

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

UNICOLORS, INC.,

Plaintiff,

v.

Case No. CV 15-3866 DMG (ASx)

BURLINGTON STORES, INC., et al.,

Defendants.

**RESPONSE OF THE REGISTER OF COPYRIGHTS
TO REQUEST PURSUANT TO 17 U.S.C. § 411(b)(2)**

On December 10, 2015, pursuant to 17 U.S.C. § 411(b)(2), the Court requested advice from the Register of Copyrights (“Register”) by March 10, 2016, on the following question (the “Request”):

Would the Register of Copyrights have refused Unicolors’ Copyright Registration No. VA 1-851-115 (for two-dimensional artwork covering repeating leopard design called CMP1076(RT), under title conversation/animal 2012(8) filed on December 14, 2012), if the Register of Copyrights had known that although Unicolors did not identify the work as being a derivative work, Unicolors had created the submitted leopard pattern artwork based upon a preexisting leopard photograph that was owned by a third party?¹

The Register hereby submits her response.

BACKGROUND

A review of the Copyright Office’s records shows the following:

On December 14, 2012, the U.S. Copyright Office (“Copyright Office” or “Office”) received an application to register a two-dimensional artwork called CMP1076(RT) (full title, *conversation/animal 2012(8): CMP 1076(RT)*). The application identified Unicolors, Inc., as the work made for hire author and copyright claimant of the two-dimensional artwork. The application stated that the work was created in 2012, and that it was published in the United States on August 31, 2012. The application did not identify the work as a derivative work or disclose that the work incorporated preexisting material. The Office registered the work with an effective date of registration (“EDR”)²

¹ Request at 2.

² The EDR is the date that the Office received a completed application, the correct deposit copy, and the proper filing fee.

of December 14, 2012, and assigned registration number VA 1-851-115. Based on the information provided in the application, the Office had no reason to question the representations in the application and accepted them as true and accurate.³

In the Order accompanying the Request, the Court found “that Defendants have sufficiently demonstrated that the [work registered under VA 1-851-115] is a derivative work based on the leopard photograph” by Patrick Giraud titled *Namibie Etosha Leopard*, and that the Plaintiff “knowingly” omitted information regarding the preexisting leopard photograph from its application.⁴ The Court has requested the Register to consider whether, given this information, the Office would have refused to register the claim.

ANALYSIS

An application for copyright registration must comply with the requirements of the Copyright Act set forth in 17 U.S.C. §§ 408(a), 409, and 410. Regulations governing applications for registration are codified in title 37 of the Code of Federal Regulations at 37 C.F.R. §§ 202.1 to 202.21 (2015). The principles that govern how the Office examines registration applications are found in the *Compendium of U.S. Copyright Office Practices, Third Edition* (“*Compendium*”). The statutory requirements, regulations, and *Compendium* practices most relevant to the Court’s request are as follows:

In pertinent part, the statutory requirements for copyright registration dictate that an application for registration shall “in the case of a compilation or derivative work,” include “an identification of any preexisting work or works that it is based on or incorporates, and a brief, general statement of the additional material covered by the copyright claim being registered.”⁵ The *Compendium* adds that “[a] claim should be limited if the work contains an appreciable amount of material that was previously published, material that was previously registered, material that is in the public domain, and/or material that is owned by an individual or legal entity other than the claimant who is named in the application,”⁶ and that “[i]f the work ... contains an appreciable amount of unclaimable⁷ material, the applicant should identify the unclaimable material that appears in that work and should exclude that material from the claim [by providing] a brief, accurate description of the unclaimable material in the appropriate field/space of the application.”⁸

³ The principles that govern how the Office examines registration applications are found in the *Compendium of U.S. Copyright Office Practices, Third Edition*. One such principle is that the Office generally “accepts the facts stated in the registration materials, unless they are contradicted by information provided elsewhere in the registration materials or in the Office’s records.” Additionally, “the Office does not conduct investigations or make findings of fact to confirm the truth of any statement made in an application.” COMPENDIUM (THIRD) § 602.4(D). The application for registration number VA 1-851-115 was filed in 2012. The governing principles that the Office would have applied at the time of application are set forth in the *Compendium of U.S. Copyright Office Practices, Second Edition*. Throughout this response, however, the Office cites the third edition of the *Compendium* because the relevant practices have not materially changed.

⁴ Order Granting Defendants’ Motion for Issuance of Request to Register of Copyrights; Plaintiff’s *Ex Parte* Application to Extend Discovery Cut-Off Date at 2, 6-7.

⁵ 17 U.S.C. § 409(9).

⁶ COMPENDIUM (THIRD) § 621.

⁷ Unclaimable means “(i) previously published material; (ii) previously registered material; (iii) material that is in the public domain; and/or (iv) copyrightable material that is not owned by the claimant named in the application.”

COMPENDIUM (THIRD) Glossary.

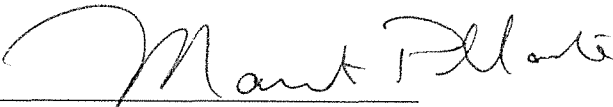
⁸ COMPENDIUM (THIRD) § 621.1.

The Copyright Office's regulations require applicants to make "[a] declaration that information provided within the application is correct to the best of [the applicant's] knowledge."⁹ Generally, the Office "accepts the facts stated in the registration materials, unless they are contradicted by information provided elsewhere in the registration materials or in the Office's records."¹⁰ The Office "generally does not compare deposit copy(ies) to determine whether the work for which registration is sought is substantially similar to another work."¹¹

Based on the foregoing governing statutory and regulatory standards, and its examining practices, had the Office been aware that the work registered under VA 1-851-115 was based on a preexisting leopard photograph owned by a third party, the Office would have refused to register the work pursuant to the application submitted because the application failed to identify that preexisting photograph.

The Office notes, however, that it is not unusual for the examiner to correspond with an applicant about factual assertions if the assertions appear to conflict with other information provided in the application materials.¹² Accordingly, if the Office becomes aware of an error at the time of application, such as the omission of the statement regarding preexisting material, or has questions about facts asserted in the application, it provides the applicant an opportunity to correct the error or verify the facts within a specified period of time.¹³ If the applicant responds in a timely fashion to the satisfaction of the Office, the Office can proceed with the registration. The Register's response herein is thus premised on the fact that the error identified in the Court's question was not timely corrected through such a process.

Dated: March 3, 2016



Maria A. Pallante
Register of Copyrights

⁹ 37 C.F.R. § 202.3(c)(2)(iii).

¹⁰ COMPENDIUM (THIRD) § 602.4(D).

¹¹ COMPENDIUM (THIRD) § 604.2(C).

¹² COMPENDIUM (THIRD) § 602.4(D).

¹³ If the work "appears to be a derivative" and the applicant fails to identify preexisting material on the registration application, the Office will "either annotate the registration record," to indicate that the work contains preexisting material, or "communicate with the applicant." *See* COMPENDIUM (THIRD) § 621.1. Generally, an applicant has 20 calendar days to respond via email, and 45 calendar days to respond via U.S. mail to questions concerning issues in the application materials. *See* COMPENDIUM (THIRD) §§ 605.6(B), 605.6(D).