United States Copyright Office
Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

February 17, 2006

Jonathan A. Hyman, Esq.
Knobbe Martens Olson & Bear LLP
2040 Main St.
Irvine, CA 92614

RE: 5-PIN INDY CROSS
Control No: 61-320-6104(K)

Dear Mr. Hyman:

I am writing on behalf of the Copyright Office Review Board in response to your second request for reconsideration, dated June 29, 2005. After reviewing the application from NHS, Inc., and the arguments you presented on Applicant's behalf, the Board agrees with the Examining Division that Applicant's 2-dimensional artwork, 5-Pin Indy Cross, is copyrightable.

However, as the Examining Division has informed you, a copy of the work as first published showing the copyright notice must be submitted in order to register the work. Letter from Giroux to Hyman of 4/1/2005. The Board has determined that, if Applicant submits by March 31, 2006, a copy of the published work, reflective of its *first* publication and which shows the copyright notice, if any, the Board will review the submission to determine whether the copy as deposited complies with the notice requirement. If, however, the Applicant does not submit a copy of the work as it was first published, with the required copyright notice, by March 31, 2006, registration will be refused and this case will be closed.

Your reliance on the best-edition requirement to avoid submission of the first published version of the work bearing a statutorily required notice is misguided. The purpose of the best edition requirement is to satisfy the needs of the Library of Congress for developing and maintaining its collections. At 37 CFR § 202, Appendix A and Appendix B set forth the best edition requirements that registration claimants must satisfy. Claimants do not decide for themselves what constitutes the best editions of their works; rather, the best edition guidelines are developed by the Library of Congress in order, most effectively, to utilize the registration deposit requirements to satisfy the permanent, archival needs of the Library. The best edition requirements do not, in any way, excuse a copyright claimant from satisfying whatever *other* statutory requirements are applicable, given the circumstances of creation and publication of a work, in order for the work to enjoy copyright protection.

The best edition requirement is primarily applicable in situations where several versions of a published work exist or in situations where a work may be contained in more than one published format, such as in both VHS and DVD formats. The purpose of the best edition

requirement is to ensure that the quality and unique characteristics of physical copies are best preserved by the Library of Congress for posterity. Again, Appendix B in 37 CFR § 202, explicitly states that the best edition of a work is that edition which "the Library of Congress determines to be most suitable for its purposes." And, its purposes are those which speak to the preservation of permanent collections for the national library.

As Ms. Giroux stated in her April 1, 2005, letter, in order to receive copyright protection, all works published prior to March 1, 1989, the effective date of the Berne Convention Implementation Act of 1988, must have carried a statutorily correct copyright notice. 17 U.S.C. § 405(a). The law provides that if the copyright notice was omitted from publicly distributed copies of a work, the copyright in such a work is not invalidated if registration is made within five years after publication without notice and a reasonable effort is made to add notice to all copies that are distributed in the U.S. after the omission has been discovered. 17 U.S.C. § 405(a)(2).

The legal basis for complying with the requirement for submitting deposit materials that show the copyright notice, for published works where such notice is required, is found at 17 U.S.C. § 410(a), which mandates that the Register examine all applications for registration to determine whether "the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met." 17 U.S.C. § 410(a) (emphasis added) Among the legal requirements of Title 17 is the requirement that a copyright notice appear on published works of authorship where publication occurred before March 1, 1989. 17 U.S.C. § 405 (a). Section 410 of the statute makes it clear that the Register has the duty, as part of her administrative actions, to assure that claims submitted for registration meet all statutory requirements for the enjoyment of copyright protection–one of those requirements is that of distribution of copies carrying a correct copyright notice if such distribution took place prior to March 1, 1989. Applicant must submit, therefore, a deposit reflecting the first publication and showing the required copyright notice since the work, said on the application to have been first published in December 1978, is required to have been published with a statutory copyright notice, and it is now more than five years since the date of first publication indicated on the application December 1978.

Office regulations, 37 CFR, chapter 2, and Compendium of Copyright Office Practices II (1984) [hereinafter *Compendium II*] do not explicitly state that the copyright notice must appear on deposit materials which also satisfy the best edition requirement: the separate requirements of adequate notice for certain published works and for acceptable registration deposit materials are stated in separate statutory sections, §§ 405 and 408, but both must be satisfied if a party seeks the registration of a work. Registration means registration of a work protected by copyright and, unless a work first published in 1978 carried a sufficient copyright notice as the law requires, or met the ameliorative provision of § 405(a)(2) of publication without sufficient copyright notice but registration made within five years of the date of original

publication, the work enters the public domain and registration, of course, is not possible. Sections 1003 and 1008.01 of *Compendium II* state that a claim will be refused when a copyright notice is required upon publication but such notice does not appear on deposit materials which have been submitted for registration. This categorical statement includes those situations in which the deposit material which has been submitted satisfies the best edition requirements. Satisfaction of best edition registration deposit requirements does not guarantee satisfaction of adherence to the statutory requirement of adequate copyright notice for a work amenable to the notice requirement.

Finally, you have stated that Applicant's deposit is not a copy of what was published in 1978 but a "current color printout" that you argue satisfies the best edition requirements of 17 U.S.C. §§ 407(a) and 408(b), administered by the Office through regulations and Office practices found in *Compendium II*. Letter from Hyman of 6/29/05 at 2. Relying upon your statement, we point out that, since the material you submitted is not a first published copy but what would be considered, for registration purposes, as identifying material, that category of deposit material is regulated by 37 CFR § 202.21. Section 202.21(c) explicitly states that at least one piece of identifying material must show, in the case of works published with a copyright notice, the notice and its position on the published work.

If you wish to send us materials which show a copy of the work at issue here as it was first published in December 1978, and bearing the statutorily required copyright notice, please respond by March 31, 2006. Should you send such material in following up with this submission, please also inform us of the day date of publication of the work. If necessary, please give an approximate day date that we may then add to the application. If no first published copy of the work showing the copyright notice, or equivalent identifying material as required in 37 CFR § 202.21(e), is forthcoming by March 31, 2006, we will close the case and consider this letter a final agency action.

Sincerely

/S/

Nanette Petruzzelli
Special Legal Advisor for Reengineering
for the Review Board
United States Copyright Office