

No. 20-915

IN THE
Supreme Court of the United States

UNICOLORS, INC.,

Petitioner,

v.

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

Respondent.

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

**BRIEF OF AMICUS CURIAE NEW YORK
INTELLECTUAL PROPERTY LAW ASSOCIATION
IN SUPPORT OF RESPONDENT**

ROBERT M. ISACKSON
*President, New York Intellectual
Property Law Association*
LEASON ELLIS LLP
1 Barker Avenue
White Plains, NY 10601
(914) 288-0022
isackson@leasonellis.com

ROBERT J. RANDO
*First Vice-President
New York Intellectual
Property Law Association,
Member of Amicus Briefs
Committee*
GREENSPOON MARDER LLP
590 Madison Avenue 18th Fl.
New York, NY 10022
(212) 524-5006
robert.rando@gmlaw.com

Counsel for Amicus Curiae

ROBERT L. RASKOPF
Counsel of Record
CORY D. STRUBLE
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Ave., 22nd Fl.
New York, NY 10010
(212) 849-7000
robertraskopf@
quinnemanuel.com

Mitchell C. Stein
BRAUNHAGEY & BORDEN
LLP
331 Park Avenue South
New York, NY 10010
(646) 829-9403
stein@braunhagey.com

September 27, 2021

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES.....	ii
INTEREST OF <i>AMICUS CURIAE</i>	1
SUMMARY OF ARGUMENT.....	2
ARGUMENT	4
I. SECTION 411(b) DOES NOT REQUIRE A SEPARATE SHOWING OF AN INTENT TO DEFRAUD.....	4
II. INTENT IS IMPLICIT WHERE SECTION 411(b) IS SATISFIED.....	8
III. SECTION 411(b) CONTAINS SUFFICIENT SAFEGUARDS AGAINST ABUSE.....	11
CONCLUSION.....	13

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Am. Tobacco Co. v. Patterson</i> , 456 U.S. 63 (1982).....	5, 13
<i>Consumer Product Safety Comm’n v. GTE Sylva- nia, Inc.</i> , 447 U.S. 102 (1980)	5
<i>DDJ Mgmt., LLC v. Rhone Grp. L.L.C.</i> , 15 N.Y.3d 147 (2010)	10
<i>De Sole v. Knoedler Gallery, LLC</i> , 139 F. Supp. 3d 618 (S.D.N.Y. 2015)	10
<i>DeliverMed Holdings, LLC v. Schaltenbrand</i> , 734 F.3d 616 (7th Cir. 2013).....	11
<i>eSpeed, Inc. v. BrokerTec USA, L.L.C.</i> , 480 F.3d 1129 (Fed. Cir. 2007).....	9
<i>Express Scripts, Inc. v. Wenzel</i> , 262 F.3d 829 (8th Cir. 2001).....	7
<i>Holder v. Hall</i> , 512 U.S. 874 (1994).....	7, 8
<i>Husky Int’l Elecs., Inc. v. Ritz</i> , 136 S. Ct. 1581 (2016).....	8
<i>Lennon v. Seaman</i> , 84 F. Supp. 2d 522 (S.D.N.Y. 2000)	5
<i>In re Napster, Inc.</i> , 191 F. Supp. 2d 1087 (N.D. Cal. 2002)	6, 7
<i>One Treasure Ltd., Inc. v. Richardson</i> , 202 F. App’x 658 (5th Cir. 2006)	5

Paragon Podiatry Lab., Inc. v. KLM Labs., Inc.,
984 F.2d 1182 (Fed. Cir. 1993)10

Pence v. United States,
316 U.S. 332 (1942).....8

Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.,
959 F.3d 1194 (9th Cir. 2020).....4

Statutory Authorities

15 U.S.C. § 1064(3).....8

17 U.S.C. § 408(d).....11

17 U.S.C. § 411(b).....1, 2, 5, 7, 8, 11

17 U.S.C. § 411(b)(2)12

17 U.S.C. § 506(e).....8

17 U.S.C.A. § 409.....9

31 U.S.C.A. § 3729(1)(A)8

Rules and Regulations

37 C.F.R. § 202.3(c)(3)(i).....9

Supreme Court Rule 37.6.....1

Legislative Materials

H.R. Rep. No. 110-617(2008).....3, 5, 6, 7, 10

INTEREST OF *AMICUS CURIAE**

This amicus curiae brief is submitted on behalf of the New York Intellectual Property Law Association (“NYIPLA”).

NYIPLA is a bar association of attorneys who practice in the area of copyright, patent, trademark and other intellectual property (“IP”) law. It is one of the largest regional IP bar associations in the United States.

The NYIPLA’s members include a diverse array of attorneys specializing in copyright law, including in-house counsel for businesses that own, enforce, and challenge copyrights, as well as attorneys in private practice who advise a wide array of clients on copyright matters and procure copyright registrations through the U.S. Copyright Office. Many of the NYIPLA’s member attorneys participate actively in copyright litigation, representing both owners and accused infringers. The NYIPLA, its members, and the clients of its members share an interest in having the standards governing the enforceability of copyrights be reasonably clear and predictable.

The NYIPLA’s members and their respective clients have a strong interest in the issues in this case. At issue here is whether 17 U.S.C. § 411(b) (“Section 411(b)”) should be read as requiring a separate show-

* Pursuant to Supreme Court Rule 37.6, counsel for *amicus curiae* states that no counsel for a party authored this brief in whole or in part, and no one other than *amicus curiae* or its counsel made a monetary contribution intended to fund the preparation or submission of this brief. The parties have consented in writing to the filing of this brief by blanket consent.

ing of an intent to defraud before inaccuracies in an application for registration, made knowingly, can be referred to the Register of Copyrights for a determination as to whether the inaccuracies, if known, would have caused refusal of the registration. Brief for Petitioner (“Br.”) at 31–40. The Petitioner contends that this reading would mean that registrations are not invalidated on the basis of “technicalities.” *Id.* at 21. The NYIPLA and its members believe, however, that the Register is best positioned to decide whether inaccurate information in a registration is a “technicality” or would be material to her decision to grant a registration.†

SUMMARY OF ARGUMENT

I. Nothing in the plain language of Section 411(b) or its legislative history suggests that Congress intended to require a separate showing of intent to defraud the Copyright Office before a court may refer an inaccurate registration to the Register of Copyrights for a determination of whether the inaccura-

† The arguments made in this brief were approved by an absolute majority of the NYIPLA’s officers and members of its Board of Directors, but do not necessarily reflect the views of a majority of the members of the Association, or of the law or corporate firms with which those members are associated. After reasonable investigation, the NYIPLA believes that no officer or director or member of the Amicus Briefs Committee who voted in favor of filing this brief, nor any attorney associated with any such officer, director or committee member in any law or corporate firm, represents a party to this litigation. Some officers, directors, committee members or associated attorneys may represent entities, including other amici curiae, which have an interest in other matters that may be affected by the outcome of this litigation.

cies were material. Section 411(b) requires said referral only when the applicant has provided inaccurate information with knowledge that the information was inaccurate. Although the statutory text is dispositive of the question, rendering examination of legislative history unnecessary, the House Report also contains no indication that Congress intended to require fraudulent intent to be shown. Indeed, the House Report makes clear that referral can be appropriate even in the case of a mistake, if “the mistake was knowingly made.” H.R. Rep. No. 110-617, at 24 (2008). Congress recognized that the Register of Copyrights was best positioned to determine if the mistake was one that mattered.

Nor is there any indication that Congress intended to import into Section 411(b) the common law fraud-on-the-Copyright-Office doctrine or its requirements that fraudulent intent, reliance, and damages be shown. Indeed, the litigation Congress cited in the House Report as motivating Section 411(b) did not involve an allegation of fraud at all, but rather an argument about whether checking the wrong box on the application for registration would impede owners of numerous musical copyrights from availing themselves of a presumption of ownership in a dispute with an alleged pirating outfit.

II. In any event, Section 411(b) is not inconsistent with the traditional common law doctrine. Section 411(b) requires several elements of a traditional fraud, such as falsity, knowledge of falsity, and materiality. Once those elements are established, the existence of intent to induce reliance upon false information and actual reliance are implicit, particularly given that any applicant for copyright registration must certify that the information in the

application is true, and acknowledge that providing false information on a copyright application is a criminal offense.

III. This reading, which is required by the statute’s text and legislative history, will not open the floodgates for referrals to the Register. In more than a decade since the enactment of Section 411(b), there have only been a handful of such referrals. *See Copyright Office Filings Under Section 411*, U.S. Copyright Office, <https://www.copyright.gov/rulings-filings/411/> (last visited September 23, 2021) (23 replies to said referrals). Courts can require an adjudication of whether information is inaccurate, and whether the applicant knew it was inaccurate at the time of the application—a demanding burden—before requiring referral. And even where referral is deemed appropriate, the Register of Copyrights is best situated to determine whether inaccuracies concern mere “technicalities” or are material to the decision to grant a registration.

The Court should affirm the Ninth Circuit’s holding that Section 411(b) contains “no [] intent-to-defraud requirement.” *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 959 F.3d 1194, 1198 (9th Cir. 2020).

ARGUMENT

I. SECTION 411(b) DOES NOT REQUIRE A SEPARATE SHOWING OF AN INTENT TO DEFRAUD

Neither the statutory text nor the legislative history requires that Section 411(b) be read to require a showing of intent to defraud. The word “fraud” appears nowhere in the statute or the portion

of the House Report that discusses the statute. *See* 17 U.S.C. § 411(b); H.R. Rep. No. 110-617, at 24. Rather, the statute sets forth three elements: (1) inaccurate information; (2) knowledge that the inaccurate information was inaccurate; and (3) materiality of the information to the Register of Copyright's decision to grant the registration. 17 U.S.C. § 411(b). While courts applying the common-law fraud-on-the-copyright-office doctrine prior to the enactment of Section 411(b) required fraudulent intent, reliance, and damages, Congress chose not to include any of those elements in the statute. *See Lennon v. Seaman*, 84 F. Supp. 2d 522, 525 (S.D.N.Y. 2000); *One Treasure Ltd., Inc. v. Richardson*, 202 F. App'x 658, 661 (5th Cir. 2006).

A statute's "legislative purpose is expressed by the ordinary meaning of the words used," and "[a]bsent a clearly expressed legislative intention to the contrary, that language must ordinarily be regarded as conclusive." *Am. Tobacco Co. v. Patterson*, 456 U.S. 63, 68 (1982) (citing *Consumer Product Safety Comm'n v. GTE Sylvania, Inc.*, 447 U.S. 102, 108 (1980)). The legislative history reveals that Congress expressed no intention inconsistent with the statute as written. Nor does the legislative history show that Congress intended, as Petitioner asserts, to codify the common law doctrine of fraud-on-the-Copyright-Office as that doctrine had been prescribed by the courts. Br. at 3, 20, 31. The House Report does not mention that doctrine. H.R. Rep. No. 110-617, at 24. Rather, as Petitioner recognizes, "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.” Br. at 38 (quoting H.R. Rep. No. 110-617, at 20. Accordingly, the House Report frames its discussion of Section 411(b) by reference to the fact that it had “been argued in litigation that a mistake in the registration documents, such as by checking the wrong box on the registration form, renders a registration invalid and thus forecloses the availability of statutory damages,” making copyright enforcement more difficult. H.R. Rep. No. 110-617, at 24.

As an example of such litigation arguments, the House Report cited the decision in *In re Napster, Inc.*, 191 F. Supp. 2d 1087, 1099 (N.D. Cal. 2002). *Id.* at n.15. Notably, in that case, the defendant, music-sharing platform Napster, did “not allege[] fraud” on the Copyright Office. *Napster*, 191 F.Supp.2d at 1100. Rather, the plaintiffs, who “control[led] 85% of all music sales,” were listed in registrations as “authors” of the musical works Napster allegedly infringed, and Napster “raised serious questions as to the validity of plaintiffs’ claims of ownership.” *Id.* at 1098, 1100. The court reasoned that, to establish ownership, the works at issue needed to be “either ‘works for hire’ or assigned to plaintiffs.” *Id.* at 1099. But the registration certificates “list[ed] plaintiffs as authors, not owners by assignment.” *Id.* The plaintiffs contended that a “presumption of ownership applies regardless of which box is checked on the copyright certificate.” *Id.* The court noted that it was “reticent to allow plaintiffs, merely because of the quantity of music they control, to railroad Napster into potentially billions of dollars in statutory damages without adequately proving ownership.” *Id.* at 1100.

With that context, the House Report expressed a desire to “prevent intellectual property thieves from exploiting this potential loophole”—i.e., a “mistake in the registration documents, such as checking the wrong box”—that would “render[] a registration invalid.” H.R. Rep. No. 110-617, at 24. Accordingly, in Section 411(b), Congress created a presumption that “a registration containing inaccuracies will satisfy the registration requirements of the Copyright Act, unless the mistake was knowingly made, and the inaccuracy, if known, would have caused the Register of Copyrights to refuse the registration.” *Id.*; 17 U.S.C. § 411(b).

As evidenced by the statute and the House Report, Congress’ main concern was with preventing unknowing, immaterial mistakes from precluding recovery for infringement. There is no discussion in the House Report of the fraud-on-the-Copyright-Office doctrine, nor did Congress express any desire to require a showing of intent to defraud in order to overcome the presumption of validity. The only evidence Petitioner cites that Congress intended to codify the fraud-on-the-Copyright-Office doctrine is a passing reference in a statement in the Copyright Office’s Annual Report. Br. at 9 (citing *Annual Report of the Register of Copyrights, Fiscal Year Ending September 30, 2008*, 13 (2008), <https://tinyurl.com/d2x94cr5>). But a statement by the Copyright Office is not evidence of what members of Congress intended. See *Express Scripts, Inc. v. Wenzel*, 262 F.3d 829, n.5 (8th Cir. 2001) (agency’s press releases were “not evidence of legislative intent because they were issued by the [agency], not a legislative body”); *Holder v. Hall*, 512 U.S. 874, n.28 (1994) (“when resort to legislative

history is necessary, it is only committee reports, not the various other sources of legislative history, that should be considered”).

In any event, “[r]esort to legislative history is only justified where the face of the [statute] is inescapably ambiguous,” *id.*, and here, there is no ambiguity. Congress chose to require only “knowledge that [the information] was inaccurate.” 17 U.S.C. § 411(b). Knowledge of falsity does not, standing alone, require an intent to defraud. *See, e.g., Husky Int’l Elecs., Inc. v. Ritz*, 136 S. Ct. 1581, 1586 (2016) (“It is therefore sensible to start with the presumption that Congress did not intend ‘actual fraud’ to mean the same thing as ‘a false representation’”). For example, the False Claims Act applies to any person who “knowingly presents” a false claim for payment, and Congress specified that “the terms ‘knowing’ and ‘knowingly’ ... require no proof of specific intent to defraud.” 31 U.S.C.A. § 3729(1)(A), (b)(1). And where Congress has sought to require a showing of fraud, it has done so explicitly, e.g., a trademark registration may be invalidated where it “was obtained fraudulently.” *Br.* at 39 (citing 15 U.S.C. § 1064(3)).

II. INTENT IS IMPLICIT WHERE SECTION 411(b) IS SATISFIED

That Congress did not intend for Section 411(b) to require a separate showing of an intent to defraud is further evident from the fact that, where Section 411(b) is satisfied, an intent to induce the Register’s reliance on inaccurate information is implicit. Section 411(b) contains several traditional elements of common-law fraud, namely falsity, knowledge of falsity, and materiality. *Pence v. United States*, 316

U.S. 332, 338 (1942). Additionally, under Section 506(e) of the Copyright Act, it is a criminal offense to “knowingly make[] a false representation of a material fact in the application for copyright registration.” 17 U.S.C. § 506(e). Congress has also empowered the Register to prescribe the form of applications for registration, 17 U.S.C.A. § 409, and the Register has long required that any application for copyright be “certified” and “state that the information provided within the application is correct to the certifying party’s knowledge.” 37 C.F.R. § 202.3(c)(3)(i), (iii).

Thus, a registration invalidated under Section 411(b) is one where the applicant knowingly provided inaccurate information, certified in the application that the information was correct when it was not, and where the Register’s decision to grant registration depends in material part on that inaccurate information.

In the patent context, courts considering claims of “inequitable conduct” that would invalidate a patent have held that “[a]n inference of intent [to deceive] may arise where material false statements are proffered in a declaration or other sworn statement submitted to the PTO.” *See eSpeed, Inc. v. BrokerTec USA, L.L.C.*, 480 F.3d 1129, 1137–38 (Fed. Cir. 2007). The “inference that material false statements” were “made with deceptive intent ‘arises not simply from the materiality of the affidavits, but from the affirmative acts of submitting them, their misleading character, and the inability of the examiner to investigate the facts.’” *Id.* at 1138 (citing *Paragon Podiatry Lab., Inc. v. KLM Labs., Inc.*, 984 F.2d 1182, 1188 (Fed. Cir. 1993)).

Similarly, in the civil fraud context, courts have recognized that a certification that a false statement is a true one supports a finding of reliance. For example, the New York Court of Appeals has held that “where a plaintiff has gone to the trouble to insist on a written representation that certain facts are true, it will often be justified in accepting that representation rather than making its own inquiry.” *DDJ Mgmt., LLC v. Rhone Grp. L.L.C.*, 15 N.Y.3d 147, 154 (2010); *e.g. De Sole v. Knoedler Gallery, LLC*, 139 F. Supp. 3d 618, 646 (S.D.N.Y. 2015) (reliance established where plaintiff “received ‘written confirmation of the truthfulness of the representations at issue.’”).

As these courts have recognized, the entire point of certifying information is correct is to affirmatively state that the recipient of the certificated information can rely upon it as being truthful and accurate. In the context of an application for copyright registration, the information is being supplied in order to induce the Register to rely on that information and grant a copyright registration. It follows that, where it has been established that an applicant provided information that it knew was incorrect, and where that information was material to the Register’s decision to grant or refuse the registration—i.e., the decision would turn on such information—intent to induce reliance upon incorrect information is implicit.

For this reason, Section 411(b) is not inconsistent with a rule that “inadvertent mistakes on registration certificates’ [do] not ‘bar infringement actions.’” Br. at 32. Inadvertence is addressed by the statute’s requirement of knowledge of falsity and materiality. Indeed, the House Report characterizes

Section 411(b) as protecting a mistake, “unless the mistake was knowingly made” and material. H.R. Rep. No. 110-617, at 24. This observation shows that Congress intended for Section 411(b) to apply to what could be considered a “mistake,” so long as that “mistake” was “knowingly made.” *Id.* And a copyright owner in the position of having made a knowing mistake is not without redress; the Copyright Act allows a registration to be corrected. 17 U.S.C. § 408(d).

III. SECTION 411(b) CONTAINS SUFFICIENT SAFEGUARDS AGAINST ABUSE

Section 411(b) contains mechanisms to sufficiently guard against the abuse that Petitioner fears, such as use of Section 411(b) as a delay tactic or to defeat otherwise legitimate copyright infringement claims. Inaccurate information and knowledge of the inaccuracy are conditions for referral to the Register of Copyrights. 17 U.S.C. § 411(b). As the Seventh Circuit has recognized, “input need not be sought immediately after a party makes such a claim” because “courts can demand that the party seeking invalidation first establish that the other preconditions to invalidity are satisfied before obtaining the Register's advice on materiality.” *DeliverMed Holdings, LLC v. Schaltenbrand*, 734 F.3d 616, 625 (7th Cir. 2013). The court further observed that requiring these elements to be established prior to referral “minimize[es] the risk that parties would use this provision as a delay tactic.” *Id.*

That approach also guards against the risk that the Copyright Office is “overwhelmed with referrals.” Br. at 21. Indeed, while Petitioner acknowledges

that some “half-a-million registration applications [are] ... submit[ted] each year,” Br. at 2, it is rare that federal courts refer registrations to the Register pursuant to Section 411(b). As the Copyright Office’s website reflects, it has issued 23 replies to such referrals since Section 411(b)’s enactment in 2008. *See Copyright Office Filings Under Section 411*, U.S. Copyright Office, <https://www.copyright.gov/rulings-filings/411/> (last visited September 23, 2021).

Nor does Section 411(b) let “willful infringers skate on technicalities.” Br. at 5. The statute requires that inaccurate information to have been such that it “would have caused the Register of Copyrights to refuse registration.” 17 U.S.C. § 411(b)(2). Referring knowing inaccuracies to the Register for a determination of materiality is sound policy, for the Register is best positioned to know whether it would have granted an application containing inaccurate information. Whether particular information constitutes an immaterial “technicality,” Br. at 13, is particularly within the Register’s facility to determine.

CONCLUSION

Amicus curiae respectfully urges this Court to affirm the holding of the decision below that Section 411(b) contains no intent-to-defraud requirement.

Respectfully submitted,

ROBERT M. ISACKSON
President
New York Intellectual
Property Law Association
LEASON ELLIS LLP
1 Barker Avenue
White Plains, NY 10601
(914) 288-0022
isackson@leasonellis.com

ROBERT J. RANDO
First Vice-President
New York Intellectual
Property Law Association,
Member of Amicus Briefs Committee
GREENSPOON MARDER LLP
590 Madison Avenue 18th Fl.
New York, NY 10022
(212) 524-5006
Robert.rando@gmlaw.com

ROBERT L. RASKOPF
Counsel of Record
CORY D. STRUBLE
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Avenue,
22nd Floor
New York, NY 10010
(212) 849-7000
robertraskopf@
quinnemanuel.com

MITCHELL C. STEIN
BRAUNHAGEY
& BORDEN LLP
331 Park Avenue South
New York, NY 10010
(646) 829-9403
Stein@braunhagey.com

Counsel for Amicus Curiae

September 27, 2021