

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF PUERTO RICO

LUIS A. VELAZQUEZ-GONZALEZ

CIVIL 07-1512CCC

v.

RAFAEL PINA, d/b/a PINA RECORDS;
et al.

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

On June 1, 2009, the Court issued an Order to the Register of Copyrights pursuant to 17 U.S.C. § 411(b)(2). Request to the Register of Copyrights Pursuant to 17 U.S.C. § 411(b)(2) (hereinafter "Request to the Register"). When an allegation is made in legal proceedings that inaccurate information has been knowingly included on an application for copyright registration, a court is required by § 411(b)(2) to seek the advice of the Register of Copyrights (hereinafter, the "Register") as to "whether the inaccuracy of information, if known, would have caused the Register of Copyrights to refuse registration." The Request to the Register presents two questions, requesting a response by July 21, 2009.

QUESTIONS PRESENTED

The first question relates to Mr. Velázquez' basic registration for a song called *Amiga Mia* for which he claims copyright in the words and music. (See Registration Number PAu3-090-987) The application was submitted by Mr. Velázquez' agent on January 3, 2007. It identifies Mr. Velázquez as both the author and claimant. The Request to the Register states that José Nieves and Kenny Vázquez, and not Luis A. Velasquez-Gonzales, are the authors of *Amiga Mia*. Request to the Register, at 2. The question presented is whether the Copyright Office would have refused registration if it had known that Mr. Velázquez was not the author of *Amiga Mia*.

The second question presented in the Request to the Register relates to the supplementary registration that Mr. Velázquez submitted to correct the basic registration. The application for supplementary registration was submitted on March 7, 2008, also by an agent for Mr. Velázquez. (See Registration Number PAu3-143-842) It was submitted to change the authorship claim by deleting Mr. Velázquez' name and adding the names of Mr. Nieves and Mr. Vazquez. It also

amended the basic registration to state that Mr. Velázquez acquired title from those individuals by a signed transfer agreement. However, the Request to the Register states that, as part of their defense against Mr. Velázquez' allegation of infringement, the authors deny the validity of the transfer agreement. Request to the Register, at 3. When he made the supplementary registration, Mr. Velázquez did not notify the Copyright Office about the legal challenge to his copyright claim. The question is whether the Copyright Office would have refused the supplementary registration if it had known that Mr. Velázquez was involved in litigation disputing the validity of the signed transfer agreement giving him rights in *Amiga Mia*.

BACKGROUND

The Copyright Office is an office of public record without enforcement or investigative authority. One of its primary responsibilities is to examine applications to register copyright claims to determine whether they satisfy the legal requirements. These applications are the primary basis for the public record established and maintained by the Copyright Office. Regulations governing submission of applications are in title 37 of the *Code of Federal Regulations*. Guidelines and procedures for internal examination practices are in *The Compendium of Copyright Office Practices II* (hereafter, *Compendium II*). See Chapter 100, *Compendium II*.

A fundamental examining principle is that “the Copyright Office does not ordinarily make findings of fact with respect to publication or any other thing done outside the Copyright Office,” such as whether the person named in the application as the author of the work submitted for registration was in fact the author of that work. See *Compendium II*, §108.05. However, there are two instances in which the Copyright Office will contact an applicant to make inquiries with respect to whether the person(s) named in the application as author and/or copyright owner are in fact the author and/or copyright owner: one is when there are statements or other evidence within the scope of the application documents that require explanation or clarification, such as an apparent inconsistency,¹ *Compendium II*, § 108.05(a), and the other is based on administrative notice. Administrative notice occurs when the Copyright Office takes notice of matters of general knowledge and “may use such knowledge as the basis for questioning applications that appear to contain or be based upon inaccurate or erroneous information.” *Compendium II*, § 108.05(b).²

The policies and practices described above apply to the review of applications for basic

¹ For example, if Mr. Velazquez had submitted a registration application naming himself as the author and/or copyright owner of a book, but the deposit copy of the book named somebody other than Mr. Velazquez as the author, and/or the copyright notice on the book named somebody other than Mr. Velazquez as the copyright owner, the Office would have inquired about the inconsistency between the information in the application and the information in the deposit copy.

² For example, if Mr. Velazquez had submitted an application naming himself as the author of the novel *Gone with the Wind*, the Office would have inquired based upon the general understanding that Margaret Mitchell was the author of that novel.

registration for compliance with the legal requirements for registration under 17 U.S.C. §§ 408(a), 409 and 410, as well as to the review of applications for supplementary registration, which are authorized by 17 U.S.C. § 408(d). A supplementary registration may be made to correct or amplify a basic registration. The procedures and practices for supplementary registration are set forth at 37 C.F.R. § 201.5 and in Chapter 1500 of *Compendium II*. Section 1504.01 of *Compendium II* includes, as an example of a case in which a correction might be made by means of supplementary registration: “A basic registration identified someone incorrectly as the author of the work.” The requirements for supplementary registration relate to who is eligible to apply, the kinds of corrections or changes that may be made and what information must be provided in an application, such as title of the work and basic registration number.

In general (but with some exceptions, discussed below), there may be only one basic registration for each work, 37 C.F.R. § 202.3. There is no limit on the number of supplementary claims that may be submitted. An exception to the general principle of one basic registration is for adverse claims. An adverse claim arises when an ownership claim is asserted that conflicts with one that appears in an earlier basic registration for the same work. 37 C.F.R. § 202.3(b)(11)(iii). In such a case, the adverse claimant may submit a separate application for basic registration.

ANALYSIS

We express no view on the ultimate question of whether the certificate of registration (and the certificate of supplementary registration) satisfy the requirement of 17 U.S.C. § 411(b). That issue depends on factual findings by the court as to whether (1) the information stated in Mr. Velazquez’ applications was accurate, and (2) whether Mr. Velazquez had knowledge that the information was inaccurate. See 17 U.S.C. § 411(b)(1). In accordance with § 411(b)(2) and the Request to the Register, we assume that the information provided by Mr. Velazquez on his application relating to the work-for-hire status of *Amiga Mia* and to his alleged authorship of *Amiga Mia* was inaccurate, and provide the Court with the Register’s advice as to whether the Register would have refused registration had she known of the inaccuracy of the information in the application.

While the Copyright Office would not knowingly register a copyright claim that erroneously identified the author or copyright owner, it is also true that in most cases, the Copyright Office would not be in a position to question an assertion of authorship or ownership made in an application for registration. A review of Mr. Velazquez’ application for basic registration reveals that the Office would have had no reason to question whether Mr. Velazquez was the author or copyright owner of *Amiga Mia*. If *Amiga Mia* was indeed a work made for hire, as asserted in the application, then by operation of law Mr. Velazquez would be considered the author of the work. See 17 U.S.C. § 201(b). As a practical matter, if the Copyright Office had reason to believe at the time it received Mr. Velázquez’ application that he was not the author, the staff responsible for reviewing his application would have contacted him to inquire about that, giving him the opportunity to either correct the application or provide an explanation. Of course, the Copyright Office cannot speculate about what his answer would have been at that

time. However, if Mr. Velázquez had provided the same response that he provided in the supplementary registration that he later submitted, his basic application would have been amended accordingly and approved.

In this case, the Copyright Office had no reason to question Mr. Velazquez's assertion that he was the owner of the copyright in a work made for hire (and therefore, as the employer or other person for whom the work was prepared, he was also the author in the eyes of the law). Therefore, based on the information before the Office at the time of the application, the Office properly issued a certificate of registration. However, if the Office had known that Mr. Velazquez was not in fact the author of *Amiga Mia* (e.g., because it was not a work made for hire), then the Office would not have issued a certificate of registration that recited that he was the author and that *Amiga Mia* is a work made for hire.³ As noted above, however, the Office would have amended the application and issued a certificate of registration reciting that Mr. Velazquez was the claimant (i.e., owner) of the copyright in *Amiga Mia* if Mr. Velazquez had asserted (either initially or in response to a query from the Office) that he had obtained the rights by assignment.

Unless there was some reason, based on the face of the application and materials provided to the Office by Mr. Velazquez, for the Office to disbelieve that he had in fact received an assignment of the copyright, the Office would have accepted Mr. Velazquez's assertion that he was the copyright owner by virtue of an assignment. On the other hand, if the Office had been aware that Mr. Velazquez was not in fact the copyright owner or the author, the Office would have refused to issue a certificate of registration naming him as copyright owner or author.

The second question in the Request to the Register asks whether the Copyright Office would have accepted the supplementary registration if it had known at the time the application was submitted that Mr. Velázquez' title to *Amiga Mia* was in dispute. The answer is that the supplementary registration would have been accepted, notwithstanding knowledge that the facts related in the application for supplementary registration were in dispute. The fact that there is a

³ We note that the issue here is whether Mr. Velazquez was *in fact* the owner of the copyright in a work made for hire. It appears that the Court has concluded that *Amiga Mia* is not a work made for hire because it was composed prior to any agreement between its authors and Mr. Velazquez. See Request to the Register, at 2. In contrast, situations have arisen in which there is a question whether, as a matter of law, a particular kind of work is eligible for work- made-for-hire status. In some such cases, the answer to that legal question is not entirely clear. For example, it is unclear to this day, and the case law has not directly addressed, whether sound recordings can qualify as works made for hire in cases where they were not made by employees within the scope of their employment. See *United States Copyright Office and Sound Recordings as Works Made for Hire: Hearing Before the Subcomm. on Courts and Intellectual Property of the H. Comm. on the Judiciary*, 106th Cong., 2d Sess., 40 (2000) (statement of Marybeth Peters, Register of Copyrights). In light of that legal uncertainty, the Copyright Office does not question applications for registrations of copyrights in sound recordings that recite that a sound recording is a work made for hire, and at least unless and until that issue is definitively resolved in the courts, the Office would not take the categorical position that a sound recording commissioned by a record company for inclusion in a record album or CD cannot be a work made for hire.

dispute over ownership or control of a work does not mean that there has been a failure to satisfy the legal requirements, discussed above, for supplementary registration, as federal court is the appropriate venue for such disputes. Nor is there any obligation for an applicant for a basic or supplementary registration to advise the Copyright Office that other parties contest the applicant's claim to copyright.⁴ Mr. Velázquez' supplementary registration was within the guidelines for submission. It satisfied the requirement of § 1504 of *Compendium II* which states that a correction is appropriate "if the information in the basic registration was incorrect at the time that basic registration was made, and the error is not one that the Copyright Office itself should have recognized." See 37 C.F.R. § 201.5(b)(2)(i). As the claimant on the basic registration, Mr. Velázquez was eligible to submit a supplementary registration for it. Also, he requested a permissible change by identifying the correct authors and providing a statement regarding how he obtained title to the work. Finally, he provided the information that was required by the application form. It is not relevant to these requirements that the validity of his written transfer agreement is being disputed, although that may provide the basis for other claimants to make a second basic registration as an adverse.⁵

FURTHER CONSIDERATIONS

Because the Copyright Office strives to maintain a complete and accurate record of claims and because of its potential relevance, we would like to take this opportunity to address a related concern. There are different procedures available that may be relevant for consideration upon conclusion of this case to assist in its resolution, depending on its outcome. That includes submitting additional supplemental registrations if further corrections to the basic registration for *Amiga Mia* are in order. 37 C.F.R. § 202.3(b)(11)(iv). Also, documents (such as assignments of rights) relating to ownership and control of *Amiga Mia* may be recorded at the Copyright Office. 37 C.F.R. § 201.4. As already discussed, an exception to the general principle of one basic registration for each work is that another basic registration may be made as an adverse claim. 37 C.F.R. § 202.3(b)(11)(iii) (exception to the "one registration per work" rule where "an applicant

⁴ If, at the time Mr. Velasquez submitted his application for supplementary registration, Mr. Nieves and Mr. Vasquez had already submitted their own registration application asserting that *they* owned the copyright in *Amiga Mia*, and if the registration specialist examining Mr. Velasquez's application for supplementary registration had been aware of the adverse claim by Mr. Nieves and Mr. Vasquez, the Office most likely would have inquired of Mr. Velasquez to obtain confirmation that, notwithstanding the protests of Mr. Nieves and Mr. Vasquez, it remained his position that he had obtained ownership of the copyright by assignment from them. Mr. Nieves and Mr. Vasquez would have been sent copies of that correspondence. But if Mr. Velasquez had reiterated his assertion of ownership, the Office would have proceeded with registration of his claim. Ultimately, a certificate of copyright registration is simply a registration of a person's *claim* of copyright ownership; resolution of disputes over ownership or authorship must be resolved in the courts rather than by the Copyright Office, which is not equipped to engage in the fact-finding and procedures involved in resolving inter partes disputes.

⁵ Of course, if Mr. Velazquez did not really acquire ownership of the copyright by an assignment from the authors of the work, and if the Office had known that he did not acquire ownership, the Office would have rejected the application for supplementary registration.

for registration alleges that an earlier registration for the same version is unauthorized and legally invalid”). Also, the authors of *Amiga Mia* are eligible to take advantage of another exception to the one basic registration principle: for an author who is not identified as the claimant in the first basic registration, another basic registration may be made that identifies the author as claimant. 37 C.F.R. § 202.3(b)(11)(ii) (permitting the author to obtain registration naming the author as claimant even in cases where the author has assigned the copyright and the assignee has obtained registration in his or her own name).

If the Court concludes that Mr. Velazquez is (and, on the effective date of registration, was) not the copyright owner of *Amiga Mia* (either as a work for hire or by assignment), then the court may order Mr. Velazquez to request that the Copyright Office cancel his registration (as well as his supplementary registration) on the ground that he was not entitled to register the copyright in his name. See 37 C.F.R. § 201.7.

Copies of the provisions of *Compendium II* and the Copyright Office Regulations cited herein are attached.

Dated: July 9, 2009

Respectfully Submitted,



Marybeth Peters
Register of Copyrights