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Mistakes Happen, but Do They Bar Your Copyright Infringement Action?

By Ashly Boesche



A copyright registration is required to bring a “civil action for infringement” in federal district court. 17 U.S.C.

§ 411(a). But, what happens when an infringement suit is based on a copyright registration that the copyright holder acquired by submitting inaccurate information? This is precisely the question that the United States Supreme Court recently answered in *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 595 U.S. ____ (2022).

Unicolors, Inc. (“Unicolors”) is a fabric designer that sells its designs to retailers and garment manufacturers. *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 959 F.3d 1194, 1195 (9th Cir. 2020). Some of Unicolors’ designs are created for specific customers and those designs are “confined,” or in other words, not released to the public or displayed in Unicolors’ showroom until the exclusivity period is over. *Id.* To save time and money, Unicolors would routinely apply for groups of its designs in a “single unit copyright registration.” *Unicolors, Inc. v. H&M Hennes Mauritz L.P.*, a 2018 WL 10307045 at *3 (C.D. Cal. 2018). The Copyright Office permits such multiple works to be registered “as a single work” so long as “the collection is sold, distributed, or offered for sale concurrently.” 2018 WL 10307045 at *1 (C.D. Cal. 2018) citing *United Fabrics Int’l, Inc. v. C&J Wear, Inc.*, 630 F.3d 1255, 1259 (9th Cir. 2011). In 2011, Unicolors applied and received a “single unit” copyright registration for 31 separate designs. *Id.* In its application to the Copyright Office, Unicolors claimed a first publication date of January 15, 2011 despite the fact that some of those designs were “confined” and not made available to the public. *Id.*

In 2017, Unicolors sued H&M Hennes & Mauritz (“H&M”) for copyright infringement of one of the fabric designs covered by its 2011 copyright registration. *Unicolors, Inc. v. H&M Hennes Mauritz L.P.*, 2018 WL 10307045 at *1 (C.D. Cal. 2018). After trial, the jury returned a verdict in Unicolors’ favor finding that H&M infringed Unicolors’ copyrighted design and awarded over \$800,000 in damages. *Id.*

“ ... CONGRESS WAS ATTEMPTING TO MAKE IT EASIER, NOT HARDER, FOR NONLAWYERS TO OBTAIN VALID COPYRIGHT REGISTRATIONS. ”

After trial, H&M moved for judgment as a matter of law, arguing that Unicolors did not have a valid copyright registration on which the lawsuit was based. *Id.* H&M argued that Unicolors obtained the copyright registration fraudulently because some of the designs included in the single copyright registration were “confined” and not published on the same date. *Id.* at 2.

The district court denied H&M’s motion relying on the Copyright Act’s safe harbor provision, which provides that “a registration remains effective despite containing 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.’” *Id.* at 3, citing 17 U.S.C. § 411(b)(1). The district court concluded that H&M failed to show that Unicolors knew that the registration contained false information and even so, that the Registrar of Copyrights would not have refused registration. *Id.*

H&M appealed and the U.S. Court of Appeals for the Ninth Circuit reversed and remanded for further proceedings in the trial court. 959 F.3d 1194 (9th Cir. 2020). According to the Ninth Circuit, the undisputed evidence at trial showed that Unicolors included inaccurate information in its copyright application “with knowledge that it was inaccurate.” *Id.* at 1200. Specifically, Unicolors knew that certain designs contained in the copyright application were confined and therefore, were published at different times. *Id.* The Ninth Circuit found, however, that after determining that the copyright registration contained inaccurate information, the district court was required to “request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register ... to refuse registration.” *Id.* It remanded so that the district court could submit this request to the Register of Copyrights. *Id.*

In reaching its decision, the Ninth Circuit did not distinguish between mistakes of law or fact in the copyright application. Rather, as soon as it

determined that Unicolors’ copyright registration contained inaccurate information, it remanded with instructions for the district court to confer with Register of Copyrights to see whether she would have issued the copyright registration if she had known about the inaccuracies. Unicolors petitioned the United States Supreme Court asking it to review the Ninth Circuit’s interpretation of the safe harbor provision of the Copyright Act, 17 U.S.C. § 411(b)(1)(A).

In the Supreme Court’s view, under the Ninth Circuit’s decision, mistakes of law may not fall within the safe harbor provision. 595 U.S. ____ (slip op. at 5-6)(2022). The Supreme Court disagreed with this reading noting that “[i]naccurate information in a registration is therefore equally (or more) likely to arise from mistake of law as a mistake of fact.” *Id.* at 6. This is particularly true in the copyright arena because applicants include novelists, poets, painters, designers – those without legal training. *Id.*

Moreover, cases decided before Congress enacted §411(b), “overwhelmingly held that inadvertent mistakes on registration certificates did not invalidate a copyright and thus did not bar infringement actions.” *Id.* citing *Urantia Foundation v. Maaherra*, 114 F.3d 955, 963 (9th Cir. 1997). The legislative history supports the view that Congress was attempting to make it easier, not harder, for nonlawyers to obtain valid copyright registrations. *Id.* at 7.

Unicolors claimed that when it applied to register its 31 designs, it was not aware that it did not satisfy the “single unit of publication” requirement. *Id.* at 5. Because it was unaware of the legal requirement that rendered the information in its application inaccurate, it did not include that information “with knowledge that it was inaccurate.” *Id.*

Ultimately, the Supreme Court held that under the safe harbor provision of the Copyright Act either a mistake of law or mistake of fact may excuse an inaccuracy in a copyright registration. This is not to suggest that great care should always be exercised in filing factually correct copyright applications, but rather that certain “understandable” inaccuracies might be forgivable. ■



THIS IS NOT TO SUGGEST THAT GREAT CARE SHOULD ALWAYS BE EXERCISED IN FILING FACTUALLY CORRECT COPYRIGHT APPLICATIONS, BUT RATHER THAT CERTAIN ‘UNDERSTANDABLE’ INACCURACIES MIGHT BE FORGIVABLE.



PRESENTATIONS



Thad seen on left.

■ **Thad Chaloehtiarana**

Thad co-moderated a Judicial Program at the ABA Section of Intellectual Property Law’s IPLSpring Conference in Washington D.C., on April 6. On the panel were: Hon. Jonathan Hudis, Administrative Trademark Judge, Trademark Trial and Appeal Board, USPTO; Hon. Steve Ruwe, Copyright Royalty Judge, Copyright Royalty Board, Library of Congress; David Carson, Copyright Claims Officer, Copyright Claims Board, US Copyright Office; and June Besek, Executive Director, Kernochan Center for Law, Media and the Arts, Columbia Law School (co-moderator).

Thad also spoke on “Recent Developments in Trade Dress Protection” at the Intellectual Property Committee meeting for the Automotive Aftermarket Suppliers Association, on April 13, and, on April 25, he spoke on a Practising Law Institute *IP Discussions* roundtable on “Product Design.”

■ **Novaira Paul**



Novaira spoke at the Coalition of Women’s Initiatives in Law lunch speaker series via Zoom on “Product Placement Pitfalls and Best Practices,” on April 21. Novaira discussed how to best represent a brand when its trademark or product is to be used

in various media, such as TV, film, and online.

PRESENTATIONS

■ **Belinda Scrimenti**

Belinda will be a panelist on May 3 with USPTO Officials at the International Trademark Association (INTA) Annual Meeting, on “Protecting Its Customers and Itself: How the United States Patent and Trademark Office is Responding to Fraud and Fighting Back.” The USPTO speakers are Amy Cotton, Deputy Commissioner for Trademarks Examination Policy; Will Covey, Deputy General Counsel & Director, Office of Enrollment & Discipline; and Michael Mangelson, Principal Counsel and Director for China IP. Belinda will provide the perspective of brand owners and their counsel.

APPOINTMENTS



■ **Jonathan Jennings**

Jonathan has been re-appointed as an Adjunct Faculty member at the University of Illinois Chicago School of Law.



■ **Phillip Barendolts**

Phil has been appointed to the North American Global Advisory Council for INTA.

World Trademark Review Magazine (WTR) 1000

Pattishall McAuliffe received the top Gold Band ranking for both the United States and Illinois in the 2022 *WTR 1000* report. **Janet A. Marvel** was ranked Gold nationally and in Illinois for “prosecution and strategy,” and Silver in Illinois for “enforcement and litigation.” **Thad Chaloehtiarana, Jonathan S. Jennings** and **Robert W. Sacoff** were nationally ranked Silver in “enforcement and litigation.” **Thad Chaloehtiarana** and **Jonathan S. Jennings** were ranked Gold in Illinois for “enforcement and litigation” and “prosecution and strategy.” **Brett A. August, Phil Barendolts, Ashly Boesche, Bradley L. Cohn, Robert W. Sacoff** and **Joseph N. Welch II** were ranked Silver in Illinois for “enforcement and litigation.” **Belinda J. Scrimenti** was ranked Silver in Illinois for “prosecution and strategy.”

WTR writes, “Whichever way you cut it, Pattishall is one of the best trademark firms in the country; it has maintained a strong brand focus for more than 135 years, possesses ultra-sophisticated expertise in all areas of trademark law and has a deep bench of professionals, including thought leaders, partners in their prime and up-and-coming stars with cutting-edge knowledge. According to clients, the team ‘consistently provides top-quality work on time, along with clear advice and practical solutions that are easy to implement’; the service is ‘extremely reliable and fantastic all-round ...’ For the full review, [click here](#).”

U.S. District Court Judgment in Favor of Ferrara Candy Co.

Judge Thomas Durkin of the U.S. District Court for the Northern District of Illinois issued a judgment and permanent injunction on January 28, 2022, in favor of Ferrara Candy Co. against ReRoot LLC, Higharchy LLC, and Chris Accetta for trademark infringement, trade dress infringement, unfair competition, and unjust enrichment based on the defendants’ marketing and sale of THC-infused products bearing imitations of Ferrara’s NERDS trademarks. Phillip Barendolts, Jessica Ekhoﬀ and Novaira Paul represented Ferrara in the case. For the full story, [click here](#).

Illinois Super Lawyers 2022

Brett August, Phillip Barendolts, Ashly Boesche, Thad Chaloehtiarana, Bradley Cohn, David Hilliard, Jonathan Jennings, Janet Marvel, Robert Sacoff, Belinda Scrimenti and **Joseph Welch II** have been designated Illinois Super Lawyers, and **Jessica Ekhoﬀ** has been designated an Illinois Rising Star.

IP Stars, *Managing Intellectual Property Magazine*

Pattishall McAuliffe again ranks in U.S. top tiers for Trade mark contentious and Trade mark prosecution, and is “Highly Recommended” in Trade marks in Illinois by *Managing Intellectual Property Magazine*.



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