

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

3 TMTV, CORP.,

4 Plaintiff,

5 v.

6 MASS PRODUCTIONS, INC., et al.,

7 Defendants.
8

CIVIL NO. 00-1338 (RLA)

9
10 **ORDER DENYING PLAINTIFF'S REQUEST FOR ATTORNEY'S FEES**

11 Plaintiff has moved the court for an award of attorney's fees as
12 a prevailing party in these proceedings pursuant to the provisions of
13 17 U.S.C. § 505. Despite the egregious conduct displayed by attorney
14 John F. Nevares, defendants' counsel, as more fully described in
15 TMTV's motion requesting attorney's fees (docket No. 414) pp. 9-13,
16 the court is compelled to deny plaintiff's petition. The Copyright
17 Act at 17 U.S.C. § 412¹ specifically disallows attorney's fees when
18 the infringement at issue occurs subsequent to the initial
19 publication of the protected work and prior to its registration. See,

20 ¹ In pertinent part, § 412 reads:

21 In any action under this title... no award of
22 statutory damages or of attorney's fees, as
23 provided by sections 504 and 505, shall be made
24 for --

25

26 (2) any infringement of copyright commenced
after first publication of the work and before
the effective date of its registration, unless
such registration is made within three months
after the first publication of the work.

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3 Johnson v. Jones, 149 F.3d 494, 505 (6th Cir. 1998) (plaintiff unable
4 to recover attorney's fees under Copyright Act if "infringement
5 'commenced' before the copyright was registered"); William A. Graham
6 Co. v. Haughey, 430 F.Supp.2d 458, 473 (E.D.Pa. 2006) (if copyright
7 is not registered prior to commencement of the infringement,
8 attorney's fees may not be awarded "regardless of whether the
9 infringement continued after the date of registration"); Parfums
10 Givenchy, Inc. v. C & C Beauty Sales, Inc., 832 F.Supp. 1378, 1393
11 (C.D.Cal. 1993) ("section [412] bars a copyright owner from
12 recovering statutory damages or attorney's fees for copyright
13 infringement if two conditions are met: (1) the copyright was
14 registered more than three months after the work was first published,
15 and (2) the infringing activity commenced after the date of first
16 publication and before the effective date of registration of the
17 work.")

18 The limitations set by section 412 were purposely designed to
19 promote the timely registration of works by copyright owners. "The
20 legislative history of section 412 supports the construction that the
21 ordinary meaning of the statutory words suggests. Congress' evident
22 purpose was to induce those owning copyrightable works to register
23 them promptly." Singh v. Famous Overseas, Inc., 680 F.Supp. 533, 535
24 (E.D.N.Y. 1988). "Since under the new legislation copyright
25 registration would no longer be compulsory, Congress, deeming
26 registration useful and important, sought some practical means of
inducing it. The means chosen was to deny the 'extraordinary'
remedies of statutory damages and attorney's fees where registration
is not promptly made. The threat of such a denial would hardly
provide a significant motivation to register early if the owner of

2
3 the work could obtain those remedies for acts of infringement taking
4 place after a belated registration. *Id.* at 536. See also, Parfums
5 Givenchy, 832 F.Supp. at 1394-95.

6 "Under section 412, infringement 'commences' when the first act
7 of infringement in a series of on-going discrete infringements
8 occurs... The alleged acts of infringement that occurred after the
9 copyright was registered do not constitute new acts of infringement
10 but a continuation of the infringement that 'commenced' prior to
11 registration." Ez-Tixz, Inc. v. Hit-Tix, Inc., 919 F.Supp. 728, 736
12 (S.D.N.Y. 1996). "[T]he first act of infringement in a series of
13 ongoing separate infringements 'commences' one continuing
14 'infringement' under Section 412(2). A new or separate basis for the
15 award of statutory damages is created only where there is a
16 difference between pre - and post - registration infringing
17 activities." Parfums Givenchy, Inc. v. C & C Beauty Sales, Inc., 832
18 F.Supp. 1378, 1393 (C.D.Cal.,1993) (internal citations brackets and
19 quotation marks omitted).

20 Plaintiff began airing the protected sitcom subject to this
21 litigation in 1997 whereas defendants' infringing derivative program
22 was broadcasted commencing in March 2000. According to the evidence
23 on record, registration of the three seminal scripts for the
24 copyrighted program did not take place until June 2000 and November
25 2001.

26 Based on the foregoing, it is evident that copyright
registration occurred years after the protected program was first
aired and subsequent to the infringement. Thus, by operation of
section 412, plaintiff is not entitled to attorney's fees in this
action despite its prevailing party status.

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3 Accordingly, TMTV's request for attorney's fees (docket No. **414**)²
4 is **DENIED**.

5 IT IS SO ORDERED.

6 San Juan, Puerto Rico, this 27th day of March, 2009.

7
8 S/Raymond L. Acosta
RAYMOND L. ACOSTA
United States District Judge

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² See Opposition (docket No. **425**).