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 FOR ANDREW D. LOCKTON AND MCHALE & SLAVIN, P.A. AS *AMICI CURIAE* IN SUPPORT OF RESPONDENT

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September 28, 2021

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INTEREST OF AMICI CURIAE

MCHALE & SLAVIN, P.A. is a Florida professional association of intellectual property attorneys that represent parties in all aspects in intellectual property protection, including both plaintiffs and defendants in copyright infringement litigation.[1] Mr. Andrew D. Lockton is an attorney at the firm of McHale & Slavin, P.A. who, among other roles, litigates intellectual property cases in trial and appellate courts. Mr. Lockton has a special interest in the issues raised herein, as they follow from the research and work that he has been doing to address the problems that have been arising more frequently regarding copyright litigation based on registration certificates which, if properly construed, do not contain the allegedly infringed material. To address this issue, he has been advocating for copyright infringement cases to, where appropriate, begin with a construction of the claim of copyright in a manner related to patent infringement litigation.

SUMMARY OF ARGUMENT

The absence of fraud in a copyright application does not, and cannot, transmute *non-registerable subject matter* into registerable subject matter. The

[1] Counsel for all parties have consented to this filing through the blanket consent each have filed with this Court. No counsel for any party authored this brief, in whole or in part, and no entity or person, aside from *amici curiae* and its counsel, made any monetary contribution toward the preparation or submission of this brief.

Copyright Office's authority to register a single work or multiple works on a single application cannot exceed the authority delegated to it by Congress. See An Act for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes, Pub. L. 94-553, title I, § 101, Oct. 19, 1976, 90 Stat. 2541 (the "1976 Copyright Act"). Pursuant to the authority delegated by Congress, the Copyright Office promulgated rules permitting multiple works to be registered on a single application—but only for certain specific categories. See 37 C.F.R. §§ 202.3-202.4. Petitioner Unicolors, Inc. ("Unicolors"), and its supporting amici, urge this Court to improperly expand that limited list to include a new "catch-all" category of works—any non-fraudulent application.

Unicolors' argument, however, does not account for its current situation, where, taking its evidence as true, the registration certificate contains material error that bars registration of the copied EH101 design under the Copyright Act and the regulations of the Copyright Office. Unicolors' registration certificate identifies a single work titled "Floral: EH103, EH105, EH111, CEH 113, EH123, EH132, CEH 146, CEH 147, EH 149, EH157, CEH 157, EH181, CEH182, EH183, EH185, CEH194, EH196, EH200, EH210 Ethnic, EH101, EH102, EH106, CEH109, EH115, CEH116, EH119, EH120, EH125, EH133, EH142, EH144" (hereafter, "Floral"), registration certificate number VA 1-770-400 (the "'400 certificate"). See J.A.227-233; see also Pet. App.

52-53. The '400 certificate only identifies the work "Floral" as "2-Dimensional artwork," see J.A.227-233; see also Pet. App. 52-53, though the record shows that Unicolors sought to register its group of published 2D designs, Br. 10-11; see also J.A.68-69.

Without first determining the scope of the work registered in the '400 certificate, the parties and the courts below assumed that the registration certificate registered the EH101 design because the work "Floral" was a "single unit of publication" of Unicolors' thirty-one submitted designs, which includes the EH101 design. See *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 959 F.3d 1194, 1196 (9th Cir. 2020). That assumption implicitly accepts two preliminary issues. First, if the submitted work "Floral" was a collective work, i.e., a compilation, then the copied EH101 design would not have been registered. See 17 U.S.C. §§ 103, 201(c); see also *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 493-94 (2001) (Ginsburg, J.) (explaining the distinction between copyright in the collective work and the copyright in the underlying material). Second, the Copyright Office does not allow published 2D artwork to be registered together as a group. See 37 C.F.R. §§ 202.3-202.4; see also *U.S Copyright Office, Compendium of U.S. Copyright Office Practices*, § 1105 (3d ed. 2021) (explaining that only "certain limited categories" of works are allowed to be registered together as a group). By process of elimination, the copied EH101 design could only have been registered if the work "Floral" qualified as a single

unit of publication. See, *e.g.*, J.A.91-92; J.A.137-139; J.A.170-173.

The Ninth Circuit correctly determined that the '400 certificate does not qualify as a "single unit of publication," because the thirty-one designs were not first published together as a single unit. *Unicolors*, 959 F.3d at 1197-00; see also *Compendium (Third)* § 1103.1(E) (works do not qualify as a single unit of publication when first published on different dates or if they were "first published as separate and discrete works, even if they were subsequently distributed together in the same unit."). The admitted evidence reflects that the designs were not first published together as a single unit, but only subsequently converted into a collection and submitted together to avoid the cost of filing separate applications for the separate designs. See *Unicolors*, 959 F.3d at 1196.

For the '400 certificate to be a registration for the EH101 design, the '400 certificate necessarily contains "inaccurate information" constituting a material error: it identifies a single date of first publication even though different designs were first published on different dates. See *Unicolors*, 959 F.3d 1196, 1200. The EH101 design was not individually registered, it was not first published as part of a "single unit of publication," and it is precluded from being registered as part of a group registration. See *id.* at 1196-00; see also 37 C.F.R. §§ 202.3-202.4. Therefore, any theory suggesting that the EH101 design is registered is based upon material error.

This error was addressed below in the context of 17 U.S.C. § 411(b), by assuming the '400 certificate registered the EH101 design and then addressing whether the registration was invalid for containing "inaccurate information" that Unicolors was aware was "inaccurate." See *Unicolors*, 959 F.3d at 1196, 1200; see also Br. 14-16, 18-22. Unicolors argues that the '400 certificate cannot be found invalid absent evidence of fraud in the application process. See, *e.g.*, Br, i, 18-22. Inherent in Unicolors' argument is that the EH101 design should be held validly registered, even though the work "Floral," registered by the '400 certificate, is not a "single-unit of publication." See *id.* at 18-22; see also *Unicolors*, 959 F.3d at 1196-00.

This Court granted certiorari to address whether indicia of fraud or material error is necessary to invalidate a copyright registration. Pet. i. ("Did the Ninth Circuit err in breaking with its own prior precedent and the findings of other circuits and the Copyright Office in holding that 17 U.S.C. § 411 requires referral to the Copyright Office where there is no indicia of fraud or material error as to the work at issue in the subject copyright registration?"). Unicolors pivots from that original question, addressing an alternate question, "whether th[e] 'knowledge' element [of 17 U.S.C. § 411] precludes a challenge to a registration where the inaccuracy resulted from the applicant's good-faith misunderstanding of a principle of copyright law?" Br. i. This reframed question avoids the question of whether indicia of material error can

invalidate a registration and fails to address a situation where, as here, the work "Floral," identified in the '400 certificate, is not the same as the EH101 design Unicolors seeks to have deemed registered.

Unicolors' argument assumes, without analysis or explanation, that the EH101 design is registered by the '400 certificate so long as the '400 certificate is not invalidated. But this does not account for the other option of copyright registration—that the '400 certificate is a registration for a collective work titled "Floral," i.e., the separate copyright in a work that excludes the subject matter of the EH101 design from the registration. See 17 U.S.C. §§ 103, 201(c). This case highlights the need to first determine the scope of the claim of copyright in an ambiguous registration certificate in a manner similar to the claim-construction analysis in a patent-infringement case.

The logical conclusion of the Ninth Circuit's analysis and holding is that the '400 certificate is that the EH101 design has never been registered. Regardless of the validity of the '400 certificate, the work "Floral" is not a "single unit of publication," and therefore, the EH101 design was not registered as part of a "single unit of publication."

ARGUMENT

I. INVALIDATING A COPYRIGHT REGISTRATION DOES NOT REQUIRE SHOWING FRAUD ON THE COPYRIGHT OFFICE WHEN THE REGISTRATION PURPORTS TO REGISTER MULTIPLE WORKS THAT ARE NOT REGISTERABLE TOGETHER IN A SINGLE APPLICATION.

When a copyright registration certificate purports to register a group of works that are barred from being registered in a single application, such error is material even absent a showing of an intent-to-defraud to the Copyright Office. Under Unicolors' evidence, for the '400 certificate to register the EH101 design, the certificate necessarily contains material error that would bar registration. A group of published 2D artwork cannot be registered together under the Copyright Office's regulations. 37 C.F.R. §§ 202.3-202.4.

Therefore, the EH101 design can only be registered by the registration for the "Floral," identified in the '400 certificate, if the work "Floral" is a "single unit of publication," i.e., all of the thirty-one separately identified designs must have been first published together as part of a single unit. See 37 C.F.R. § 202.3; see also *Unicolors*, 959 F.3d at 1196.

Unicolors admitted, however, that the different designs were first published separately but later collected and filed together to save money and avoid filing separate applications for the designs. See

Unicolors, 959 F.3d at 1196-00; see also J.A.52-54. Therefore, the Ninth Circuit held that the work "Floral" was not a "single unit of publication." *Unicolors*, 959 F.3d at 1200. The Ninth Circuit did not hold that the registration was invalid but remanded the case with instructions to inquiry whether the Register of Copyrights would have refused registration of the '400 certificate if it was known that the group of designs were not a "single unit of publication." *Ibid.*

In its opinion, the Ninth Circuit affirmed its recent opinion in *Gold Value Int'l Textile, Inc. v. Sanctuary Clothing, LLC*, 925 F.3d 1140 (9th Cir. 2019), to confirm there is no "intent-to-defraud requirement" for invalidating a registration. *Unicolors*, 959 F.3d at 1198 (citing *Gold Value*, 925 F.3d at 1147). The Ninth Circuit correctly held that fraud is not necessary to invalidate a registration certificate under the amendment to the 1976 Copyright Act, only that inaccurate information is included in an application with the "knowledge" that such information is inaccurate. *Gold Value*, 925 F.3d at 1147.

In 2008, the 1976 Copyright Act was amended to address "harmless error" in a registration certificate. See Prioritizing Resources and Organization for Intellectual Property Act of 2008, Pub. L. 110-403, title I, § 101(a), Oct. 13, 2008, 112 Stat. 2863 (the "PRO IP Act"); see also 17 U.S.C. § 411(b). The inquiry under § 411(b) focuses on whether the subject registration certificate contains "inaccurate

information." See 17 U.S.C. § 411(b). Such "inaccurate information" will not invalidate the registration, however, unless it was included in the application "with knowledge that it was inaccurate" and the inaccuracy, if known, would have caused the Register of Copyrights to refuse registration. *Ibid.*

As the Ninth Circuit addressed in *Unicolors* and *Gold Value*, "knowledge" that information in an application is inaccurate is not the same as an "intent-to-defraud" the Copyright Office. See *Unicolors*, 959 F.3d at 1198; see also *Gold Value*, 925 F.3d at 1147. As the Ninth Circuit addressed, the plain language of § 411(b) requires only "knowledge" that inaccurate material is included in an application, not a showing of fraud. *Gold Value*, 925 F.3d at 1147 (citing *Lamie v. United States Tr.*, 540 U.S. 526, 534 (2004)).

Despite Unicolors' failure to comply with the registration requirements, it argues that an "applicant's good-faith misunderstanding of a principle of copyright law" precludes a challenge to the validity of a copyright registration. See Br. 1. But this Court has "long recognized the 'common maxim, familiar to all minds, that ignorance of the law will not excuse any person, either civilly or criminally.'" *Jerman v. Carlisle, McNellie, Rini, Kramer & Ulrich LPA*, 559 U.S. 573, 581 (2010) (quoting *Barlow v. United States*, 32 U.S. 404, 411 (1833)); accord *United States v. Int'l Minerals & Chem. Corp.*, 402 U.S. 558, 563 (1971) ("The principle that ignorance of the law is no defense applies whether the law be a statute or a duly

promulgated and published regulation.").

The plain text of the PRO IP Act, addressing "harmless error" in a copyright application, does not require a showing of "fraud" or an "intent-to-defraud." Pub. L. 110-403, § 101(a); see also 17 U.S.C. § 411(b). The statute requires only knowledge that information included was inaccurate, not that the applicant understood the legal ramifications of the inaccurate information. See 17 U.S.C. § 411(b).

In this case, the '400 certificate contains "inaccurate information" if the certificate is assumed to register the EH101 design as part of a "single unit of publication." Unicolors admitted that the work "Floral," identified in the '400 certificate as the work registered, was not a single unit of publication; the different designs collected to make "Floral" were separately published but collected together for later publication as a group and registration. See *Unicolors*, 959 F.3d at 1196, 1200. Unicolors had knowledge of these facts. See *id.* at 1196. These facts, if stated in the application would have caused the Register of Copyrights to refuse registration as a "single unit of publication." See *Compendium (Third)* § 1103.1(E).

II. BEFORE DETERMINING WHETHER THE '400 CERTIFICATE IS VALID, THE COURT SHOULD DETERMINE THE SCOPE OF THE COPYRIGHT PURPORTED TO BE REGISTERED.

As addressed supra, Section I, the analysis of whether the '400 certificate contains "inaccurate information" is based upon assumptions that have not been independently analyzed or established. Specifically, the analysis assumes that the registration of the work "Floral" is a registration for the EH101 design. See, *e.g.*, *Unicolors*, 959 F.3d at 1196 (stating without analysis that Unicolors received a registration for the EH101 design). Though the Ninth Circuit concluded that the work "Floral," identified by the '400 certificate, is not a "single unit of publication," see *id.* at 1200, it did not determine the scope of that work to determine what subject matter was registered through the '400 certificate. Before determining whether the '400 certificate is valid, the claim of copyright should be construed to determine the scope of the work "Floral."

The logical extension of the Ninth Circuit's analysis and holding in *Unicolors* is that regardless of whether the '400 certificate is valid, the copied EH101 design is not registered by the '400 certificate. It was undisputed that the EH101 design could only be registered if the '400 certificate qualified as a "single unit of publication." See 959 F.3d at 1197-98; see also J.A.170-173. As the Ninth Circuit held, the work "Floral," identified in the '400 certificate, is not a

single unit of publication. *Unicolors*, 959 F.3d at 1198-00. Accordingly, independent of whether the '400 certificate is a valid registration, the work registered by that certificate does not include the EH101 design. See *Unicolors*, 959 F.3d at 1198-00; see also J.A.170-173.

The EH101 design is not registered. Unicolors never applied to register the EH101 design alone. See J.A.53-54. The work "Floral," identified in the '400 certificate, is not a "single unit of publication," which would permit the EH101 design to be included in the scope of the registered work. See *Unicolors*, 959 F.3d at 1198-00; see also 37 C.F.R. 202.3(b)(4)(i)(A). Finally, the EH101 design cannot be registered as part of a group registration because published 2D artwork is not capable of being registered as a group. See 37 C.F.R. §§ 202.3-202.4; see also *Compendium (Third)* § 1105.2.

The scope of the copyright in the work "Floral" is ambiguous. The '400 certificate does not identify the work "Floral" as a "single unit of publication." J.A.227-233. The certificate does not identify the work "Floral" as a group of published 2D artwork being submitted for registration as a group, *ibid.*, which would not have been acceptable under the Copyright Office's regulations, see 37 C.F.R. §§ 202.3-202.4. The '400 certificate does not imply that the registration is for the one design EH101. See J.A.227-233.

The Ninth Circuit did not determine the scope of

the copyright in the work "Floral." In analyzing whether the '400 certificate was valid, the Ninth Circuit *assumed* that the '400 certificate was a registration for the EH101 design as part of a single unit of publication. See *Unicolors*, 959 F.3d at 1196. But that assumption is not based on the '400 certificate itself. See J.A.227-233. Rather, that assumption appears to follow from litigation arguments, because, as Respondent H&M Hennes & Mauritz, L.P. ("H&M") correctly stated, "multiple textile designs may only be registered together under one registration if they qualify as a 'single unit.'" See J.A.170-173.

Before determining the validity of the '400 certificate, the scope of the work "Floral" should be properly construed. It is undisputed that Unicolors collected thirty-one separate designs for submission as the work "Floral," and it is undisputed that those designs were first published in separate groups. See *Unicolors*, 959 F.3d at 1196, 1200. The most natural conclusion based on the facts is that the work "Floral" is a collective work, see 17 U.S.C. §§ 103, 201(c), and the validity of that work depends on whether there was any original expression in the collective work, see *id.*, §§ 102, 103. If "Floral" is a collective work, i.e., a compilation of the preexisting designs, then the EH101 design is not within the scope of the subject matter that was registered. See *id.*, §§ 102, 103, 201(c).

As this Court recently addressed in *Fourth Estate*

Pub. Ben. Corp. v. Wall-Street.com, LLC, 139 S. Ct. 881 (2019) (Ginsburg, J.), the Copyright Act's registration requirement, codified at 17 U.S.C. § 411(a), requires registration of the allegedly infringed work to be made before litigation can commence. Registration must be made for the specific "work" that is the subject of the infringement suit. 17 U.S.C. § 411(a). Implicit in that statutory requirement is that the registration of one work does not permit a lawsuit based upon a different work. See *ibid.*

Here, Unicolors pursued an infringement action based upon the alleged infringement of the EH101 design based on a registration certificate identifying the work "Floral" as the registered work. See J.A.227-233; see also *Unicolors*, 959 F.3d at 1196. The parties and court assumed that the registration for "Floral" included the EH101 design within its subject matter, assuming without ever analyzing or determining the critical preliminary question of whether the scope of the work "Floral" included the EH101 design. See *Unicolors*, 959 F.3d at 1196.

When the scope of the claim of copyright identified in a registration certificate is ambiguous, as it is in the present case, before determining infringement or validity of the registration, the scope of the registered copyright should be construed. A similar issue was addressed by this Court in the patent-infringement context in in *Markman v. Westview Instruments*, 517 U.S. 370 (1996) (Souter, J.).

In *Markman*, this Court identified there are two elements in a simple patent case, "construing the patent and determining whether infringement occurred." *Id.* at 384. While infringement is a question for the jury, the proper construction of the patent claim is a question of law for the courts to resolve uniformly. *Id.* at 384-85 (quoting *Winans v. Denmead*, 56 U.S. 330, 338 (1854), and citing *Winans v. New York & Erie R. Co.*, 62 U.S. 88, 100 (1859), *Hogg v. Emerson*, 47 U.S. 437, 484 (1848), and *Parker v. Hulme*, 18 F. Cas. 1138, 1140 (1849)).

These same patent litigation principles are applicable to copyright litigation when the claim of copyright in the registration certificate is ambiguous. First, the district court should construe the claim of copyright that has been registered (or submitted for registration) and second, the issue of infringement should be addressed, either on summary judgment or by a jury. The scope of the claim of copyright submitted for registration is an objective inquiry for the courts to resolve for the same reasons that this Court held that the claim of a patent must be construed by the courts. See *Markman*, 517 U.S. at 388-90.

Similar to a patent claim, the claim of copyright that is registered is set out in a written instrument and "[t]he construction of written instruments is one of those things that judges often do are likely to do better than jurors unburdened by training in exegesis." See *id.* at 388. Here, the '400 certificate

identifies the claim of copyright registered as the work "Floral." J.A.277-233. The work "Floral" is a collection of thirty-one discrete designs. See *Unicolors*, 959 F.3d at 1196.

Before the validity of the '400 certificate can be determined, the scope of the claim of copyright in the '400 certificate should be determined. The '400 certificate cannot be a registration for a group of published designs, see 37 C.F.R. § 202.3-202.4, and it is not a registration for a "single unit of publication," *Unicolors*, 959 F.3d at 1200. But that leaves a possibility that the work "Floral," registered by the '400 certificate, is a compilation, i.e., a collective work of the thirty-one designs. Following a proper construction, it is possible that the '400 certificate is a valid registration, but it is not a registration for the EH101 design.

CONCLUSION

For the reasons set forth above, amici respectfully submit that the Court should affirm the decision of the Ninth Circuit.

Respectfully submitted,

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September 28, 2021