

In the Supreme Court of the United States

UNICOLORS, INC.,

Petitioner,

v.

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

Respondents.

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

**AMICUS BRIEF OF AMERICAN SOCIETY OF MEDIA
PHOTOGRAPHERS, INC. AND CALIFORNIA SOCIETY OF
ENTERTAINMENT LAWYERS JOINED BY FIVE OTHER
CREATOR RIGHTS GROUPS IN SUPPORT OF PETITIONER**

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TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
INTEREST OF AMICI CURIAE.....	1
SUMMARY OF ARGUMENT	4
ARGUMENT.....	6
I. THE CIRCUIT SPLIT CAUSED BY <i>UNICOLORS</i> IS EVEN MORE PRONOUNCED WHEN ANALOGOUS PATENT AND TRADEMARK CASES REQUIRING SPECIFIC INTENT TO DECEIVE THE USPTO TO INVALIDATE A REGISTRATION ARE CONSIDERED	6
II. ANOTHER CIRCUIT SPLIT BETWEEN THE NINTH CIRCUIT AND THE ELEVENTH CIRCUIT JUST AROSE REGARDING WHETHER AN INFRINGEMENT CAN RAISE REFERRAL TO THE COPYRIGHT OFFICE UNDER 17 U.S.C. § 411(b)(2) <i>AFTER TRIAL</i>	15
III. CONSTRUING § 411(a) AND § 411(b) TOGE- THER, THE COURT SHOULD CLARIFY THAT “INACCURATE INFORMATION” REGARDING AN EXPRESS OR IMPLICIT LEGAL CONCLUSION REGARDING PUBLICATION IS NEVER A GROUND TO REFUSE REGISTRATION UNDER 17 U.S.C. § 411(b)	19
CONCLUSION.....	28

TABLE OF AUTHORITIES

	Page
CASES	
<i>Access Now, Inc. v. Sw. Airlines Co.</i> , 385 F.3d 1324 (11th Cir. 2004)	17
<i>Advisers, Inc. v. Wiesen-Hart, Inc.</i> , 238 F.2d 706 (6th Cir. 1956).....	14
<i>Anheuser-Busch, Inc. v. Bavarian Brewing Co.</i> , 264 F.2d 88, 84 Ohio Law Abs. 97 (6th Cir. 1959)	12
<i>Billy-Bob Teeth, Inc. v. Novelty, Inc.</i> , 329 F.3d 586 (7th Cir. 2003)	15
<i>Bouchat v. Baltimore Ravens, Inc.</i> , 241 F.3d 350 (4th Cir. 2001).....	14
<i>Bouve v. Twentieth Century-Fox Film Corp.</i> , 122 F.2d 51 (D.C. Cir. 1941)	15
<i>City of Rancho Palos Verdes v. Abrams</i> , 544 U.S. 113, 125 S. Ct. 1453 (2005).....	13
<i>Dear v. Q Club Hotel, LLC</i> , 933 F.3d 1286 (11th Cir. 2019)	17
<i>Donald Frederick Evans & Assocs., Inc. v. Cont'l Homes, Inc.</i> , 785 F.2d 897 (11th Cir. 1986)	6
<i>eBay Inc. v. MercExchange, L.L.C.</i> , 547 U.S. 388, 126 S. Ct. 1837 (2006)	10
<i>Fonar Corp. v. Domenick</i> , 105 F.3d 99 (2d Cir. 1997)	14
<i>Fox Film Corp. v. Doyal</i> , 286 U.S. 123, 52 S. Ct. 546, 76 L. Ed. 1010 (1932)	10

TABLE OF AUTHORITIES – Continued

	Page
<i>Gallup, Inc. v. Kenexa Corp.</i> , 149 F. App'x 94 (3d Cir. 2005)	14
<i>Gold Value Int'l Textile, Inc. v. Sanctuary Clothing, LLC</i> , 925 F.3d 1140 (9th Cir. 2019)	8, 23, 24
<i>Harrison v. PPG Industries, Inc.</i> , 446 U.S. 578, 64 L. Ed. 2d 525, 100 S. Ct. 1889 (1980)	13
<i>Hoffmann-La Roche, Inc. v. Promega Corp.</i> , 323 F.3d 1354 (Fed. Cir. 2003)	9
<i>In re Bose Corp.</i> , 580 F.3d 1240 (Fed. Cir. 2009)	11, 13
<i>Internet Prods. LLC v. LLJ Enters.</i> , 2020 U.S. Dist. LEXIS 220090 (D.N.J. Nov. 24, 2020)	24
<i>Kimberly-Clark Corp. v. Johnson & Johnson & Pers. Prods. Co.</i> , 745 F.2d 1437 (Fed. Cir. 1984)	18
<i>Kingsdown Med. Consultants, Ltd. v. Hollister Inc.</i> , 863 F.2d 867 (Fed. Cir. 1988)	8, 10, 12, 13
<i>Larson Mfg. Co. of S.D., Inc. v. Aluminart Prods. Ltd.</i> , 559 F.3d 1317 (Fed. Cir. 2009)	10
<i>Midlevelu, Inc. v. ACI Info. Grp.</i> , 2021 U.S. App. LEXIS 6167 (11th Cir. 2021)	18
<i>One Treasure Ltd., Inc. v. Richardson</i> , 202 F. App'x 658 (5th Cir. 2006)	14

TABLE OF AUTHORITIES – Continued

	Page
<i>Opati v. Republic of Sudan</i> , 140 S. Ct. 1601 (2020)	21
<i>Original Appalachian Artworks, Inc. v. Toy Loft, Inc.</i> , 684 F.2d 821 (11th Cir. 1982)	6
<i>Roberts v. Gordy</i> , 877 F.3d 1024 (11th Cir. 2017).....	6, 7, 16
<i>San Juan Prods., Inc. v. San Juan Pools, Inc.</i> , 849 F.2d 468 (10th Cir.1988)	12
<i>Scanner Techs. Corp. v. ICOS Vision Sys. Corp.</i> , 528 F.3d 1365 (Fed. Cir. 2008).....	10
<i>Smith Int'l, Inc. v. Olin Corp.</i> , 209 USPQ 1033 (T.T.A.B. 1981)	11
<i>Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.</i> , 537 F.3d 1357 (Fed. Cir. 2008)	8, 9, 10, 12
<i>Symbol Techs., Inc. v. Opticon, Inc.</i> , 935 F.2d 1569 (Fed. Cir. 1991)	11
<i>Therasense, Inc. v. Becton, Dickinson & Co.</i> , 649 F.3d 1276 (Fed. Cir. 2011)	passim
<i>Torres v. Cantine Torresella S.r.l.</i> , 808 F.2d 46 (Fed. Cir. 1986)	11
<i>Torres-Negron v. J & N Records, LLC</i> , 504 F.3d 151 (1st Cir. 2007).....	14
<i>Unicolors, Inc. v. H&M Hennes & Mauritz, Ltd. P'ship</i> , 959 F.3d 1194 (9th Cir. 2020) passim	
<i>United States v. Brannan</i> , 562 F.3d 1300 (11th Cir. 2009).....	17

TABLE OF AUTHORITIES – Continued

	Page
<i>W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.</i> , 377 F.2d 1001, 54 C.C.P.A. 1442 (CCPA 1967)	11
STATUTES	
15 U.S.C. § 1064(3)	11
17 U.S.C. § 411(a)	19, 24, 25, 26
17 U.S.C. § 411(b)	passim
17 U.S.C. § 411(b)(1)	7, 16, 17, 27
17 U.S.C. § 411(b)(2)	15, 16, 19, 26
17 U.S.C. § 412.....	5, 25, 27
Public Law No: 110-403 (10/13/2008).....	4
JUDICIAL RULES	
Sup. Ct. R. 37.6	1
REGULATIONS	
37 C.F.R. § 202.3(b)(4)	20
LEGISLATIVE MATERIALS	
84 Federal Register 66328 (Dec. 4, 2019 Notification of Inquiry/ Proposed Rules)	22, 24

TABLE OF AUTHORITIES – Continued

Page

OTHER AUTHORITIES

Melville B. Nimmer, <i>Copyright Publication</i> , 56 COLUM. L. REV. 185 (1956), https://www-jstor-org.proxy.libraries.smu.edu/stable/pdf/1119728.pdf?refreqid=excelsior%3Af46b67e310c838eab689c735d400f037	22, 23
Thomas F. Cotter, <i>Toward A Functional Definition of Publication in Copyright Law</i> , 92 MINN. L. REV. 1724 (2008)	23
United States Copyright Office, <i>Annual Report, Fiscal 2019</i> , https://www.copyright.gov/reports/annual/2019/ar2019.pdf	13, 19, 25
United States Copyright Office, <i>Form VA</i> , https://www.copyright.gov/forms/formva.pdf	19



INTEREST OF AMICI CURIAE

AMERICAN SOCIETY OF MEDIA PHOTOGRAPHERS, INC. (ASMP) is a 501(c)(6) non-profit trade association representing thousands of members who create and own substantial numbers of copyrighted photographs. These members all envision, design, produce, and sell their photography in the commercial market to entities as varied as multinational corporations to local mom and pop stores, and every group in between. In its seventy-five-year history, ASMP has been committed to protecting the rights of photographers and promoting the craft of photography.¹

CALIFORNIA SOCIETY OF ENTERTAINMENT LAWYERS (CSEL) is a non-profit corporation comprised of attorneys representing authors, screenwriters, songwriters, and other creative professionals in the entertainment industry.

AMERICAN PHOTOGRAPHIC ARTISTS (APA) is a leading national organization run by and for professional photographers. APA strives to improve the environment for photographic artists and clear the pathways to success in the industry. Recognized for its broad industry reach, APA continues to expand

¹ Pursuant to this Court's Rule 37.6, counsel for amici curiae certifies that this brief was not authored in whole or in part by counsel for any party and that no person or entity other than amici curiae, its members, or its counsel has made a monetary contribution intended to fund the preparation or submission of this brief. All parties have consented to the filing of this brief. Notice of intent to file this amici brief was provided at least 10 days prior to the deadline to file the brief.

benefits for its members and works to champion the rights of photographers and image-makers worldwide.

ASSOCIATION OF MEDICAL ILLUSTRATORS (AMI), established in 1945, is an international trade association for biomedical illustrators and animators. Their members are highly specialized visual artists that apply their creativity and scientific expertise to advance life sciences, medicine, and healthcare. The AMI engages in education and advocacy to support all creators of intellectual property to own, control and preserve their rights as guaranteed by national and international copyright laws and conventions.

DIGITAL JUSTICE FOUNDATION (DJF) is a nonprofit legal organization dedicated to protecting individual rights in digital spaces, with a particular focus on being a voice for underrepresented individual users and consumers. As part of this mission, the DJF advocates for individual rights, including civil liberties, privacy rights, and intellectual property rights, especially where such rights are implicated by the internet and other digital technologies.

GRAPHIC ARTISTS GUILD, INC. (GAG) is a 501(c)(6) non-profit trade association which has advocated on behalf of graphic designers, illustrators, animators, cartoonists, comic artists, web designers, and production artists for fifty years. GAG educates graphic artists on best practices through webinars, Guild e-news, resource articles, and meetups. The GRAPHIC ARTISTS GUILD HANDBOOK: PRICING & ETHICAL GUIDELINES has raised industry standards and provides graphic artists and their clients guidance on best practices and pricing standards.

NATIONAL PRESS PHOTOGRAPHERS ASSOCIATION (NPPA) is a 501(c)(6) non-profit organization dedicated to the advancement of visual journalism in its creation, editing, and distribution. NPPA's members include video and still photographers, editors, students, and representatives of businesses that serve the visual journalism community. Since its founding in 1946, the NPPA has been the Voice of Visual Journalists, vigorously promoting the constitutional and intellectual property rights of journalists as well as freedom of the press in all its forms, especially as it relates to visual journalism.



SUMMARY OF ARGUMENT

A decade ago, Congress codified the doctrine of fraud on the Copyright Office in the registration process to enhance the ability of copyright creators to enforce their copyrights by passing the Prioritizing Resources and Organization for Intellectual Property Act of 2008 (“Pro IP Act”). Title I of the Act amends federal copyright law to “. . . provide a safe harbor for copyright registrations that contain inaccurate information.”² As result, 17 U.S.C. § 411(b) was amended.

The Ninth Circuit decision *Unicolors, Inc. v. H&M Hennes & Mauritz, Ltd. P’ship*, 959 F.3d 1194 (9th Cir. 2020) creates a clear intra-circuit conflict regarding whether fraud is necessary to invalidate a copyright registration under 17 U.S.C. § 411(b). This amici brief will not repeat the arguments in the Petition regarding the circuit split between the Eleventh Circuit (deceptive intent required) and the Ninth Circuit (no deceptive intent required).

Rather, this amici brief points out that this Court should look to analogous law requiring deceptive intent to the United States Patent and Trademark Office (“USPTO”) to invalidate either a patent or invalidate a trademark. Thus, if *Unicolors* is affirmed by this Court, it will send shockwaves in the area of patents and trademarks and likely will create uncertainty and possible reversal of decades of well-

² Public Law No: 110-403 (10/13/2008). (<https://www.congress.gov/bill/110th-congress/senate-bill/3325?q=%7B%22search%22%3A%5B%22Prioritizing+Resources+and+Organization+for++Intellectual+Property%22%5D%7D&s=9&r=2>)

settled law requiring deceptive intent, including the *en banc* opinion *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1290 (Fed. Cir. 2011) that reaffirmed that “the accused infringer must prove that the patentee acted with the specific intent to deceive the PTO.” (emphasis added). *See* § I below.

This amici brief also points out that a new circuit split between the Ninth Circuit and the Eleventh Circuit just arose regarding whether an infringer can raise referral to the Copyright Office under 17 U.S.C. § 411(b)(2) after trial. This Court should grant the Petition to clarify that any request to “the Register of Copyrights to advise the court” must be timely done by motion before trial. *See* § II below.

Further, this amici brief points out that an alleged inaccuracy regarding express or implicit legal conclusions regarding publication can never be a ground to refuse copyright registration because both published and unpublished works can be registered. As a result, the district court has no need to “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” under § 411(b)(2). Rather, the district court can consider any publication legal conclusions in determining whether statutory damages or attorney fees are authorized under 17 U.S.C. § 412. *See* § III below.

This Court should grant the Petition to resolve the circuit conflicts and provide much needed clarity that will prevent the copyright system and the courts from being cluttered and plagued by infringers claiming a copyright registration should be invalidated based upon implicit legal conclusions regarding publication

in a copyright application. Proposed clarifications are set forth in § III below.



ARGUMENT

I. THE CIRCUIT SPLIT CAUSED BY *UNICOLORS* IS EVEN MORE PRONOUNCED WHEN ANALOGOUS PATENT AND TRADEMARK CASES REQUIRING SPECIFIC INTENT TO DECEIVE THE USPTO TO INVALIDATE A REGISTRATION ARE CONSIDERED

As set forth in the Petition, there is a clear circuit split between the Ninth Circuit and the Eleventh Circuit regarding whether an intent to deceive the Copyright Office is necessary to invalidate a copyright registration under 17 U.S.C. § 411(b). Petition, at 14-16.

The Eleventh Circuit in *Roberts v. Gordy*, 877 F.3d 1024, 1029-30 (11th Cir. 2017) ruled that scienter is necessary—not just mere knowledge.

On the other hand, the scienter necessary for invalidating a registration is also clear and well settled. See *Original Appalachian*, 684 F.2d at 828 (“While . . . 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. Where this element of ‘scienter’ is lacking, courts generally have upheld the copyright.”); *Donald Frederick Evans*, 785 F.2d at 904; *St. Luke’s*, 573 F.3d at 1201 (“Omissions or misrepresentations in a copy-

right application can render the registration invalid where there has been intentional or purposeful concealment of relevant information. Thus, there must be a showing of scienter in order to invalidate a copyright registration.”) (internal citations omitted).

Therefore, in 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. While the district court correctly found material inaccuracies in the registrations, it erred by not applying the appropriate scienter for Fraud on the Copyright Office.

Id. (Emphasis added).

In contrast, the Ninth Circuit in *Unicolors* ruled that mere knowledge of a claimed inaccurate fact (without any intent to deceive the Copyright Office or knowledge that a legal conclusion was erroneous) is sufficient to invalidate a copyright registration.

The undisputed evidence adduced at trial further shows that *Unicolors* included the inaccurate information “with knowledge that it was inaccurate.” 17 U.S.C. § 411(b)(1)(A). And the knowledge inquiry is not whether Unicolors knew that including a mixture of confined and non-confined designs would run afoul of the single-unit registration requirements; the inquiry is merely whether Unicolors knew that certain designs included in the registration were confined and, therefore, were each published separately to

exclusive customers. See *Gold Value Int'l Textile, Inc.*, 925 F.3d at 1147. At trial, *Unicolors* admitted to having such knowledge.

Unicolors, 959 F.3d at 1200 (emphasis added).

Nearly a decade ago, in the patent context, an *en banc* Federal Circuit in *Therasense, Inc. v. Becton, Dickinson & Co.*, reaffirmed that deceptive intent was required to invalidate a patent registration and acknowledged the trio of Supreme Court cases that formed the basis for a specific intent to deceive.

To prevail on a claim of inequitable conduct, the accused infringer must prove that the patentee acted with the specific intent to deceive the PTO. *Star*, 537 F.3d at 1366 (citing *Kingsdown*, 863 F.2d at 876). A finding that the misrepresentation or omission amounts to gross negligence or negligence under a “should have known” standard does not satisfy this intent requirement. *Kingsdown*, 863 F.2d at 876. “In a case involving nondisclosure of information, clear and convincing evidence must show that the applicant made a deliberate decision to withhold a known material reference.” *Molins*, 48 F.3d at 1181 (emphases added). In other words, the accused infringer must prove by clear and convincing evidence that the applicant knew of the reference, knew that it was material, and made a deliberate decision to withhold it.

This requirement of knowledge and deliberate action has origins in the trio of Supreme Court cases that set in motion the develop-

ment of the inequitable conduct doctrine. In each of those cases, the patentee acted knowingly and deliberately with the purpose of defrauding the PTO and the courts. See *Precision*, 324 U.S. at 815-16 (assertion of patent known to be tainted by perjury); *Hazel-Atlas*, 322 U.S. at 245 (a “deliberately planned and carefully executed scheme to defraud” the PTO involving both bribery and perjury); *Keystone*, 290 U.S. at 246-47 (bribery and suppression of evidence).

Intent and materiality are separate requirements. *Hoffmann-La Roche, Inc. v. Promega Corp.*, 323 F.3d 1354, 1359 (Fed. Cir. 2003). A district court should not use a “sliding scale,” where a weak showing of intent may be found sufficient based on a strong showing of materiality, and vice versa. Moreover, a district court may not infer intent solely from materiality. Instead, a court must weigh the evidence of intent to deceive independent of its analysis of materiality. Proving that the applicant knew of a reference, should have known of its materiality, and decided not to submit it to the PTO does not prove specific intent to deceive. See *Star*, 537 F.3d at 1366 (“the fact that information later found material was not disclosed cannot, by itself, satisfy the deceptive intent element of inequitable conduct”).

Because direct evidence of deceptive intent is rare, a district court may infer intent from indirect and circumstantial evidence. *Larson Mfg. Co. of S.D., Inc. v. Aluminart Prods. Ltd.*,

559 F.3d 1317, 1340 (Fed. Cir. 2009). However, to meet the clear and convincing evidence standard, the specific intent to deceive must be “the single most reasonable inference able to be drawn from the evidence.” *Star*, 537 F.3d at 1366. Indeed, the evidence “must be sufficient to require a finding of deceitful intent in the light of all the circumstances.” *Kingsdown*, 863 F.2d at 873 (emphasis added). Hence, when there are multiple reasonable inferences that may be drawn, intent to deceive cannot be found. *See Scanner Techs. Corp. v. ICOS Vision Sys. Corp.*, 528 F.3d 1365, 1376 (Fed. Cir. 2008) (“Whenever evidence proffered to show either materiality or intent is susceptible of multiple reasonable inferences, a district court clearly errs in overlooking one inference in favor of another equally reasonable inference.”).

Therasense, Inc., 649 F.3d at 1290-91 (Emphasis added).

This Court has analogized patent and copyright cases due to their similarities. “A copyright, like a patent, is at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals and the incentive to further efforts for the same important objects” *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392, 126 S. Ct. 1837, 1840 (2006) *quoting Fox Film Corp. v. Doyal*, 286 U.S. 123, 127, 52 S. Ct. 546, 76 L. Ed. 1010 (1932) ((internal quotation marks omitted)).

Over a decade ago, in the trademark context, the Federal Circuit in *In re Bose Corp.*, 580 F.3d 1240,

1243 (Fed. Cir. 2009) reaffirmed that the fraud necessary to invalidate a trademark registration must be proven with clear and convincing evidence.

A third party may petition to cancel a registered trademark on the ground that the “registration was obtained fraudulently.” 15 U.S.C. § 1064(3). “Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application.” *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986). A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 1004, 54 C.C.P.A. 1442 (CCPA 1967). Indeed, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (T.T.A.B. 1981).

Id., at 1243 (emphasis added).

The Federal Circuit also made clear that an intent to deceive the USPTO was necessary to invalidate a trademark registration based, in part, on patent cases.

We have previously stated that “[m]ere negligence is not sufficient to infer fraud or dishonesty.” *Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1582 (Fed. Cir. 1991).

We even held that “a finding that particular conduct amounts to ‘gross negligence’ does not of itself justify an inference of intent to deceive.” *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 876 (Fed. Cir. 1988) (*en banc*). The principle that the standard for finding intent to deceive is stricter than the standard for negligence or gross negligence, even though announced in patent inequitable conduct cases, applies with equal force to trademark fraud cases. After all, an allegation of fraud in a trademark case, as in any other case, should not be taken lightly. *San Juan Prods.*, 849 F.2d at 474 (*quoting Anheuser-Busch, Inc. v. Bavarian Brewing Co.*, 264 F.2d 88, 92, 84 Ohio Law Abs. 97 (6th Cir. 1959)). Thus, we hold that a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO.

Subjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis. Of course, “because direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence. But such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement.” *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1366 (Fed. Cir. 2008). When drawing an inference

of intent, “the involved conduct, viewed in light of all the evidence . . . must indicate sufficient culpability to require a finding of intent to deceive.” *Kingsdown*, 863 F.2d at 876.

In re Bose Corp., 580 F.3d at 1244-45 (Emphasis added).

“As The Chief Justice has cogently observed: ‘In a case where the construction of legislative language such as this makes so sweeping and so relatively unorthodox a change as that made here, I think judges as well as detectives may take into consideration the fact that a watchdog did not bark in the night.’” *City of Rancho Palos Verdes v. Abrams*, 544 U.S. 113, 131-32, 125 S. Ct. 1453, 1465 (2005) (Stevens, J., concurring) *quoting Harrison v. PPG Industries, Inc.*, 446 U.S. 578, 602, 64 L. Ed. 2d 525, 100 S. Ct. 1889 (1980) (dissenting opinion). The Petition notes: “The Copyright Office itself further stated that passage of the PRO IP Act “strengthens the intellectual property laws of the United States” and specifically, “it amends section 411 of the copyright law 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*, 12–13 (2008).” Petition, at 10-11 (emphasis added). Thus, at least one watchdog wagged its tail because the “doctrine of fraud” on the Copyright Office was being codified.

Clearly, an intent to defraud the Copyright Office remains necessary to invalidate a copyright registration. Otherwise, Congress and the Copyright Office would have noted that the PRO IP Act was superseding at least the following caselaw: *Torres-*

Negron v. J & N Records, LLC, 504 F.3d 151, 162 (1st Cir. 2007) (“[M]ost errors or mistakes in a copyright registration application will be inadvertent or immaterial, and thus will not invalidate the application.”); *Fonar Corp. v. Domenick*, 105 F.3d 99, 106 (2d Cir. 1997) (“Absent a showing that [plaintiff] defrauded or made a deliberate misrepresentation to the Copyright Office, we think that a presumption of regularity and appropriateness in filing is ordinarily subsumed in the presumption of validity that attaches to a certificate of copyright registration.”); *Gallup, Inc. v. Kenexa Corp.*, 149 F. App’x 94, 96 (3d Cir. 2005) (“[I]t is not clear that even knowing misrepresentations can void a copyright registration where the Register has not relied on them.”); *Bouchat v. Baltimore Ravens, Inc.*, 241 F.3d 350, 357 (4th Cir. 2001) (“Accidental but harmless mistakes in a copyright application do not subsequently preclude an infringement action against an alleged copier.”); *One Treasure Ltd., Inc. v. Richardson*, 202 F. App’x 658, 660 (5th Cir. 2006) (“Courts have repeatedly excused a wide range of errors, like those complained of by the defendant including misidentification of copyright claimant, misclassification of a work, misstatement of work’s author, misstatement of a work’s creation and publication dates, and misstatement that a work is made for hire.”); *Advisers, Inc. v. Wiesen-Hart, Inc.*, 238 F.2d 706, 708 (6th Cir. 1956) (“It is our conclusion, nevertheless, that 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.”); *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329

F.3d 586, 591 (7th Cir. 2003) (“[C]ase law is overwhelming that inadvertent mistakes on registration certificates do not . . . bar infringement actions, unless the alleged infringer has relied to its detriment on the mistake, or the claimant intended to defraud the Copyright Office by making the misstatement.”) (citations omitted); and, *Bouve v. Twentieth Century-Fox Film Corp.*, 122 F.2d 51, 55 (D.C. Cir. 1941) (“nor shall any error in classification invalidate or impair the copyright protection secured under this title”) (emphasis added above).

II. ANOTHER CIRCUIT SPLIT BETWEEN THE NINTH CIRCUIT AND THE ELEVENTH CIRCUIT JUST AROSE REGARDING WHETHER AN INFRINGER CAN RAISE REFERRAL TO THE COPYRIGHT OFFICE UNDER 17 U.S.C. § 411(b)(2) *AFTER TRIAL*

There is a clear circuit split between the Ninth Circuit and the Eleventh Circuit that just arose regarding whether an infringer can raise referral to the Copyright Office under 17 U.S.C. § 411(b)(2) after trial.

In *Unicolors*, the jury found that “*Unicolors* owned a valid copyright in the EH101 artwork, H&M infringed on that copyright by selling the contested skirt and jacket, and H&M’s infringement was willful.” 959 F.3d at 1196. “[F]ollowing the unfavorable verdict, H&M filed a renewed motion for judgment as a matter of law that contended, in relevant part, that *Unicolors*’s ‘400 Registration covering the EH101 work was invalid because *Unicolors* secured the registration by including known inaccuracies in its application for registration.” *Id.* at 1197.

Thus, the Ninth Circuit authorized a defendant infringer to argue after trial (or even during appeal) that “the district court was required to ‘request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register . . . to refuse registration.’ 17 U.S.C. § 411(b)(2).” *Id.* at 1200. “Because the district court did not make the statutorily required request, we remand the case so that the district court can complete this requirement before deciding whether *Unicolors’s* registration is invalid, which would require dismissing *Unicolors’s* claims and entering judgment in favor of H&M.” *Id.* at 1200 (emphasis added).

In contrast, the Eleventh Circuit ruled (after the filing of this Petition) that a defendant infringer could not wait until after trial to “request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register . . . to refuse registration.” 17 U.S.C. § 411(b)(2). The Eleventh Circuit found that the defendant infringer had invited any error or had forfeited the issue by waiting until after trial:

Newstex faults the district court for failing to consult with the Register of Copyrights about the fraud it alleged MidlevelU perpetrated on the Copyright Office, a consultation Newstex contends was required by statute. 17 U.S.C. § 411(b)(2) (providing that the court shall consult with the Register regarding the materiality of inaccurate information on a copyright-registration application “[i]n any case” in which inaccurate information described in section 411(b)(1) is alleged); see *Roberts v. Gordy*, 877 F.3d 1024, 1029 (11th

Cir. 2017) (explaining that section 411(b)(1) codifies the defense of fraud on the Copyright Office). And so, Newstex says, a new trial is warranted.

To the extent that the district court committed any error on this issue, Newstex invited it. *United States v. Brannan*, 562 F.3d 1300, 1306 (11th Cir. 2009). During trial, the district court asked *Newstex* about the statutory procedure for consulting the Register. *Newstex* asked the district court if it could bring an outline of the procedure the following morning. The district court agreed. But *Newstex* never followed up. So it induced the district court to proceed to a verdict and a judgment without consulting the Register. *Cf. Dear v. Q Club Hotel, LLC*, 933 F.3d 1286, 1299 & n.6 (11th Cir. 2019). It may not challenge the purported error now.

Even if Newstex had not invited any error, it forfeited the issue. *Access Now, Inc. v. Sw. Airlines Co*, 385 F.3d 1324, 1331 (11th Cir. 2004). Newstex never mentioned the requirement before trial. When the parties and the district court discussed fraud on the Copyright Office, *Newstex* told the district court that the factual questions underlying its argument should go to the jury and then the district court could decide whether the findings were sufficient to invalidate the registrations—without any mention that the district court must first consult with the Register at any point. *Cf. Dear*, 933 F.3d at 1299. Later, when *MidlevelU* moved for

judgment as a matter of law, *Newstex* again said nothing about the requirement. And *Newstex* did not include this issue in its motion for post-trial relief. Newstex never argued to the district court that it must consult with the Register before either it or the jury considered any issue relating to fraud on the Copyright Office. So we will not consider any argument that the district court erred on that basis. *Id.*

Midlevelu, Inc. v. ACI Info. Grp., 2021 U.S. App. LEXIS 6167, at *25-26 (11th Cir. Mar. 3, 2021) (emphasis added).

This Court should be mindful of flooding the copyright system with “fraud on the Copyright Office” claims where the defendant infringer has not sufficiently alleged or shown a specific intent to deceive the Copyright Office, or even that the infringed work was not registerable. *Kimberly-Clark Corp. v. Johnson & Johnson & Pers. Prods. Co.*, 745 F.2d 1437, 1454 (Fed. Cir. 1984) (“Fraud in the PTO’ has been overplayed, is appearing in nearly every patent suit, and is cluttering up the patent system.”). An *en banc* Federal Circuit noted that “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.” *Therasense, Inc.*, 649 F.3d at 1290 (Emphasis added).

As of the end of fiscal 2019, the Copyright Office Registration Program received 516,713 claims to works

of authorship and closed 611,584.³ The Copyright Office should not be strained and cluttered with belated after trial requests under 17 U.S.C. § 411(b)(2) “to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration” under § 411(b)(2).”

III. CONSTRUING § 411(a) AND § 411(b) TOGETHER, THE COURT SHOULD CLARIFY THAT “INACCURATE INFORMATION” REGARDING AN EXPRESS OR IMPLICIT LEGAL CONCLUSION REGARDING PUBLICATION IS NEVER A GROUND TO REFUSE REGISTRATION UNDER 17 U.S.C. § 411(b)

The copyright application at issue in *Unicolors* was on Form VA. [ER2023]. A copyright registration application for Visual Arts on Form VA⁴ requests both legal conclusions (*e.g.* “First Publication of This Particular Work”) and facts (*e.g.* “Year In Which Creation Of This Work Was Completed”). Express or implied legal conclusions (*e.g.* “first publication” or “group publication”) may be debatable among lawyers, judges and the Copyright Office. Facts, on the other hand, are simply accurate or inaccurate.

With this background, 17 U.S.C. § 411(b) refers to “inaccurate information” in a copyright application or registration (as opposed to erroneous legal conclusions or inaccurate facts):

- (1) A certificate of registration satisfies the requirements of this section and section 412 [17

³ United States Copyright Office Annual Report, Fiscal 2019, at p. 37. <https://www.copyright.gov/reports/annual/2019/ar2019.pdf>

⁴ <https://www.copyright.gov/forms/formva.pdf>

USCS § 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.

(2) In 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.

17 U.S.C. § 411(b) (Emphasis added).

In *Unicolors*, the willful infringer defendant H&M claimed plaintiff's copyright registration contained "known inaccuracies" – a/k/a/ an implicit erroneous legal conclusion regarding group publication of a collection of published works as a single work. "Under the Copyright Act, an author may register a collection of published works 'as a single work,' so that the registrant need pay only one filing fee. 37 C.F.R. § 202.3(b)(4) (effective January 24, 2011)." *Unicolors*, 959 F.3d at 1198. Willful infringer defendant "H&M noted that *Unicolors* used a single copyright registration to register thirty-one separate works, one of which was EH101. But to register a collection of works as a 'single unit' as *Unicolors* did, H&M maintained that the works must have been first sold or offered for sale in some integrated manner." 959 F.3d at 1197-98.

The Ninth Circuit morphed the express legal conclusion on the copyright application of “a January 15, 2011 date of first publication” (*Unicolors*, 959 F.3d at 1196) into an implicit legal conclusion that registration of the thirty-one separate works was sought as part of a published collection as a single work copyright. From a materiality standpoint, the district court and the Ninth Circuit appear satisfied that the infringed EH101 artwork was published on January 15, 2015 as expressly stated on the copyright application. 59 F.3d at 1196. So ultimately defendant infringer H&M sought to invalidate plaintiff’s copyright registration based upon implicit erroneous legal conclusions regarding artwork that was not even alleged to be infringing.

Emphasizing that the issue was a legal conclusion, the *Unicolors* court acknowledged that the Ninth Circuit “never previously addressed what it means to publish multiple works as a ‘single unit.’” 959 F.3d at 1197-98. Like an *ex post facto* law, the Ninth Circuit added a new “bundled unit” requirement that was never in existence at the time plaintiff filed its copyright application.⁵ As discussed in the Petition at 17-21, the Ninth Circuit did not rely on the old *Copyright Compendium II* in effect from 1988 to 2017 when the copyright application was filed (which supports registration and does not refer to “bundling”), but rather relied upon the current

⁵ See *Opati v. Republic of Sudan*, 140 S. Ct. 1601, 1607 (2020) (“No doubt, reasons like these are exactly why the Constitution discourages retroactive lawmaking in so many ways, from its provisions prohibiting *ex post facto* laws, bills of attainder, and laws impairing the obligations of contracts, to its demand that any taking of property be accompanied by just compensation.”).

Copyright Compendium III that does refer to “bundling.” As discussed above, “when there are multiple reasonable inferences that may be drawn, intent to deceive cannot be found.” *Therasense, Inc.*, 649 F.3d at 1290-91.

The Copyright Office recently acknowledged continued confusion regarding the distinction between published and unpublished works.⁶ The Office confirmed this issue by describing it as “so complex and divergent from an intuitive and colloquial understanding of the terms that it serves as a barrier to registration.”⁷ This barrier is decidedly not what was envisioned by the creation of the Copyright Act. The Office continues, “[v]arious individuals and groups have repeatedly expressed frustration to the Office regarding difficulty in determining whether a work has been published when completing copyright application forms.”⁸

Copyright legal scholar Melville Nimmer notes that there is still the lack of a clear definition of what publication means and how courts should interpret it.⁹ Nimmer states publication usually occurs when “by consent of the copyright owner the tangible copies are sold, leased, loaned, given away, or otherwise made

⁶ 84 Federal Register 66328 (Dec. 4, 2019 Notification of Inquiry/Proposed Rules).

⁷ *Id.*

⁸ *Id.*

⁹ Melville B. Nimmer, *Copyright Publication*, 56 COLUM. L. REV. 185, 187 (1956), <https://www-jstor-org.proxy.libraries.smu.edu/stable/pdf/1119728.pdf?refreqid=excelsior%3Af46b67e310c838eab689c735d400f037>.

available to the general public.”¹⁰ He further suggests there is ambiguity within the meaning of publication that makes it extremely difficult to determine how “comprehensive and unrestricted” the disposition must be “in order to constitute public disposition.”¹¹ He suggests that it is difficult, for example, to determine whether a television network distributing prints of its films to different stations that generally televise all network programs constitutes distribution to the general public.¹²

Although it is without question that there are competing “statutory and case law definitions of [the term] publication,”¹³ the Ninth Circuit metes out extreme punishment on the copyright creator when a court sides with an alleged infringer regarding whether a work was “published.” In *Unicolors*, the Ninth Circuit vacated a substantial judgment against the willful infringer defendant based upon an erroneous (or at least debatable) implicit legal conclusion regarding registration of collection of published works as a single unit. The *Unicolors* court relied on its earlier opinion *Gold Value Int’l Textile, Inc. v. Sanctuary Clothing, LLC*, 925 F.3d 1140, 1144 (9th Cir. 2019), *cert denied* 140 S. Ct. 1294 where the Ninth Circuit sided with the infringer that a work was “published” and rejected the copyright creator’s good faith arguments that the work was “unpublished”

¹⁰ *Id.*

¹¹ *Id.*

¹² *Id.* at 198.

¹³ Thomas F. Cotter, *Toward A Functional Definition of Publication in Copyright Law*, 92 MINN. L. REV. 1724, 1784 (2008).

which resulted in the court: (1) invalidating the copyright registration for the work on the ground the work was “published” not “unpublished”; (2) dismissing of the creator’s infringement action based upon an error in the copyright registration regarding “unpublished”; and, (3) awarding of over \$120,000.00 to the infringer based upon a copyright registration technicality. *Gold Value*, 925 F.3d at 1148. Citing *Gold Value*, the Copyright Office recently noted the dire “consequences an applicant may face if it incorrectly indicates on an application for a copyright registration that the work at issue is unpublished.”¹⁴ Thus, the end result is “gotcha” allegations by infringers who challenge published works were unpublished (*Unicolors*) or challenge unpublished works were published (*Gold Value*).

At least one court has criticized the *Gold Value* opinion relied upon by *Unicolors* and ruled that “[a]bsent binding law or even a clear consensus in case law supporting the assertion that material is ‘published’ . . . the Court cannot conclusively find that Plaintiff was dishonest when it stated that the text was ‘unpublished’ when it submitted its application to the Copyright Office.” *Internet Prods. LLC v. LLJ Enters.*, 2020 U.S. Dist. LEXIS 220090, at *13 (D.N.J. Nov. 24, 2020).

As a matter of law, an infringed copyrighted “work” within the meaning of 17 U.S.C. § 411(a) was either published or unpublished at the time that a copyright application for registration is filed. However, the legal conclusion of whether an infringed “work” was published or unpublished or published as a

¹⁴ 84 Federal Register 66330 (12/4/19 Notification of Inquiry)

single unit collection is completely immaterial to whether the “work” is registerable.

In an infringement action, the legal conclusion of whether an infringed “work” under 17 U.S.C. § 411(a) was published or unpublished or published as a single unit collection is relevant to whether 17 U.S.C. § 412 allows the recovery of statutory damages or attorney fees.

With the above in mind, the Court should grant the Petition to interpret 17 U.S.C. § 411(b) to provide much needed clarity on invalidation of a copyright registration based upon an alleged erroneous legal conclusion regarding publication. Such clarifications could include:

1. Recognizing that whether an infringed “work” under 17 U.S.C. § 411(a) is published or unpublished or published as collection as a single unit are all legal conclusions. There has been and will be in the future good faith debate among courts, scholars, and the Copyright Office regarding the legal conclusion of publication that this Court can never completely clarify given the myriad of factual situations encompassed in over 38,861,134 copyright registrations.¹⁵
2. Reading § 411(a) regarding an infringed “work” and § 411(b) together, an infringer must allege invalidation of copyright registration based upon “inaccurate information” as to that infringed “work.” The district court

¹⁵ United States Copyright Office Annual Report, Fiscal 2019, at p. 37. <https://www.copyright.gov/reports/annual/2019/ar2019.pdf>.

should act as a gatekeeper to strike or grant judgment on the pleadings as to an infringer's allegations of "inaccurate information" as to works not claimed to be infringed. In *Unicolors*, there was no dispute that the infringed "work" (EH101) was valid and was first published on January 15, 2011, so the infringer's allegations under § 411(b) were ripe to be struck or adjudged without merit.

3. Reading § 411(a) regarding an infringed "work" and § 411(b) together, an infringer's claimed "inaccurate information" under § 411(b) regarding the legal conclusion of publication of an infringed "work" will never justify refusal of registration for that "work" because both published and unpublished works can be registered. As a result, there will never be a situation under § 411(b)(2) where the Copyright Office could "refuse registration" on publication grounds alone, so the district court would never have to "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" under § 411(b)(2). This helps prevent a cluttering of the copyright system and the courts.
4. In the event a "request [to] the Register of Copyrights to advise" under § 411(b)(2) is otherwise appropriate, then the infringer must make a motion to the district court to make such a request before any trial. Before any such request to the Copyright Office, the district court should act as a gatekeeper to

strike or grant judgment on the pleadings as to any insufficient allegations of intent to deceive the Copyright Office under § 411(b)(1)(A).

5. Although whether an infringed work is published or unpublished is a legal conclusion, a district court has the power under § 412 to make any legal determinations regarding publication necessary to determine a copyright owner's right to attorney fees or statutory damages. For instance, if the infringer establishes that, contrary to the first publication date in the registration, the infringed "work" (EH101) had an "effective date of registration" more than "3 months after the first publication," then the district court could disallow statutory damages and attorney fees under § 412. In *Unicolors*, the defendant infringer made no such claim.



CONCLUSION

For the reasons set forth above, amici join Petitioners in respectfully requesting that the Court grant the petition for a writ of certiorari.

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