.⁴⁵ There may be instances during the application process, however, where communication between the applicant and the Office is required:

As a general rule, the [registration] specialist will communicate with the applicant if he or she discovers that the applicant failed to provide sufficient information in a particular field or space of the application or elsewhere in the registration materials, or if the applicant otherwise failed to meet the registration requirements.⁴⁶

⁴³ COMPENDIUM (THIRD) § 602.4(C).

⁴⁴ *Id.* § 602.4(D).

⁴⁵ 17 U.S.C. § 410(a); COMPENDIUM (THIRD) § 602.

⁴⁶ COMPENDIUM (THIRD) § 605.3(B).

For example, when examining an application for a derivative work, “[i]f the scope of the claim is unclear and the issue cannot be addressed with an annotation, the registration specialist will communicate with the applicant.”⁴⁷

These communications are retained by the Office, and “[t]he registration record will indicate that there is correspondence in the file concerning the registration.”⁴⁸ If the registration specialist examining the claim adds or amends information within the registration record based on those communications, “the specialist will add a note containing the full name of the person who supplied the information, the organization or individual(s) that the person represents (if any), and the date the information was supplied.”⁴⁹

REGISTER’S RESPONSE TO THE COURT

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

⁴⁷ *Id.* § 621.9.

⁴⁸ *Id.* § 605.3(C).

⁴⁹ *Id.*

Questions 1, 2(a), and 2(b)

Question 1 asks the Register whether she would have refused to register Copyright Registration No. TXu 2-156-964 if she knew that the deposit material contained preexisting graphics and photographs that Defendant did not author. For reasons stated in section I-A, the Register would not have refused Defendant's claim had she known this information. In the application for Copyright Registration No. TXu 2-156-964, Defendant asserted a claim in "text" and did not assert a claim to any two-dimensional artwork or photographs.⁵⁰ Because it was clear from the application that Defendant was not asserting a claim to copyright in the graphics and photographs, the Office would have registered the claim even if it had known that the graphics and photographs in the deposit materials were preexisting materials authored by someone other than Defendant.

Question 2(a) asks the Register whether she would have refused to register Copyright Registration No. TXu 2-156-964 if she had known that "an appreciable amount of the text in the deposit materials is based on or

⁵⁰ As noted above, Defendant submitted a supplementary registration application to explicitly exclude from the registration "photograph(s)" and "artwork." The Office declined to issue the supplementary registration pending the resolution of this dispute.

incorporates preexisting materials authored by someone other than [Defendant], specifically the documents identified . . . as ‘the Playbook.’”⁵¹ As discussed above, an applicant is generally required to identify any preexisting work or works that a derivative work is based on or incorporates and provide a general statement of the additional material covered by the copyright being registered.⁵² Unclaimable preexisting material, however, should be disclaimed “only if it represents an appreciable portion of the work as a whole.”⁵³

If the Register had been aware that Defendant’s work was based on or incorporated a preexisting work that constituted an appreciable portion of Defendant’s work as a whole, she would not have registered the claim as submitted. Instead, the registration specialist would have corresponded with the applicant to request that Defendant disclaim the preexisting material and clarify what material Defendant had added to the preexisting work.

If, however, as posed in Question 2(b), the Register became aware that Defendant’s work contained “a limited number of individual words or phrases authored by someone other than” Defendant, then the registration specialist

⁵¹ Request at 4.

⁵² See 17 U.S.C. § 409(9).

⁵³ COMPENDIUM (THIRD) § 621.2.

would have registered the claim as submitted.⁵⁴ An applicant is not required to disclaim a minimal amount of unclaimable material or to disclaim material that is uncopyrightable, such as individual words or short phrases.⁵⁵

Question 3

If the Register had known that Defendant's work was completed in 2017, and not 2014, as Defendant stated in the application for Copyright Registration No. TXu 2-156-964, the Office would not have registered Defendant's work. The Office would have corresponded with Defendant to obtain the correct year of completion before issuing a registration.⁵⁶

Questions 4 and 5

Questions 4 and 5 relate to whether Defendant identified the appropriate authors on the application for Copyright Registration No. TXu 2-156-964.

In Question 4, the Court asks whether the Register would have refused registration if she had known that Defendant's work contained text that Defendant did not author. As discussed above, if the work incorporates an

⁵⁴ Request at 4.

⁵⁵ *Id.*; see 37 C.F.R. § 202.1(a)(prohibiting registration of "[w]ords and short phrases such as names, titles, slogans").

⁵⁶ As noted above, Defendant submitted a supplementary registration application to change the year of completion in the registration from 2014 to 2017. The Office declined to issue the supplementary registration pending the resolution of this dispute.

appreciable amount of preexisting copyrightable text that was authored by someone other than Defendant, Defendant was required to disclaim that text in the application.⁵⁷ However, “applicants do not need to disclaim attributions, citations, or direct quotations, because in most cases it is obvious that this material was not created by the author of the work.”⁵⁸

If the Register had known that Defendant’s work contained text that was not authored by Defendant, the registration specialist would have examined the deposit material to attempt to identify the third-party authored text and determine whether Defendant intended to register such text. If it was clear that Defendant did not own the copyright in the material the other author contributed or that Defendant did not intend to register that contribution, then specialist would have registered Defendant’s work.⁵⁹

If Defendant appeared to be claiming ownership of text authored by another author, the specialist would have communicated with Defendant to clarify if ownership of that text had been transferred to Defendant, which should be noted on the application. If the text authored by another author was a

⁵⁷ COMPENDIUM (THIRD) § 621.2.

⁵⁸ *Id.*

⁵⁹ *Id.* § 613.10(C).

preexisting work on which the work Defendant sought to register was based, and the preexisting text constituted an appreciable amount of the text that Defendant sought to register, then the registration specialist would have registered the work only if Defendant disclaimed that text in the application.

If, as posed in Question 5, the Register became aware that Defendant's work contained text that Defendant authored jointly with someone else, the registration specialist would not have registered the claim as it was submitted because it did not identify all authors of the work. If the Register had become aware that Defendant's work contained text that Defendant authored jointly with someone else, the specialist would have obtained the names of any co-authors and added them to the registration certificate.

As explained above, a joint work is a work "prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole."⁶⁰ Thus, if Defendant prepared his work without the assistance of another author, the work cannot be a joint work. Likewise, if Defendant created his work with the assistance of another author,

⁶⁰ 17 U.S.C. § 101 (definition of "joint work").

then it would only be a joint work if the two authors intended that their contributions be merged into a unitary whole.

Dated: October 26, 2021

A handwritten signature in black ink, reading "Shira Perlmutter", is written over a horizontal line.

Shira Perlmutter

Register of Copyrights and Director
of the U.S. Copyright Office