

Nos. 19-55840, 19-55892

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IN THE UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT

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UNIVERSAL DYEING AND PRINTING, INC.,  
Plaintiff-Appellant/ Cross-Appellee,

v.

TOPSON DOWNS OF CALIFORNIA, INC.,  
Defendant-Appellee/ Cross-Appellant.

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ON APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE CENTRAL DISTRICT OF CALIFORNIA

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**BRIEF FOR THE UNITED STATES AS AMICUS CURIAE  
IN SUPPORT OF APPELLANT/CROSS-APPELLEE**

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## **INTRODUCTION AND INTEREST OF THE UNITED STATES**

The United States files this amicus brief pursuant to 28 U.S.C. 517 and Federal Rule of Appellate Procedure 29(a). Under the Copyright Act, if a defendant in a copyright infringement action alleges that the plaintiff knowingly included inaccurate information in its application for a certificate of registration, “the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.” 17 U.S.C. 411(b)(2). The question presented in this copyright infringement action is whether the district court erred by holding that the plaintiff’s registration was invalid on the basis of alleged knowing misstatements in the application without first seeking the Register of Copyrights’ views on whether such misstatements, if known, would have caused the Register to refuse the registration.

The Register of Copyrights, as director of the Copyright Office, has an interest in preserving her statutorily-mandated prerogative to assess, under the appropriate procedures, whether registration would have been denied if the applicant had provided accurate information. See 17 U.S.C. 411(b)(2). The Register’s interest in ensuring that courts comply with this statutory requirement as prescribed by Congress is distinct from the interests of the parties in copyright infringement actions.

## STATUTORY AND FACTUAL BACKGROUND

A. The Copyright Act provides for the registration of works by the Register of Copyrights as director of the Copyright Office. 17 U.S.C. 408(a), 410. To obtain registration, an author must submit the required deposit copy or copies of her work, an application including information about the work, and an application fee to the Copyright Office. 17 U.S.C. 408(a), (b), 409, 708. The Register of Copyrights determines whether the work “constitutes copyrightable subject matter” and whether other statutory requirements have been met, and if so, registers the claim and issues a certificate of registration. 17 U.S.C. 410(a). If the Register instead “determines that . . . the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration.” 17 U.S.C. 410(b).

Under the Copyright Act, registration of a copyright is not a “condition of copyright protection.” 17 U.S.C. 408(a). Absent registration, an author still obtains “exclusive rights” in her work at the time she creates it, including rights of reproduction, distribution, and display. See 17 U.S.C. 106. Registration of a copyright generally is a “precondition to filing” an infringement claim, however. *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 157 (2010). In particular, Section 411 of the Copyright Act provides, as a general matter, that “no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.” 17

U.S.C. 411(a). Thus, as the Supreme Court recently observed, under Section 411(a) of the Act, registration of the copyright is “akin to an administrative exhaustion requirement that the owner must satisfy before suing to enforce ownership rights.” *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881, 887 (2019).

Authors who attempt to register their works but are denied registration by the Copyright Office may nonetheless “institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.” 17 U.S.C. 411(a). In those circumstances, the Register has a statutory right to “become a party to the action with respect to the issue of registrability of the copyright claim,” though the “Register’s failure to become a party shall not deprive the court of jurisdiction to determine that issue.” *Id.*

In addition to being a statutory precondition to instituting an infringement action, registration can be relevant to substantive issues in litigation. A certificate of registration obtained within five years of when a work was first published “constitute[s] prima facie evidence of the validity of the copyright and of the facts stated in the certificate.” 17 U.S.C. 410(c). Registration can also be relevant to the types of damages available in an infringement action, though that issue is not presented here. 17 U.S.C. 412.

**B.** In 2008, Congress enacted the Prioritizing Resources and Organization for Intellectual Property Act, Pub. L. No. 110-403, 122 Stat. 4256 (Pro IP Act), which, *inter alia*, amended the Copyright Act to add Section 411(b). Pursuant to that section,

a certificate of registration meets the requirements of Section 411(a)—and thus entitles an author to institute an infringement action—even if it includes inaccurate information, unless such information “was included on the application for copyright registration with knowledge that it was inaccurate,” and the inaccuracy, “if known, would have caused the Register of Copyrights to refuse registration.” 17 U.S.C. 411(b)(1). If a defendant in an infringement suit alleges that the plaintiff knowingly included inaccurate information in its application for a certificate of registration, “the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.” 17 U.S.C. 411(b)(2).

C. Universal Dyeing & Printing, Inc. (Universal), a fabric printer, obtained a copyright registration on a fabric design known as the “28 Design” with an effective date of September 7, 2011. Excerpts of Record Vol. I (ERI) 5. The 28 Design was registered as a part of a collection of fifteen textile designs. *Id.*; see 17 U.S.C. 408(c)(1). A registration for a published collection covers the component individual textile designs that the claimant owned at the time the application was filed that were not previously published, previously registered or in the public domain. U.S. Copyright Office, *Compendium of U.S. Copyright Practices* § 509.1 (3d ed. 2014); see also *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 853 (9th Cir. 2012) (holding that works “must be sold, distributed or offered for sale concurrently” to be registrable as a published collection). As discussed below, the parties dispute whether



the registration constitutes a valid registration of the 28 Design or if the component designs had been previously published when the collection was created.

In May 2017, Universal filed a complaint against Topson Downs of California, Inc. (Topson), alleging copyright infringement. Universal claimed that Topson infringed the copyright in the 28 Design by distributing and selling fabric and garments with a design that is substantially similar to the 28 Design. See ERI 4.

**D.** Following a two-day trial, the district court entered judgment in favor of Topson. ERI 10-14. The district court concluded that the registration was invalid for two reasons. First, the court held that although Universal's application for registration stated that it was the author of all fifteen designs that it was attempting to register, it actually was the author of only three of the designs, including the 28 Design at issue, while the other twelve designs were assigned to Universal by a third party author. ERI 5-8. Second, the court determined that the fifteen designs could not be registered as a publication collection because, contrary to Universal's representation on the application, they had not all been sold, distributed, or offered for sale concurrently. ERI 12-13. Specifically, the district court concluded that Universal had added the fifteen designs to a Design Book in its showroom, which, the court found, Universal provided to customers for the purpose of soliciting orders, on various dates prior to the publication date listed on the application. ERI 9-10, 13.

Based on these conclusions, the court held that although Universal had a presumption of validity for its copyright and the facts stated in its registration

certificate, Topson had rebutted that presumption. ERI 10-11. The court stated that because the presumption was rebutted, Universal had “the burden of proving it has a valid registration.” ERI 11.

Because the district court determined that, contrary to Universal’s representations on its application, it was not the author of all fifteen designs, and that the designs were published on various dates prior to the listed July 2011 publication date, the court held that Universal “failed to establish that it has a valid single work registration that complies with the single unit of publication requirement.” ERI 13. The court further concluded that Universal thus had “not established its prima facie case for infringement,” and entered judgment in favor of Topson. ERI 13-14.

## **ARGUMENT**

### **THIS COURT SHOULD REMAND TO THE DISTRICT COURT TO SEEK THE VIEWS OF THE REGISTER OF COPYRIGHTS AS REQUIRED BY SECTION 411 OF THE COPYRIGHT ACT.**

**A.** Registration of a copyright with the Register of Copyrights is a precondition to filing a copyright infringement action. 17 U.S.C. 411(a). Thus, if an author has not registered a copyright, her infringement suit generally must be dismissed.

Although a certificate of registration typically satisfies the registration requirement, under Section 411(b)(1) of the Copyright Act, it will not do so if the applicant included inaccurate information on the application with knowledge that it was inaccurate, and the Register of Copyrights would have refused registration if the

inaccuracy had been known. In a court action where a party challenges the validity of a copyright registration on this basis, Congress specified that the court “shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.” 17 U.S.C. 411(b)(2).

Here, defendant Topson challenged the validity of the certificate of registration in briefing before the district court. See ERII 328-329, 346-347. As set forth above, the district court held that Universal’s representations with respect to authorship and publication dates of the designs it registered were inaccurate. ERI 5-13. The government takes no position on the district court’s factual findings.

The district court erred, however, by failing to follow Congress’s explicit instruction that “[i]n any case in which” a party alleges that the application for a registration contained inaccurate information that the applicant knew was inaccurate and which, if known, would have caused the denial of the certificate, the “court **shall** request the Register of Copyrights to advise the court” whether it would have refused registration had it known about the inaccurate information. 17 U.S.C. 411(b)(2) (emphasis added). Instead, without first seeking the views of the Register of Copyrights, the district court held that Universal’s registration was invalid.

The court’s failure to follow Congress’s clear statutory mandate is particularly anomalous because the Register is uniquely positioned to resolve the question at issue—*i.e.*, whether “the inaccuracy of the information, if known, would have caused

*the Register of Copyrights* to refuse registration.” 17 U.S.C. 411(b)(1)(B) (emphasis added). It is unsurprising that Congress instructed courts to ask the Register to answer that question. Moreover, the required inquiry to the Register in these circumstances is of a piece with the statutory scheme, which ensures that district courts will not resolve questions regarding whether registration was appropriate without a full opportunity for the Register to express her views. Indeed, although an applicant can institute an infringement action after the Register refuses registration, Congress provided that the applicant must notify the Register, and that the Register has the right to “become a party to the action with respect to the issue of registrability.” 17 U.S.C. 411(a).

The Seventh Circuit has recognized the importance of this statutory requirement that a district court seek the Register’s views pursuant to the procedure outlined in Section 411(b)(2). In a decision that is particularly instructive here, the Seventh Circuit held that the failure to request the Register of Copyrights’ views in the circumstances presented here constitutes reversible error and warrants a remand. See *DeliverMed Holdings, LLC v. Schaltenbrand*, 734 F.3d 616 (7th Cir. 2013); see also Universal Br. 19-22 (arguing that this Court should follow *DeliverMed Holdings*). In *DeliverMed Holdings*, the district court had invalidated plaintiff’s copyright registration following a bench trial in which it determined that plaintiff had made material misrepresentations in its registration application. 734 F.3d at 622-623. Although the Seventh Circuit upheld the district court’s finding that plaintiff had knowingly

included inaccurate information on the registration application, it vacated the court's declaratory judgment invalidating the registration and remanded for further proceedings. *Id.* at 623-625. The court noted that in the 2008 PRO IP Act, Congress had enacted a "new procedure for courts confronted with a registration allegedly obtained by knowing misstatements in an application." *Id.* at 623. Under this procedure, the Seventh Circuit ruled, a court cannot rely solely on its "own assessment of the Register's response to an inaccuracy"; rather, "the statute obligates courts to obtain an opinion from the Register on the matter." *Id.* (citing 17 U.S.C. 411(b)(2)).

The Seventh Circuit further opined that it made no difference that neither party asked the court to consult the Register since "ignoring a clear statutory directive due to the inadvertence of the parties would defeat the purpose of 17 U.S.C. 411(b)(2) and deprive the Register of its right to weigh in on precisely this issue." *DeliverMed Holdings*, 734 F.3d at 624. The court thus recognized the fact that the plain language of the statute makes clear Congress's intent to provide the Register with the opportunity to assess, under the appropriate procedures, whether she would have denied registration had she known the actual facts. See *id.* The district court has no discretion to eliminate that right, as evidenced by the mandatory nature of the provision. Nor are the parties entitled to deprive the Register of her statutory prerogative by failing to affirmatively request that the court seek the Register's views.

Rather, Section 411(b)(2) protects a right of the Register, in her capacity as director of the Copyright Office, which is independent of the parties' rights and interests.

Accordingly, the Seventh Circuit remanded the case to afford the district court the opportunity to seek the Register's views, and, upon "receiving that advisory opinion," to "then determine whether to invalidate [plaintiff's] registration."

*DeliverMed Holdings*, 734 F.3d at 624-625. The Seventh Circuit's analysis is correct, applies with equal force here, and supports vacatur of the judgment and a remand.

In short, Congress's purpose in enacting Section 411(b)(2) would be subverted if this Court were to affirm the district court's holding that Universal's registration was invalid without a remand to seek the Register's views. As the Seventh Circuit explained, however, a district court need not immediately seek the views of the Register any time a defendant merely alleges a knowing misstatement in an application for a certificate of registration. See *DeliverMed Holdings*, 734 F.3d at 625. Rather, before seeking the views of the Register, district "courts can demand that the party seeking invalidation [of the registration] first establish" that "(1) the registration application included inaccurate information; and (2) the registrant knowingly included the inaccuracy in his submission to the Copyright Office." *Id.* Here, the district court already determined that Topson had established that, contrary to Universal's statements in its application, Universal was not the author of all of the designs in the collection it sought to have registered and that the designs had been placed in the design book before July 15, 2011. ERI 11. At that point, under Section 411(b)(2), the

court was required to obtain the Register’s views before invalidating the registration.<sup>1</sup> See *Gold Value Int’l Textile, Inc. v. Sanctuary Clothing, LLC*, 925 F.3d 1140, 1143, 1148 (9th Cir. 2019) (in response to district court inquiry, Register of Copyrights stated that registration would have been denied had Register known of inaccuracy; thus, district court satisfied Section 411(b) when it held registration invalid), *petition for cert. filed*, U.S. No. 19-708 (Dec. 4, 2019).

**B.** Compounding its error, the district court did not even purport to determine, pursuant to the statutory standard in Section 411(b)(1)(B), whether “the inaccuracy of the information” that it found in Universal’s application “if known, would have caused the Register of Copyrights to refuse registration.” 17 U.S.C. 411(b)(1)(B). Instead, the district court stated that Topson had “rebutted the presumption of validity afforded by 17 U.S.C. 410(c),” and that Universal thus had “the burden of proving it has a valid registration.” ERI 11. The court thereby conflated the issue of whether the *registration* was valid with the ultimate question of whether the *copyright* is valid.

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<sup>1</sup> In its opening brief, Universal also challenges the district court’s holdings on several alternative factual and legal grounds. The United States does not take a position on the merits of these issues or on whether the Court should reach them prior to remand to the district court to comply with Section 411(b)(2). We note, however, that if this Court were to determine that Universal did not knowingly make misrepresentations in its registration application, that could obviate the need for the district court to seek the Register’s views pursuant to Section 411(b)(2).

As discussed, Congress made clear in multiple ways that the district court should not make determinations regarding the validity of a copyright registration without first obtaining the input of the Register of Copyrights. Congress authorized the commencement of a copyright infringement action only if an application for registration has been filed, and the Register has either granted or refused registration. See 17 U.S.C. 411(a). If registration is refused, the author must provide the Register with notice of any infringement action, and the Register has a statutory right to participate in the litigation. *Id.* And if the Register is deprived as an initial matter of her prerogative to assess the application because the author did not provide her with accurate information, the Register has a statutory right to inform the district court of whether she would have refused registration had she known of the correct information. See 17 U.S.C. 411(b)(2).

The provision cited by the district court, 17 U.S.C. 410(c), addresses a different question. Cf. ERI 11-13. That provision states that a “certificate of a 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 certificate.” 17 U.S.C. 410(c). Accordingly, the provision addresses the evidentiary value of the certificate of registration in determining the validity of the copyright, which is one of the ultimate questions the district court would resolve in cases that are not dismissed on threshold grounds. Section 410(c) is not relevant to the threshold



issue of the validity of the registration itself, which the court must resolve by using the procedures set forth in Section 411.

For these reasons, this Court should remand to the district court with instructions to seek the views of the Register of Copyrights in accordance with 17 U.S.C. 411(b)(2). If the Register states that she would have refused registration had she known the actual facts, and the district court determines that the registration is invalid, then it should dismiss Universal's action. *Gold Value*, 925 F.3d at 1142-1148 (Court affirms dismissal of plaintiff's infringement claims where district court had considered Register's response, provided pursuant to procedure under Section 411(b)(2), that registration would have been refused had Copyright Office known of misstatement in application).

If the district court determines that the registration is valid under Section 411(b)(2) after obtaining the Register's views, however, it still would need to determine whether Topson infringed Universal's copyright. To prevail on its copyright infringement claim, Universal would bear the burden of proving that it owns a valid copyright in the 28 Design and that Topson infringed that copyright. *L.A. Printex*, 676 F.3d at 846. Having passed the threshold registration requirement, the certificate of registration would only be relevant to the extent that it provides Universal with a presumption of validity of the copyright and the facts stated on the certificate, which Topson can rebut by "simply offer[ing] some evidence or proof to dispute or deny the plaintiff's prima facie case of infringement." *Lamps Plus, Inc. v.*

*Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1144 (9th Cir. 2003) (quotation marks omitted). The court would ultimately determine whether the 28 Design is subject to copyright protection and, if so, whether Topson infringed the copyright in the 28 Design.

## CONCLUSION

This Court should vacate the judgment and remand the case to the district court with instruction to seek the views of the Register of Copyrights in accordance with 17 U.S.C. 411(b)(2).

Respectfully submitted,

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### **CERTIFICATE OF COMPLIANCE**

I hereby certify this brief complies with the requirements of Fed. R. App. P. 29(a)(5), 32(a)(5), (6), and (7), and Circuit Rule 32-1 because it has been prepared in 14-point Garamond, a proportionally spaced font, and, according to the word count of Microsoft Word, it contains 3,355 words, excluding the parts of the brief exempted under Fed. R. App. P. 32(f).

/s/ Stephanie R. Marcus  
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