

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 PETITIONER**

---

Scott Alan Burroughs  
Stephen M. Doniger  
Trevor W. Barrett  
DONIGER/BURROUGHS PC  
603 Rose Avenue  
Venice, CA 90291

Thomas M. Bondy  
Lauren A. Weber  
ORRICK, HERRINGTON &  
SUTCLIFFE LLP  
1152 15th Street, N.W.  
Washington, D.C. 20005

E. Joshua Rosenkranz  
*Counsel of Record*  
Christopher J. Cariello  
Jennifer Keighley  
Joseph R. Kolker  
Katherine Kerrick  
ORRICK, HERRINGTON &  
SUTCLIFFE LLP  
51 West 52nd Street  
New York, NY 10019  
(212) 506-5000  
jrosenkranz@orrick.com

*Counsel for Petitioner*

---

**QUESTION PRESENTED**

Section 411(a) of the Copyright Act requires a copyright holder to apply for and obtain a copyright registration before initiating an infringement lawsuit. Such applications often contain inaccuracies. But § 411(b)(1) provides that “inaccurate information” is not a basis for challenging a registration’s validity unless the inaccuracy “was included ... with knowledge that it was inaccurate” and “would have caused the Register of Copyrights to refuse registration.”

The question presented is whether that “knowledge” element precludes a challenge to a registration where the inaccuracy resulted from the applicant’s good-faith misunderstanding of a principle of copyright law?

## TABLE OF CONTENTS

	<b>Page</b>
QUESTION PRESENTED .....	i
TABLE OF AUTHORITIES .....	iv
OPINIONS BELOW.....	1
JURISDICTION.....	1
STATUTORY PROVISIONS INVOLVED .....	1
INTRODUCTION .....	2
STATEMENT OF THE CASE.....	5
Congress Abolishes Mandatory Registration While Relaxing Copyright Formalities .....	5
Unicolors Designs And Registers A Collection Of Fabric Artwork And H&M Willfully Infringes .....	9
H&M Challenges Unicolors’ Copyright Registration.....	13
SUMMARY OF THE ARGUMENT.....	18
ARGUMENT .....	22
Under § 411(b), An Applicant Who Makes An Innocent Mistake Of Law Does Not Have “Knowledge” That The “Information” Is “Inaccurate.” .....	22

A. The text of § 411(b)(1)(A) requires subjective awareness of the inaccuracy, which is not satisfied when the applicant makes an innocent mistake.....	24
B. Section 411(b) codified the common-law rule that a good-faith mistake—including a mistake of law—cannot be a basis for challenging a copyright registration.....	31
C. When a statute requires “knowledge” of a circumstance with factual and legal components, a mistake of law is a defense.....	40
D. Congress could not have intended a rule that would so severely override copyright holders’ rights and remedies and disrupt infringement litigation. ....	44
CONCLUSION.....	53
ADDENDUM	

## TABLE OF AUTHORITIES

	<b>Page(s)</b>
<b>Cases</b>	
<i>Advisers, Inc. v. Wiesen-Hart, Inc.</i> , 238 F.2d 706 (6th Cir. 1956).....	32, 34, 35
<i>Archie MD, Inc. v. Elsevier, Inc.</i> , 261 F. Supp. 3d 512 (S.D.N.Y. 2017) .....	45
<i>Billy-Bob Teeth, Inc. v. Novelty, Inc.</i> , 329 F.3d 586 (7th Cir. 2003).....	34, 35
<i>Bouchat v. Balt. Ravens, Inc.</i> , 241 F.3d 350 (4th Cir. 2001).....	33, 36
<i>Bruhn NewTech, Inc. v. United States</i> , 144 Fed. Cl. 755 (2019).....	48
<i>Bryan v. United States</i> , 524 U.S. 184 (1998).....	41, 43
<i>Budget Cinema, Inc. v. Watertower Assocs.</i> , 81 F.3d 729 (7th Cir. 1996).....	49
<i>Christensen v. Harris County</i> , 529 U.S. 576 (2000).....	31
<i>Data Gen. Corp. v. Grumman Sys. Support Corp.</i> , 36 F.3d 1147 (1st Cir. 1994) .....	33
<i>Davis v. Mich. Dep't of Treasury</i> , 489 U.S. 803 (1989).....	20, 31, 37

<i>DeliverMed Holdings, LLC v. Schaltenbrand</i> , 734 F.3d 616 (7th Cir. 2013).....	37, 50
<i>Donald Frederick Evans &amp; Assocs., Inc. v. Cont'l Homes, Inc.</i> , 785 F.2d 897 (11th Cir. 1986).....	33
<i>Duncan v. Blackbird Prods. Grp., LLC</i> , No. 17-03404-CV-S-BP (W.D. Mo. Apr. 15, 2021).....	47
<i>Eckes v. Card Prices Update</i> , 736 F.2d 859 (2d Cir. 1984).....	33, 36, 37
<i>Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.</i> , 499 U.S. 340 (1991).....	52
<i>Fischer v. Forrest</i> , 968 F.3d 216 (2d Cir. 2020).....	49
<i>Fourth Est. Pub. Ben. Corp. v. Wall-Street.com, LLC</i> , 139 S. Ct. 881 (2019).....	7, 51
<i>Glob.-Tech Appliances, Inc. v. SEB S.A.</i> , 563 U.S. 754 (2011).....	26
<i>Golan v. Holder</i> , 565 U.S. 302 (2012).....	39
<i>Gold Value Int'l Textile, Inc. v. Sanctuary Clothing, LLC</i> , 925 F.3d 1140 (9th Cir. 2019).....	41, 48, 50

<i>Mississippi ex rel. Hood v. AU Optronics Corp.</i> , 571 U.S. 161 (2014).....	26
<i>Isbrandtsen Co. v. Johnson</i> , 343 U.S. 779 (1952).....	38
<i>Joe Mittenhal, Inc. v. Irving Berlin, Inc.</i> , 291 F. 714 (S.D.N.Y. 1923) .....	32
<i>Kay Berry, Inc. v. Taylor Gifts, Inc.</i> , 421 F.3d 199 (3d Cir. 2005) .....	15
<i>Kingsdown Med. Consultants, Ltd. v. Hollister, Inc.</i> , 863 F.2d 867 (Fed. Cir. 1988) .....	39
<i>Kirtsaeng v. John Wiley &amp; Sons, Inc.</i> , 568 U.S. 519 (2013).....	20, 37, 48
<i>Lamps Plus, Inc. v. Seattle Lighting Fixture Co.</i> , 345 F.3d 1140 (9th Cir. 2003).....	32, 36
<i>Liparota v. United States</i> , 471 U.S. 419 (1985).....	42, 43
<i>Masquerade Novelty, Inc. v. Unique Indus., Inc.</i> , 912 F.2d 663 (3d Cir. 1990) .....	33, 37
<i>Matrix Int’l Textile, Inc. v. Monopoly Textile, Inc.</i> , No. CV160084, 2017 WL 5654794 (C.D. Cal. May 12, 2017) .....	47

<i>McFadden v. United States</i> , 576 U.S. 186 (2015).....	42
<i>McLaughlin v. Richland Shoe Co.</i> , 486 U.S. 128 (1988).....	40
<i>Novelty Textile, Inc. v. Windsor Fashions, Inc.</i> , No. CV12-05602, 2013 WL 12114062 (C.D. Cal. Aug. 12, 2013).....	47
<i>Original Appalachian Artworks, Inc. v. Toy Loft, Inc.</i> , 684 F.2d 821 (11th Cir. 1982).....	32, 33, 36
<i>Petrella v. Metro-Goldwyn-Mayer, Inc.</i> , 572 U.S. 663 (2014).....	48
<i>Raquel v. Educ. Mgmt. Corp.</i> , 196 F.3d 171 (3d Cir. 1999).....	33
<i>Reed Elsevier, Inc. v. Muchnick</i> , 559 U.S. 154 (2010).....	7, 33
<i>Rehaif v. United States</i> , 139 S. Ct. 2191 (2019).....	41
<i>Roberts v. Gordy</i> , 877 F.3d 1024 (11th Cir. 2017).....	30, 37, 45
<i>Robi v. Five Platters, Inc.</i> , 918 F.2d 1439 (9th Cir. 1990).....	39
<i>Safeco Ins. Co. of Am. v. Burr</i> , 551 U.S. 47 (2007).....	40



<i>Samantar v. Yousuf</i> , 560 U.S. 305 (2010).....	38
<i>SellPoolSuppliesOnline.com, LLC v. Ugly Pools Arizona, Inc.</i> , 804 F. App'x 668 (9th Cir. 2020) .....	48
<i>Serv. &amp; Training, Inc. v. Data Gen. Corp.</i> , 963 F.2d 680 (4th Cir. 1992).....	36
<i>Star Athletica, L.L.C. v. Varsity Brands, Inc.</i> , 137 S. Ct. 1002 (2017).....	24
<i>Therasense, Inc. v. Becton, Dickinson &amp; Co.</i> , 649 F.3d 1276 (Fed. Cir. 2011).....	39
<i>Thomas Wilson &amp; Co. v. Irving J. Dorfman Co.</i> , 433 F.2d 409 (2d Cir. 1970) .....	36
<i>Three Boys Music Corp. v. Bolton</i> , 212 F.3d 477 (9th Cir. 2000).....	36
<i>Turner &amp; Dahnken v. Crowley</i> , 252 F. 749 (9th Cir. 1918).....	33
<i>Unicolors v. Urban Outfitters, Inc.</i> , 853 F.3d 980 (9th Cir. 2017).....	46
<i>United States v. Backer</i> , 134 F.2d 533 (2d Cir. 1943) .....	32
<i>United States v. U.S. Gypsum Co.</i> , 438 U.S. 422 (1978).....	25

*Urantia Found. v. Maaherra*,  
114 F.3d 955 (9th Cir. 1997).....34

*Washingtonian Pub. Co. v. Pearson*,  
306 U.S. 30 (1939).....8, 32, 49, 51

### **Constitutional Provisions**

U.S. Const. art. I, § 8, cl. 8.....52

### **Treaties, Statutes & Regulations**

7 U.S.C. § 2024(b)(1) .....43

15 U.S.C. § 1064(3).....39

### **Copyright Act**

17 U.S.C. § 101.....29, 45, 46

17 U.S.C. § 110(1) .....26

17 U.S.C. § 110(2) .....26

17 U.S.C. § 408.....7

17 U.S.C. § 408(d) .....49, 52

17 U.S.C. § 409.....7, 19, 27

17 U.S.C. § 409(1) .....27

17 U.S.C. § 409(4) .....28

17 U.S.C. § 409(5) .....28

17 U.S.C. § 409(6) .....28

17 U.S.C. § 409(9) .....	28
17 U.S.C. § 409(10) .....	28
17 U.S.C. § 410.....	7
17 U.S.C. § 411.....	7, 50
17 U.S.C. § 411(a) .....	7, 50
17 U.S.C. § 411(b) .....	<i>passim</i>
17 U.S.C. § 411(b)(1).....	8, 9, 24
17 U.S.C. § 411(b)(1)(A).....	<i>passim</i>
17 U.S.C. § 411(b)(2).....	9, 18, 51
17 U.S.C. § 412.....	7,8, 24, 49
17 U.S.C. § 504(c)(2) .....	26
17 U.S.C. § 505.....	49
17 U.S.C. § 506(a)(1)(C).....	26
17 U.S.C. § 506(e) .....	29
17 U.S.C. § 507.....	48
17 U.S.C. § 1401(c)(1)(6).....	26
18 U.S.C. § 922(g).....	41
18 U.S.C. § 924(a)(2) .....	41

Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, <i>as last revised</i> , Paris, July 24, 1971, Art. 5(2), 1161 U.N.T.S. 3, S. Treaty Doc. No. 99-273 .....	39
Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 .....	38
Copyright Act of 1790, Pub. L. No. 1-15, 1 Stat. 124 .....	6
Copyright Act of 1909, Pub. L. No. 60- 349, 35 Stat. 1075 .....	7, 8, 32, 44
PRO-IP Act, Pub. L. No. 110-403 (2008) .....	3
37 C.F.R. § 202.3(4) .....	15
37 C.F.R. § 202.3(b)(4) .....	47
<b>Other Authorities</b>	
Howard B. Abrams & Tyler T. Ochoa, <i>Law of Copyright</i> (2020 ed.) .....	34
Annual Report of the Register of Copy- rights, Fiscal Year Ending Septem- ber 30, 2008 (2008), <a href="https://tinyurl.com/d2x94cr5">https://tinyurl.com/d2x94cr5</a> .....	9, 37
<i>Black's Law Dictionary</i> (11th ed. 2019) .....	25, 26

Jane C. Ginsburg, <i>The U.S. Experience with Mandatory Copyright Formalities: A Love/Hate Relationship</i> , 33 Colum. J.L. & Arts 311 (2010).....	6
Paul Goldstein, <i>Goldstein on Copyright</i> (2021).....	36
H. Comm. on Judiciary, 87th Cong., 1st Sess., Rep. of the Register of Copyrights on the General Revision of the U.S. Copyright Law (Comm. Print 1961), <a href="https://tinyurl.com/mkwuc7sw">https://tinyurl.com/mkwuc7sw</a> .....	6
H.R. Rep. No. 60-2222 (1909) .....	6, 45
H.R. Rep. No. 110-617 (2008) .....	9, 38, 45, 52
Benjamin Kaplan, S. Comm. on the Judiciary, Subcomm. on Patents, Trademarks, & Copyrights, 86th Cong., <i>The Registration of Copyright, Copyright Office Study No. 17</i> (Comm. Print 1958), <a href="https://tinyurl.com/46bmx35b">https://tinyurl.com/46bmx35b</a> .....	5
Wayne R. LaFare, <i>Substantive Criminal Law</i> (3d ed. 2020).....	41
<i>Merriam-Webster's Collegiate Dictionary</i> (11th ed. 2006) .....	25
Model Penal Code (Am. L. Inst. 2021) .....	26, 42

Melville B. Nimmer & David Nimmer, 2 <i>Nimmer on Copyright</i> (2021).....	8, 34, 37, 38
Response of the Register of Copyrights, <i>Fashion Ave. Sweater Knits, LLC v. Poof Apparel Corp.</i> , No. 2:19-cv- 06302 (C.D. Cal. Feb. 8, 2021), Dkt. 129-1 .....	31
Thorvald Solberg, Library of Congress, <i>Report on Copyright Legislation</i> (1904).....	6
Stanford Law School Law and Policy Lab Copyright Licensing Practicum, <i>Revising the Requirements for Software Registration</i> (2017-2018), <a href="https://tinyurl.com/4dxbx8nb">https://tinyurl.com/4dxbx8nb</a> .....	46
U.S. Copyright Office, Compendium of U.S. Copyright Office Practices (2d ed. 1988).....	15
U.S. Copyright Office, Compendium of U.S. Copyright Office Practices (3d ed. 2017).....	46
U.S. Copyright Office, Online Publication, 84 Fed. Reg. 66,328-01 (Dec. 4, 2019).....	44, 45
U.S. Copyright Office, Registration Modernization, 85 Fed. Reg. 12,704- 01 (Mar. 3, 2020).....	46

*Webster's Third New International  
Dictionary (2002) .....27*

## **OPINIONS BELOW**

The opinion of the Court of Appeals is reported at 959 F.3d 1194 and reprinted at Pet. App. 1a-15a. The order of the Court of Appeals denying the petition for rehearing en banc is unreported and reprinted at Pet. App. 134a-35a. The district court's unpublished opinion is available at 2018 WL 10307045 and reprinted at J.A. 175-202.

## **JURISDICTION**

The Ninth Circuit entered judgment on May 29, 2020 and entered its order denying the petition for rehearing on August 7, 2020. The petition for a writ of certiorari was filed on January 4, 2020 and granted on June 1, 2021. This Court has jurisdiction under 28 U.S.C. § 1254(1).

## **STATUTORY PROVISIONS INVOLVED**

Section 411(b) of the Copyright Act, 17 U.S.C. § 411(b), provides in pertinent part:

(1) A certificate of registration satisfies the requirements of this section and section 412, regardless of whether the certificate contains any inaccurate information, unless—

(A) the inaccurate information was included on the application for copyright registration with knowledge that it was inaccurate; and



(B) the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration.

(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.

Other relevant provisions of the Copyright Act, and a regulation promulgated thereunder, are reproduced in the addendum to this brief.

## INTRODUCTION<sup>1</sup>

This case is about whether Congress intended to depart from a century of precedent and start penalizing poets and artists for innocent mistakes in copyright registrations.

Across the half-a-million registration applications that artists and authors submit each year, mistakes abound. The registration form may look simple. But the reality for many authors, from sophisticated publishing houses to TikTok influencers, is that the process is beset by snags. Backroom mix-ups yield typos, factual errors, and basic mistakes in, say, the titles of works or their dates of creation. And lay applicants

---

<sup>1</sup> The Joint Appendix, Petition Appendix, and Addendum are cited as “J.A.,” “Pet. App.,” and “Add.” Unless otherwise specified, cites to statutory provisions are to the Copyright Act, codified at Title 17 of the U.S. Code.

inject errors for failure to appreciate the nuances of statutory terms like “publication,” “derivative work,” or “work made for hire”—legal quagmires on which entire chapters of treatises are written and rewritten as the law evolves. Innocent mistakes in copyright registrations are, and always have been, inevitable.

But innocent mistakes are not a defense to claims of copyright infringement. More than a century ago, the courts established the “fraud on the Copyright Office” doctrine. Although courts expressed the doctrine in various ways, they have never wavered from the doctrine’s central premise: An accused infringer could not defeat an infringement suit on the basis of an innocent mistake in the copyright registration. That was true whether the inaccuracy was attributable to the applicant’s misapprehension of facts or law.

In 2008, Congress codified this doctrine in the Prioritizing Resources and Organization for Intellectual Property—or PRO-IP—Act, Pub. L. No. 110-403 (2008). It created a safe harbor establishing that registration authorizes a copyright infringement suit “regardless of whether the certificate contains any inaccurate information, unless ... the inaccurate information was included ... *with knowledge that it was inaccurate.*” § 411(b)(1)(A) (emphasis added). At issue here is whether that provision means what it says, and says what a century’s worth of case law held before it: Innocent mistakes are never enough to challenge a copyright registration.

The text of the provision leaves no doubt. The plain meaning of the phrase “with knowledge” requires an applicant to possess awareness that infor-

mation “included” on a copyright application is inaccurate. The phrase is untempered by textual modifiers that would suggest any type of objective or constructive knowledge standard. And the law presumes that Congress did not abandon the common-law fraud-on-the-Copyright-Office doctrine without clearly indicating that intention.

As for the wisdom underlying the rule, leave aside history and logic—just look at this case. Unicolors sued H&M for a brazen act of infringement. H&M willfully copied Unicolors’ copyrighted fabric design stitch-for-stitch—as a unanimous jury swiftly found.

Only after the jury verdict did H&M assert that the whole litigation was a waste. It argued that the registration for the fabric design at issue also covered other fabric designs, and that it was legally improper to include some of those designs on the same application. H&M offered no evidence that Unicolors had knowledge that it was impermissible to list the designs together—a practice Unicolors had employed, unproblematically, many times before and that was consistent with contemporaneous guidance and precedent. The alleged inaccuracy had nothing to do with H&M, its rights, or its notice of ownership. Nor did it change the reality that H&M clearly stole Unicolors’ artwork. But the Ninth Circuit held that as long as Unicolors had knowledge of the *factual* circumstances underlying the creation and sale of its designs, it did not matter how ardently Unicolors believed that the application was legally permissible, or how reasonable that belief was.

Section 411(b)(1)(A) is not supposed to be a Get Out Of Jail Free card. And the PRO-IP Act was not about letting willful infringers skate on technicalities. Section 411(b)(1)(A)'s equitable defense exists only to prevent copyright plaintiffs from profiting by knowingly abusing the copyright system. Turning the defense into a game of litigation gotcha will scuttle the intellectual property rights of countless legitimate copyright holders, with no countervailing benefits.

This Court should adopt the only interpretation of § 411(b)(1)(A) supported by that provision's text and a century of legal tradition. Copyright applicants must endeavor to comply with registration requirements in good faith. But innocent mistakes—whether characterized as legal or factual—cannot be penalized for the benefit of infringers. The Ninth Circuit's decision should be reversed.

## STATEMENT OF THE CASE

### ***Congress Abolishes Mandatory Registration While Relaxing Copyright Formalities***

Historically, the English and American copyright systems had subjected copyright protection to numerous, often hypertechnical, “formalities”—official prerequisites to securing copyright protection. *See generally* Benjamin Kaplan, S. Comm. on the Judiciary, Subcomm. on Patents, Trademarks, & Copyrights, 86th Cong., *The Registration of Copyright, Copyright Office Study No. 17* (Comm. Print 1958), <https://tinyurl.com/46bmx35b>. Among them was mandatory copyright registration, which required authors to record their ownership of works in a central regis-

try as a condition of acquiring exclusive rights. Copyright Act of 1790, Pub. L. No. 1-15, § 1, 1 Stat. 124. A registry gives the public “the means of determining the status and ownership of copyright claims.” H. Comm. on Judiciary, 87th Cong., 1st Sess., Rep. of the Register of Copyrights on the General Revision of the U.S. Copyright Law 6 (Comm. Print 1961), <https://tinyurl.com/mkwuc7sw>. This, in turn, facilitates purchase, licensing, and use of copyrighted works, ultimately helping artists and the public alike realize the value of society’s creative output.

Under the 1790 Act, courts enforced various registration formalities with a vengeance. Minor errors on a registration application could invalidate the registration and defeat an author’s rights. At the turn of the 20th century, the Register of Copyrights lamented that “a system has gradually grown up under which valuable literary property rights have come to depend upon exact compliance with the[] statutory formalities which have no relation to the equitable rights involved.” Thorvald Solberg, Library of Congress, *Report on Copyright Legislation* 25 (1904). A few years later, a House Report raised alarms that “[t]he failure of a shipping clerk ... may destroy a copyright of great value,” noting that “many copyrights have been lost ... by some accident or mistake.” H.R. Rep. No. 60-2222, at 11 (1909). The “extent and complexity” of registration formalities “often prov[ed] a trap for the unwary.” Jane C. Ginsburg, *The U.S. Experience with Mandatory Copyright Formalities: A Love/Hate Relationship*, 33 Colum. J.L. & Arts 311, 322 (2010).

The Copyright Act of 1909 was a sea change. Congress eliminated registration as a condition to acquiring exclusive rights. Pub. L. No. 60-349, § 12, 35 Stat. 1075, 1078. The modern rule is that “[a]n author gains ‘exclusive rights’ in her work immediately upon the work’s creation.” *Fourth Est. Pub. Ben. Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881, 887 (2019). Copyright protection does not depend on completing any further task or obtaining any further permission.

Instead, the registration system operates through a set of “remedial incentives to encourage copyright holders to register their works.” *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 158 n.1 (2010); see §§ 408-12. Most significantly, § 411(a) provides that “no civil action for infringement ... shall be instituted until pre-registration or registration of the copyright claim has been made.” See generally *Fourth Est.*, 139 S. Ct. 881.

Beyond being a prerequisite to filing an infringement claim, the validity and timing of registration have significant consequences for the ensuing lawsuit. Most notable is the effect on statutory damages and attorneys’ fees—two remedies critical to effective enforcement of copyrights. Both remedies are generally unavailable unless a valid registration was in place when the infringer started infringing. § 412. Moreover, registration “made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the [registration] certificate,” § 410—a significant evidentiary benefit in litigation.

The courts quickly recognized that the 1909 Act had effected a “complete revision of the copyright laws ... intended definitely to grant valuable, enforceable rights to authors, publishers, etc. without burdensome requirements.” *Washingtonian Pub. Co. v. Pearson*, 306 U.S. 30, 36 (1939). They followed Congress’s lead and relaxed the other strictures of registration. “The courts generally have been most lenient, under both the 1909 Act and the current Act, with respect to any innocent error contained in an application for a registration certificate.” Melville B. Nimmer & David Nimmer, 2 *Nimmer on Copyright* § 7.20[B][1] (2021). Courts reached a universal consensus that “a misstatement or clerical error in the registration application, if unaccompanied by fraud, should neither invalidate the copyright nor render the registration certificate incapable of supporting an infringement action.” *Id.* This judge-made doctrine came to be known as “fraud on the Copyright Office.”

In 2008, it was Congress’s turn to follow the courts’ lead, completing the journey away from ancient strictures by adding a new provision, § 411(b), to the Copyright Act. That provision limited the circumstances in which “inaccurate information” can invalidate a copyright registration. Section 411(b)(1) is structured as a safe harbor for copyright holders. It provides that “[a] certificate of registration satisfies the requirements of this section and section 412, regardless of whether the certificate contains any inaccurate information, unless” two conjunctive requirements are met: (A) the “inaccurate information” on the “certificate” was “included on the application ... 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.” § 411(b)(1).

Congress also added a new procedural innovation: “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.” § 411(b)(2). In other words, Congress did not want a court deciding whether an error would have been material to the Copyright Office without consulting the source.

The Copyright Office described what was obvious from the text and structure: § 411(b) “codif[ied] the doctrine of fraud on the Copyright Office.” Annual Report of the Register of Copyrights, Fiscal Year Ending September 30, 2008, at 13 (2008), <https://tinyurl.com/d2x94cr5>. Congress explained that the goal was “[t]o prevent intellectual property thieves” from escaping liability by way of “a mistake in the registration documents,” such as “checking the wrong box on the registration form.” H.R. Rep. No. 110-617, at 24 (2008).

***Unicolors Designs And Registers A Collection Of Fabric Artwork And H&M Willfully Infringes***

Unicolors is a Los Angeles-based company that designs and manufactures fabrics. It markets its artwork to apparel manufacturers for use in clothes. Pet. App. 4a. Because its success depends on producing trendy and attractive fabrics, Unicolors invests heav-



ily in its design team. J.A. 50-51. And to protect that investment, Unicolors relies on the copyright system.

In December 2010, a Unicolors designer named Hannah Lim developed artwork for a fabric design:



J.A. 41, 230. Lim envisioned the pattern as a “landscape” from the perspective of someone “looking ... into nature.” J.A. 41. And she “drew each of the[] elements by hand.” J.A. 43. Unicolors designated the design “EH101.” Pet. App. 5a.

EH101 was part of a collection of 31 works of art that Unicolors launched on January 15, 2011, when it

presented the collection to its sales team and released it to its showroom. J.A. 58, 69. In February 2011, Unicolors submitted an application for copyright registration for all 31 designs in its January collection. *Id.*; Add. 33a.<sup>2</sup> The Copyright Office granted the application and issued a certificate of registration for the collection. J.A. 227-31.

H&M is one of the biggest clothing companies in the world, with hundreds of retail stores in the United States. Pet. App. 6a. In 2015, it began selling a jacket and skirt with a design virtually identical to EH101 (albeit in black and white). *Id.* The copying was blatant. H&M, without payment or consent, had plagiarized Unicolors' copyrighted design "row by row, layer by layer," *id.*, as is evident from this side-by-side overlay of the two designs:

---

<sup>2</sup> In challenging the registration, H&M did not make the application form part of the record. But the contents of the application are undisputed. For the Court's convenience and by the parties' agreement, the application is reproduced in the addendum to this brief (at 33a-43a). The addendum excerpts the submitted form only, but not the deposits of materials.



*Compare J.A. 232 (H&M jacket) with J.A. 233 (Unicolors fabric).*

Unicolors sued for copyright infringement. H&M's defense was so tenuous as to beggar belief. Heading into trial, H&M claimed that it never knew about, and did not copy, EH101. In an amazing coincidence, a Chinese entity named Shaoxing DOMO Apparel Co., Ltd. had come up with the exact same design. J.A. 160-61. Virtually on the eve of trial, H&M's counsel, purporting to represent DOMO, sought and obtained a copyright registration in H&M's version of EH101. The district court ultimately excluded the registration as an improper attempt to "manufacture" a presumption that DOMO had created the pattern. J.A. 34-35. H&M then advised the district court that it planned to call a DOMO

employee at trial to testify to creation of the work. J.A. 12-17. A bit of sleuthing revealed that the “employee” was in fact the CEO of a different company that does business with H&M. J.A. 25-29. So H&M withdrew the witness. Ultimately, H&M called not a single live witness at trial to attest to its DOMO-created-the-art-work story or to otherwise explain to the jury how H&M came to sell a jacket with a design virtually identical to EH101.

Unsurprisingly, the jury found that H&M had willfully infringed Unicolors’ copyright. Pet. App. 16a-18a. It found the infringement damaging enough to award \$846,720. Pet. App. 18a. The district court eventually reduced the award on remittitur to \$266,209.33. Pet. App. 6a. It also awarded Unicolors attorneys’ fees and costs. Pet. App. 6a-7a.

### ***H&M Challenges Unicolors’ Copyright Registration***

Then came the ambush. In the nearly two years leading up to trial, H&M never questioned the validity of Unicolors’ copyright registration. Only after the jury found H&M to be a willful infringer did H&M challenge the registration’s validity in a post-trial motion.

H&M’s argument was pure technicality. H&M did not contest that EH101 was worthy of copyright protection. It did not dispute that Unicolors authored and owned the copyright. It did not even suggest that any error on the application pertained to EH101. Instead, it argued that the whole registration was invalid—and the whole trial was therefore null—only because

Unicolors listed *other* works on the same application as EH101. H&M insisted that it was improper to list some of the works on the same form as EH101 and that the application thus contained “inaccurate information” within the meaning of § 411(b).

The relevant facts are as follows: As noted above, Unicolors first presented the whole collection of 31 works of art to the sales team on January 15, 2011, then placed the designs in its showroom. J.A. 52-59. Of them, 22 designs—including EH101—remained in the showroom, where they were “available for public viewing.” Pet. App. 5a-6a. H&M does not suggest there was anything wrong with listing these 22 together on one registration application. But they challenged the inclusion of the other nine designs. Those designs were “confined”—a word that Unicolors used to describe removing the designs from its showroom to reserve them for particular customers who had rights of first refusal to purchase them for a defined exclusivity period. Pet. App. 5a-6a; J.A. 76-78.

H&M argued that the application contained “inaccurate information” because listing all 31 designs on the same application form was an implicit representation that it was legally permissible to register them together. According to H&M, that implicit representation was wrong because it was impermissible for Unicolors to register the confined designs on the same application as the non-confined designs. C.A. Dkt. 8-4 at ER 678-80 (H&M JMOL).

The relevant regulation says nothing about confined or non-confined designs, labels that have no technical meaning in copyright law. The regulation

simply states that a single registration form is permissible for, “[i]n the case of published works, all copyrightable elements that are otherwise recognizable as self-contained works, that are included in the same unit of publication, and in which the copyright claimant is the same.” 37 C.F.R. § 202.3(4).

At the time, no regulation, guidance, case, or commentary advised Unicolors that there was anything wrong with considering designs to be part of the “same unit of publication” when they were created the same month and presented to a sales team on the same day. The regulation does not define “same unit of publication.” And, as of 2011, the Copyright Office had offered no meaningful guidance about how to apply that term to particular types of works (e.g., visual works) or to particular industries (e.g., fabrics). The then-current edition of the *Compendium of Copyright Office Practices*—colloquially referred to as “*Compendium II*”—just repeated the regulation in slightly different words: “Works that are otherwise recognizable as self-contained may be registered on a single application and upon payment of a single fee, if they are first published in a *single unit of publication* and the copyright claimant of all works in the unit is the same.” U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 607.01 (2d ed. 1988) (emphasis added). Beyond that, the Third Circuit had interpreted this requirement liberally to allow designs to be registered together even when they were not “related.” *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 205-06 (3d Cir. 2005). Nevertheless, H&M’s position was that the confined designs were not in the “same unit of publication” as the non-confined designs, because the former were removed from the

showroom and offered to customers on an exclusive basis.

H&M adduced no evidence that anyone at Unicolors believed—much less had “knowledge”—that it was impermissible to list the confined and non-confined designs on the same application. Unicolors had done it many times before without incident or objection. Unicolors CEO Nader Pazirandeh, who signed the form, attested in it that everything was “correct to the best of [his] knowledge.” Add. 41a. When asked why Unicolors included the entire collection on one form, he put it in business terms, not legalese. Although he had no recollection of the particular process—Unicolors files many registration forms—he surmised that “one of my designers” felt that the designs in that January collection “are going to be successful” and so “put it up for registration.” J.A. 53. Unicolors included all the designs first released on January 15 on one form “[f]or saving money”—that is, to pay one registration fee, rather than 31 fees. J.A. 53-54. As for the publication date on the application, Pazirandeh did not “make any independent investigation” into its veracity. J.A. 53. He “trust[ed]” whoever completed the form, which could have been a “secretary or somebody in the design room.” *Id.*

The district court rejected H&M’s argument on two separate grounds. First, it found that there was no inaccuracy: It was permissible to list these works on one application because no evidence suggested that “the works listed in the ... Registration were published separately.” J.A. 181. Second, it found that there was “no evidence indicating ... Unicolors *knew* the ... Registration contained false information at the

time of the registration,” foreclosing any finding that “Unicolors intended to defraud the Copyright Office.” J.A. 182.

The Ninth Circuit reversed both grounds. First, it found an inaccuracy because it disagreed with the district court’s construction of the single-unit publication requirement. The Ninth Circuit acknowledged that it had “never previously addressed what it means to publish multiple works as a ‘single unit.’” Pet. App. 11a. Nevertheless, the court held that the plain meanings of “single” and “unit” suggest that single-unit registration can apply only to a “singular, bundled item.” Pet. App. 12a. The court then opened what it called the “proverbial toolkit of statutory interpretation” and withdrew “[t]he principle of *noscitur a sociis*.” *Id.* It thought this principle “reinforced” its conclusion because the regulation referred to “otherwise ... self-contained works,” which, the court believed, suggested that a “‘single-unit of publication’ does not cover separate self-contained works.” Pet. App. 12a-13a.

In support of its reading, the court quoted a newer edition of the *Compendium—Compendium III*—that post-dated Unicolors’ application and registration. The newer edition opined that collections of works are in a “single unit” if they “are physically bundled together and distributed to the public as a unit.” Pet. App. 13a n.3. The court found that to include the confined and non-confined designs on one registration form violated its newly announced “single[], bundled item” standard, and that applying “*Skidmore* deference” to *Compendium III* would result in the same conclusion. Pet. App. 13a & n.3.



As to the second ground, the court did not disturb the district court's finding that Unicolors believed the registration accurately treated the works as a single unit of publication. But the court held that this was irrelevant: "[T]he 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." Pet. App. 14a. On this basis, the Ninth Circuit reversed and remanded to the district court to "request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register ... to refuse registration." Pet. App. 14a (quoting § 411(b)(2)). If so, the registration will be invalidated, and with it the verdict.

### SUMMARY OF THE ARGUMENT

Under § 411(b)(1)(A), a copyright registration applicant who includes inaccurate information on a registration form due to a mistaken understanding of the law does not have "knowledge" that the "information" is "inaccurate."

**A.** The text of § 411(b)(1)(A) unambiguously requires a defendant challenging the validity of a registration certificate to prove that the applicant possessed awareness of an inaccuracy. In common parlance, if you ask someone whether they gave information "with knowledge that it was inaccurate," that means, "Did you know it was wrong when you said it? Were you lying?" Both English and legal usage dic-

tionaries define “knowledge” as a state of subjective awareness. By contrast, legal standards that depart from requiring proof of subjective awareness employ modifiers like “constructive” or “presumed,” or include language like “knew or should have known”—language Congress included elsewhere in the Copyright Act, but chose not to include in § 411(b)(1)(A).

Nothing in the statutory text suggests the Ninth Circuit’s distinction between inaccurate information included as a result of a mistake of fact and inaccurate information included as a result of a mistake of law. The words “inaccurate information” naturally encompass both. We know that is what Congress meant here because it used the term “information” to encompass both facts and legal conclusions in § 409, which provides a list of “information” that must be included on a registration application.

The text requires proof of “knowledge” that the “information” itself was inaccurate, not knowledge of surrounding or underlying facts or circumstances from which one could derive knowledge. That means that whether an inaccuracy results from an applicant’s mistake as to a historical event or real-world circumstance or as to how the law applies to those facts, the applicant does not have “knowledge” that the “information” is “inaccurate.”

**B.** The backdrop of common law provides further proof that the Ninth Circuit’s reading of § 411(b) is wrong. Section 411(b) codified the longstanding fraud-on-the-Copyright-Office doctrine, under which a good-faith mistake, whether of fact or law, cannot be a basis for challenging a copyright registration.

Every circuit that analyzed the issue agreed that an inadvertent mistake was insufficient to invalidate a registration. No circuit suggested the Ninth Circuit's distinction between factual and legal mistakes. And numerous cases rejected efforts to invalidate registrations on the basis of good-faith legal errors.

“When Congress codifies a judicially defined concept, it is presumed, absent an express statement to the contrary, that Congress intended to adopt the interpretation placed on that concept by the courts.” *Davis v. Mich. Dep’t of Treasury*, 489 U.S. 803, 813 (1989). The same presumption applies where a statute “covers an issue previously governed by the common law.” *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 538 (2013) (internal quotation marks omitted). Far from clearly intending to depart from the common law, Congress clearly intended to retain it. This conclusion accords with Congress’s stated objective of closing loopholes that would prevent copyright enforcement; the general trend in the law away from requiring strict adherence to copyright formalities; and analogous doctrines in both patent and trademark law.

C. When a statute requires “knowledge” of a circumstance with both factual and legal components, a mistake of law is a defense. This Court has so held in various contexts where a good-faith mistake of law negates the state of mind required by a statute. The Ninth Circuit erred in ignoring these cases in favor of the maxim that ignorance of the law is no defense. That principle precludes a defendant accused of violating a statutory proscription from claiming that he was unaware of that proscription. But it has no appli-

cation where, because of a collateral mistake of law, the defendant lacks the requisite state of mind—a well-recognized defense that plainly applies to § 411(b)(1)(A)’s requirement of “knowledge.”

**D.** Congress could not have intended to defeat the rights and remedies of copyright holders and instigate the mischief the Ninth Circuit’s approach invites.

Congress understood that mistakes on copyright applications are inevitable. Most applicants are lay-people, not copyright experts. Nettlesome questions of copyright law inevitably yield innocent legal errors on registration applications. Under the Ninth Circuit’s rule, these innocent mistakes would be penalized with devastating consequences. Because of the three-year statute of limitations, invalidating a copyright registration could prevent a copyright holder from ever remedying infringement. And even if a copyright holder could correct any error and re-file within the statute of limitations, two significant remedies—statutory damages and attorneys’ fees—would be unavailable in many cases.

These dynamics would also create perverse incentives in litigation, encouraging infringers to scour registrations for technical errors in hopes of using § 411(b)(1)(A) as a delay tactic or to blow up an adverse jury verdict. Meanwhile, the Copyright Office would be overwhelmed with referrals, many of them baseless, concerning whether a claimed inaccuracy is material. The Ninth Circuit identified no benefit that Congress might have hoped to achieve by allowing infringers to use technicalities to avoid liability. The equities of the Ninth Circuit’s reading of § 411(b) are so

lopsided that Congress could never have intended them.

The decision below should be reversed.

### ARGUMENT

#### **Under § 411(b), An Applicant Who Makes An Innocent Mistake Of Law Does Not Have “Knowledge” That The “Information” Is “Inaccurate.”**

To pose the question is to answer it: Does an applicant have “knowledge” of the inaccuracy of a statement if, by dint of a good-faith misunderstanding, she does not know that the statement is inaccurate? Of course not: Someone who does not know that a statement is inaccurate has no knowledge that it is inaccurate.

Yet the Ninth Circuit—and that circuit alone—paradoxically answers: Yes. Under the Ninth Circuit’s interpretation, an applicant who is aware of all historical *facts* but misunderstands the *legal effect* of those facts still has “knowledge” that her statement is inaccurate. This is so even if she honestly believes it to be accurate. In the Ninth Circuit’s view, it does not matter how reasonable the applicant’s understanding of the law was—or even if it was consistent with the only relevant precedents and official guidance at the time. Failure to anticipate where the courts are headed can be a basis to invalidate the author’s rights.

Specifically, here, the “inaccurate information” the Ninth Circuit found in Unicolors’ registration application was an implicit representation that it was legally permissible to include all 31 designs on the same application because all were part of the “same unit of publication.” Unicolors did not know that its implicit statement was incorrect. But the Ninth Circuit held that did not matter: “[T]he 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.” Pet. App. 14a.

The Ninth Circuit was wrong. The plain text of § 411(b)(1)(A) establishes a subjective knowledge standard that is not satisfied where an inaccuracy results from *any* innocent mistake, whether factual or legal. § A. That reading comports with the century-old common-law rule that punished only intentional misstatements, not innocent misunderstandings of complex legal principles—a rule that Congress is presumed to have adopted since it gave no clear indication of an intention to abandon it. § B. And that reading comports with this Court’s precedents and the principle that when a provision requires knowledge of a circumstance with legal and factual components, a good-faith mistake of law is a defense. § C. Any other reading would severely constrain copyright owners’ rights and encourage litigation mischief in ways that Congress could not have intended. § D.

**A. The text of § 411(b)(1)(A) requires subjective awareness of the inaccuracy, which is not satisfied when the applicant makes an innocent mistake.**

This Court can “begin and end [its] inquiry with the text, giving each word its ordinary, contemporary, common meaning.” *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) (internal quotation marks omitted). Section 411(b)(1) provides:

A certificate of registration satisfies the requirements of this section and section 412, regardless of whether the certificate contains any inaccurate information, unless—

(A) the inaccurate information *was included* on the application for copyright registration *with knowledge* that it was inaccurate ....

(Emphasis added). The plain meaning of the italicized text requires a defendant challenging the validity of a registration certificate to prove that the applicant possessed awareness of an inaccuracy. That standard cannot be satisfied where the applicant honestly, though mistakenly, believed the information to be accurate.

1. Ask anyone: When you told me X, did you give me that information “with knowledge that it was inaccurate”? For example: When you miscalculated the amount of taxable income on your tax return, did you do so “with knowledge that it was inaccurate”? Or same question, when you mistakenly included your

discretionary bonus as part of your annual salary on your mortgage application? The natural understanding of those questions is: “Did you know it was wrong when you said it? Were you lying?” No one would cop to knowing the inaccuracy unless he had the subjective state of mind that the information was false and purposely said it anyway. No one says, “When I filled out the 25-step worksheet on Form 8606 to determine taxable income following my conversion of nondeductible and deductible traditional IRAs into a Roth IRA, I now realize that I misinterpreted the instructions for calculating my basis on a rollover from a qualified retirement plan at Step 23. But I knew all the historical facts. So yes, I reported the incorrect amount of taxable income with knowledge that it was inaccurate.”

This normal parlance comports with both the plain English and legal definitions of “with knowledge.” English usage dictionaries define “knowledge” as “the fact or condition of being aware of something.” *Merriam-Webster’s Collegiate Dictionary* 691 (11th ed. 2006). Legal dictionaries define it as “[a]n awareness or understanding of a fact or circumstance; a state of mind in which a person has no substantial doubt about the existence of a fact.” *Black’s Law Dictionary* (11th ed. 2019).

And the Model Penal Code, which this Court has looked to for “guidance” on “questions of this type,” *United States v. U.S. Gypsum Co.*, 438 U.S. 422, 444 (1978), is in accord as well. It defines “knowingly” to include “aware[ness]” of “attendant circumstances” that are an element of an offense, or at a minimum “aware[ness] of a high probability” that such circum-



stances exist—in other words, willful blindness. Model Penal Code § 2.02(2)(b) & (7) (Am. L. Inst. 2021); see *Glob.-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 766 (2011) (endorsing the Model Penal Code’s equivalency between knowledge and willful blindness).

By contrast, legal standards that depart from requiring proof of subjective awareness take modifiers like “constructive,” “presumed,” or “reckless.” *Black’s Law Dictionary* (11th ed. 2019) (definition of “knowledge”). Congress made the decision to include these kinds of modifiers elsewhere in the Copyright Act.<sup>3</sup> “Had Congress intended” that for § 411(b)(1)(A), “it easily could have drafted language to that effect.” *Mississippi ex rel. Hood v. AU Optronics Corp.*, 571 U.S. 161, 169 (2014).

The phrase “with knowledge” thus specifies a condition of mind of the applicant who “included” “the inaccurate information”: The applicant must have possessed an awareness. Of what? The final, dependent clause of § 411(b)(1)(A) tells us: that the “information” “[i]s inaccurate.” And because an applicant cannot, as a logical matter, simultaneously be aware that he is saying something inaccurate while believing that something to be accurate, it follows that

---

<sup>3</sup> *E.g.*, § 506(a)(1)(C) (criminal copyright infringement; “knew or should have known”); § 110(1)-(2) (carveouts for certain types of infringement; “knew or had reason to believe”); § 504(c)(2) (statutory damages cap for innocent infringement; “was not aware and had no reason to believe”); § 1401(c)(1)(6) (civil penalties for improper use of notices of noncommercial use; “knowing” includes “grossly negligent disregard of the truth or falsity of the information”).

someone who mistakenly, but genuinely, believes in the veracity of his statement does not run afoul of § 411(b)(1)(A). Only an applicant who is either subjectively aware of an inaccuracy or willfully blind to an inaccuracy satisfies the standard.

2. Nothing in the statutory text suggests the Ninth Circuit’s distinction between (1) an applicant who does not know the information is inaccurate because she is wrong about a historical event or real-world circumstance; and (2) an applicant who does not know the information is inaccurate because she misapprehends how the law applies to those facts.

The safe harbor sets an expansive baseline rule: A registration is generally valid “regardless of ... *any* inaccurate information.” Right off the bat, that encompasses *all* categories. “Inaccurate” means “containing a mistake or error.” *Webster’s Third New International Dictionary* 1139 (2002). An error can be a mistake of fact or of law. And “information” means “knowledge communicated by others or obtained” or “knowledge of a particular event or situation.” *Webster’s Third New International Dictionary* 1160 (2002). That too encompasses not just historical facts but also logic and analysis applied to those facts.

We know that Congress used the word “information” to encompass not just facts but also legal conclusions, because that is how Congress used the word two sections earlier to describe the contents of the very same application. Section 409 provides a list of items that an “application for copyright registration ... shall include.” At the end, it describes that list as “information ... bearing upon the preparation or iden-

tification of the work or the existence, ownership, or duration of the copyright.” § 409(10). That list includes various facts, such as the “name and address of the copyright claimant,” § 409(1), and “the title of the work,” § 409(6). But the “information” also includes a wide variety of legal conclusions, including whether the work is “a work made for hire,” § 409(4), or “a compilation or derivative work,” § 409(9), and “how the claimant obtained ownership of the copyright,” § 409(5).

So the safe harbor begins from the premise that mistaken assertions concerning facts *or* legal conclusions on the application will generally not be a basis for challenging a registration. Congress then used the same words—“information” and “inaccurate”—in § 411(b)(1)(A)’s carveout from that safe harbor. Those words have the same meaning in both parts of the sentence: The carveout is inapplicable—and the broad safe harbor applies—“unless the inaccurate information was included on the application for copyright registration *with knowledge* that it was inaccurate.” That means that an accused infringer can never challenge an application based on “inaccurate information” without proving that the applicant knew the information “was inaccurate.”

In short, nothing in § 411(b) suggests any distinction between “knowledge” of underlying facts and “knowledge” of how a legal rule applies to those facts. If the “information” that is “inaccurate” is a historical fact—such as the title of the work—§ 411(b)(1)(A) asks whether the applicant knew that fact was “inaccurate.” If the “information” that was “inaccurate” is a legal conclusion—such as whether a design was a

work for hire or whether it was permissible to put that design on the same application with others—then § 411(b)(1)(A) asks whether the applicant knew that legal conclusion was “inaccurate.” The text requires proof of “knowledge” that the “information” itself was inaccurate, not knowledge of surrounding or underlying facts or circumstances from which one could derive knowledge.

Any other reading has ramifications that extend beyond invalidating a registration. Section 411(b)(1)(A) has a criminal analog in § 506(e), which similarly prohibits applicants from “knowingly” making “false representation[s]” in registration applications. The knowledge scienter that Congress chose presumably has the same meaning in both provisions. As unlikely as it is for Congress to have intended to punish a lay copyright holder for failing to anticipate a subsequent legal ruling, it is downright inconceivable that Congress would have attached criminal consequences to such a mistake.

**3.** The rule is as simple as it is sensible. Consider two singers, both of whom complete copyright registration applications that incorrectly assert that their sound recordings are unpublished. Unbeknownst to the first artist, her agent had in fact sent promotional copies of the sound recording to disc jockeys a few months prior in hopes the DJs would play the song. This was an “offer[] to distribute copies or phonorecords to a group of persons for purposes of ... public performance,” thus meeting the statutory definition of “publication.” § 101. But because the artist did not know that her agent disseminated her

song, she indicated that the song had not been published.

The second singer took it upon herself to send copies of her song to various DJs. She sent them by email, but never heard back. When she filled out her copyright registration application, she of course knew that she had emailed the songs to DJs. But she had not yet released the song in what she considered to be a public way, and did not realize that the law treated her unrequited emails to DJs as publication. So, like the first artist, she checked the box indicating that the song was unpublished.

The first singer's inaccuracy is based on factual error—she was unaware of a real-world occurrence with legal consequences. The second singer's inaccuracy is based on legal error—she knew of the real-world occurrence, but was unaware of its legal consequence. There is no reason Congress would have wanted to excuse the first singer but penalize the second. Both were honest when they attested to their belief that the information included in their applications was accurate. And so neither included the information while possessing awareness that the description of their works as unpublished was inaccurate. That is all that matters under § 411(b)(1)(A), as the Eleventh Circuit held on a fact pattern much like our second artist's above. *Roberts v. Gordy*, 877 F.3d 1024, 1028-30 (11th Cir. 2017).

That is how the Copyright Office reads § 411(b)(1)(A): It maintains that “a copyright registration should not be invalidated—and the copyright owner's ability to enforce the copyright compro-

mised—when the application was submitted in good faith based on a reasonable interpretation of the law.” Response of the Register of Copyrights at 18, *Fashion Ave. Sweater Knits, LLC v. Poof Apparel Corp.*, No. 2:19-cv-06302 (C.D. Cal. Feb. 8, 2021), Dkt. 129-1. Although the statutory text is unambiguous on that score, the Copyright Office’s position would merit *Skidmore* deference if there were any ambiguity. See *Christensen v. Harris County*, 529 U.S. 576, 587 (2000).

**B. Section 411(b) codified the common-law rule that a good-faith mistake—including a mistake of law—cannot be a basis for challenging a copyright registration.**

The backdrop of common law provides further proof that the Ninth Circuit’s reading of § 411(b) is wrong. Congress codified the longstanding fraud-on-the-Copyright-Office doctrine, which flatly rejected the distinction the Ninth Circuit drew here between knowledge of the underlying facts and knowledge of the law. At common law, every circuit that analyzed the issue (eight circuits in all, including the Ninth Circuit) agreed that innocent or inadvertent errors—including errors resulting from good-faith legal misunderstandings—did not bar an infringement action.

“When Congress codifies a judicially defined concept, it is presumed, absent an express statement to the contrary, that Congress intended to adopt the interpretation placed on that concept by the courts.” *Davis*, 489 U.S. at 813. Because Congress did not even suggest that it wanted to depart from the common-

law rule—let alone expressly state such an intention—the common-law backdrop is dispositive.

1. The rule at common law was that “inadvertent mistakes on registration certificates” would not “bar infringement actions.” *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1145 (9th Cir. 2003) (internal quotation marks omitted). A copyright registration could not be invalidated absent “intentional or purposeful concealment of relevant information.” *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 828 (11th Cir. 1982).

This rule was born of recognition that the Copyright Act of 1909 marked a stark departure from the inequitable and unpopular regime of formalities and technicalities described above (at 5-6). Early cases that adopted the rule quoted this Court’s observation that the 1909 Act constituted a “complete revision of the copyright laws ... intended definitely to grant valuable, enforceable rights to authors, publishers, etc., *without burdensome requirements.*” *Washingtonian Pub. Co.*, 306 U.S. at 36 (emphasis added) (cited in *Advisers, Inc. v. Wiesen-Hart, Inc.*, 238 F.2d 706, 708 (6th Cir. 1956); *United States v. Backer*, 134 F.2d 533, 536 (2d Cir. 1943)). Or, as Judge Learned Hand put it, the 1909 Act abolished “purposeless technicality” in favor of “open[ing] a path for authors beside and not through the quagmire which had been created under the old act.” *Joe Mittenhal, Inc. v. Irving Berlin, Inc.*, 291 F. 714, 715 (S.D.N.Y. 1923) (Hand, J.). Thus, “useless technicalities” could not “cut down the benefits conferred” by copyright registration. *Advisers*, 238 F.2d at 708; *Backer*, 134 F.2d at 536 (same); *see also*

*Turner & Dahnken v. Crowley*, 252 F. 749, 751 (9th Cir. 1918) (“where ... the essential steps have been taken to secure copyright ... slight variance in [publication] dates ought not to destroy the proof of copyright”).

Courts articulated various formulations of the doctrine. But every circuit agreed on this baseline: A copyright plaintiff could not lose a registration’s benefits because of “inadvertent” errors, *Data Gen. Corp. v. Grumman Sys. Support Corp.*, 36 F.3d 1147, 1161 (1st Cir. 1994), *abrogated on other grounds by Reed Elsevier*, 559 U.S. 154; *Raquel v. Educ. Mgmt. Corp.*, 196 F.3d 171, 177 (3d Cir. 1999), *judgment vacated*, 531 U.S. 952 (2000); “inadvertent and innocent” omissions, *Eckes v. Card Prices Update*, 736 F.2d 859, 861-62 (2d Cir. 1984); “[a]ccidental” mistakes, *Bouchat v. Balt. Ravens, Inc.*, 241 F.3d 350, 357 (4th Cir. 2001); or errors that were not “intentional or purposeful,” *Donald Frederick Evans & Assocs., Inc. v. Cont’l Homes, Inc.*, 785 F.2d 897, 904 (11th Cir. 1986) (citing *Original Appalachian*, 684 F.2d at 828). “Only the knowing failure to advise the Copyright Office of facts which might have occasioned a rejection of the application constitute[d] reason for holding the registration invalid.” *Eckes*, 736 F.2d at 861 (internal quotation marks and alterations omitted); *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 667 (3d Cir. 1990) (same).

In sum, a “long line of cases” established that an “inadvertent error cannot be grounds for dismissing [a copyright] suit.” *Raquel*, 196 F.3d at 184-85 (Alito, J., dissenting). The common-law position was so monolithic that one treatise recently declared:



“Simply put, no case can be found that has ever seriously considered the issue of fraud on the Copyright Office in the absence of some colorable claim of a misrepresentation in the application.” Howard B. Abrams & Tyler T. Ochoa, *Law of Copyright* § 16.13 (2020 ed.).

Some circuits went further in protecting copyright plaintiffs, formulating the standard not just in terms of knowing errors, but in terms of deceptive intent or intent to induce reliance. In other words, the more robust version of the fraud-on-the-Copyright-Office doctrine required proof of, well, fraud. The Sixth Circuit, for example, demanded proof that the applicant acted with the “intention to secure an advantage in violation of the statute, or with a fraudulent purpose.” *Advisers*, 238 F.2d at 707. And the Seventh and Ninth Circuits held that errors did not bar an infringement action unless the defendant “relied to its detriment on the mistake, or the claimant intended to defraud the Copyright Office by making the misstatement.” *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F.3d 586, 591 (7th Cir. 2003); *Urantia Found. v. Maaherra*, 114 F.3d 955, 963 (9th Cir. 1997). Cases like these led one of the leading treatises to summarize the common law as standing for the proposition that “a misstatement or clerical error in the registration application, if unaccompanied by fraud, should neither invalidate the copyright nor render the registration certificate incapable of supporting an infringement action.” *2 Nimmer on Copyright* § 7.20 (collecting pre-PRO-IP Act cases).

2. Whatever the precise formulation of the doctrine, no circuit so much as suggested the Ninth Circuit's rule: that an innocent mistake of law could be grounds for challenging a registration so long as the applicant knew the historical facts. Quite the opposite. Numerous cases flatly rejected efforts to challenge good-faith legal errors in registrations. In one case, the artists began making and selling novelty "snaggly teeth" in the mid-1990s, operating out of the kitchen of one of their mothers. *Billy-Bob*, 329 F.3d at 589. They later incorporated their company. *Id.* They then obtained copyright registrations for various models of the teeth in 1999, without the assistance of a lawyer, and identified the teeth as works made for hire. *Id.* But that label was improper because "the corporation did not exist when the teeth were authored." *Id.* at 591. The applicants knew the underlying facts—when they created the teeth and formed the corporation. Yet, the Seventh Circuit held that they could still pursue the infringement action, because the inaccuracy reflected an "inadvertent mistake[]." *Id.*

In one of the landmark cases on the doctrine, *Advisers*, the applicant listed an incorrect publication date for its book, based on the legal misapprehension that distributing the book to the public (instead of shipping it to distributors) constituted publication. 238 F.2d at 707. The applicant knew the underlying facts about when it shipped the packages and when distributors put the book into the public's hands. But the Sixth Circuit rejected the defendant's challenge to the registration as a "useless technicalit[y]," holding that the plaintiff's "innocent misstatement" did not bar the infringement action. *Id.* at 708.

In yet another case, the applicants erroneously failed to identify their dolls as derivative works. The applicants knew the relevant historical facts: that the dolls “were derived in part from viewing other artists’ soft-sculpture work.” *Original Appalachian*, 684 F.2d at 828. But they mistakenly thought that the application’s instructions defining derivative works “did not apply to their dolls.” *Id.* at 828 n.9. The Eleventh Circuit excused the omission because it was not “intentional or purposeful.” *Id.* at 828.

Similar examples abound at common law. As another leading treatise put it, courts “excused innocent errors or omissions affecting virtually every material aspect of a copyright registration application.” Paul Goldstein, *Goldstein on Copyright* § 3.12.3 (2021) (collecting pre-PRO-IP Act cases). Several circuits excused errors resulting from confusion about the requirements for derivative works. *See, e.g., Lamps Plus*, 345 F.3d at 1145; *Bouchat*, 241 F.3d at 357; *Serv. & Training, Inc. v. Data Gen. Corp.*, 963 F.2d 680, 689 (4th Cir. 1992); *Eckes*, 736 F.2d at 861-62. The Ninth Circuit excused an error caused by confusion about what qualified as a “complete copy” for purposes of the deposit requirement. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 486 (9th Cir. 2000). And the Second Circuit excused an error in identifying the author of the work. *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 412 (2d Cir. 1970). In each case, it did not matter that the applicant knew the underlying facts. It was enough that the applicant did not appreciate how the law applied to those facts to yield an inaccuracy.

3. This common-law backdrop is dispositive under two related principles. First, as the Copyright Office, commentators, and other circuits agree, § 411(b) “codif[ie]d the doctrine of fraud on the Copyright Office.” Annual Report of the Register of Copyrights, Fiscal Year Ending September 30, 2008, at 13 (2008), <https://tinyurl.com/d2x94cr5>; see *Roberts*, 877 F.3d at 1029; 2 *Nimmer on Copyright* § 7.20 [B][2] (Section 411(b) “took the court-made standards underlying” the fraud-on-the-Copyright-Office doctrine and “articulated [them] directly in the Copyright Act.”); see also *DeliverMed Holdings, LLC v. Schaltenbrand*, 734 F.3d 616, 625 n.3 (7th Cir. 2013) (discussing the “fraud on the Copyright Office inquiry” under § 411(b)).

Congress’s use of “knowledge” as the required scienter corresponds to the common law’s recognition that a registration could not be invalidated absent a “knowing failure to advise the Copyright Office of facts which might have occasioned a rejection of the application.” *Eckes*, 736 F.2d at 861-62 (internal quotation marks omitted); *Masquerade*, 912 F.2d at 667. “When Congress codifies a judicially defined concept,” this Court must interpret the resulting statute’s text with the presumption, “absent an express statement to the contrary, that Congress intended to adopt the interpretation placed on that concept by the courts.” *Davis*, 489 U.S. at 813.

Second, at a minimum, “[w]hen a statute covers an issue previously governed by the common law,” this Court must interpret its text with the presumption “that Congress intended to retain the substance of the common law.” *Kirtsaeng*, 568 U.S. at

538 (internal quotation marks and alteration omitted). That presumption, too, controls unless “a statutory purpose to the contrary is evident.” *Samantar v. Yousuf*, 560 U.S. 305, 320 n.13 (2010) (quoting *Isbrandtsen Co. v. Johnson*, 343 U.S. 779, 783 (1952)).

Far from demonstrating an intention to silently overrule a century of common law, all indications reinforce the view that Congress intended to retain the rule that protected copyright owners. Congress’s stated objective in the PRO-IP Act was to prevent “intellectual property thieves from exploiting [a] potential loophole” by arguing that an inadvertent mistake in the registration documents, “such as checking the wrong box on the registration form,” could invalidate a registration. H.R. Rep. No. 110-617, at 24; *see also id.* at 20 (the PRO-IP Act’s core purpose was “to improve intellectual property enforcement,” including by “eliminating loopholes that might prevent enforcement of otherwise validly registered copyrights”).

The Act also continued a general trend in copyright law of shifting inexorably away from requiring strict adherence to formalities. *See generally 2 Nimmer on Copyright* § 7.01 (discussing the gradual lifting of various formalities). By way of example, the major legislative event that transpired between the passage of the Copyright Act of 1976 and the PRO-IP Act was the Senate’s ratification of the Berne Convention. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853. The Berne Convention requires that “the enjoyment and the exercise of [copyright] rights shall not be subject to any formal-

ity.” Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, *as last revised*, Paris, July 24, 1971, Art. 5(2), 1161 U.N.T.S. 3, S. Treaty Doc. No. 99-273. The United States “became party to Berne’s multilateral, formality-free copyright regime in 1989.” *Golan v. Holder*, 565 U.S. 302, 309 (2012). Congress would not have silently departed from the trend by reinjecting formalities into copyright protection.

Moreover, Congress was well aware of the norm in other areas of intellectual property against cancelling property rights based on innocent mistakes in applications. The patent law doctrine of “inequitable conduct” has long required proof that the applicant “acted with the specific intent to deceive the [Patent and Trademark Office]” in misrepresenting material information on a patent application. *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1290 (Fed. Cir. 2011) (en banc); *see also Kingsdown Med. Consultants, Ltd. v. Hollister, Inc.*, 863 F.2d 867, 872, 876 (Fed. Cir. 1988). And a misstatement on a trademark application will not jeopardize the registration without evidence that the registration “was obtained fraudulently,” 15 U.S.C. § 1064(3), including proof of “the registrant’s knowledge or belief that the representation [wa]s false, [and] the intent to induce reliance upon the misrepresentation and reasonable reliance thereon,” *Robi v. Five Platters, Inc.*, 918 F.2d 1439, 1444 (9th Cir. 1990). There 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. If anything, Congress would want to give more latitude to copyright

applicants, who are almost always laypeople, than to trained and licensed patent prosecutors.

**C. When a statute requires “knowledge” of a circumstance with factual and legal components, a mistake of law is a defense.**

This Court has authoritatively rejected the distinction the Ninth Circuit drew between knowledge of underlying facts and knowledge of how the law applies to those facts: “Where ... the statutory text and relevant court and agency guidance allow for more than one reasonable interpretation, it would defy history and current thinking to treat a defendant who merely adopts one such interpretation as a *knowing* or reckless violator.” *Safeco Ins. Co. of Am. v. Burr*, 551 U.S. 47, 70 n.20 (2007) (emphasis added). Notably, this Court reached that conclusion under a provision (in the Fair Credit Reporting Act) that permitted proof under a mere “reckless” standard. Even under that lower standard, this Court held that courts must exclude violations of the statute based on legal conclusions that, “albeit erroneous,” were “not objectively unreasonable.” *Id.* at 69-70.

This Court reached a similar conclusion under the Fair Labor Standards Act. The provision at issue there required proof of a “willful violation[],” which includes taking a position in reckless disregard of the law. *McLaughlin v. Richland Shoe Co.*, 486 U.S. 128, 132-33 (1988). This Court held that the provision required proof “that the employer either knew or showed reckless disregard for the matter of whether its conduct was prohibited by the statute.” *Id.* at 133.

The same is true in the criminal context. In *Rehaif v. United States*, the Court interpreted “knowingly” to mean that “in a prosecution under 18 U.S.C. § 922(g) and § 924(a)(2), the Government must prove both that the defendant knew he possessed a firearm *and that he knew he belonged to the relevant category of persons barred from possessing a firearm.*” 139 S. Ct. 2191, 2200 (2019) (emphasis added). This “‘collateral’ question of law” determined whether the defendant had the “guilty state of mind” that the statute required. *Id.* at 2198.

The Ninth Circuit ignored these cases in favor of the inapposite maxim that ignorance of the law is not a defense. It invoked an earlier Ninth Circuit decision that said: “[T]he term ‘knowingly’ does not necessarily have any reference to a culpable state of mind or to knowledge of the law.” *Gold Value Int’l Textile, Inc. v. Sanctuary Clothing, LLC*, 925 F.3d 1140, 1147 (9th Cir. 2019) (quoting *Bryan v. United States*, 524 U.S. 184, 192 (1998)) (cited at Pet. App. 10a). That earlier panel further quoted *Bryan* for the proposition that “the knowledge requisite to knowing violation of a statute is factual knowledge as distinguished from knowledge of the law.” *Id.*

The Ninth Circuit misunderstood the maxim. A criminal defendant who is accused of a substantive crime—say, murder—cannot defend against the charge by pleading, “I didn’t realize that murder was illegal.” In other words, it is no defense that “the defendant is unaware of the existence of a statute proscribing his conduct.” Wayne R. LaFare, *Substantive Criminal Law* § 5.6(a) (3d ed. 2020). If applied here, that principle would mean that Unicolors could not



defeat § 411(b)(1)(A) by claiming, “We didn’t realize there were consequences to including material inaccuracies on a copyright registration application.”

But black-letter law distinguishes that scenario from “the situation ... where the defendant has a mistaken impression concerning the legal effect of some collateral matter and that mistake results in his misunderstanding the full significance of his conduct.” *Id.* A husband is no bigamist if he “mistakenly believes ... his prior divorce is valid”; a possessor is no thief if he believes “that his prior dealings had vested ownership ... in him.” *Id.* As the Model Penal Code puts it, “[i]gnorance or mistake as to a matter of fact or law *is a defense*” when the “ignorance or mistake” negates the “purpose, knowledge,” or other applicable mental state “required to establish a material element of the offense.” Ignorance or Mistake, Model Penal Code § 2.04(1)(a) (emphasis added); *see McFadden v. United States*, 576 U.S. 186, 198-99 (2015) (Roberts, C.J., concurring in part and concurring in the judgment) (“when ‘there is a legal element in the definition of the offense,’ a person’s lack of knowledge regarding that legal element *can* be a defense” (quoting *Liparota v. United States*, 471 U.S. 419, 425 n.9 (1985))). That is precisely how § 411(b)(1)(A) works. The phrase “with knowledge that it [i]s inaccurate” defines a condition of mind that will often turn on some understanding of law. And so the absence of that understanding negates that element.

This Court drew that distinction in *Liparota*, which interpreted a statute imposing criminal liability on “whoever knowingly uses, transfers, acquires, alters, or possesses [food stamps] in any manner not

authorized by [the statute] or the regulations.” 471 U.S. at 420 (second alteration in original) (quoting 78 Stat. 708, as amended, 7 U.S.C. § 2024(b)(1)). This Court held that the statute required knowledge that the food stamps had been used unlawfully. *Id.* at 425 & n.9. In response, the dissent argued that this was tantamount to “establish[ing] a defense of ignorance of the law.” *Id.* at 436 (White, J., dissenting). But the Court rejected that framing, explaining that it was merely applying an “element in the definition of the offense,” which required knowledge of a circumstance with a legal component. *Id.* at 425 n.9 (majority op.).

Indeed, *Bryan* itself contradicts the Ninth Circuit’s view. At issue was a provision that attached a consequence to “willfully” violating certain statutes, including one that forbids dealing in firearms without a federal license. This Court confirmed that in order to prove a “willful violation of a statute, the Government must prove that the defendant acted with knowledge that his conduct was unlawful.” 524 U.S. at 191-92 (citation and internal quotation marks omitted). The passage the Ninth Circuit quoted merely rejected the defendant’s argument that the Government had to prove even more: that the defendant “acted with knowledge of the [specific] licensing requirement” at issue in that case. *Id.* at 190, 193. So, if anything, *Bryan* undermines the Ninth Circuit’s view that it was irrelevant whether Unicolors had a good-faith belief that it was permissible to combine the confined and non-confined designs on one registration.

**D. Congress could not have intended a rule that would so severely override copyright holders' rights and remedies and disrupt infringement litigation.**

There is no way Congress could have intended to defeat the rights and remedies of copyright holders and instigate the mischief the Ninth Circuit's approach invites.

1. A copyright application can confound even seasoned experts as they attempt to “reconcile conflicting judicial opinions” on “complex” legal questions. U.S. Copyright Office, Online Publication, 84 Fed. Reg. 66,328-01, 66,328 (Dec. 4, 2019).

But who usually fills out copyright applications? Artists. Designers. Poets. Musicians. Programmers. Not lawyers, much less “copyright prosecutors.” These applicants are not steeped in the nuances of copyright law. They are not people Congress would have wanted to punish for making innocent mistakes of law or (as here) failing to anticipate a change in guidance or subsequent judicial gloss.

To the contrary, Congress knew that innocent mistakes abound. It was aware of the range of legal errors, catalogued above (at 35-36), that triggered (unsuccessful) accusations of fraud on the Copyright Office at common law, including uncertainty about whether, or when, a work was published and what qualifies as a derivative work, a work made for hire, or a complete work. Just as Congress recognized in the 1909 Act that a shipping clerk's mistake should not destroy a “copyright of great value,” H.R. Rep. No.

60-2222, at 11 (1909), Congress knew some 99 years later that “checking the wrong box” on registration paperwork should not carry that result either, H.R. Rep. No. 110-617, at 24 (2008).

And since Congress passed the PRO-IP Act, the Copyright Office has documented countless ways in which these same nettlesome questions, and others, continue to yield innocent legal errors. Simply checking the box for “published” versus “unpublished,” or filling in “publication date” is fraught with peril. Applicants have always had trouble figuring out whether or when a work was published under § 101, and those questions have only become more complicated with the proliferation of methods for sharing content online and through various social media platforms. U.S. Copyright Office, Online Publication, 84 Fed. Reg. 66,333. We have already noted (at 29-30) the example of the applicant who incorrectly believed (and stated on the registration form) that a song was unpublished, unaware that sending it to disc jockeys amounted to publication. *Roberts*, 877 F.3d at 1030. Another applicant was confused about whether prior licensing of a work qualifies as publication, which the court itself in that case recognized as an “unsettled legal question.” *Archie MD, Inc. v. Elsevier, Inc.*, 261 F. Supp. 3d 512, 520 (S.D.N.Y. 2017).

The Copyright Office reports that applicants regularly call with questions about whether works sent by email, link, or through streaming platforms qualify as published. U.S. Copyright Office, Online Publication, 84 Fed. Reg. 66,333. But the Copyright Office cannot give applicants legal advice. It says, “the applicant—not the U.S. Copyright Office—must deter-

mine whether the work is published or unpublished.” U.S. Copyright Office, Compendium of U.S. Copyright Office Practices, §§ 1009.4, 1904.1 (3d ed. 2017). Singers and artists left to their own devices cannot be expected to get the law right every time.

The same goes for the portion of the application directing applicants to identify whether the work qualifies as a derivative work under § 101 and to exclude any preexisting material from the claim. The Ninth Circuit itself recently called the application form a “minefield for applicants attempting to properly register a derivative work.” *Unicolors v. Urban Outfitters, Inc.*, 853 F.3d 980, 990 (9th Cir. 2017). The applicant there had “inadvertently excluded” source artwork from its claim because it misunderstood how to complete the form. *Id.* The form requires applicants to use a series of checkboxes to identify individual elements of preexisting works that should be excluded from the claim. The Copyright Office has confirmed that this form often “lead[s] to errors in identifying new or preexisting material.” U.S. Copyright Office, Registration Modernization, 85 Fed. Reg. 12,704-01, 12,708 (Mar. 3, 2020).

The Copyright Office recently commissioned a report detailing the confusion plaguing the process for obtaining copyright protection for software products. See Stanford Law School Law and Policy Lab Copyright Licensing Practicum, *Revising the Requirements for Software Registration* 1-2 (2017-2018), <https://tinyurl.com/4dxbx8nb>. In particular, there is no clear guidance on how to register frequently updated versions of a software product, how to identify authorship for open-source code often developed by hundreds

or thousands of contributors, or how to determine the publication date of cloud-based software that can be disseminated without the individual distribution of any copies of the work. *Id.* at 7-13.

And, of course, this case illustrates the challenges in determining when it is permissible to register multiple works on the same application form—a question of first impression, as the Ninth Circuit noted. 37 C.F.R. § 202.3(b)(4); Pet. App. 11a. Indeed, before the decision below, district courts had held that multiple different fabric designs *can* be listed on the same application, even if they are subsequently sold separately, without imposing any requirement that the works be published as part of a bundled collection. *See, e.g., Matrix Int’l Textile, Inc. v. Monopoly Textile, Inc.*, No. CV160084, 2017 WL 5654794, at \*2 (C.D. Cal. May 12, 2017); *Novelty Textile, Inc. v. Windsor Fashions, Inc.*, No. CV12-05602, 2013 WL 12114062, at \*4 (C.D. Cal. Aug. 12, 2013).

A recent opinion details an applicant’s confusion over a trifecta of issues: whether his photos qualified as works made for hire, whether they were published, and whether they qualified as derivative works. As to each, “there was no evidence that [the applicant] ‘knew’ he was legally in the wrong” when he completed his application. *Duncan v. Blackbird Prods. Grp., LLC*, No. 17-03404-CV-S-BP, Dkt. 437 at 11-14 (W.D. Mo. Apr. 15, 2021).

In short, copyright applicants have been making inadvertent legal errors on registration paperwork forever, *see supra* 32-36, and they always will. A return to 19th-century norms for punishing innocent

mistakes will not improve the quality of applications. Poets and artists will not become copyright experts or gain facility with the “proverbial toolkit of statutory interpretation.” Pet. App. 12a. They will just start losing cases to willful infringers and eventually lose the incentive to create.

2. Under the Ninth Circuit’s rule, the consequences of getting any of these legal judgments wrong can be devastating—and deeply unfair in letting infringers off scot-free for even the most blatant infringements. Congress cannot have intended § 411(b) to yield these “intolerable consequences” that would “fail to further basic constitutional copyright objectives.” *Kirtsaeng*, 568 U.S. at 540, 544.

The typical consequence of invalidating a registration under § 411(b) is the dismissal of the copyright holder’s infringement claims. *See, e.g., Gold Value*, 925 F.3d at 1150 (affirming dismissal of claims with prejudice following invalidation under § 411(b)); *Sell-PoolSuppliesOnline.com, LLC v. Ugly Pools Arizona, Inc.*, 804 F. App’x 668, 669 (9th Cir. 2020) (affirming summary judgment in favor of defendant following invalidation under § 411(b)); *Bruhn NewTech, Inc. v. United States*, 144 Fed. Cl. 755, 821 (2019) (entering judgment in favor of defendant after invalidation under § 411(b)).

The dismissal can be effectively case-ending. The statute of limitations for copyright claims is just three years and begins to run when the infringement is discovered. § 507; *see Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 670 n.4 (2014). By the time the plaintiff files a new or supplemental registration, *see*

§ 408(d), to remedy the purported inaccuracy, many claims would be untimely. This is a case in point: The Ninth Circuit did not issue its decision finding purported “known inaccuracies” in the registration certificate until more than four years after Unicolors filed its complaint. Pet. App. 14a. And as this Court recognized over 80 years ago, “[w]ithout [a] right of vindication, a copyright is valueless.” *Washingtonian Pub. Co.*, 306 U.S. at 40.

Even copyright holders who can file new lawsuits within the statute of limitations after obtaining a new registration may have little incentive to do so, because they are unable to recover statutory damages or attorneys’ fees—among the most important tools in protecting copyrights. § 412; *supra* 7; e.g., *Fischer v. Forrest*, 968 F.3d 216, 222 (2d Cir. 2020), *cert. petition filed* (2021); *Budget Cinema, Inc. v. Watertown Assocs.*, 81 F.3d 729, 733 (7th Cir. 1996). Consequently, a copyright holder who brings a claim based on a new or supplemental registration often will have to pay a lawyer out of pocket (rather than on contingency) for the prospect of recovering a pittance. That outcome frustrates the Copyright Act’s goal of encouraging copyright enforcement.

Completely apart from the consequence to the claim, the Ninth Circuit’s rule threatens another penalty that will chill copyright plaintiffs from the start. When an infringer gets a case dismissed based on a mistake in the registration paperwork, the infringer can collect attorneys’ fees as the prevailing party. § 505. This is no hypothetical. It happened in *Gold Value* (the case on which the Ninth Circuit relied here), where the court reasoned that prevailing even



on a “technical defense” deserves a fee award. 925 F.3d at 1150.

Strangely, these drastic consequences would unfairly disadvantage domestic authors compared to their foreign counterparts because § 411 applies only to “United States work[s].” § 411(a). Foreign authors would not face the same consequences for inadvertent registration errors, because they are allowed to sue without first registering their works.

**3.** The interplay among all these consequences will yield perverse incentives that will change copyright litigation forever. Infringers will shift their focus from defending their conduct on the merits to scouring registrations, and conducting discovery, in search of any hint of an error or any gray area in the law. It will transform an equitable defense meant solely to “prevent plaintiffs from abusing the registration process,” *DeliverMed*, 734 F.3d at 622, into a powerful weapon for infringers to exploit at will.

Since § 411(b) sets no deadline for challenging the validity of a registration, accused infringers will make tactical judgments about when to raise the defense. They can raise it at the outset of a case, which can be a potent “delay tactic.” *Id.* at 625. Or as this case illustrates, a defendant can run a copyright holder (and the court) through discovery, trial, and verdict—and then, after losing, start scouring the registration for ways to challenge the verdict. This strategy robs the copyright holder of the opportunity to develop evidence at trial showing that any purported inaccuracy was not made with knowledge of its inaccuracy. This strategy also allows the defendant to run out the clock

on the statute of limitations and insulate ongoing infringement from statutory damages and attorneys' fees. And then, at the end of the day, the infringer can seek fees for all the work it (unnecessarily) did while sitting on its rights. With options like these, a willful infringer caught dead to rights will have little reason to settle or stop infringing.

Meanwhile, the Copyright Office will be overwhelmed with referrals—many of them baseless. It is far easier for an infringer to show that the plaintiff knew the underlying facts than that it understood the application of a collateral legal rule, and therefore the inaccuracy. And infringers are free to demand a referral upon merely “alleg[ing]” the inclusion of “inaccurate information” with knowledge that it was inaccurate. § 411(b)(2). The resulting deluge of referrals could sink an agency already confronting “staffing and budgetary shortages,” *Fourth Est.*, 139 S. Ct. at 892, and further delay resolution of copyright litigations.

4. On the flip side, the Ninth Circuit identified no benefit that Congress might have hoped to achieve with the rule that court adopted. The rule does not advance any legitimate interest of the accused infringer—here, or in most any other case that has brought to light an error. Registration requirements are not for the benefit of infringers, but rather for the benefit of law-abiding artists seeking to license the work of others, and for the benefit of the public. *See supra* 5-6. And “[t]he duty not to infringe is unaffected” by copyright registration errors, which impose “no[] injur[y]” on infringers. *Washingtonian Pub. Co.*, 306 U.S. at 40. The most common errors—including

all the sorts of errors catalogued above—have no bearing on the plaintiff’s ownership rights, the accused infringement, or the infringer’s or public’s interest in receiving notice of copyright ownership. Indeed, these are often errors that, if they had been brought to light before litigation, easily could have been corrected without consequence through the filing of an application for supplemental registration. § 408(d).

In short, allowing infringers to leverage § 411(b) into a Get Out Of Jail Free card simply does nothing to further “[t]he primary objective of copyright,” which is “to promote the Progress of Science and useful Arts.” *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991) (quoting U.S. Const. art. I, § 8, cl. 8). It just provides a windfall for any infringer, including one who, like H&M, has no real defenses and was found guilty of willful infringement. That is the exact opposite of Congress’s stated objective “[t]o prevent intellectual property thieves” from escaping liability based on “a mistake in the registration documents.” H.R. Rep. No. 110-617, at 24 (2008).

\*\*\*

The equities of the Ninth Circuit’s reading of § 411(b) are so lopsided and the costs so steep that one would be tempted to stretch to find a way to avoid that reading even if that is what the statute clearly said. But these factors here *confirm* the text, structure, and common-law backdrop. When Congress called this the PRO-IP Act, it was being descriptive, not ironic.

**CONCLUSION**

This Court should reverse the Ninth Circuit's judgment.

Respectfully submitted,

Scott Alan Burroughs  
Stephen M. Doniger  
Trevor W. Barrett  
DONIGER/BURROUGHS PC  
603 Rose Avenue  
Venice, CA 90291

Thomas M. Bondy  
Lauren A. Weber  
ORRICK, HERRINGTON &  
SUTCLIFFE LLP  
1152 15th Street, N.W.  
Washington, D.C. 20005

August 3, 2021

E. Joshua Rosenkranz  
*Counsel of Record*  
Christopher J. Cariello  
Jennifer Keighley  
Joseph R. Kolker  
Katherine Kerrick  
ORRICK, HERRINGTON &  
SUTCLIFFE LLP  
51 West 52nd Street  
New York, NY 10019  
(212) 506-5000  
jrosenkranz@orrick.com