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 *AMICUS CURIAE* VICTORIA BURKE IN SUPPORT OF RESPONDENT

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INTEREST OF *AMICUS CURIAE*[1]

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SUMMARY OF ARGUMENT

The Copyright application process is a marvel: of all the intellectual property applications for protection, it is most akin to a trust exercise. Its purpose is to put others on notice that a particular fixed expression is protected. This requires that the applicant convey accurate information on the application. The Copyright office, in turn, puts full faith in an applicant's representations without independently verifying any of it. That is, unlike patent or trademark applications—which undergo rigorous scrutiny by an examiner—a copyright application and the decision to grant registry primarily stands on the word of the applicant.

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[1] No counsel for any party has authored this brief in whole or in part, and no person other than *amicus* or their counsel have made any monetary contribution intended to fund the preparation or submission of this brief. All parties have filed blanket consents to the filing of amicus briefs in this matter. *Amicus'* university and firm affiliations are for identification purposes only; *amicus'* university and firm take no position on this case.

This trust-based system is ripe for abuse by those who game the system for profit. For good reason, Congress imposes on this trust exercise a standard of care for the applicant. 17 U.S.C. § 411(b) imposes a low bar: it is implicated only when the applicant knowingly includes information in the application that is not correct. Notably, the statute says "knowledge" without specifically requiring actual knowledge. Moreover, it does not require a finding of intent by the applicant to commit fraud.

The United States Court of Appeals for the Ninth Circuit faithfully applied this standard. Trial testimony revealed that Unicolors knew when it filed its Copyright application that information provided in it was false. Specifically, Unicolors represented that it had published together all 31 works noted on its application. It had not. After making that finding, the Ninth Circuit properly requested the Register of Copyrights to determine if the inaccurate information would have prevented the copyright from being registered. This is exactly how Congress intended this procedure to work.

The integrity of the application process is fragile because it trusts the applicant to "do the right thing" and not exploit the lack of oversight. An applicant that games the system for profit should not be rewarded with a valid copyright to then use as a sword to assert infringement claims. And when an applicant does, it is necessary to uphold the procedure that Congress gave for referral to the Register of Copyrights. The decision below should be affirmed.

ARGUMENT

I. Copyright's trust-based system relies on an applicant's truthfulness

The process for applying for a copyright is designed to be simple. The application itself is only two pages and contains nine sections. *See, e.g.*, Form VA, U.S. Copyright Office, available at https://www.copyright.gov/forms/formva.pdf (last visited Sep. 26, 2021). A layperson can complete it with ease. The Copyright office provides ample free online resources to assist applicants as well.[2] The registration consists of "the submission by the copyright claimant of basic facts and material," which the Copyright Office "examines for evident signs of uncopyrightability or other defects." Benjamin Kaplan, *An Unhurried View of Copyright*, 82 (1967).

> If the Office finds none, it issues a certificate which has prima facie effects in litigation. The process lays down a public record and brings works under official security; and though the record is supplied ex parte and the official look is very superficial, there is value in both.

Id.

In a copyright application, the applicant attests to the validity of the statements provided within the four-corners of the document. "A copyright registration is 'prima facie evidence of the validity of the cop-

[2] *See* https://www.copyright.gov/help/tutorials.html (last visited Sep. 26, 2021).

yright and the facts stated in the certificate.'" *United Fabrics Int'l, Inc. v. C&J Wear, Inc.*, 630 F.3d 1255, 1257 (9th Cir. 2011) (quoting 17 U.S.C. § 410(c)). The Copyright office "accepts the facts stated in the registration materials, unless they are contradicted by information provided elsewhere in the registration materials or in the Office's records." Response of Register 7-8, *Fashion Ave. Sweater Knits, LLC v. Poof Apparel Corp.*, No. 2:19-cv-06302, Dkt. 129-1 (C.D. Cal. Feb. 8, 2021) (available at https://www.copyright.gov/rulings-filings/411) (last visited Sep. 26, 2021). The Copyright examiner "does not make findings of fact with respect to publication or any other thing done outside the Copyright Office" to substantiate the information provided by the application. *See* Response of Register, *Velazquez-Gonzalez v. Pina 1*, No. 3-07-cv-01512, Dkt. 109, (D.P.R. July 15, 2009) (citing U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* ("*Compendium*") § 108.05 (2d ed. 1988)) (available at https://www.copyright.gov/rulings-filings/411)(last visited Sep. 26, 2021).

In other words, applicants are trusted to provide truthful and accurate information when filing. "The Copyright Office's regulations require applicants to make a declaration…that the information provided within the application is correct to the best of [the applicant's] knowledge." *See* Response of Register 7, *Fashion Ave. Sweater Knits* (quoting 37 C.F.R. § 202.3(c)(3)(iii)).

In amending Section 411(b) through the Prioritizing Resources and Organization for Intellectual Property Act, Pub. L. No. 110-403 (PRO-IP Act),

Congress canonized the standard as being the knowledge of the applicant at the time of filing her application. A certificate of registration is satisfactory—even if it "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.

17 U.S.C. §411(b)(1). The standard, then, is knowledge, not intent. And nothing in the statute, or the legislative history of the PRO-IP Act, differentiates between actual or constructive knowledge or requires one over the other. Either will do. As Omar Khayyam famously said, "The moving finger writes, and having writ moves on."

Trial testimony can "rebut the presumption of copyright validity with some evidence or proof to dispute or deny the plaintiff's prima facie case of infringement." *United Fabrics*, 630 F.3d at 1258 (internal quotation marks omitted). The Court's role is discrete: when inaccurate information "is alleged," it "shall" ask the Register of Copyrights if knowledge of the inaccurate information would have resulted in a refused registration. 17 U.S.C. § 411(b)(2). Or put differently, whether the misplaced trust in the applicant's representations mattered.

This process distinguishes the copyright application process from the patent and trademark application processes. Unlike those processes, everything

from the application itself to the Section 411 referral process is built on the applicant providing accurate information. For good reason, then, Congress left out of Section 411(b) the fraud or intent-to-deceive elements that apply to patents and trademark registrations. *Gold Value Int'l Textile, Inc. v. Sanctuary Clothing, LLC*, 925 F.3d 1140, 1147 (9th Cir. 2019) (Section 411 "does not require a showing of fraud, but only that the claimant included inaccurate information on the application 'with knowledge that it was inaccurate.'") (quoting 17 U.S.C. § 411(b)(1)(A).

Unicolors opines on brief that "[t]here is no reason to believe that Congress intended to make copyright law the only area in which innocent mistakes in applications can jeopardize intellectual property rights." Unicolors Br. at 39. But Section 411 is meant to prevent "a mistake in the registration documents, such as checking the wrong box on the registration form" from rendering a "registration invalid and thus foreclos[ing] the availability of statutory damages." *See* H.R. Rep. No. 110-617 at 23 (May 5, 2008). Under Section 411, a copyright registration stands unless "inaccurate information was included on the application…with knowledge that it was inaccurate." 17 U.S.C. § 411(b)(1). Congress expressly did not go so far as to demand intent, only *knowledge*. *Id.*

Because the Copyright office does not scrutinize the applications it receives, Congress placed a higher burden on applicants to submit truthful information when filing. And like any other applicant, designers are perfectly capable of filling out the simple application correctly and accurately.

II. Unicolors is gaming the system

Comparatively few cases exist where a court has referred a Section 411(b) question to the Register of Copyrights. Most cases for design infringement in the fashion world settle out of court with a licensing agreement. Few go to trial where a close examination of the application would occur through discovery and testimony. Only such a close examination can reveal that the applicant has knowingly provided false information, thereby triggering referral to the Register of Copyrights. Copyright applicants like Unicolors, then, are often free from scrutiny unless they file infringement actions that proceed to trial instead of resolving out of court.

Notably, since Congress enacted the PRO-IP Act, the Register has now received only 24 referral requests (including the present case) under Section 411(b). *See* https://www.copyright.gov/rulings-filings/411 (last visited Sep. 26, 2021). Two of them relate to Unicolors.

In 2016, Unicolors filed an infringement suit related to a leopard print design. *See Unicolors, Inc. v. Burlington Stores Inc.*, No. 2-15-cv-03866, 2016 WL 2641490 (C.D. Cal. Mar. 8, 2016). Unicolors had lifted the design at issue from a leopard photo in the public domain and only slightly altered the animal's head. As H&M's brief depicts, Unicolors even left the animal's spots in the exact same place. H&M Br. at 9. Still, Unicolors registered the work as an original. Recognizing the obvious, the district court concluded Unicolors had "'knowingly' omitted information regarding the preexisting leopard photograph from its application" and asked the Register of Copyrights to

review the validity of the registration under Section 411(b).

Upon referral, the Register noted its reliance on the veracity of the applicant: "Based on the information provided in the application, the Office had no reason to question the representations in the application and accepted them as true and accurate." *See* Response of Register 5, *Unicolors Inc. v. Burlington Stores Inc.*, No. 2-15-cv-03866, Dkt. 40 (C.D. Cal. Mar. 8, 2016) (available at https://www.copyright.gov/rulings-filings/411) (last visited Sep. 26, 2021). But "had the Office been aware that the work registered…was based on a preexisting leopard photograph owned by a third party, the Office would have refused to register the work" because the "application failed to identify that preexisting photograph." *Id.* at 6.

Proving that a leopard indeed never changes its spots, Unicolors again exploited the trust-based copyright system here. To save money, *see* J.A. 54, Unicolors bundled thirty-one different designs in a single application as a "single unit" collection, even though at least nine of them were designated as "confined" to prevent being sold with the others. In other words, they were not published on the same date as the other twenty-two. *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 959 F.3d 1194, 1199 (9th Cir. 2020) (citing the "plain meaning of 'single unit' in §202.3(b)(4)(i)(A)"). This is akin to a fashion house gaining protection for its winter, spring, summer, and fall design collections with a single application, despite each design debuting—i.e., the publication date being—in a separate season.

Unsurprisingly, the law does not allow this. "When one registers a collection of works in a single copyright, it can be registered either as a "published" or an "unpublished" collection. 37 C.F.R. § 202.3(b)(4). That is, a single work registration is permissible for a single copyright claimant when, "in the case of published works, all copyrightable elements are otherwise recognizable as self-contained works *and are included in a single unit of publication*." 37 C.F.R. § 202.3(b)(4) (quotation modified and emphasis added); *see McLaren v. Chico's FAS, Inc.*, No. 10 Civ. 2481(JSR), 2010 WL 4615772, at *2 (S.D.N.Y. Nov. 9, 2010) ("the works must be first published together to qualify as" a single work registration); *Olander Enterprises, Inc. v. Spencer Gifts, LLC*, 812 F. Supp. 2d 1070, 1076 (C.D. Cal. 2011) ("a group of published works must be first published together" to "qualify as a 'single unit of publication'"). A necessary element of a published-collection copyright is that the collection is sold, distributed or offered for sale concurrently. *See* 37 C.F.R. § 202.3(b)(4); 17 U.S.C. § 101; *United Fabrics*, 630 F.3d at 1259.

Unicolors' gamesmanship of bundling separately-published works in a single application exploits the trust placed in copyright applicants. A copyright application puts the public on notice of a work that is protected by copyright. But when separate collections published separately are bundled as a single unit, how can one interpret which of the thirty-one designs are protected by the single registration? With separate publication dates, how can the Register—or the public—parse which portion of the registration still stands?

As the Ninth Circuit rightly found, then, Unicolors' knowledge "that certain designs included in the registration were confined" and thus "published separately to exclusive customers" triggered Section 411(b)(2). Unicolors' admission at trial that it had not in fact published the bundled works together constituted "undisputed evidence" that Unicolors included inaccurate information "with knowledge that it was inaccurate." *See Unicolors*, 959 F.3d at 1198; 17 U.S.C. § 411(b)(1)(A).[3]

Unicolors' decision to use a single application to register thirty-one designs—nine of which were not published contemporaneously with the others—might have been more efficient than the alternative. And chances are, Unicolors saw only a remote possibly of suffering the legal penalty of having its application invalidated. Having acquired *thousands* of copyright registrations, one wonders how many of Unicolors' registrations would realistically survive a closer look.

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[3] Unicolors objects to the Ninth Circuit's reliance on a new edition of the *Compendium* for what a "single unit" is. *See* Unicolors Br. 17. But each version of the *Compendium* requires the same thing of a single-unit: that the separately-copyrightable works be published together. *See Compendium* §1103 (3d ed. 2017) ("first distributed to the public in the packaged unit."); *Compendium* § 607.01 (2d ed. 1984) ("first published in a single unit of publication"); *Compendium* § 2.14.3 (IV) (1st. ed. 1973) ("first published as a unit"). By confining certain designs for later publication, and representing the works were published together, Unicolors included inaccurate information on its application with knowledge that it was inaccurate. This conclusion flows from any edition of the Compendium.

III. The validity of Unicolors' registration is yet to be determined

When an infringement case is based entirely on a registration which may not be valid due to facts revealed at trial, the entire infringement case is at stake. *See Fourth Est. Pub. Ben. Corp. v. Wall-Street.com, LLC.*, 139 S. Ct. 881, 885 (2019) ("[I]n enacting § 411(a), Congress…reaffirmed the general rule that registration must precede an infringement suit."). Upon finding that Unicolors knowingly included inaccurate information in its application, the Ninth Circuit properly ordered referral to the Register of Copyrights to weigh in. *See Unicolors,* 959 F.3d at 1200 (remanding "with instructions to submit an inquiry to the Register of Copyrights asking whether the known inaccuracies contained in [Unicolors'] application…if known to the Register of Copyrights, would have caused it to refuse registration.").

The "Register has the authority to interpret the copyright laws and ... its interpretations are entitled to judicial deference if reasonable." *Batjac Productions Inc. v. GoodTimes Home Video Corp.,* 160 F.3d 1223, 1230 (9th Cir. 1998) (internal quotation marks omitted). That deference is built into Section 411: if the Register had known that Unicolors did not publish all the works in a single unit, would it have mattered? 17 U.S.C. § 411(b). This Court should affirm and let this process run.

CONCLUSION

Unicolors breached the trust that underlies the application process. Section 411(b) is meant to have teeth: when a design company represents inaccurate information with "knowledge that it was inaccurate," scrutiny from the Register of Copyrights is in order. The ruling by the Ninth Circuit Court of Appeals should be affirmed.

Respectfully submitted,

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