

No. 20-915

IN THE
Supreme Court of the United States

UNICOLORS, INC.,

Petitioner,

v.

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

Respondent.

On Writ of Certiorari
to the United States Court of Appeals
for the Ninth Circuit

**BRIEF OF *AMICI CURIAE*
INTELLECTUAL PROPERTY LAW
PROFESSORS IN SUPPORT OF PETITIONER**

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INTEREST OF *AMICI CURIAE*

This brief *amici curiae* is submitted in support of petitioners pursuant to Rule 37 of the Rules of this Court.¹

Amici are professors of intellectual property law and scholars who have studied the history and development of copyright law in the United States. *Amici* have no financial interest in the parties to or the outcome of this case. *Amici* share a professional and academic interest in seeing copyright law develop in a manner that best promotes the creation and distribution of new works of authorship. To that end, *amici* present a summary of their understanding of the relevant history to aid the Court in its deliberations.

A full list of *amici* can be found in the Appendix.

SUMMARY OF ARGUMENT

In the 18th Century, U.S. copyright law was heavily dependent on the formalities of registration, deposit, and notice. Beginning with the 1909 Copyright Act, however, Congress slowly began to minimize the importance of formalities, including registration. Section 411(b) is best understood, in context, as the culmination of this century-long effort

¹ The parties have consented to the filing of this brief. No counsel for a party authored this brief in whole or in part, and no party or counsel for a party made a monetary contribution intended to fund its preparation or submission. No person, other than *amici* or their counsel, made a monetary contribution to the preparation or submission of this brief. *Amici's* university affiliations are for identification purposes only; *amici's* universities take no position on this case.

by Congress to minimize the importance of formalities.

The doctrine of fraud on the Copyright Office arose by negative implication from cases *upholding* copyright registrations where inadvertent or immaterial errors were made. The language of section 411(b) can reasonably be interpreted to codify the essential elements of the doctrine of fraud on the Copyright Office: intent (inferred from the applicant’s “knowledge”), falsity (“inaccurate information was included on the application”), and materiality (“would have caused the Register of Copyrights to refuse registration”).

“Publication” is a term of art in copyright law, resulting in a complex and sometimes contradictory body of case law. Uncertainty regarding the definition of “publication” matters, because an application for copyright registration requires the applicant to state whether and when a work has been “published.” In effect, however, the Ninth Circuit’s recent case law holds that an applicant with knowledge of the facts *should have known* that that the legal standard of “publication” was satisfied. This is a negligence standard in all but name, and it is inconsistent with the language of the statute (“with knowledge that it was inaccurate”).

In interpreting section 411(b), this Court should take care not to water down the standards of intent and materiality prescribed by Congress, lest it inadvertently re-create the kinds of problems encountered in the analogous context of fraud on the Patent Office (also known as “inequitable conduct”).

ARGUMENT

I. FOR THE PAST CENTURY, CONGRESS HAS MINIMIZED THE IMPORTANCE OF FORMALITIES, INCLUDING COPYRIGHT REGISTRATION, IN COPYRIGHT LAW.

The Berne Convention, the major international treaty concerning copyright protection, provides that “The enjoyment and the exercise of these rights shall not be subject to any formality.”² But before the 1909 Copyright Act, the formalities of registration, deposit, and notice were critical to the validity and existence of a federal statutory copyright in the United States. Beginning with the 1909 Act, in order to pave the way for eventual U.S. adherence to the Berne Convention, Congress slowly began to minimize the importance of formalities, including registration, in federal copyright law. Section 411(b) is best understood, in context, as the culmination of this century-long effort by Congress to minimize the importance of formalities.

A. 1790-1909: The Age of Formalities

To be “entitled to the benefit of this act,” the Copyright Act of 1790 required the author or owner to register the title of the work with the clerk of the district court *before* publication, to publish notice of

² Berne Convention for the Protection of Literary and Artistic Works, revised at Paris July 24, 1971, as amended Sept. 28, 1979, entered into force for the United States March 1, 1989, 1161 U.N.T.S. 3, S. Treaty Doc. No. 99-27 (1986) [hereinafter Berne Convention], art. 5(2), available at <https://wipolex.wipo.int/en/text/283698> (last visited August 1, 2021).

the registration for four weeks in one or more newspapers within two months of registration, and to deposit a copy of the published work with the Secretary of State within six months of publication.³ The 1802 amendment required that the author or owner, “before he shall be entitled to the benefit of the [1790] act, ... he shall, *in addition to* the requisites enjoined in the third and fourth sections of said act,” publish a notice of the registration on the work itself.⁴

In *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), this Court held that, according to the plain language of these acts, these conditions were mandatory.⁵ “[W]e are not at liberty to say they are unimportant and may be dispensed with,”⁶ it said, concluding that “every requisite in both acts is essential to the title.”⁷

The Copyright Act of 1831 likewise provided “[t]hat no person shall be entitled to the benefit of this act, unless he shall” register the title of the work with the clerk of the district court *before* publication, deposit a copy of the published work within three months of publication, and publish notice of the

³ Act of May 31, 1790, ch. 15, §3 (registration and notice), §4 (deposit), 1 Stat. 124, 125.

⁴ Act of April 29, 1802, ch. 36, §1, 2 Stat. 171 (emphasis added).

⁵ *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 663-64 (1834) (“No one can deny that when the legislature are about to vest an exclusive right in an author or an inventor, they have the power to prescribe the conditions on which such right shall be enjoyed, and that no one can avail himself of such right who does not substantially comply with the requisitions of the law.”).

⁶ *Id.* at 664.

⁷ *Id.* at 665.

copyright “in the several copies of each and every edition published during the term.”⁸

The 1870 Copyright Act carried these formalities forward. It provided “That no person shall be entitled to a copyright unless he shall, *before publication*,” register the title of the work with the Librarian of Congress, and deposit two copies of the work with the Librarian of Congress within ten days of publication.⁹ Publishing notice of the registration on the work itself was no longer a condition of owning a copyright; instead, it became a condition of “maintain[ing] an action for the infringement of his copyright.”¹⁰

B. 1909 to Today: Reducing the Role of Formalities

The 1909 Act considerably changed the role of copyright formalities. It provided that “any person ... may secure copyright for his work by publication thereof with the notice of copyright required by this Act.”¹¹ Registration of the copyright and deposit of two copies of the best published edition were no longer

⁸ Act of Feb. 3, 1831, ch. 16, §§4-5, 4 Stat. 436, 437.

⁹ Act of July 8, 1870, ch. 230, §90, 16 Stat. 198, 213.

¹⁰ Act of July 8, 1870, ch. 230, §97, 16 Stat. 198, 214.

¹¹ Act of Mar. 4, 1909, Pub. L. 60-349, ch. 320, §9, 35 Stat. 1075, 1077 (codified in 1947 at 17 U.S.C. §10, repealed 1978). Publication without proper notice placed the work in the public domain. *National Comics Pubs., Inc. v. Fawcett Pubs.*, 191 F.2d 594, 598 (2d Cir. 1951) (“It is of course true that the publication of a copyrightable ‘work’ puts that ‘work’ into the public domain except so far as it may be protected by [statutory] copyright.”).

required to obtain a copyright.¹² Congress, however, continued to require registration and deposit as a condition of “maintain[ing]” an infringement action.¹³

In 1939, this Court confirmed that registration and deposit were no longer mandatory conditions to obtain a copyright (even though they were required to file an infringement action). In *Washingtonian Pub. Co. v. Pearson*, 306 U.S. 30 (1939), the work at issue was published with proper notice in December 1931, but registration and deposit did not occur until February 1933, fourteen months later, and six months after the infringement commenced. The Court first remarked on the general intent of the statute with regard to formalities:

The Act of 1909 is a complete revision of the copyright laws, different from the earlier Act both in scheme and language. It introduced many changes and was intended definitely to grant valuable, enforceable rights to authors, publishers, etc., *without burdensome requirements*

Under the old Act deposit of the work was essential to the existence of copyright. This requirement caused serious difficulties and unfortunate losses.... It is no longer necessary to deposit anything to secure a copyright of a

¹² There was one exception: registration was still required to secure a federal statutory copyright for an unpublished work. Act of Mar. 4, 1909, Pub. L. 60-349, ch. 320, §11, 35 Stat. 1075, 1078 (codified in 1947 at 17 U.S.C. §12, repealed 1978).

¹³ Act of Mar. 4, 1909, Pub. L. 60-349, ch. 320, §12, 35 Stat. 1075, 1078 (codified in 1947 at 17 U.S.C. §13, repealed 1978).

published work, but only to publish with the notice of copyright.

Id. at 36-37 (emphasis added, internal quote omitted).

In response to the argument that the copyright owner failed to deposit two copies “promptly” after publication, as required by the statute, the Court said:

Congress intended that prompt deposit when deemed necessary should be enforced ... by the register; also that while no action can be maintained before copies are actually deposited, mere delay will not destroy the right to sue. Such forfeitures are never to be inferred from doubtful language.

Id. at 42.

The 1976 Copyright Act came into effect on January 1, 1978.¹⁴ Under the 1976 Act, federal copyright protection “subsists” automatically in any “original work of authorship” as soon as it is “fixed in any tangible medium of expression.”¹⁵ As enacted, proper notice was still required when a work was “published,”¹⁶ but the Act allowed omission of such notice to be “cured” in some circumstances.¹⁷ The Act

¹⁴ Copyright Act of 1976, Pub. L. 94-553, § 102, 90 Stat. 2541, 2598.

¹⁵ 17 U.S.C. §102(a); *see also* 17 U.S.C. §302(a) (“Copyright in a work created on or after January 1, 1978, subsists from its creation ...”); 17 U.S.C. §101 (“A work is ‘created’ when it is fixed in a copy or phonorecord for the first time”).

¹⁶ 17 U.S.C. §401(a), as enacted in Copyright Act of 1976, Pub. L. 94-553, §101, 90 Stat. 2541, 2576.

¹⁷ 17 U.S.C. §405(a), as enacted in Copyright Act of 1976, Pub. L. 94-553, § 101, 90 Stat. 2541, 2578.

expressly states that, like deposit, “registration is not a condition of copyright protection.”¹⁸ As enacted, however, registration was still a prerequisite to filing an infringement suit.¹⁹

When the United States adhered to the Berne Convention, effective March 1, 1989,²⁰ it eliminated the requirement that proper notice be placed on published copies.²¹ For “Berne Convention works whose country of origin is not the United States,” it eliminated the prerequisite that a work be registered before filing an infringement action.²² A decade later, Congress further limited the registration prerequisite to “United States works” only.²³

Finally, after the United States signed the TRIPS Agreement,²⁴ it restored the copyright in works of

¹⁸ 17 U.S.C. §408(a); *see also* 17 U.S.C. §407(a) (deposit).

¹⁹ 17 U.S.C. §411(a), as enacted in Copyright Act of 1976, Pub. L. 94-553, § 101, 90 Stat. 2541, 2583 (“Subject to the provisions of subsection (b), no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title.”).

²⁰ *See* Berne Convention Implementation Act of 1988, Pub. L. 100-568, §13(a), 102 Stat. 2853, 2861; 53 Fed. Reg. 48748 (Dec. 2, 1988).

²¹ *See* Berne Convention Implementation Act of 1988, Pub. L. 100-568, §7(a), 102 Stat. 2853, 2857, *codified at* 17 U.S.C. §401(a).

²² *See* Berne Convention Implementation Act of 1988, Pub. L. 100-568, §7(a), 102 Stat. 2853, 2857, *codified at* 17 U.S.C. §411(a).

²³ 17 U.S.C. §411(a) (current version).

²⁴ Agreement on Trade Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex C, 1869 U.N.T.S. 299 (1994).

foreign origin that had previously been forfeited for failure to comply with copyright formalities.²⁵

Thus, by the time Congress enacted the provision at issue here, it had slowly but steadily reduced the importance of copyright formalities over the course of the 20th Century. This Court has followed Congress' lead, holding that failure to comply with §411(a)'s registration precondition does not deprive a federal court of subject-matter jurisdiction. *Reed Elsevier, Inc. v. Munchnick*, 559 U.S. 154 (2010). Congress continues to encourage prompt registration, through a combination of carrots (presumption of validity,²⁶ and statutory damages and attorneys' fees²⁷) and sticks (registration is required before filing suit, for United States works only²⁸). At the same time, Congress has made it absolutely clear that "registration is *not* a condition of copyright protection."²⁹ It would be inconsistent with this express statutory command to bar an infringement action for an inadvertent mistake in the registration process.

²⁵ 17 U.S.C. §104A.

²⁶ 17 U.S.C. §410(c).

²⁷ 17 U.S.C. §412.

²⁸ 17 U.S.C. §411(a).

²⁹ 17 U.S.C. §408(a) (emphasis added).

II. SECTION 411(b) WAS INTENDED TO MAKE IT EASIER FOR COPYRIGHT OWNERS TO ENFORCE THEIR COPYRIGHTS, BY MAKING IT HARDER FOR DEFENDANTS TO INVALIDATE REGISTRATIONS.

The doctrine of fraud on the Copyright Office arose by negative implication from cases *upholding* copyright registrations where inadvertent or immaterial errors were made. In *Advisers, Inc. v. Wiesen-Hart, Inc.*, 238 F.2d 706 (6th Cir. 1956), for example, the court upheld a registration that listed a publication date of December 9, 1953 (the date of distribution to retail customers), when the book had actually been published in August 1953 (when the books were shipped to distributors). The court said: “an innocent misstatement, or a clerical error, in the affidavit and certificate of registration, *unaccompanied by fraud* or intent to extend the statutory period of copyright protection, does not invalidate the copyright, nor is it thereby rendered incapable of supporting an infringement action.” *Id.* at 708 (emphasis added). *Accord*, *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 828 (11th Cir. 1982); *Eckes v. Card Prices Update*, 736 F.2d 859, 862 (2d Cir. 1984); *Masquerade Novelty, Inc. v. Unique Industries, Inc.*, 912 F.2d 663, 668 n.5 (3d Cir. 1990).

The converse proposition, that a registration may be invalidated by fraud on the Copyright Office, arose from the logical inference that an intent to defraud can be inferred from the *intentional* submission of false and material information on the application for registration. In *Russ Berrie & Co. v. Jerry Elsner Co.*,

482 F. Supp. 980 (S.D.N.Y. 1980), for example, the plaintiff had made only trivial changes to the design of a stuffed gorilla that was in the public domain. The court criticized the plaintiff for intentionally failing to disclose this material information in its application: “The knowing failure to advise the Copyright Office of facts which might have occasioned a rejection of the application constitute[s] reason for holding the registration invalid and thus incapable of supporting an infringement action.” *Id.* at 988. *Accord, Eckes*, 736 F.2d at 861-62; *Masquerade*, 912 F.3d at 667.

The statutory provision before the Court, 17 U.S.C. § 411(b), was added to the Copyright Act in 2008 as part of “Prioritizing Resources and Organization for Intellectual Property Act” (the PRO-IP Act).³⁰ According to the legislative history, § 411(b) was one of a “a number of changes to copyright and trademark law that will *enhance* the ability of intellectual property rights holders to enforce their rights.” H.R. Rep. No. 110-617, at 23 (2008) (emphasis added). Section 411(b) was intended to deter claims “in litigation that a mistake in the registration documents, such as checking the wrong box on the registration form, renders a registration invalid and thus forecloses the availability of statutory damages.” *Id.* at 24.

Supporting this point, the House Report (*id.* at 24 n.15) cited *In re Napster, Inc. Copyright Litig.*, 191 F. Supp. 2d 1087, 1099 (N.D. Cal. 2002), in which Napster argued that record companies had improperly claimed some sound recordings as works-made-for-hire in its registrations, thereby

³⁰ Act of Oct. 13, 2008, Pub. L. 110-403, §1(a), 122 Stat. 4256.

invalidating the presumption of ownership for those sound recordings. The argument was rejected:

It is a well-established principle that errors in plaintiffs' copyright certificates do not automatically invalidate the certificates and their corresponding presumption of ownership. *See* 17 U.S.C. § 408(d) (allowing the filing of a supplementary registration to correct any errors)... "Absent intent to defraud and prejudice, inaccuracies in copyright registration do not bar actions for infringement." *Harris v. Emus Records Corp.*, 734 F.2d 1329, 1335 (9th Cir. 1984)... Unless Napster can show that plaintiffs defrauded the Copyright Office in a manner that prejudiced Napster, the alleged inconsistencies in plaintiffs' certificates do not rebut the presumption of ownership.

Id. at 1099-1100.

At the time of §411(b)'s passage, the Copyright Office, which had worked closely with the House and Senate Committees on the legislation, stated that the purpose of § 411(b) was "to codify the doctrine of fraud on the Copyright Office in the registration process." U.S. Copyright Office, Annual Report of the Register of Copyrights, Fiscal Year Ending September 30, 2008, at 12–13 (2008), at <https://www.copyright.gov/reports/annual/2008/ar2008.pdf>; U.S. Copyright Office, NewsNet Issue 354, Oct. 20, 2008, at <https://www.copyright.gov/newsnet/2008/354.html>.

The language of section 411(b) can reasonably be interpreted to codify the judicially-created doctrine of fraud on the Copyright Office. The essential elements of the doctrine are the intentional submission of false

and material information on the application for registration. *See Original Appalachian Artworks*, 684 F.2d at 828 (“While these cases establish that omissions or misrepresentations in a copyright application can render the registration invalid, a common element among them has been intentional or purposeful concealment of relevant information.”). Section 411(b) likewise requires intent (inferred from the applicant’s “knowledge”), falsity (“inaccurate information was included on the application”), and materiality (“would have caused the Register of Copyrights to refuse registration”).

There is absolutely nothing indicating that Congress intended the wording of § 411(b) to modify the court-developed doctrine *that the legislative history cites with approval*,³¹ or to make it easier to invalidate registrations. Indeed, if anything, the language of section 411(b) can be interpreted to make it *harder* to invalidate erroneous copyright registrations, in two respects. First, some courts had interpreted “material” to mean information that was merely “relevant” or that “*might* have occasioned a rejection of the application,” *Russ Berrie & Co.*, 482 F.

³¹ In at least two other instances, this Court has accepted statements in the legislative history indicating that Congress intended to codify judicially-created doctrines, despite a change in statutory language. *See Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 355 (1991) (change from “all the writings of an author” in the 1909 Act to “original works of authorship” in the 1976 Act was merely intended “to maintain the *established standards* of originality”; emphasis added by the Court); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994) (newly codified §107 was intended “to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way”) (quoting H.R. Rep. No. 94-1476, at 66 (1976)).

Supp. At 988 (emphasis added); whereas section 411(b) requires false information that “*would* have caused the Register of Copyrights to refuse registration.” 17 U.S.C. § 411(b) (emphasis added). Second, section 411(b)(2) directs courts to consult the Register of Copyrights on the issue of materiality. (See Part IV.B., below.)

III. AN APPLICANT FOR REGISTRATION CANNOT HAVE “KNOWLEDGE” THAT INFORMATION IS INACCURATE WHEN IT DEPENDS ON LAW THAT IS UNSETTLED, CONFLICTING, AND CONFUSING.

A. Publication is a Term of Art in Copyright Law, So Mistakes About Whether and When a Work Has Been “Published” Are Common.

“Under the 1909 Act, an unpublished work was protected by state common law copyright from the moment of its creation until it was either published or until it received protection under the federal copyright scheme.” *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1165 (9th Cir. 1996); *see also Caliga v. Inter Ocean Newspaper Co.*, 215 U.S. 182, 188 (1909) (“At common law, the exclusive right to copy existed in the author until he permitted a general publication.”). “If the [work] was then published in compliance with the Act, including notice of copyright, it received statutory copyright protection; if it was published without notice, the common law copyright was forfeited, and the material entered the public domain.” *Kepner-Tregoe, Inc. v. Vroom*, 186 F.3d 283, 287-88 (2d Cir. 1999). *See also Twin Books*, 83 F.3d at 1165; *cf. Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 347 (1908) (“when

a work is published in print, the owner's common-law rights are lost; and, unless the publication be in accordance with the requirements of the statute, the statutory right is not secured.") (internal quotes and citation omitted). "Publication," therefore, marked the dividing line between state and federal copyright protection, and publication with notice marked the dividing line between federal statutory copyright protection and the public domain.

The 1909 Act defined "date of publication," as "the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority."³² But because the consequences of publication without proper notice were so drastic, courts held that this definition "was an enactment to fix the date from which the copyright term should begin to run, and not a general definition of what constituted publication." *Cardinal Film Corp. v. Beck*, 248 F. 368, 368 (S.D.N.Y. 1918); *accord, Patterson v. Century Productions*, 93 F.2d 489, 492 (2d Cir. 1937); *Hirshon v. United Artists Corp.*, 243 F.2d 640, 644 (D.C. Cir. 1957). "What constitutes publication ... must be determined, therefore, in each case by considering its facts in the light of the policy of the Copyright Act." *Hirshon*, 243 F.2d at 644.

As a result, a complex and sometimes contradictory body of case law arose around the definition of "publication." See HOWARD B. ABRAMS & TYLER T. OCHOA, *THE LAW OF COPYRIGHT* §8:14 (West 2020 ed.) ("While a number of broad generalities emerge from a

³² Act of Mar. 4, 1909, Pub. L. 60-349, ch. 320, §62, 35 Stat. 1075, 1087-88 (codified in 1947 at 17 U.S.C. §26, repealed 1978).

review of the cases concerning publication, an exception or contradiction of most if not all of the generalities about publication can also be found.”); WILLIAM F. PATRY, PATRY ON COPYRIGHT §6:30 (West 2021 ed.):

Because of the draconian penalty of loss of all protection—federal and state—for publication without a proper notice, courts deciding cases under the pre-1976 Act statutes turned “publication” into a technical construct not always coterminous with the general notion of “making public,” or even with the statutory notion of divestment of common-law rights.

The definition of “publication” in the 1976 Act is essentially a codification of some of the complex case law that arose under the 1909 Act. *See* 17 U.S.C. § 101 (definition of “publication”). Nonetheless, “many interpretive puzzles remain. The cases themselves suggest that the meaning of the term is often unpredictable, and that outcomes may be driven more by the desire to achieve certain results than by conformity with settled principles.” Thomas F. Cotter, *Toward a Functional Definition of Publication in Copyright Law*, 92 Minn. L. Rev. 1724, 1770-71 (2008). *See generally* ABRAMS & OCHOA, §§8:25-8:37 (surveying case law on “publication” under the 1976 Act); PATRY ON COPYRIGHT §§6:47-6:55.40 (same).

B. The Ninth Circuit’s Standard for an Applicant’s “Knowledge” Is Really a Negligence Standard in Disguise.

Uncertainty regarding the definition of “publication” matters in this case because an application for copyright registration requires the applicant to state

whether or not the work has been “published,” and to list the date and nation of first publication. As the U.S. Copyright Office explains:

The applicant—not the U.S. Copyright Office—must determine whether a work is published or unpublished.... Determining whether a work is published or unpublished should be based on U.S. copyright law under Title 17.... The Office will not give specific legal advice on whether a particular work has or has not been published. However, if an assertion is clearly contrary to facts known by the Office, a claim may be questioned, or in certain situations, refused.

U.S. COPYRIGHT OFFICE, COMPENDIUM OF COPYRIGHT OFFICE PRACTICES §1904.1 (rev. 3d ed. 2021).³³

Because of the many uncertainties concerning the definition of publication, determining whether, when and where a work was first “published” is a daunting task, fraught with potential hazards, even for an experienced attorney. For a layperson, confronting this issue for the first time, the possibility of an erroneous interpretation of the law is exponentially larger. Yet under the Ninth Circuit’s decisions in this case and in *Gold Value*, a mistake concerning the law is *categorically irrelevant* to whether “inaccurate information” has been included on the application. This is an absurd interpretation of section 411(b) that

³³ Chapter 19 of the Compendium (14 pages) “provides a definition and discussion of publication for works created or first published on or after January 1, 1978,” *id.* at §1901, and the words “publish,” “published” or “publication” appear 4663 times in the Compendium (in only 1300 pages).

will lead to innumerable invalidations of registrations.

In *Gold Value Int’l Textile, Inc. v. Sanctuary Clothing, LLC*, 925 F.3d 1140 (9th Cir. 2019), plaintiff Fiesta Fabrics registered a collection of 33 “unpublished” fabric designs. Before the application date, however, Fiesta had sold samples (190 yards) of one of the designs to “a limited group of existing and potential customers for the limited purpose of securing full production contracts for hundreds or thousands of yards of fabric.” *Id.* at 1142. Fiesta’s president “testified that he knew that sample fabric bearing the 1461 Design had been sold prior to approving the copyright registration application, but that he did not consider sampling to be publication.” *Id.* at 1142-43. After the district court invalidated its first registration, Fiesta filed a second application for the design as a “published” work. The district court denied leave to amend to add the new registration.

On appeal, Fiesta argued that “any publication of the 1461 Design was a ‘limited’ distribution for promotional purposes and did not constitute legal publication under the limited publication doctrine.” *Id.* at 1145.³⁴ Because Fiesta’s second application was inconsistent with its first application, however, the Ninth Circuit held that “Fiesta *admitted* that this allegedly limited distribution constituted legal publication,” *id.* at 1146 (emphasis added), despite the

³⁴ See *Academy of Motion Picture Arts & Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1452 (9th Cir. 1991) (“[A] publication is ‘limited’ ... when tangible copies of the work are distributed both (1) to a ‘definitely selected group,’ and (2) for a limited purpose, without the right of further reproduction, distribution or sale.”).

fact that Fiesta *submitted the second application only because the district court had invalidated the first one*. Heads I win, tails you lose.

With regard to intent, the Ninth Circuit held that “knowledge” of the legal definition of publication was irrelevant: “Although Fiesta asserts that it did not believe that such sales constituted publication as a matter of law, ... the knowledge requisite to knowing violation of a statute is factual knowledge as distinguished from knowledge of the law.” *Id.* at 1147 (internal citation omitted). Because “Fiesta was admittedly aware of the *facts* regarding its fabric sales,” the Ninth Circuit held that its application “cannot be characterized as an inadvertent or good faith mistake.” *Id.* at 1148 (emphasis added).

In effect, the Ninth Circuit’s standard holds that an applicant with knowledge of the facts *should have known* that the legal standard of “publication” was satisfied. This is a negligence standard in all but name, and it is completely inconsistent with Congress’ direction that only intentional misrepresentations (“with *knowledge* that it was inaccurate”) should invalidate a registration.

C. The Ninth Circuit Found “Knowledge” in This Case, Despite Suggesting That the Legal Issue was a Case of First Impression, and Without Finding Clear Error.

The case before the Court involves both the legal definition of “publication” and a Copyright Office regulation that permits “copyrightable elements that are *otherwise recognizable as self-contained works*” to be registered as one work in one application, if they

“are included in a single unit of publication.” 37 C.F.R. § 202.3(b)(4)(i)(A) (2011) (emphasis added).³⁵

The Ninth Circuit acknowledged that “this court has *never previously addressed* what it means to publish multiple works as a ‘single unit.’” *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 959 F.3d 1194, 1199 (9th Cir. 2020), *cert. granted*, No. 20-915 (U.S. June 1, 2021) (emphasis added). It also indicated that the only known precedent outside the circuit on this question was neither relevant nor helpful. *Id.* at n.2. In fact, however, there were numerous precedents on the issue, all of them suggesting a lenient interpretation of “single unit of publication,” but depending on different criteria. *See Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 204-06 (3d Cir. 1995) (works need not be related, but were included in a single catalog); *Donald Bruce & Co. v. B.H. Multi Com Corp.*, 964 F. Supp. 265, 268-69 (N.D. Ill. 1997) (disputed fact issue whether rings were sold as a line of jewelry, but finding inadvertent error was not material); *Benham Jewelry Corp. v. Aron Basha Corp.*, 45 U.S.P.Q.2d 1078 (S.D.N.Y. 1997) (12 related pendants sold separately but marketed as a single line); *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 489 F. Supp. 174, 180 (N.D. Ga. 1980) (dolls sold separately but marketed as a single line), *aff’d*, 684 F.2d 821, 828 (11th Cir. 1982) (different registration error was inadvertent). *But see Tabra, Inc. v. Treasures de Paradise Designs, Inc.*, 15 U.S.P.Q.2d 1234 (N.D. Cal. 1990) (denying preliminary injunction on multiple grounds, including single registration of “unrelated” jewelry designs).

³⁵ The same language is now codified, with only minor changes, at 37 C.F.R. § 202.3(b)(4) (2021).

The point, of course, is *not* that the Petitioner in this case was aware of or should have been aware of these cases. The point is that even an experienced attorney who found these cases might easily be uncertain whether a group of works were or were not included in a “single unit of publication.” Petitioner’s president, who lacked any legal training, certainly cannot be said to have stated that they were “*with knowledge that*” his opinion was “inaccurate.”³⁶

IV. BOTH KNOWLEDGE AND MATERIALITY SHOULD BE INTERPRETED LENIENTLY TO AVOID THE CHAOS OF INVALIDATING THOUSANDS OF REGISTRATIONS.

A. The Analogous Patent Doctrine of Inequitable Conduct Shows What Can Happen If Courts Make It Too Easy To Challenge Registrations.

The doctrine of fraud on the Copyright Office can be analogized to the doctrine of fraud on the Patent Office, also known as the doctrine of inequitable

³⁶ Indeed, the trial court found “*no evidence* indicating that Unicolors *knew* the 400 Registration contained false information.” *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 2018 WL 10307045, at *4 (C.D. Cal. Aug. 1, 2018) (emphasis added). The Ninth Circuit’s finding to the contrary was *not* based on any finding of clear error, but solely on testimony as to Unicolors’ *general business practices*: “Unicolors *would have* placed non-confined designs in [its] showroom, making them ‘available for public viewing’ and purchase. Confined designs, on the other hand, *would not be* placed in [its] showroom for the public at large to view.” 959 F.3d. at 1196 (emphasis added). Note the conditional tense of the testimony that the appellate panel relied on.

conduct. “Inequitable conduct is an equitable defense to patent infringement that, if proved, bars enforcement of a patent.” *Therasense, Inc. v. Becton-Dickinson & Co.*, 649 F.3d 1276, 1285 (Fed. Cir. 2011) (en banc). As the Federal Circuit explained, “[t]his judge-made doctrine evolved from a trio of Supreme Court cases that applied the doctrine of unclean hands to dismiss patent cases involving egregious misconduct.” *Id.* “Each of these unclean hands cases before the Supreme Court dealt with particularly egregious misconduct, including perjury, the manufacture of false evidence, and the suppression of evidence.” *Id.* at 1287. See *Keystone Driller Co. v. General Excavator Co.*, 290 U.S. 240, 243 (1933); *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238, 240, 245 (1944), *overruled on other grounds by Standard Oil Co. v. United States*, 429 U.S. 17 (1976); and *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806, 816-20 (1945).

As the doctrine evolved, “inequitable conduct came to require a finding of both intent to deceive and materiality.” *Therasense*, 649 F.3d at 1287. Over time, however, the Federal Circuit began to water these elements down. As the court in *Therasense* explained:

In the past, this court has espoused low standards for meeting the intent requirement, finding it satisfied based on gross negligence or even negligence.... This court has also previously adopted a broad view of materiality.... [See] 37 C.F.R. § 1.56 (1977) (a reference is material if “there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to

issue as a patent”). Further weakening the showing needed to establish inequitable conduct, this court ... [began to hold] patents unenforceable based on a reduced showing of intent if the record contained a strong showing of materiality, and vice versa. In effect, this change conflated, and diluted, the standards for both intent and materiality.

Id. at 1287-88.

Although the Federal Circuit “embraced these reduced standards for intent and materiality” with the best of intentions, “to foster full disclosure to the PTO,” *id.* at 1288, the *Therasense* opinion vividly describes what happened next: “Left unfettered, the inequitable conduct doctrine ... plagued not only the courts but also the entire patent system.” *Id.* at 1289. “Because the doctrine focuses on the moral turpitude of the patentee with ruinous consequences for the reputation of his patent attorney, it discourages settlement and deflects attention from the merits of validity and infringement issues.... Inequitable conduct disputes also increase the complexity, duration and cost of patent infringement litigation that is already notorious for its complexity and high cost.” *Id.* at 1288. Summarizing these and additional negative consequences, the Federal Circuit concluded:

While honesty at the PTO is essential, low standards for intent and materiality have inadvertently led to many unintended consequences, among them, increased adjudication cost and complexity, reduced likelihood of settlement, burdened courts, strained PTO resources, increased PTO backlog, and impaired patent quality. This court now tightens the

standards for finding both intent and materiality *in order to redirect a doctrine that has been overused to the detriment of the public.*

Id. at 1290 (emphasis added).

There are, of course, significant differences between the patent and copyright systems. In particular, the system of prior art search, substantive examination, and grant in the Patent Office results in a presumption of validity that can only be overcome by clear and convincing evidence. *Microsoft Corp. v. i4i, L.P.*, 564 U.S. 91, 95 (2011). By contrast, the Copyright Office merely registers a “copyright claim,” 17 U.S.C. § 408(a), and it examines applications only “to determine whether they satisfy the statutory requirements for registrability, including copyrightability, and otherwise comply with the Office’s regulations.” U.S. COPYRIGHT OFFICE, COMPENDIUM OF COPYRIGHT OFFICE PRACTICES §101.3(A) (rev. 3d ed. 2021). Thus, the presumption of validity for copyrights in 17 U.S.C. § 410(c) is only a “bursting bubble” presumption that orders the burdens of producing evidence. Fed. R. Evid. 301; *Estate of Hogarth v. Edgar Rice Burroughs, Inc.*, 342 F.3d 149, 166-67 (2d Cir. 2003); *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1217-18 (9th Cir. 1997). Nonetheless, in interpreting section 411(b), this Court should take care not to water down the standards of intent and materiality prescribed by Congress, lest it inadvertently re-create (on a lesser scale) the kinds of problems encountered in the analogous context of fraud on the Patent Office.

B. Materiality is Relevant Only After a Court Finds the Applicant Submitted Inaccurate Information With Knowledge or Intent.

17 U.S.C. § 411(b)(2) provides: “In any case in which inaccurate information ... 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.” Although not stated in the legislative history, this subsection may have been inspired by the embarrassing episode in *Whimsicality, Inc. v. Rubie’s Costume Co.*, 891 F.2d 452 (2d Cir. 1989), in which the Second Circuit erroneously invalidated a registration based on “fraud on the Copyright Office” because of its misunderstanding of Copyright Office procedures.

In registering six of its animal costumes, plaintiff *Whimsicality* described the works as “soft sculptures” rather than as “costumes.” 891 F.2d at 454. The district court held the costumes were not protected by copyright, because they did not contain any “pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” 17 U.S.C. § 101 (definition of “pictorial, graphic, and sculptural works”); *see generally Star Athletica, LLC v. Varsity Brands, Inc.*, 580 U.S. ___, 137 S. Ct. 1002 (2017). The Second Circuit affirmed on the alternative ground that *Whimsicality* had committed “fraud on the Copyright Office,” because “[i]t was aware ... that an application for costumes as such would be rejected.” 891 F.2d at 455-56.

On remand, however, the plaintiff submitted an affidavit from Copyright Office Examiner Frank

Vitalos, Section Head of the Visual Arts Section of the United States Copyright Office. In it, he explained “that the use of the term ‘soft sculpture’ on the registration applications was within the practice routinely allowed by the Copyright Office, and that he decided to issue the registrations after finding separable artistic content in the works.” *Whimsicality, Inc. v. Rubie’s Costume Co.*, 836 F. Supp. 112, 115 (S.D.N.Y. 1993).³⁷ Vitalos further declared that the “description of the works as soft sculpture did not and does not constitute a representation to the Copyright Office that the works in question have no useful function,” *id.*, and that “Whimsicality did not misrepresent the nature of the works in question to the Copyright Office.” *Id.* at 118. Based on this new evidence, the district court granted relief from the judgment under Federal Rule of Civil Procedure 60(b)(2). It found that “Whimsicality’s [alleged] ‘bad faith’ did not involve affirmative misstatements or the withholding of material information from the copyright examiner,” and that “no reasonable Copyright Office examiner would have been misled by the Whimsicality applications and accompanying deposits.” 836 F. Supp. at 120. Consequently, the court held that “there was no fraud on the copyright office in connection with the registration of the six Whimsicality costumes in question.” *Id.* at 120-21.

³⁷ See also U.S. COPYRIGHT OFFICE, COMPENDIUM OF COPYRIGHT OFFICE PRACTICES §808.11(D) (rev. 3d ed. 2021) (explaining that where the applicant claims there are separable artistic “features” in costumes, “the authorship should be specifically described, such as ... ‘soft sculpture’ (in the case of a puppet or animal costume).”).

Although input from the Copyright Office is valuable and necessary, courts have nonetheless recognized that the §411(b) mechanism has “obvious potential for abuse.” *DeliverMed Holdings, LLC v. Schaltenbrand*, 734 F.3d 616, 625 (7th Cir. 2013). See also *Energy Intelligence Group v. CHS McPherson Refinery, Inc.*, 304 F. Supp. 3d 1051, 1055 (D. Kan. 2018) (“this procedure creates a serious potential for abuse because it allows infringers to delay proceedings simply by alleging technical violations of the underlying copyright registrations.”). If mere *allegations* are sufficient to trigger the court’s duty to make a § 411(b)(2) request to the Copyright Office, it gives infringers a blueprint for an effective stalling tactic, one that will exacerbate delays as more defendants use it and the Copyright Office is inundated with § 411(b)(2) queries.

Instead, courts have sensibly conducted their own assessment of any such allegations before sending a query to the Copyright Office. See *DeliverMed*, 734 F.3d at 625 (“courts 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.”); *Energy Intelligence*, 304 F. Supp. 3d at 1055-56 (“before seeking the Register’s advice on materiality, the party seeking invalidation of the copyright must first establish the preconditions to invalidity”); *Yellowcake Inc. v. Morena Music*, ___ F. Supp. 3d ___, 2021 WL 795823, at *19 (E.D. Cal., Mar. 2, 2021) (ordering copyright owner “to respond to the challenges to the validity of its registrations” before query to Copyright Office). The Copyright Office itself has recommended that “before 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.” *DeliverMed*, 734 F.3d at 625 (quoting the Register’s response).

CONCLUSION

Since the 1909 Act, Congress has slowly but steadily reduced the United States’ reliance on formalities as a condition of copyright protection. Section 411(b) continued this trend by codifying, for the first time, the doctrine of fraud on the Copyright Office, and strengthening the element of materiality. An applicant cannot be said to have “knowledge” that the publication status of a work is inaccurate when the case law on the legal standard of “publication” is in a confused and contradictory state. The Ninth Circuit’s standard of “knowledge, which precludes any inquiry into legal matters, is in effect a negligence standard, because it compels a finding that an applicant *should have known* what the legal definition of “publication” is. If the Ninth Circuit’s standard is upheld, it can reasonably be predicted that chaos will ensue, as happened when the Federal Circuit briefly adopted a similar watered-down standard in patent law.

The judgment of the court of appeals should be reversed, and the case should be remanded to determine whether any errors on the application were intentional, taking legal knowledge into account, before asking the Register to opine on whether the error was “material” under subsection 411(b)(2).

Respectfully submitted,

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