United States Copyright Office
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September 27, 2013

Cades-Schutte
Attention: Martin E. Hsia
Cades Schutte Building
1000 Bishop Street, Suite 1200
Honolulu, Hawaii 96813

Re: ***HOMOSEXUALITY THE IDENTITY CRISIS***
Correspondence ID: 1OUN8Q

Dear Mr. Hsia:

The Review Board of the United States Copyright Office ("Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the work entitled: *Homosexuality The Identity Crisis* (hereinafter, the "Work"). You submitted this request on behalf of your client, Science of Identity Foundation, on October 28, 2009. I apologize for the delay in the issuance of this determination. After periods of inaction, staff departures, and budgetary restrictions, the Register of Copyrights has appointed a new Board and we are proceeding with second appeals of registration refusals as expeditiously as possible.

The Board has examined the application, the deposit copies, and all of the correspondence in this case. After careful consideration of the arguments in your second request for reconsideration, the Board affirms the Registration Program's denial of registration of this copyright claim. The Board's reasoning is set forth below. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action on this matter.

I. ADMINISTRATIVE RECORD

On January 28, 2008, an application, deposit, and fees were received from you on behalf of your client to register the Work. By letter dated June 10, 2008, Registration Specialist John Poff refused registration on the ground that the work was first published between January 1, 1978 and March 1, 1989 without an adequate notice and was received in the U.S. Copyright Office (the "Office") more than five years after publication without notice. *Letter from Registration Specialist, John Poff, to Martin Hsia* (June 10, 2008)

In a letter dated June 2, 2008, you submitted a first request for reconsideration of the refusal to register due to omission of the notice. *Letter from Martin Hsia to Copyright R&P Division* (June 2, 2008). Included with the letter was a declaration of Socorro M. Bismark stating that the Work was not published in the United States prior to March 1, 1989, and therefore remains subject to copyright protection. *Id.* at 2. By letter dated July 29, 2008, Attorney Advisor, Virginia Giroux-Rollow, stated that section 401 of the copyright law provides that whenever a work is published in the U.S. or elsewhere by authority of the copyright owner,

a notice of copyright may be placed on all publicly distributed copies. Because the Work was first published without a copyright notice on March 5, 1987, and received in the Copyright Office more than five years after publication without a copyright notice, the work was in the public domain. *Letter from Attorney Advisor, Virginia Giroux-Rollow, to Martin Hsia,* at 1 July 29, 2008). Moreover, she stated that registration under GATT provisions of the URAA was not possible because the author, Chris Butler, was both a U.S. citizen and domiciled in the U.S. at the time of first publication in the Philippines.

Finally, in a letter dated October 24, 2008, you request that the Office reconsider for a second time its refusal to register the Work. *Letter from Martin Hsia to Copyright RAC Division* (October 24, 2008). You advance several reasons why the Work should be registered, and include the declaration of Socorro M. Bismark describing certain matters relating to the work and the circumstances of publication. Mr. Bismark asserts that copyright notice was accidentally omitted from less than 2,000 out of 8,000 copies of the work distributed in the Philippines prior to March 1, 1989. *Declaration of Socorro M. Bismark*, at 2 (October 23, 2008). Copyright notice was also omitted from copies of the Work distributed in the United States on or after Ocotber 1997, amounting to less than 200 copies of the 600 total distributed. *Id.* You argue that the distribution of the work in the Philippines should not be considered a publication within the meaning of the U.S. copyright law because the U.S. copyright law does not apply to extraterritorial acts, because it was not made to the "public," and/or because it was a limited publication. Moreover, if the distribution in the Philippines is considered to be a publication under the current copyright law, you assert that your client avoided divestiture of copyright as provided in section 405(a)(1) of the Copyright Act, which provides that omission of copyright notice from a work publicly distributed prior to March 1, 1989 does not invalidate the copyright if the omission is from a "relatively small number of copies. 17 U.S.C. § 405(a)(1). Finally, you state that registration should be issued by virtue of the rule of doubt.

II. DECISION

A. *The Legal Framework*

Section 401(a) of the Copyright Act, as written at the time of first publication of the work in March, 1987, provided: "Whenever a work protected under this title is published in the United States *or elsewhere* by authority of the copyright owner, a notice of copyright as provided by this section shall be placed on publicly distributed copies from which the work can be visually perceived, either directly or with the aid of a machine or device." 17 U.S.C. § 401(a) (1987) (emphasis added). The reference to "or elsewhere" makes it clear that the notice requirement was intended to apply to works distributed abroad as well as the United States. Nevertheless, to ensure that there was no ambiguity about this issue both Congressional Reports included the following paragraph:

> Subsection (a) of both section 401 and section 402 require that a notice be used whenever the work "is published in the United States or elsewhere by authority of the copyright owner." The

> phrase "or elsewhere," which does not appear in the present law, makes the notice requirement applicable to copies or phonorecords distributed to the public anywhere in the world, regardless of where and when the work was first published. The values of notice are fully applicable to foreign editions of works copyrighted in the United States, especially with the increased flow of intellectual materials across the national boundaries, and the gains in the use of notice on editions published aboard under the Universal Copyright Convention should not be wiped out. The consequences of omissions or mistakes with respect to the notice are far less serious under the bill than under the present law, and section 405(a) makes doubly clear that a copyright owner may guard himself against errors or omissions by others if he makes use of the prescribed notice an express condition of his publishing licenses.

H.R. Rep. No. 94-1476, 2d Sess. at 144 (1976); S. Rep. No. 94-473, 1st Sess. at 127 (1995).

The issue of publication abroad without copyright notice was directly raised in *Hasbro Bradley, Inc. v. Sparkle Toys, Inc.*, 780 F.2d 189 (2d Cir. 1985). In that case, the copyright owner was an American licensee of a Japanese firm which had initially designed and manufactured certain toys and had publicly distributed the toys in Japan without copyright notice. The court ruled that the "omission of notice from toys sold by Takara or with its authority outside the United States violated § 401 of the Act...." *Id.* at 193. The court ultimately upheld the copyright due to a copyright registration within five years of publication under § 405(a)(2). A similar rational was applied in *Greenwich Film Productions S.A. v. DRG Records, Inc.*, 25 U.S.P.Q.2d 1435 (S.D.N.Y. 1992) in which copyright in two sound recordings was lost due to publication of the sound recordings in France without copyright notice.

In your letter for second reconsideration, you assert that case law establishes that publication without copyright notice in a foreign country does not divest copyright protection, citing *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162 (9th Cir. 1996) and *Heim v. Universal Pictures Co.*, 154 F.2d 480 (2d Cir. 1946). *Letter from Martin Hsia to Copyright RAC Division*, at 6-7 (October 24, 2008). Those cases are inapposite to consideration of registration of the Work because they are decided under the provisions of the1909 Copyright Act, rather than the Copyright Act of 1976. There is conflicting law under the 1909 Copyright Act regarding whether publication abroad without copyright notice divests copyright protection, although regulations of the Copyright Office clearly take the position that the notice provision does apply to works first published abroad. 37 C.F.R. § 202.2(a)(3)(2009). The position taken in the regulations was primarily the result of modifications in the law occurring as a result of the adoption of the Universal Copyright Convention, which occurred after the *Heim* decision. In any event, Congress removed any ambiguity over the issue in the 1976 Act by explicitly providing that copyright notice applied to works published abroad, as well as the United States.

You also raise the argument that the U.S. copyright law cannot be given an extraterritorial effect. *Letter*, at 7-9. Your argument begins with a discussion of this issue in the *Heim* case, and then cites *Quality King Distributors, Inc. v. L'Anza Research International Inc.*, 523 U.S. 135 (1998) and *Omega S.A. v. Costco Wholesale Corporation*, 541 F.3d 982 (9th Cir. 2008) which denied extraterritorial application of the first sale doctrine in copyright infringement actions where the party asserting the doctrine obtained the copyrighted work abroad and imported it into the United States. With respect to the *Heim* case, as already stated above, the Congress rejected the position taken in *Heim* by enacting a copyright notice provision applying to works published abroad as well as U.S. works. With respect to cases dealing with the first sale doctrine, Congress was silent as to whether the first sale doctrine had an extraterritorial effect, and courts construing the provision adopted a presumption that there was no such affect. As regarding the notice provision in current law, Congress has stated that notice applies to works published abroad between 1978 to 1989, and that explicit statement of statutory policy is controlling.

You further assert that the distribution of 8,000 copies of the Work in the Philippines was a limited publication because it was restricted both as to persons and purpose, citing *White v. Kimmell*, 193 F.2d 744 (9th Cir. 1952), and other precedents. *Letter*, at 2-4. The facts as you have presented them in your application, your letter for second reconsideration, and Mr. Bismark's Declaration do not support such a legal conclusion. The work itself is a professionally printed work containing an ISBN number and a pricing bar code. The application states that it was first published on March 5, 1987 in the Philippines. Mr. Bismark states: "Prior to March 1, 1989, copies of 'Homosexuality The Identity Crisis'were distributed or offered to be distributed only in the Philippines." *Declaration*, at 2. There are no indications of any intention or action to limit the distribution of the Work. The Board determines that a general publication occurred when the 8000 copies of the work were distributed.

The leading case on the subject, *White v. Kimmell*, actually supports a finding of a general publication, rather than a limited publication. In that case, approximately 200 copies of a self- published manuscript were distributed over a period years. The Court found this to be a general publication rather than a limited one. One overriding factor in concluding that the manuscript was not restricted as to persons was that many who received copies were not "acquainted" with the author. *White*, at 745. Nothing in the information presented to the Board suggests that the 8000 people who secured copies had any acquaintance with the author of the Work. Moreover, in *Penguin Books U.S.A. v. New Christian Church*, 288 F. Supp. 2d 544 (S.D.N.Y. 2003) the court stated: "A select group cannot be created by an author's 'subjective test of cordiality.' Thus, when works are given or sold to persons deemed 'worthy' a select call is not created and the publication is not limited." *Id* at 556. Similar findings of general publication were reached in *Continental Casualty Company v. Beardsley*, 253 F.2d 702 (2d Cir 1958)(distribution of approximately 100 sets of forms lacking a notice), and *Brown v. Tabb*, 714 F.2d 1088 (11th Cir. 1983)(distribution of a jingle without limitation as to use). While your client may have subjectively believed that the purchasers of the Work were followers of the author does not establish the student purchasers as a select group. *See*, *contra Lish v. Harper's Magazine Foundation*, 807 F. Supp. 1090 (S.D.N.Y. 1992)(work distributed to small number of

students in classroom setting where students were informed of the confidential nature of the distribution).

You further assert that the section 405(a)(1) limitation on copyright divestiture applies because notice was omitted from a "relatively small" number of copies of the Work. 17 U.S.C. § 405(a)(1). According to Mr. Bismark, omission occurred on "less than 2,000 copies out of 8,000 total copies." *Declaration*, at 2. The Board disagrees with your characterization of these numbers as "relatively small." Cases interpreting this provision have typically found omissions of much smaller numbers to exceed to limitation in section 405(a)(1). The Court in *Donald Frederick Evans and Assoc. v. Continental Homes Inc.*, 785 F.2d 897 (11th Cir. 1986) found that 2,500 of 102,500 copies (2.4%) was more than a "relatively small number." Likewise, *Sunset Lamp Corp. v. Alsy Corp.*, 698 F. Supp. 1146 (S.D.N.Y. 1988) invalidated the copyright for banana leaf table lamps where between three percent and ten percent of the lamps reached consumers without copyright labels. *Wabash Publishing Company v. Flanagan*, 10 U.S.P.Q.2d 1714 (N.D. Ill. 1989) ruled that omission of notice on 710 out of 28,000 copies failed to satisfy the exception. The Board determines that the section 405(a)(1) limitation is not applicable to this case.

Finally, you argue that your client is entitled to registration under the rule of doubt as provided in *Compendium II*, § 108.07. *Letter*, at 5. It is clear that this principle applies only when the Office determines that there is "reasonable doubt" as to whether a court would find that this work was placed in the public domain due to the notice informality. There is no doubt in this instance, and the doctrine is not applicable.

III. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the work entitled: *Homosexuality The Identity Crisis*. This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: _____
William J. Roberts, Jr.
Copyright Office Review Board