

No. 20-915

In the Supreme Court of the United States

UNICOLORS, INC.,
PETITIONER,

v.

H&M HENNES & MAURITZ, L.P.,

***ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT***

**BRIEF OF THE INTELLECTUAL PROPERTY LAW
ASSOCIATION OF CHICAGO AS AMICUS CURIAE
IN SUPPORT OF NO PARTY**

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INTEREST OF AMICUS CURIAE¹

The Intellectual Property Law Association of Chicago (“IPLAC”) respectfully requests that this Court reverse the United States Court of Appeals for the Ninth Circuit’s (“Ninth Circuit”) decision in *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 959 F.3d 1194 (9th Cir. 2020).²

Founded in 1884 in Chicago, Illinois, a principal forum for U.S. technological innovation and intellectual property litigation, IPLAC is the country’s oldest bar association devoted exclusively to intellectual property matters. IPLAC has as its governing objects, *inter alia*, to aid in the development of intellectual property laws, the administration of them, and the procedures of the U.S. Patent and Trademark Office, the U.S. Copyright Office, and the U.S. courts and other officers and tribunals charged with administration. IPLAC’s about 1,000 voluntary members include attorneys in private and corporate practices in the areas of copyrights, patents, trademarks, trade secrets, and the legal issues they present before federal courts throughout the United States, as well as before the U.S. Patent and

¹ Pursuant to Supreme Court Rule 37.6, no counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person or entity other than the amicus curiae, its members, or its counsel, made such a monetary contribution.

² Pursuant to Supreme Court Rule 37.3(a), Petitioner and Respondents have provided blanket consents to the filing of amicus briefs.

Trademark Office and the U.S. Copyright Office.³ IPLAC's members represent innovators and accused infringers in roughly equal measure and are split roughly equally between plaintiffs and defendants in litigation.

As part of its central objectives, IPLAC is dedicated to aiding in developing intellectual property law, especially in the federal courts.⁴

ISSUES PRESENTED

At issue in this case is basic statutory interpretation. Petitioner requests that this Court determine whether 17 U.S.C. § 411(b)(2) requires a district court to refer a question of copyright registration validity to the Register of Copyrights where the “inaccurate information” as defined by 17 U.S.C. § 411(b)(1) is not fraudulent or subject to a material error. In other words, Petitioner requests that this Court answer the question of whether 17 U.S.C. § 411(b)(2) requires a showing of fraud, before

³ In addition to the statement of footnote 1, after reasonable investigation, IPLAC believes that (a) no member of its Board or Amicus Committee who voted to prepare this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter; (b) no representative of any party to this litigation participated in the authorship of this brief; and (c) no one other than IPLAC, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

⁴ Although over 30 federal judges are honorary members of IPLAC, none were consulted on, or participated in, this brief.

a court is required to request the advice of the Register of Copyrights.

IPLAC submits that the text of 17 U.S.C. § 411(b) unambiguously answers this question: courts must request the advice of the Register of Copyrights only if (A) knowingly inaccurate information is included in the subject application, and (B) the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration. Because this implicates all elements of common law fraud, IPLAC respectfully submits that this Court should hold that (1) 17 U.S.C. § 411(b) unambiguously requires a showing of fraud, and (2) the Ninth Circuit impermissibly reduces the burden on a party challenging a copyright registration in direct contradiction of the statute.

SUMMARY OF ARGUMENT

The Court should reverse the Ninth Circuit's decision and find that 17 U.S.C. § 411(b)(2) requires a court to request the advice of the Register of Copyrights if, and only if, inaccurate information defined by 17 U.S.C. § 411(b)(1)(A) and (B) is alleged in an action for copyright infringement. The language in 17 U.S.C. § 411(b)(1) unambiguously establishes a fraud standard by requiring (a) a false statement of material fact (inaccurate information must be included in the application for copyright registration, and the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration), (b) made with knowledge that the statement was false (the inaccurate information was submitted to the Register of Copyrights with

knowledge that it was inaccurate), (c) made for the purpose of inducing a party to act (the inaccurate information was submitted to the Register of Copyrights to obtain copyright registration), (d) reliance on the false statement (the Register of Copyrights relied on the inaccurate information in issuing the registration), and (e) damages arising from reliance on the statement (a copyright registration issued on knowingly inaccurate information in the copyright application). This straightforward reading also implicates the pleading requirements of Federal Rules of Civil Procedure 8(c), which requires pleading fraud as an affirmative defense, and 9(b), which requires a party to plead with particularity the circumstances constituting fraud.

The Ninth Circuit's decision breaks from its own prior precedent and causes a circuit split that has the potential to result in improper forum shopping. Likewise, the broadening of the requirement to request the advice of the Register of Copyrights, absent meeting the requirements of the statute, is likely to substantially burden the Copyright Office.

ARGUMENT

I. The Plain Language of 17 U.S.C. § 411(b)(1) and (2) Requires an Allegation of Fraud on the Copyright Office before a Court is Required to Request Advice from the Register of Copyrights

Section 411 of the Copyright Act, entitled "Registration and civil infringement actions," provides the prerequisites for bringing a copyright infringement action in federal court, and states: ". . .

subject to the provisions of subsection (b), no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title . . .” 17 U.S.C. § 411(a).

Taken together, Sections 411(a) and 411(b) of the Copyright Act require registration or preregistration before bringing a copyright infringement action in federal court, and permit suit so long as the certificate of registration is not knowingly and materially inaccurate. 17 U.S.C. § 411(a) (“ . . . subject to the provisions of subsection (b), no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title . . .”); 17 U.S.C. § 411(b)(1) (“A certificate of registration satisfies the requirements of this section and section 412, regardless of whether the certificate contains any inaccurate information, unless-- (A) the inaccurate information was included on the application for copyright registration with knowledge that it was inaccurate; and (B) the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration.”).

To that end, § 411(b)(2) requires that, “[i]n any case in which inaccurate information described under paragraph (1) is alleged, the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.”

Because “[w]ords are to be given the meaning that proper grammar and usage would assign them,” A. Scalia & B. Garner, *Reading Law: The Interpretation of Legal Texts* 140 (2012), the “rules of grammar govern” statutory interpretation “unless they contradict legislative intent or purpose.” *Nielsen v. Preap*, 139 S. Ct. 954, 965 (2019). Both §§ 411(b)(1) and (2) are unambiguous and thus must be interpreted as written. *See also, Estate of Cowart v. Nicklos Drilling Co.*, 505 U.S. 469, 476 (1992) (“The controlling principle in this case is the basic and unexceptional rule that courts must give effect to the clear meaning of statutes as written.”); *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017). The court therefore “begin[s] and end[s] [its] inquiry with the text, giving each word its ‘ordinary, contemporary, common meaning.’” *Star Athletica*, 137 S. Ct. at 1010 (2017) (*citing Walters v. Metropolitan Ed. Enterprises, Inc.*, 519 U.S. 202, 207 (1997)) (internal quotation marks omitted). Under these maxims of statutory interpretation, the narrow category of inaccurate information that might invalidate a certificate of registration for purposes of bringing suit unambiguously requires a showing of fraud or material error amounting to fraud.

- A. On Its Face, Section 411(b)(1) Requires Fraud or Known Material Error Amounting to Fraud Before a Copyright Registration Certificate Fails to Satisfy the Registration Requirement Under §§ 411 and 412.

“[W]hen a statute covers an issue previously governed by the common law,” we must presume that

“Congress intended to retain the substance of the common law.” *Samantar v. Yousuf*, 560 U.S. 305, n. 13 (2010). “[W]hen the statute's language is plain, the sole function of the courts—at least where the disposition required by the text is not absurd—is to enforce it according to its terms.” *Lamie v. United States Tr.*, 540 U.S. 526, 534 (2004) (citation omitted).

The plain language of § 411(b)(1) mirrors the elements of common law fraud. *Roberts v. Gordy*, 877 F.3d 1024, 1030 (11th Cir. 2017) (“[I]n order to invalidate a registration, (1) the application must contain inaccuracies, (2) the inaccuracies must be material, and (3) the applicant must have the required scienter of intentional or purposeful concealment.”). Mere inaccuracy is insufficient. By the plain language of the statute, the registrant must have purposefully submitted the inaccurate information to the Copyright Office in the application with the knowledge that the information was inaccurate, and the Copyright Office would have refused the application if it had known of the inaccuracy.

A plain reading of § 411(b)(1) reveals only one logical meaning: regardless of the presence of inaccurate information in a certificate, unless all of the elements presented in §§ 411(b)(1)(A) and (B) are satisfied, all certificates of registration satisfy §§ 411 and 412. Those elements are: (1) inaccurate information; (2) included on the application for copyright registration; (3) with knowledge that the information was inaccurate; and (4) inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration. *See Cain v. Osman*, 286 F. App'x 934, 936 (7th Cir. 2008).

In contrast to the Ninth Circuit’s decision, this is consistent with the Copyright Office’s own understanding of the statute, as well as the lower courts and other circuits. *See* U.S. Copyright Office, Annual Report of the Register of Copyrights, at 8-9 (2009) (“The Prioritizing Resources and Organization for Intellectual Property Act (Pub. L. No. 110-403), also known as the PRO-IP Act . . . amends section 411 of the copyright law to codify the doctrine of fraud on the Copyright Office in the registration process.”); *Roberts*, 877 F.3d at 1029 (“This statute, which Congress modified in 2008, codifies the defense of Fraud on the Copyright Office.”); *Energy Intel. Grp., Inc. v. CHS McPherson Refinery, Inc.*, 304 F. Supp. 3d 1051, 1063 (D. Kan. 2018) (“[T]he Refinery must show that EIG intended to defraud the Copyright Office. This interpretation is supported by the plain language of the statute, which requires the inaccurate information to be “included on the application . . . with knowledge that it was inaccurate.”); *see also Archie MD, Inc. v. Elsevier, Inc.*, 261 F. Supp.3d 512, 520 (S.D.N.Y. 2017) (applicant must subjectively know of the inaccuracy when preparing the application). Indeed, finding invalidation is “not justified if the information was included inadvertently,” *Archie MD, Inc.*, 261 F. Supp. 3d at 520, or if the inaccuracy was not “made with the scienter necessary for invalidating a registration.” *Roberts*, 877 F.3d at 1030.

B. On Its Face, Section 411(b)(2) Requires a Party to Allege Inaccurate Information as Defined by § 411(b)(1) Before the Court Must Request Advice from The Register of Copyrights.

Section 411(b)(2) is a conditional statement. Conditional statements consider imagined or uncertain situations and the possible results of these situations. They are created through one dependent clause and one independent clause, whereby the dependent clause sets the condition for the happening of the independent clause. Most often this is reflected in if/then statements: If A, then B.

As applied here, § 411(b)(2)'s condition that "[i]n any case in which inaccurate information described under paragraph (1) is alleged," must be satisfied first. It is immediately recognizable as a condition because the following independent clause premises its existence on the condition: "the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration." This cannot stand alone because § 411(b)(2) provides instructions for determining whether a certificate of registration containing inaccuracies satisfies § 411. This is also self-evident because § 411(b)(1) unambiguously states that "[a] certificate of registration satisfies the requirements of this section and section 412, regardless of whether the certificate contains any inaccurate information." Without the specific instruction in § 411(b)(1), as a whole, regarding when a court should request the advice of the Register of Copyrights under § 411(b)(2), courts

would need to request the Register of Copyright's advice in every case.

Section 411(b)(2) contains two conditions that must be satisfied before a court is required to request the advice of the Register of Copyrights: (1) "inaccurate information described under paragraph" (1); and (2) "is alleged."

(1) "Inaccurate information under paragraph (1)"

In all but the most unusual situations, a single use of a statutory phrase must have a fixed meaning. *See Ratzlaf v. United States*, 510 U.S. 135, 143 (1994). The court therefore avoids interpretations that would "attribute different meanings to the same phrase. *Cochise Consultancy, Inc. v. United States ex rel. Hunt*, 139 S. Ct. 1507, 1512 (2019). This conclusion is plainly evident on the face of the statute.

Read in context with § 411(b)(2), the plain meaning of subsection 411(b)(1) is that inaccurate information that meets the condition in § 411(b)(2) must satisfy both §§ 411(b)(1)(A) and (B). No other reading makes sense as § 411(b)(1) explicitly protects registrations with inaccurate information unless both (A) and (B) are met. There is no need to request the advice of the Register of Copyrights if the inaccurate information did not affect both the validity of the registration under § 411 and the availability of remedies in § 412.

(2) "Is Alleged"

Section 411(b)(2) specifically provides that the court must request the advice of the Register of

Copyrights “[i]n any case in which inaccurate information [. . .] is alleged.” Logic follows that if inaccurate information is not alleged then the rest of the section does not apply. Black’s Law Dictionary provides two definitions for “alleged”:

1. Asserted to be true as described <alleged offenses>.
2. Accused but not yet tried <alleged murderer>

ALLEGED, Black's Law Dictionary (11th ed. 2019);

and one definition for “allege”:

To assert as true, esp. that someone has done something wrong, though no occasion for definitive proof has yet occurred

ALLEGE, Black's Law Dictionary (11th ed. 2019).

Thus, something is alleged when asserted but not yet proved. In the civil litigation context, in order to be read consistently with Federal Rules of Civil Procedure 8(c) and 9(b), allegations of fraud that serve to defeat a claim—such as a defense barring a copyright infringement action from proceeding under §§ 411 and 412 for fraud on the Copyright Office—are special affirmative defenses that are waived if not pled in a timely manner.

Because § 411(b) sets forth the standard for finding fraud on the Copyright Office, a party seeking to invoke § 411(b) must sufficiently plead the allegation of fraud to the level of particularity Fed. R. Civ. P. Rule 9(b) requires. Under Rule 9, “[i]n alleging fraud

or mistake, a party must state with particularity the circumstances constituting fraud or mistake.” This is consistent with § 411(b)’s specific construction.

In *DeliverMed Holdings, LLC v. Schaltenbrand*, 734 F.3d 616, 625 (7th Cir. 2013), the Seventh Circuit observed that § 411(b) serves a specific and narrow purpose that should not be arbitrarily invoked without specific allegations, stating “[g]iven its obvious potential for abuse, we must strongly caution both courts and litigants to be wary of using this device in the future.”

In line with the Copyright Office’s own interpretations and Fed. R. Civ. Pro. Rule 9(b), *DeliverMed Holdings, LLC* also sets forth guidance on how a court should approach a § 411(b) claim:

[C]ourts can demand that the party seeking invalidation first establish that the other preconditions to invalidity are satisfied before obtaining the Register’s advice on materiality. In other words, a litigant should demonstrate that (1) the registration application included inaccurate information; and (2) the registrant knowingly included the inaccuracy in his submission to the Copyright Office.

[. . .]

Once these requirements are met, a court may question the Register as to whether the inaccuracy would have resulted in the application’s refusal.

DeliverMed Holdings, LLC v. Schaltenbrand, 734 F.3d at 625.

The Seventh Circuit notes that this method has been endorsed by the Copyright Office, and this endorsement should be adopted by this Court. *See id.* (“Once these requirements are met, a court may question the Register as to whether the inaccuracy would have resulted in the application's refusal. Aside from minimizing the risk that parties would use this provision as a delay tactic, this approach has the added benefit of an endorsement from the Register.”); *See also* Response of the Register of Copyrights to Request Pursuant to 17 U.S.C. § 411(b)(2) at 10–11, *Olem Shoe Corp. v. Wash. Shoe Co.*, No. 1:09-cv-23494 (S.D.Fla. Oct. 14, 2010) (“[B]efore asking the Register whether she would have refused to register a copyright ... a court should feel free to determine whether there is in fact a misstatement of fact.”).

In contrast, the Ninth Circuit's current standard falls short of the requirements of both § 411 and Rule 9(b). The Ninth Circuit's delinking of “inaccurate” from “knowing” —a registration may be invalidated if the information is “inaccurate”, and the applicant merely knew that it submitted the information to the Copyright Office—does not align with either the text of the statute or Fed. R. Civ. P. Rule 9(b).

This Court should adopt the strict allegation standard set forth in *DeliverMed Holdings* to ensure consistent application of law among the federal courts. The Ninth Circuit's holding carves out exceptions to Fed. R. Civ. P. Rule 9(b) not present in the statute. If a party does not plead fraud or mistake under § 411(b)

according to the standard required by Rule 9(b), then the party has not properly alleged fraud or mistake.

Likewise, though not an issue directly before the Court, Fed. R. Civ. P. Rule 8(c)(1) expressly lists fraud as an affirmative defense, and invalidity has been recognized as an implied affirmative defense. See, e.g., *Cornwall v. U.S. Const. Mfg., Inc.*, 800 F.2d 250, 252 (Fed. Cir. 1986) (“Since any matter that does not controvert the opposing party's prima facie case is to be affirmatively pleaded, it appears that the defense of invalidity is an affirmative defense.”); *Deckers Outdoor Corp. v. Fortune Dynamic, Inc.*, No. CV 15-769 PSG (SSX), 2015 WL 12731929, at *6 (C.D. Cal. May 8, 2015) (“invalidity is an affirmative defense to a claim of design patent infringement that must be proven by Defendants by clear and convincing evidence”); *United States v. Krieger*, 773 F. Supp. 580, 582 (S.D.N.Y. 1991) (“failure to plead the affirmative defenses of illegality and invalidity constitutes failure to “place in issue” the validity of the personal guarantees.”); *Federal Deposit Ins. Corp. v. Central Air Control, Inc.*, D.Kan.1992, 785 F. Supp. 898 (guarantors of promissory notes were precluded from claiming invalidity based upon lack of consideration; defense had not been raised in answer). A party who wishes to rely on § 411(b) must properly and timely so plead, or else they have waived the right to contest the registration. The Ninth Circuit’s holding thus also creates an exemption to pleading affirmative defenses for fraud on the Copyright Office that directly contradicts the wording of Rule 8(c)(1).

II. The Ninth Circuit’s Holding Impermissibly Favors Parties Challenging a Copyright Registration

The Copyright “Act is expressly intended to create a federal law of uniform, nationwide application by broadly preempting state statutory and common-law copyright regulation.” *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 731 (1989).

The Ninth Circuit’s holding below undermines this intended uniformity by implicitly favoring parties challenging copyright registrations. This sets a standard lower than any other circuit, reads in conditions not present, omits express limitations, and creates a circuit split by breaking with its own prior precedent. *See, e.g., L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 853–54 (9th Cir. 2012); *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1145 (9th Cir. 2003) (stating that inaccuracies “do not invalidate a copyright ... [unless] the claimant intended to defraud the Copyright Office by making the misstatement”) (*quoting Urantia Found. v. Maaherra*, 114 F.3d 955, 963 (9th Cir. 1997)); *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 486–87 (9th Cir. 2000) (same), *overruled on other grounds by Skidmore v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020) (en banc); *Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 487 (9th Cir. 1985) (“Absent fraud, a misstatement or clerical error in the registration application ... will not invalidate the copyright”) (internal quotation marks omitted), *overruling on other grounds recognized by Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1448 (9th Cir. 1994). Challengers in the Ninth Circuit now

only need allege the presence of inaccurate information and the availability of facts at the time of the application to determine that it was inaccurate in order to make the submission “knowing.” The Ninth Circuit now becomes the ideal venue for any litigant accused of copyright infringement.

To ensure that courts follow the plain meaning of § 411(b) in a uniform way, IPLAC respectfully urges this Court to adopt the standard in *DeliverMed Holdings, LLC v. Schaltenbrand*, 734 F.3d 616, 625 (7th Cir. 2013) and other federal circuits.

CONCLUSION

For the foregoing reasons, IPLAC respectfully requests that the Court reverse the Ninth Circuit’s decision below.

Respectfully submitted,

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