



## Fashion & Apparel Law BLOG

For the latest on Fashion, Apparel and Beauty Law

# Fashion Apparel Law Blog

Posted at 3:37 PM on July 14, 2009 by Sheppard Mullin

## What Is the Jurisdictional Pre-Requisite for Copyright Litigation?: Do Denim v. Fried Denim

On June 17, 2009, Judge Laura Taylor Swain of the Southern District of New York dismissed the copyright claims of jeans maker Do Denim against rival manufacturer Fried Denim Inc., holding that the mere filing of the copyright applications, fees and deposits did not satisfy the jurisdictional requirement that a copyright be registered before a lawsuit is initiated. Do Denim v. Fried Denim, No. 08Civ.10947, 2009 U.S. Dist. LEXIS 51512, at \*7 (S.D.N.Y. June 17, 2009). This decision highlights the importance of copyright registration, as a jurisdictional prerequisite for plaintiffs hoping to protect their designs.

In 2005, Plaintiff Do Denim created two back pocket designs for its jeans -- the "Wings Design" and the "Dragon Design." Defendant Fried Denim allegedly copied these unique designs in the production and sale of its own jeans. Among other things, Plaintiff claimed that the Defendant's copying and use of the "Wings" and "Dragon" designs constituted copyright infringement.

The Copyright Act provides that "no civil action for infringement of the copyright in any United States work shall be instituted *until pre-registration or registration of the copyright claim has been made* in accordance with this title." 17 U.S.C. § 411(a) (emphasis added). Although Plaintiff had delivered the deposits, applications and fees required for copyright registration in both of its designs, the Copyright Office had yet to respond. Defendant Fried Denim argued that because of this lack of response, registration had not "been made" and therefore the Court lacked subject matter jurisdiction. Plaintiff replied that its delivery and filing of the applications, fees and deposits was in fact sufficient to constitute "registration" being "made," thereby conferring upon the Court the requisite subject matter jurisdiction.

This issue has been a divisive one in recent years. As Judge Laura Taylor Swain notes in her opinion that although the Second Circuit has yet to address the question of when a registration has "been made" for the purpose of copyright litigation, it is the subject of a current circuit split between the Tenth Circuit and the Eighth Circuit. The Tenth Circuit concluded in La Resolana Architects, PA v. Clay Realtors Angel Fire, 416 F.3d 1195 (10th Cir. 2005) that "only upon registration or refusal to register is a copyright holder entitled to sue for copyright infringement. The Eighth Circuit held in Action Tapes, Inc. v. Mattson, 462 F.3d 1010,1013 (8th Cir. 2006) that the copyright owner may sue for infringement once the owner has delivered the deposits, application, and fee required for registration. Judge Swain ultimately sided with the Tenth Circuit in her opinion, thereby dismissing Do Denim's copyright claims.

It is interesting to note that although the Second Circuit has not examined this area before, the Southern District of New York has. In City Merchandise v. Kings Overseas, No. 99 CV 10456, 2001 U.S. Dist. LEXIS 3176, at \*4 (S.D.N.Y. March 22, 2001), Judge Richard Conway Casey stated that "it is well settled that the court lacks subject matter jurisdiction unless the claimant has a registration or its registration has been refused." This holding, coupled with Judge Swain's recent opinion in Do Denim, clearly demonstrates where the Southern District of New York stands on the registration issue.

These decisions emphasize the importance of securing copyright registration before attempting to protect a copyright, especially in the Southern District of New York. Additionally, potential defendants in copyright matters should be mindful at the outset to ask the potential plaintiff for a valid copyright registration. As Do Denim v. Fried Denim demonstrates, this simple step may stop a premature copyright litigation dead in its tracks.

**Trackbacks (0)**

**Comments (0)**

**Attorney Advertising**