

# UNDERSTANDING *UNICOLORS*: MISTAKES OF LAW DON'T NECESSARILY INVALIDATE COPYRIGHT REGISTRATION CERTIFICATES

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## I. INTRODUCTION

Can mistakes of fact or law in an application for copyright registration invalidate a copyright certificate? As many lawyers love to say, it depends. And in this inquiry, the validity of the copyright certificate depends on the copyright owner's mental state when including the inaccuracy on her application for copyright registration.

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In the only intellectual property decision of the October 2021–2022 term, the Supreme Court held in *Unicolors v. H&M* that the Copyright Act’s § 411(b) safe-harbor provision protects the validity of a copyright certificate against good faith mistakes of either fact or law made by the copyright holder in the application for copyright registration.<sup>1</sup> In a relatively short opinion authored by Justice Breyer,<sup>2</sup> the majority adopted a purposivist interpretation of the statutory language and legislative history of § 411(b) to clarify that exclusion from the safe harbor requires “knowledge,” which means “actual, subjective awareness of both the facts and the law,” rather than a higher “intent-to-defraud” standard.<sup>3</sup> While ultimately finding in favor of the copyright owner, Unicolors, Justice Breyer provided an important carve-out that allows courts to look for willful blindness or constructive knowledge of inaccuracies in place of actual knowledge to exclude copyright holders from § 411(b)’s safe harbor protection.<sup>4</sup>

In 2016, Plaintiff Unicolors sued H&M for copyright infringement alleging that H&M’s “Xue Xu” design printed on jackets and skirts infringed Unicolors’ “EH101” textile copyright.<sup>5</sup> The matter went to trial and the jury found H&M liable for copyright infringement.<sup>6</sup> However, at the close of trial, H&M asked the court to grant it judgment as a matter of law that Unicolors’ registration should be referred to the Register of Copyrights under § 411(b)(2) to determine the validity of Unicolors’ copyright because Unicolors’ registration contained inaccurate information regarding publication.<sup>7</sup>

The District Court denied H&M’s motion, finding that there was no evidence of intent-to-defraud, and rather that Unicolors simply did not know

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1. *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 142 S. Ct. 941 (2022).

2. *Unicolors v. H&M* was Justice Breyer’s last intellectual property decision before retiring from the Supreme Court. Over the course of his time on the bench, Justice Breyer has shaped copyright law. *See* *Kirtsaeng v. Wiley*, 568 U.S. 519 (2013); *ABC v. Aero*, 573 U.S. 431 (2014); *Google v. Oracle*, 141 S. Ct. 1183 (2021); *MGM v. Grokster*, 545 U.S. 913 (2005) (Breyer, J., joining unanimous opinion by Justice Souter); *Allen v. Cooper*, 140 S. Ct. 994 (2020) (Breyer, J., joining majority opinion); *Eldred v. Ashcroft*, 537 U.S. 186 (2003) (Breyer, J., dissenting); *Golan v. Holder*, 565 U.S. 302 (2012) (Breyer, J., dissenting); *Petrella v. MGM*, 572 U.S. 663 (2014) (Breyer, J., dissenting); *Star Athletica v. Varsity Brands*, 137 S. Ct. 1002 (2017) (Breyer, J., dissenting); *Georgia v. Public Resources*, 140 S. Ct. 1498 (2020) (Breyer, J., joining both Justice Thomas’ and Justice Ginsburg’s dissents); *see also* Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281 (1970).

3. *Unicolors v. H&M*, 142 S. Ct. at 947.

4. *Id.* at 948.

5. *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 959 F.3d 1194, 1195 (9th Cir. 2020).

6. *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 2018 WL 10307045, at \*1 (C.D. Cal. Aug. 1, 2018).

7. *Id.*

that it failed the same unit of publication requirement.<sup>8</sup> H&M appealed to the Ninth Circuit, which clarified that there was no intent-to-defraud requirement for denial of the safe harbor but found that Unicolors did not benefit from the safe harbor because § 411(b) excuses only mistakes of *facts* not mistakes of *law*.<sup>9</sup> Unicolors sought certiorari and the Supreme Court granted the petition to address whether mistakes of law were protected by the safe harbor and to clarify the requisite mental state required for denial of the safe harbor.<sup>10</sup>

While some scholars argue that *Unicolors v. H&M* was not a monumental Supreme Court case since it resolved a narrow question in which there was not much, if any, disagreement in the lower courts,<sup>11</sup> the underlying facts of the case draw attention to the copyright trolling issue lurking in the background of much of copyright litigation. As H&M pointed out, Unicolors has filed hundreds of similar copyright infringement suits against numerous fashion brands.<sup>12</sup> In oral arguments, Justice Sotomayor was the only Justice to raise the copyright troll issue, and in addressing Unicolors' counsel, she asked, "how do I describe a truly innocent mistake of law from one in which a sophisticated party with the capacity to confer with lawyers makes a mistake that they could have easily checked?"<sup>13</sup> Despite briefing in the case, largely by amici in support of H&M,<sup>14</sup> the Court's opinion does not directly address how sophisticated, professional plaintiffs—or copyright trolls—evade responsibility for their misuse of the copyright registration system, but rather focuses instead on the impact of § 411(b) on relatively unprofessional plaintiffs.

This Note addresses the tension between copyright's fundamental goal to promote accessibility of copyright protections to non-lawyer creatives and the exploitation of the copyright system by copyright trolls. Part II of this Note

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8. *Id.*

9. *Unicolors v. H&M*, 959 F.3d at 1200.

10. *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 141 S. Ct. 2698 (2021).

11. See Jasper L. Tran, Response, *Copyright's Legal Mistake*, GEO. WASH. L. REV. ON DOCKET (Mar. 22, 2022), <https://www.gwlr.org/copyrights-legal-mistake>; see also Ronald Mann, *Justices Require Actual Knowledge That Application Was Erroneous to Invalidate Copyright Filing*, SCOTUSBLOG (Feb. 24, 2022), <https://www.scotusblog.com/2022/02/justices-require-actual-knowledge-that-application-was-erroneous-to-invalidate-copyright-filing/> ("As I noted above, *Unicolors* resolves a narrow question. Indeed, as the dissent points out, the question that the court answers is not even one on which there is any disagreement in the lower courts. There is every reason to think that *Unicolors* will fade from view in the not-so-distant future.")

12. Brief for Respondent at 7, *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 142 S. Ct. 941 (2022) (No. 20-915).

13. Transcript of Oral Argument at 17, *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 142 S. Ct. 941 (2022) (No. 20-915).

14. See generally Brief for Professors of Copyright Law as Amici Curiae Supporting Respondent, *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 142 S. Ct. 941 (2022) (No. 20-915).

focuses on the historical and legal background necessary to understand the Supreme Court's ruling and reasoning. Part III provides a deeper understanding of the Supreme Court's *Unicolors* decision. Lastly, Part IV identifies the underlying copyright troll problem and contemplates some proposed efforts that Congress, the courts, and the Copyright Office can adopt to deter the troll.

## II. BACKGROUND

### A. COPYRIGHT FORMALITIES AND THE PURPOSE OF COPYRIGHT REGISTRATION

Copyright law in the United States aims to incentivize creation by providing exclusive rights to copyright holders while striking a balance with the public interest of access to these works.<sup>15</sup> The Intellectual Property Clause of the United States Constitution authorizes Congress to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>16</sup>

Historically, Congress sought to fulfill the goals of copyright law by enforcing compliance with the copyright formalities of registration, renewal, notice, and deposit. As explained by legal scholar Christopher Sprigman, “For most of our history, U.S. copyright included a system of procedural mechanisms, referred to collectively as ‘copyright formalities,’ that helped to maintain copyright’s traditional balance between providing private incentives to authors and preserving a robust stock of public domain works from which future creators could draw.”<sup>17</sup> In exchange for the market-based incentives provided to authors to create works, copyright formalities—namely registration, renewal, notice, and deposit—have functioned to inform the public and ensure preservation of the work for future public use.

In 1790, Congress enacted the first copyright statute,<sup>18</sup> which required authors to comply with copyright formalities.<sup>19</sup> Importantly, failure to comply

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15. *See Sony Corp. of Am. v. Universal City Studios*, 464 U.S. 417, 429 (1984) (“The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.”).

16. U.S. CONST. art. I, § 8, cl. 8.

17. Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 487 (2004).

18. Copyright Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1947).

19. *See Sprigman, supra* note 17, at 487.

resulted in termination of the copyright.<sup>20</sup> In 1886, various countries adopted the Berne Convention for the Protection of Literary and Artistic Works, which made formalities largely voluntary.<sup>21</sup> To comply with international norms and make copyright less onerous and more obtainable, Congress deformedalized copyright over a series of reforms and legislation. Beginning with the Copyright Act of 1976<sup>22</sup> and culminating with the Berne Convention Implementation Act of 1988,<sup>23</sup> the Copyright Renewal Act of 1992,<sup>24</sup> and the Sonny Bono Copyright Term Extension Act of 1998,<sup>25</sup> “Congress pared back, and in some instances entirely discarded, copyright formalities.”<sup>26</sup>

Under current copyright law, a work of authorship is protected by copyright from the moment it is created so long as the work is original and fixed in a tangible medium of expression.<sup>27</sup> While copyright registration is no longer required for a work to be protected by copyright, registration provides several important benefits to both copyright holders and the public.<sup>28</sup> As explained by Robert J. Kasunic, the Associate Register of Copyrights and Director of Registration Policy and Practice for the U.S. Copyright Office: “Although copyright registration as a condition for copyright protection has gradually been eliminated over the past two centuries, the importance of registration and the benefits it bestows has increased.”<sup>29</sup> To incentivize registration, Congress created various benefits to authors to register their works with the Copyright Office.<sup>30</sup> Timely copyright registration provides

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20. *See* *Wheaton v. Peters*, 33 U.S. 591, 593 (1834) (“The security of a copyright to an author, by the acts of congress, is not a technical grant of precedent and subsequent conditions. All the conditions are important: the law requires them to be performed, and, consequently, their performance is essential to a perfect title.”).

21. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as revised at Paris on July 24, 1971 and amended in 1979. S. TREATY DOC. NO. 99-27 (1986).

22. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (1967) [hereinafter 1976 Act].

23. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988).

24. Copyright Renewal Act of 1992, Pub. L. No. 102-307, 106 Stat. 264 (1992).

25. Sonny Bono Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 (1998).

26. Sprigman, *supra* note 17, at 487. This shift from a “conditional” copyright system to an “unconditional” system in which formalities are largely voluntary, has put a strain on copyright law and the balance it seeks to achieve. Consequently, a movement to re-formalize copyright formalities in such a way that embraces modern technology has emerged.

27. *See* 17 U.S.C. §§ 102(a), 408(a).

28. U.S. COPYRIGHT OFF., COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 202 (3d ed. 2021).

29. Robert J. Kasunic, *The Benefits of Registration*, 68 J. COPYRIGHT SOC’Y U.S.A. 83, 85–86 (2020–2021).

30. *Id.* at 84.

copyright holders with the ability to file suit for infringement,<sup>31</sup> to claim statutory damages and attorney's fees,<sup>32</sup> and to use registration as *prima facie* evidence of the validity of the copyright and the facts stated in the certificate.<sup>33</sup>

Copyright registration, in addition to filtering out meritless copyright claims that would otherwise overwhelm courts,<sup>34</sup> also serves to provide the public with information about the copyrighted work and put potential infringers on notice via the Copyright Office's public records database.<sup>35</sup>

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31. See 17 U.S.C. § 411(a); see also *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com*, 139 S. Ct. 881, 892 (2019) (“[T]he Copyright Act safeguards copyright owners, irrespective of registration, by vesting them with exclusive rights upon creation of their works and prohibiting infringement from that point forward.”).

32. See 17 U.S.C. §§ 412(c), 504–05.

33. See *id.* § 410(c).

34. See George Thuronyi, *The Fourth Estate Decision and Copyright Registration*, LIBR. CONGRESS: COPYRIGHT CREATIVITY AT WORK (Mar. 14, 2019) (“The registration approach is part of Congress’s considered scheme to filter copyright claims through the Copyright Office, resulting in an improved record for the courts as well as the public at large to rely upon.”) <https://blogs.loc.gov/copyright/2019/03/the-fourth-estate-decision-and-copyright-registration/>.

35. See Kasunic, *supra* note 29, at 91–92. In *Unicolors*, amici in support of H&M highlight some shortcomings of the Copyright Office’s public databases, especially as it concerns visual art. See Brief of Amici Curiae California Fashion Association in Support of Respondent at 10, *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 142 S. Ct. 941 (2022) (No. 20-915) (“The Copyright Office’s online catalog does not include pictures or copies of the registered work itself; only the written information submitted on the application form itself. . . . Theoretically, the only way to be sure that a given fabric design or other work of authorship was not previously registered by someone else would be to put the design in question firmly in mind, and then go through and search the entire Library of Congress collection of deposit copies to look for the proverbial matching needle in one of the world’s largest haystacks.”). Even legal scholar Jane Ginsburg argues, “formalities that condition the existence or enforcement of copyright on supplying information about works of authorship should enable effective title searching, thus furthering the economic interests both of copyright owners and of potential exploiters.” See Jane C. Ginsburg, *The U.S. Experience with Copyright Formalities: A Love/Hate Relationship*, 33 COLUM. J.L. & ARTS 311, 312–13 (2010). Excitingly, the Copyright Office agrees and is currently undertaking various modernization efforts to improve the copyright registration system and redesign the public records database system with an ability to utilize APIs. See Registration Modernization, 85 Fed. Reg. 12704, 12709 (Mar. 3, 2020) (“A copyright system of the twenty-first century demands flexibility, agility, and adaptability to technological advancement . . . . The Office believes that the use of APIs—interfaces that permit communication between two systems or software programs—could improve the registration system by enabling programs used in the process of creating works to submit copyright registration applications or extract data from the online public record.”). Considering the differing needs and wants of various types of copyright holders, APIs will allow for copyright holders to utilize the Copyright Office’s records to best satisfy their differing needs. Regarding textile copyrights, “[d]atabases could help a company avoid infringing existing designs or recognize a supplier didn’t create a fabric. Once infringement is alleged, a database could also help attorneys find similar designs to show claimed originality wasn’t actually that creative and

Copyright registration is able to do so because it creates data about a copyrighted work.<sup>36</sup> A certificate of registration creates a public record of key facts relating to a work, “including the title of the work, the author of the work, the name and address of the claimant or copyright owner, the year of creation, and information about whether the work is published, has been previously registered, or includes preexisting material.”<sup>37</sup>

In the registration process, the putative copyright owner provides various facts relevant to the work she is seeking to register in an application for registration.<sup>38</sup> Unlike applications for patents or trademarks, the Copyright Office accepts many of the facts stated in the application at face value without investigation or verification.<sup>39</sup> Rather, an examiner at the Copyright Office uses her knowledge and expertise to spot problems and inconsistencies that can be addressed prior to issuing a certificate, often corresponding with applicants to remedy such issues.<sup>40</sup> Notwithstanding, applications with mistakes—intentional or otherwise—may be issued a valid certificate of copyright registration.<sup>41</sup>

## B. SECTION 411

Under § 411(a), a copyright holder must register her work with the Copyright Office in order to bring a civil action for infringement.<sup>42</sup> As Justice Ruth Bader Ginsburg explained in *Fourth Estate*, “[i]n enacting 17 U.S.C. § 411(a), Congress both reaffirmed the general rule that registration must precede an infringement suit, and added an exception in that provision’s second sentence to cover instances in which registration is refused.”<sup>43</sup> Copyright registration triggers the right to sue.

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deserves thin protection[.]” See Kyle Jahner, *Textile Design Copyrights Remain Tricky After High Court Ruling*, BLOOMBERG L. (Feb. 28, 2022), <https://news.bloomberglaw.com/ip-law/textile-design-copyrights-remain-tricky-after-high-court-ruling>.

36. Sprigman, *supra* note 17, at 487.

37. U.S. COPYRIGHT OFF., CIRCULAR 1: COPYRIGHT BASICS 5 (2021), <https://www.copyright.gov/circs/circ01.pdf>.

38. See generally U.S. COPYRIGHT OFF., CIRCULAR 2: COPYRIGHT REGISTRATION (2021), <https://www.copyright.gov/circs/circ02.pdf>.

39. Kasunic, *supra* note 29, at 89.

40. *Id.* at 90–93 (“Given the 25% correspondence rate annually, the interaction with examiners as intermediaries in the registration process plays an important role in improving the public record and resolving many issues prior to the issuance of a certificate of registration.”).

41. See generally U.S. COPYRIGHT OFF., *supra* note 38.

42. Registration, or a refusal of registration, by the Copyright Office is a prerequisite to filing a lawsuit for copyright infringement involving a U.S. work. See 17 U.S.C. § 411(a).

43. *Fourth Estate Public Benefit Corp. v. Wall-Street.com*, 139 S. Ct. 881, 890–91 (2019) (citing to H.R. REP. NO. 94-1476, at 157 (1976)); see also *Petrella v. Metro-Goldwyn-Mayer*,

Congress chose to relax the registration formality of § 411 by enacting § 411(b) as a safe harbor to protect copyright holders.<sup>44</sup> In 2008, Congress enacted the Prioritizing Resources and Organization for Intellectual Property Act<sup>45</sup> (Pro-IP Act) with the intention of making “a number of changes to copyright and trademark law that [would] enhance the ability of intellectual property rights holder to enforce their rights.”<sup>46</sup> The Pro-IP Act amended the Copyright Act to add § 411(b) as a rule of “Harmless Error,” which provides a safe harbor for copyright holders against invalidation from mistakes made on an application for registration.<sup>47</sup> The safe harbor amendment was largely motivated by Congress’s desire “to prevent intellectual property thieves from exploiting [a] potential loophole” by “argu[ing] in litigation that a mistake in the registration documents, such as checking the wrong box on the registration form, renders a registration invalid[.]”<sup>48</sup>

Under the § 411(b)(1) safe harbor, a copyright holder’s certificate of registration is valid 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.<sup>49</sup>

If it is alleged that the copyright holder knowingly included the inaccuracy on the application, § 411 (b)(2) is triggered. Under § 411(b)(2):

[T]he 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.<sup>50</sup>

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Inc., 132 S. Ct. 1962, 1977 (2014) (“Although registration is ‘permissive,’ both the certificate and the original work must be on file with the Copyright Office before a copyright owner can sue for infringement.”); *Alaska Stock, LLC. v. Houghton Mifflin Harcourt Publ’g Co.*, 747 F.3d 673, 67 (9th Cir. 2014) (“Though an owner has property rights without registration, he needs to register the copyright to sue for infringement.”).

44. Grace Pyun, *2008 Pro-IP Act: The Inadequacy of the Property Paradigm in Criminal Intellectual Property Law and Its Effect on Prosecutorial Boundaries*, 19 DEPAUL J. ART TECH. & INTELL. PROP. L. 355, 375 (2009).

45. Prioritizing Resources and Organization for Intellectual Property Act of 2008, Pub. L. No. 110-403, 122 Stat. 4256 (2008).

46. H.R. REP. NO. 110-617, at 23 (2008).

47. Pro-IP Act § 101(a).

48. H.R. REP. NO. 110-617, at 24, n.15 (2008) (citing *In re Napster, Inc.*, 191 F. Supp. 2d 1087, 1099 (N.D. Cal. 2002)).

49. 17 U.S.C. § 411(b)(1) (emphasis added).

50. *Id.* § 411(b)(2).



Put simply, if a copyright holder made a mistake, her registration is protected by the safe harbor. However, if she did not make a mistake, her registration is at risk of invalidation.

What is the difference between a mistake and a non-mistake? In other words, what mental state would satisfy the “with knowledge that it was inaccurate” requirement: fraud, intentional deception, actual knowledge, constructive knowledge, or willful blindness? Fraud and intentional deception would require that the copyright holder be aware of the inaccuracy and choose to include the inaccuracy on the application for copyright registration in order to trick the Copyright Office into granting a copyright that likely should not be granted. Actual knowledge would require that the copyright holder was aware of the inaccuracy and chose to include it in the application but did not have any sort of intention to game the Copyright Office. Constructive knowledge, on the other hand, would not require that the copyright holder was aware of the inaccuracy, but rather that she should have been aware. Like constructive knowledge, willful blindness would not require that the copyright holder be aware of inaccuracy, but rather that she chose to keep herself unaware and in the dark as to whether the inaccuracy was inaccurate or not.

Some courts, scholars, and even the Register of Copyrights interpreted the “with knowledge that it was inaccurate” requirement of § 411(b)(1)(A) to mean that the Pro-IP Act amended § 411 of copyright law to codify the doctrine of “fraud on the Copyright Office”<sup>51</sup> in the registration process.<sup>52</sup> Under this assumption, a showing of intentional deception or fraud would be required for exclusion from the safe harbor, thereby risking invalidation of the copyright registration by the Register of Copyrights. Yet, there remained an apparent split among scholars and the circuit courts as to the request mental state required by § 411(b)(1)(A) for exclusion of the safe harbor protections. According to the Eleventh Circuit in *Roberts v. Gordy*, § 411(b)(1)(A) requires “deceptive intent,” whereas the Ninth Circuit held in *Gold Value International*

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51. The doctrine of fraud on the Copyright Office developed by way of cases that upheld the validity of copyright registrations where inadvertent or immaterial errors were made. For example, in *Advisers, Inc. v. Wiesen-Hart, Inc.*, the Sixth Circuit held that “an innocent misstatement, or a clerical error, in the affidavit and certificate of registration, *unaccompanied by fraud* or intent to extend the statutory period of copyright protection, does not invalidate the copyright, nor is it thereby rendered incapable of supporting an infringement action.” 238 F.2d 706, 708 (6th Cir. 1956) (emphasis added). Overtime, the converse proposition that a registration may be invalidated by fraud birthed the doctrine and defense of fraud on the Copyright Office.

52. U.S. COPYRIGHT OFF., ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS 13 (2008), <https://www.copyright.gov/reports/annual/2008/ar2008.pdf>.

*Textile v. Sanctuary Clothing* that “there is no such intent-to-defraud requirement.”<sup>53</sup>

If intentional deception or fraud is not required for exclusion from the safe harbor, then what lesser mental state is sufficient to exclude a copyright holder from the safe harbor? The clarification of the requisite mental state in § 411(b)(1)(A) is crucial because it triggers § 411(b)(2), in which a court shall refer the certification issue to the Register of Copyrights.<sup>54</sup> If the Register of Copyrights determines that, had she known of the inaccuracy at the time, she would still have granted registration, the certification of registration would be protected by the safe harbor. However, if the Register of Copyrights determines that she would have refused registration, the certification of registration is invalidated, likely allowing the defendant to escape liability for copyright infringement.<sup>55</sup> The lower the mental state required, the easier it is for infringing defendants to argue that a copyright holder’s mistake in her registration should not be protected by the safe harbor and her application should be reexamined by the Register of Copyrights to determine whether the copyright certificate should be invalidated. The higher the mental state requirement, the more difficult it would be to ultimately invalidate a copyright holder’s registration certificate.

### III. UNICOLORS V. H&M CASE SUMMARY

#### A. FACTUAL AND PROCEDURAL HISTORY

Unicolors and H&M are no strangers to the courtroom, and neither party is particularly sympathetic.<sup>56</sup> Unicolors is a Los Angeles, California-based company in the business of creating, purchasing, and obtaining copyrights to graphic artworks that are printed on fabrics and sold to fashion brands.<sup>57</sup> As H&M noted:

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53. *See* *Roberts v. Gordy*, 877 F.3d 1024, 1030 (11th Cir. 2017); *Gold Value Int’l Textile, Inc. v. Sanctuary Clothing, L.L.C.*, 925 F.3d 1140, 1147 (9th Cir. 2019).

54. *See* 17 U.S.C. § 411.

55. This determination by the Register of Copyrights is a bit more complicated than Congress may have anticipated. In practice, an examiner at the Copyright Office communicates with applicants to remedy any issues in their application to approve certification rather than outright refusing the application as is. In practice, an examiner refuses registration if the applicant does not respond in a timely manner or refuses to correct the inaccuracy. *See* Kasunic, *supra* note 29, at 90.

56. *Unicolors v. H&M: A Fast Fashion Copycat and Alleged ‘Copyright Troll’ Go to Trial*, FASHION L. (Dec. 7, 2017), <https://www.thefashionlaw.com/a-fast-fashion-copycat-and-an-alleged-copyright-troll-are-currently-at-trial/>.

57. *Unicolors v. H&M*, 959 F.3d at 1195.

“A cursory PACER search shows that Unicolors has filed literally hundreds of these lawsuits. Its victims include Amazon, Bass Pro, Bloomingdale’s, Burlington Stores, Century 21, Dillard’s, The Dress Barn, JCPenney, Kmart, Kohl’s, Lord & Taylor, Macy’s, Neiman Marcus, Nordstrom, Ross, Saks, Sears Roebuck, The TJX Companies, Urban Outfitters, and Walmart.”<sup>58</sup>

Very few of Unicolors’ cases have gone to trial, and most have settled out of court, ahead of trial, “largely because it tends to be much cheaper and more expeditious to settle a case than it is to finance and fight through a trial.”<sup>59</sup> Unsurprisingly, Unicolors has been called a copyright troll.<sup>60</sup> H&M, on the other hand, is a large international clothing retailer that is widely considered a fast-fashion<sup>61</sup> copycat.<sup>62</sup> H&M has been on the receiving end of numerous copyright infringement suits and allegations, largely from fashion designers and labels.<sup>63</sup>

In 2011, Unicolors registered thirty-one fabric designs in a single registration, the ’400 Registration, under the Copyright Office’s same unit of publication exception.<sup>64</sup> The same unit of publication exception allows for works packaged together and published on the same date to be registered in a single application rather than individual applications.<sup>65</sup> In their application for registration, Unicolors listed January 15, 2011, as the publication date for all of

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58. Brief for Respondent at 7, *Unicolors, Inc. v. H&M Hennes & Mauritz, LP.*, 142 S. Ct. 941 (2022) (No. 20-915).

59. *A Fast Fashion Copycat*, *supra* note 56.

60. Brief for Respondent at 6, *Unicolors v. H&M.*, 142 S. Ct. 941 (2022) (No. 20-915); *A Fast Fashion Copycat*, *supra* note 56; Noah Smith, *Are Copyright Trolls Taking Over the Fashion Industry?*, *FORTUNE* (Oct. 7, 2015), <https://fortune.com/2015/10/07/patent-trolls-fashion/>.

61. A class action lawsuit was recently filed against H&M, alleging that H&M is “greenwashing” or engaging in false and misleading marketing regarding the sustainability of its clothing. *See generally* Complaint, *Commodore v. H&M Hennes & Mauritz L.P.*, 7:2022-cv-06247, (S.D.N.Y. filed July 22, 2022).

62. *See* Reply Brief for Petitioner at 2, *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 142 S. Ct. 941 (2022) (No. 20-915).

63. Fashion clothing designs are not protectable under U.S. copyright laws. However, there have been attempts to secure stronger legal protection for fashion. For example, the Council of Fashion Designers of America tried to pass the Innovative Design Protection Act of 2012, which sought to provide designers a three-year period during which designs could be protected, so long as they went through a rigorous process to prove they were “novel” and had never existed before; the bill was never brought to a vote. *See* S.3523, 112th Cong. (2012).

64. Registration No. VA 1-770-400 (“the ’400 Registration”).

65. 37 C.F.R. § 202.3(b)(4) (2020) (“For the purpose of registration on one application and upon the payment of one filing fee, the following shall be considered one work: In 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.”).

the thirty-one works.<sup>66</sup> When questioned about the '400 Registration at trial, Unicolors' President Nader Pazirandeh testified that Unicolors submits collections of works in a single copyright registration "for saving money."<sup>67</sup> Within the '400 Registration, Unicolors included the "EH101" design,<sup>68</sup> which it claims was a work for hire made by Hannah Lim, a designer for Unicolors.<sup>69</sup>

In 2016, Unicolors filed suit against H&M for copyright infringement alleging that H&M's "Xue Xu" design printed on jackets and skirts infringed Unicolors' EH101 copyright.<sup>70</sup> The matter went to trial and the jury awarded Unicolors \$817,920 in disgorgement damages and \$28,800 in lost profit damages.<sup>71</sup> At the close of trial, H&M asked the District Court to grant it judgment as a matter of law that Unicolors' registration should be referred to the Register of Copyrights because it contained inaccurate publication information.<sup>72</sup> Specifically, the '400 Registration contained inaccurate publication information because only twenty-two of the thirty-one designs were made available to the public on January 15, 2011, while the remaining

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66. *Unicolors v. H&M*, 959 F.3d at 1196.

67. *Id.*

68. The EH101 design was one of the twenty-two designs that was made available to the public. Although the referral to the Register of Copyrights was stayed, this fact could have potentially been key in the determination of whether the Register of Copyrights would have refused or granted the registration.

69. Joint Appendix at 21, *Unicolors, Inc. v. H&M Hennes & Mauritz, LP.*, 142 S. Ct. 941 (2022) (No. 20-915). Interestingly, in 2015, H&M acquired a Chinese copyright for the allegedly infringing "Xue Xu" design from Shaoxing County DOMO Apparel Co., Ltd. with a publication date of June 18, 2014. *Id.* at 33. H&M's Chinese "Xue Xu" copyright was the same design claimed in Unicolors' EH101 copyright. In its motion for judgment as a matter of law, H&M contended that while the court granted judicial notice of the Chinese copyright registration, the jury was not instructed properly on the presumptions that flow from the copyright registrations for Xue Xu. *Id.* at 94. Ultimately, the District Court held, "Even if the Chinese copyright registration did create a presumption of originality, the Court still did not err in refusing to instruct the jury about such a presumption because H&M LP failed to establish a connection between the Chinese copyright registration and its own garments. The Court took judicial notice of the Chinese Xue Xu registration, which established the registration's existence. But H&M LP presented no testimony or documents whatsoever about the origin of the design on its own garments . . . . H&M LP's failure to establish any connection between the Chinese Xue Xu registration and its own design rendered the registration irrelevant." *Id.* at 187.

70. *Unicolors v. H&M*, 959 F.3d at 1195.

71. *Unicolors v. H&M*, 2018 WL 10307045, at \*1.

72. It appears that H&M requested referral to the Register of Copyrights as a last-ditch effort to escape copyright infringement liability in the hopes that the Register of Copyright would find that Unicolors' '400 Registration should have been refused. Consequently, this would strike down the jury's finding of copyright infringement and damages award against H&M. This is exactly the kind of action that Congress intended to protect copyright holders against when enacting the § 411(b) safe harbor.

nine were only presented to Unicolors' salespeople, not the public.<sup>73</sup> A work is published when it is offered to the public.<sup>74</sup> The '400 Registration contained published and unpublished works in violation of the same unit of publication exception.

The District Court denied H&M's motion for judgment as a matter of law, finding that the publication inaccuracy did not invalidate Unicolors' registration since there was no evidence that Unicolors intended to defraud the Copyright Office.<sup>75</sup> Rather, the District Court reasoned that Unicolors did not know that it had failed to satisfy the same unit of publication requirement because it provided the inaccurate information in the application *without* "knowledge that it was inaccurate."<sup>76</sup>

H&M then appealed to the Ninth Circuit. The Ninth Circuit clarified that there was no intent-to-defraud requirement for denial of the safe harbor protection given its recent ruling in *Gold Value*.<sup>77</sup> Under a view that § 411(b) excused only good-faith mistakes of facts, not mistakes of *law*, the Ninth Circuit held that Unicolors' mistake as to the same unit of publication requirement was not protected by the safe harbor.<sup>78</sup> The Ninth Circuit struck down the infringement claims and damages awards against H&M and remanded to the District Court to submit an inquiry to the Register of Copyrights asking whether she would have refused the registration if she had known of the inaccuracy at the time the application for registration was submitted.<sup>79</sup>

Following the Ninth Circuit's ruling, the District Court referred the certification issue to the Register of Copyrights for advice, but Unicolors successfully requested a stay of the response from the Copyright Office in light of the Supreme Court's decision to review the case.<sup>80</sup> The Register of Copyrights did not issue a response to the request.

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73. *Unicolors v. H&M*, 959 F.3d at 1196.

74. See 17 U.S.C. § 101 (defining publication as "the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending").

75. *Unicolors v. H&M*, 2018 WL 10307045, at \*3–4.

76. *Id.*

77. *Unicolors v. H&M*, 959 F.3d at 1198; see *Gold Value*, 925 F.3d at 1147.

78. *Unicolors v. H&M*, 959 F.3d at 1200 (emphasis added).

79. *Id.* at 1200–01.

80. Joint Appendix at 220, *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 142 S. Ct. 941 (2022) (No. 20-915).

## B. THE SUPREME COURT'S RULING

Unicolors sought certiorari and the Supreme Court granted the petition to address the circuit split regarding the requisite mental state required in § 411(b)(1)(A).<sup>81</sup> As aforementioned, under the Eleventh Circuit's view in *Roberts v. Gordy*, § 411(b)(1)(A) requires "deceptive intent," such that an accidental or innocent mistake of fact or law included in an application for registration would not invalidate the copyright.<sup>82</sup> In comparison, under the Ninth Circuit's new interpretation in *Unicolors*, § 411(b)(1)(A) does not require an intent-to-deceive and mistakes of *fact* may be protected by the safe harbor, but any mistake of *law* on the application for registration would invalidate the copyright.<sup>83</sup> Initially, Unicolors posed the question presented to the Court as:

Did the Ninth Circuit err in breaking with its own prior precedent and the findings of other circuits and the Copyright Office in holding that 17 U.S.C. § 411 requires referral to the Copyright Office where there is no indicia of fraud or material error as to the work at issue in the subject copyright registration?<sup>84</sup>

However, the question was refined and briefed on the merits as:

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?<sup>85</sup>

Although Justice Breyer stated that the question whether "knowledge" required an "indicia of fraud" was a "subsidiary question fairly included" in the question presented to the Court,<sup>86</sup> the dissent, written by Justice Thomas, disagreed and argued that the case should have been dismissed as improvidently granted.<sup>87</sup>

Notwithstanding, the Supreme Court held that a copyright registration is protected by the § 411(b) safe harbor if the copyright holder did not have actual knowledge that she included inaccurate information in her registration, regardless of whether the inaccuracy stemmed from either a mistake of fact or

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81. *Unicolors v. H&M*, 142 S. Ct. at 945.

82. *See Roberts v. Gordy*, 877 F.3d 1024, 1030 (11th Cir. 2017).

83. *Unicolors v. H&M*, 959 F.3d at 1200 (emphasis added).

84. Eileen McDermott, *Justices Express Frustration Over Question Presented in Unicolors v. H&M, But Lean Toward Preserving Copyright Registrations*, IP WATCHDOG (Nov. 8, 2021), <https://ipwatchdog.com/2021/11/08/justices-express-frustration-question-presented-unicolors-v-hm-lean-toward-preserving-copyright-registrations/id=139686/>.

85. Unicolors Brief at I, *Unicolors, Inc. v. H&M Hennes & Mauritz, LP.*, 142 S. Ct. 941 (2022) (emphasis added).

86. *Unicolors v. H&M*, 142 S. Ct. at 949.

87. *Id.* at 952 (Thomas, J., dissenting).

of law.<sup>88</sup> Justice Breyer employed a purposivist interpretation of § 411(b)(1) to hold that “knowledge” refers to “actual, subjective awareness of both the facts and law.”<sup>89</sup> Relying on the House Report, Justice Breyer explained that “Congress enacted § 411(b) to make it easier, not more difficult, for nonlawyers to obtain valid copyright registrations.”<sup>90</sup> Congress intended to “eliminat[e] loopholes that might prevent enforcement of otherwise validly registered copyrights,” to prevent copyright infringers from escaping liability based on a technicality.<sup>91</sup> Considering this history, the Court found that “it would make no sense if § 411(b) left copyright registrations exposed to invalidation based on applicants’ good-faith misunderstandings of the details of copyright law.”<sup>92</sup>

To illustrate his reasoning, Justice Breyer provided a helpful birdwatching analogy:

A brief analogy may help explain the issue we must decide. Suppose that John, seeing a flash of red in a tree, says, “There is a cardinal.” But he is wrong. The bird is not a cardinal; it is a scarlet tanager. John’s statement is inaccurate. But what kind of mistake has John made?

John may have failed to see the bird’s black wings. In that case, he has made a mistake about the brute facts. Or John may have seen the bird perfectly well, noting all of its relevant features, but, not being much of a birdwatcher, he may not have known that a tanager (unlike a cardinal) has black wings. In that case, John has made a labeling mistake. He saw the bird correctly, but does not know how to label what he saw. Here, Unicolors’ mistake is a mistake of labeling. But unlike John (who might consult an ornithologist about the birds), Unicolors must look to judges and lawyers as experts regarding the proper scope of the label “single unit of publication.” The labeling problem here is one of law. Does that difference matter here? . . . We think it does not.<sup>93</sup>

In other words, Unicolors’ misunderstanding of the legal requirements of publication meant that Unicolors did not include the publication inaccuracy in its application “*with knowledge that it was inaccurate*,” and as such Unicolors was protected by the safe harbor and its registration remained valid.<sup>94</sup>

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88. *Id.* at 944.

89. *Id.* at 947.

90. *Id.* at 948.

91. *Id.* (citing H.R. REP. NO. 110-617, at 20 (2008)).

92. *Id.*

93. *Id.* at 946 (internal citation omitted).

94. *Id.* at 947 (quoting § 411(b)(1)(A)).

In addressing arguments that copyright holders will too easily claim lack of knowledge to avoid the consequences of inaccurate applications, Justice Breyer provided an important carve-out in which willful blindness or constructive knowledge of inaccuracies can satisfy the “with knowledge that it was inaccurate” requirement of § 411(b).<sup>95</sup> Justice Breyer explained that “courts need not automatically accept a copyright holder’s claim that it was unaware of the relevant legal requirements of copyright law.”<sup>96</sup> Courts may look at “[c]ircumstantial evidence, including the significance of the legal error, the complexity of the relevant rule, the applicant’s experience with copyright law, and other such matters,” to find that an applicant was actually aware of, or willfully blind to, the legal inaccuracy.<sup>97</sup>

Interestingly, the Supreme Court asked, “But did Unicolors *know* about this inaccuracy?”<sup>98</sup> Although Justice Breyer did not directly address the copyright troll issue in his opinion, perhaps H&M served as an unsympathetic sacrificial lamb that allowed him to inexplicitly address the tension between copyright’s fundamental goals to promote accessibility of copyright protections to non-lawyer creatives and the exploitation of the copyright system by copyright trolls. The Court could have made it harder for defendants to exclude copyright holders from safe harbor protections, but it chose not to. The Court rejected the higher intent-to-defraud the Copyright Office standard in favor of a lower actual knowledge standard to exclude a copyright holder from the § 411(b) safe harbor while basing its reasoning in Congress’ desire to make it easier for non-lawyer creatives to obtain valid copyrights. This appears counterintuitive, but an actual knowledge standard with a constructive knowledge or willful blindness carve-out likely will not harm the non-lawyer

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95. *Id.* at 948.

96. *Id.*

97. *Id.* (citing to *Intel Corp. Inv. Pol’y Comm. v. Sulyma*, 140 S. Ct. 768, 778–79 (2020)).

98. *Id.* at 946. On remand the Ninth Circuit stated that “under the correct reasoning of the safe-harbor provision in light of the Supreme Court’s ruling . . . a court’s § 411(b) finding regarding a registrant’s lack of intent to defraud is also a § 411(b) finding regarding the registrant’s lack of knowledge that his copyright application contained inaccuracies—factual or legal.” *See Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 52 F.4th 1054, 1069 (9th Cir. 2022). As a result, the Ninth Circuit relied on the district court’s express conclusion that H&M failed to make “any showing that Unicolors intended to defraud the Copyright Office,” which meant that “the district court determined that Unicolors lacked knowledge that it submitted inaccuracies with its application and as a result that its ’400 Registration is entitled to the safe-harbor provision’s protection.” *Id.* Despite Unicolors’ familiarity with the copyright registration system, experience with copyright law, and initiation of hundreds of suits alleging infringement, the Ninth Circuit did not make an inquiry into whether Unicolors was willfully blind to the legal requirements of the same unit of publication exception, because “this case does not present a context where Unicolors has taken a legal position that egregiously misapplies a clear statute.” *Id.*



creative earnestly applying for and asserting her rights, however it does serve to protect alleged infringers from claims that likely should not have been brought in the first place by copyright trolls.

#### IV. MISTAKE OR MISUSE?

##### A. THE COPYRIGHT TROLL PROBLEM

While patent trolls have received attention from intellectual property scholars, policy makers, and courts for at least two decades, copyright trolls have lurked in the background of the majority of intellectual property discussions until fairly recently.<sup>99</sup> “Recent empirical studies show the field of copyright litigation is increasingly being overtaken by ‘copyright trolls’ . . . .”<sup>100</sup> Likewise, courts have begun to recognize “the challenge in administering intellectual property law to discourage so-called intellectual property ‘trolls’ while protecting genuine creativity.”<sup>101</sup>

Defining what makes a copyright holder a troll is inevitably controversial.<sup>102</sup> While a clear definition of what or who is a copyright troll as opposed to an overzealous copyright owner may be appealing, a bright line rule or rigid definition is too restrictive as the business model and strategy of copyright trolls evolves with changes to the law and copyright system. Rather, a more fluid and descriptive concept of copyright trolls and trolling draws attention to the different methods and strategies that are employed in practice.<sup>103</sup> Notwithstanding, if there is any unifying characteristic of a troll, it is that they are “systematic opportunists.”<sup>104</sup>

The concept of copyright trolling generally involves an opportunistic plaintiff that is more focused on the business of litigation to enforce copyrights than the creation or licensing of works.<sup>105</sup> Copyright trolls “recognize[d] the existence of a potentially lucrative business model hidden within the contours

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99. Matthew Sag, *Copyright Trolling, An Empirical Study*, 100 IOWA L. REV. 1105, 1107 (2014) (providing a detailed empirical and doctrinal study of copyright trolling showing the astonishing rate of growth of multi-defendant John Doe litigation associated with allegations of infringement concerning BitTorrent file sharing and pornographic films).

100. *Malibu Media, L.L.C. v. Doe*, 2015 WL 4092417, at \*2 (S.D.N.Y. July 6, 2015).

101. *Design Basics L.L.C. v. Lexington Homes, Inc.*, 858 F.3d 1093, 1096 (7th Cir. 2017).

102. Sag, *supra* note 99, at 1108.

103. There are various subsets of copyright trolls, such as multi-defendant John Doe file sharing trolls, paparazzi trolls, music sampling trolls, fabric textile trolls, and more. For a brief history and evolution of the copyright troll concept, see James DeBriyn, *Shedding Light on Copyright Trolls: An Analysis of Mass Copyright Litigation in the Age of Statutory Damages*, 19 UCLA ENT. L. REV. 79, 86–90 (2012).

104. Sag, *supra* note 99, at 1113.

105. *Id.* at 1107.

of the Copyright Act,” and crept into U.S. copyright law.<sup>106</sup> The copyright registration system is a lenient honor system that trusts the accuracy of the applicant.<sup>107</sup> As clarified by the Court in *Unicolors*, the Copyright Act’s § 411(b) safe-harbor provision protects copyright holders from having their registration invalidated due to innocent mistakes of fact or law. However, the congressional intent to make valid copyrights more accessible to non-lawyer creatives unintentionally opened the door to exploitation by copyright trolls.

Much like the business model of patent trolls, copyright trolls typically operate by creating or acquiring copyrights, seeking out actual or potential infringers, and commencing or threatening litigation with the goal of forcing monetary settlement or an award of damages.<sup>108</sup> As explained by legal theorist Shyamkrishna Balganesh, “To the copyright troll, the substance of an

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106. Shyamkrishna Balganesh, *The Uneasy Case Against Copyright Trolls*, 86 S. CAL. L. REV. 723, 738 (2013). Harry Wall, an Englishman from the 1800s, is often named as “the world’s first ‘copyright troll.’” In 1842, the United Kingdom’s 1833 Dramatic Copyright Act was extended to cover musical compositions. As the myth goes, Wall, husband to comic singer Annie Adams, quickly understood and took advantage of the 1842 Act’s new opportunities and developed a business in which he obtained a power of attorney from the assignee of deceased composers to collect statutory fees for unauthorized performances of songs by sending demand letters to performers. It was reported that “ladies would be discouraged from singing songs in public for fear of receiving letters from agents such as Wall demanding money.” Unsurprisingly, the U.K. musical scene of the late 1800s and the Royal Copyright Commission were outraged by Wall’s exploitation of statutory penalties. Music publishers raised the matter before the Royal Copyright Commission, to which Thomas Chappell said he had refused to deal with Wall because he ‘did not like the character of the man or the character of the proceedings,’ later adding that such things were done by ‘people who do not care anything for the work or anything else, all they want is the money they can get.’ See Isabella Alexander, *Neither Bolt nor Chain, Iron Safe nor Private Watchman, Can Prevent the Theft of Words: The Birth of the Performing Right in Britain*, in PRIVILEGE AND PROPERTY: ESSAYS ON THE HISTORY OF COPYRIGHT 321, 339 (Ronan Deazley et al. eds., 2010) (quoting Royal Commission on Laws and Regulations relating to Home, Colonial and Foreign Copyrights (1878) 24 Parliamentary Papers [C.2036] at pp. 106, 109 & 115).

107. See generally Kasunic, *supra* note 29, at 83 (discussing the benefits of copyright registration as well as the process by which Copyright Office examiners review applications for registration).

108. See Balganesh, *supra* note 106, at 732–33. In the early 2010s, a Nevada-based company called Righthaven LLP discovered a fatally fruitful business model that followed three simple steps: (1) recruit content owners, principally newspapers; (2) identify plausible cases of copyright infringement, such as the reposting of newspaper articles on blogs; and (3) acquire a partial assignment of copyright that is tailored precisely to the infringement identified in step two. This model worked well for some time, but those “assignments” were subject to a secret “Strategic Alliance Agreement,” meaning that Righthaven possessed nothing more than a right to sue. Righthaven flew too close to the sun because an agreement transferring the right to sue without any of the copyright owner’s other exclusive rights is ineffectual. Ultimately, Righthaven’s suits were dismissed and the firm went under from legal fees. See Sag, *supra* note 99, at 1111–13.

individual claim matters much less than its aggregate returns from the enforcement of multiple claims. This explains why it is able to settle each claim for amounts much lower than the damages it seeks. Yet, when aggregated together, the settlements prove to be beneficial.”<sup>109</sup> Rather than pursue actual damages—which are often difficult to calculate—the Copyright Act allows copyright owners to pursue statutory damages in an infringement action.<sup>110</sup>

More often than not, a copyright troll’s business model complies with all of copyright’s formal rules as a matter of law, which places courts in muddy waters when trying to balance the core aims of copyright law and policy.<sup>111</sup> As discussed above, post-Berne, copyright formalities are largely voluntary; however, Congress still sought to encourage registration by providing legal and market-based benefits.<sup>112</sup> While there is debate whether copyright’s fundamental theory of market incentives does in fact drive creativity or not,<sup>113</sup> in practice, copyright law provides economic incentives, namely registration, to which copyright trolls have latched on. Copyright trolls are opportunistic and their business strategies exploit loopholes and leniencies in the law.<sup>114</sup>

In the early 2000s, copyright trolls “found their way into the fashion industry after their predecessors encountered success in bringing ‘strike suits’ in other fields.”<sup>115</sup> Copyright infringement suits over print designs on garments have been brought by textile companies largely based in Los Angeles, California.<sup>116</sup> This model of copyright textile trolling is particularly attractive “[b]ecause U.S. copyright law allows for copyright claims to target all parties

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109. Balganes, *supra* note 106, at 765; *see also* Sag, *supra* note 99, at 1108 (“The paradigmatic troll plays a numbers game in which it targets hundreds or thousands of defendants, seeking quick settlements priced just low enough that it is less expensive for the defendant to pay the troll rather than defend the claim.”).

110. 17 U.S.C. § 504(c)(1).

111. Balganes, *supra* note 106, at 780.

112. Dotan Oliar, Nathaniel Pattison, & K. Ross Powell, *Copyright Registrations: Who, What, When, Where, and Why*, 92 TEX. L. REV. 2211 (2014) (presenting a systematic study of the registration records at the U.S. Copyright Office that used an original data set containing all 2.3 million registrations from 2008 to 2012 focused on understanding who is registering what, where, when, and why.).

113. *See generally* Diane Leenheer Zimmerman, *Copyrights as Incentives: Did We Just Imagine That?*, 12 THEORETICAL INQUIRIES L. 29 (2011) (challenging the notion that copyright protections are needed to provide authors with the necessary economic incentives to create).

114. Whether or not copyright litigation as a content-independent revenue stream results in frivolous lawsuits or helps plaintiffs assert their rights is a hotly contested debate. *See* Shyamkrishna Balganes & Jonag B. Gelbach, *Debunking the Myth of the Copyright Troll Apocalypse*, 101 IOWA L. REV. 43, 48–49 (2016).

115. *Id.*; Charles E. Colman, *The History and Doctrine of American Copyright Protection for Fashion Design: Managing Mazer*, 7 HARV. J. SPORTS & ENT. L. 151, 179 (2016).

116. Smith, *supra* note 60.

involved in the production and sales process, from retailers to labels to textile manufacturers,” meaning “misappropriated patterns could represent millions of dollars to a successful plaintiff.”<sup>117</sup> Since textile designs are often composed of “redundant-by-definition patterns consisting of finite elements and shapes,” this further complicates infringement analysis.<sup>118</sup> When textile designs are registered, the presumption of validity in registration often forces defendants to settle.<sup>119</sup> According to Doug Lipstone, partner at Weinberg Gosner whose clients are targets of textile copyright trolls, “This is not about copyright. This is about legalized extortion, it is shakedowns under the presumption of validity you can get from a copyright registration . . . . It is an absolute tax.”<sup>120</sup>

## B. PROPOSED EFFORTS TO DETER THE TROLL

There is much debate as to whether Congress, the courts, or the Copyright Office is best positioned administratively to address the copyright troll problem. While certain efforts can be made by Congress, the courts and the Copyright Office are better equipped to deter trolling.

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117. *Id.*

118. Jahner, *supra* note 35.

119. *Id.* Stephen Doniger and Scott Alan Burroughs are credited to have “pioneered these lawsuits over the past decade,” in which they have filed over 700 suits for copyright infringement that have “targeted garments which feature designs they claim are purloined from their clients, who are mostly large textile converters and importers, such as L.A. Printex Industries, Star Fabrics, Unicolors, and UFI.” See Smith, *supra* note 60; see also Michael Goodyear, *A Shield or a Solution: Confronting the New Copyright Troll Problem*, 21 TEX. REV. ENT. & SPORTS L. 77 (2020) (examining the motivations and dangers of the attorney as a copyright troll focused on extorting money over pursuing legitimate claims to the detriment of the spirit of copyright); *Usherson v. Bandshell Artist Mgmt.*, 2020 WL 3483661 (S.D.N.Y. June 26, 2020), *aff'd* in part sub nom. *Liebowitz v. Bandshell Artist Mgmt.*, 858 F. App'x 457 (2d Cir. 2021), and *aff'd* sub nom. *Liebowitz v. Bandshell Artist Mgmt.*, 6 F.4th 267 (2d Cir. 2021) (“Richard Liebowitz, who passed the bar in 2015, started filing copyright cases in this District in 2017. Since that time, he has filed more cases in this District than any other lawyer: at last count, about 1,280; he has filed approximately the same number in other districts. In that same period, he has earned another dubious distinction: He has become one of the most frequently sanctioned lawyers, if not *the* most frequently sanctioned lawyer, in the District. Judges in this District and elsewhere have spent untold hours addressing Mr. Liebowitz’s misconduct, which includes repeated violations of court orders and outright dishonesty, sometimes under oath. He has been called ‘a copyright troll,’ . . . ‘a clear and present danger to the fair and efficient administration of justice,’ . . . a ‘legal lamprey[ ],’ . . . and an ‘example of the worst kind of lawyering,’ . . .”) (internal citations omitted).

120. Smith, *supra* note 60. For defense strategies against copyright trolls, see generally Matthew Sag & Jake Haskell, *Defense Against the Dark Arts of Copyright Trolling*, 103 IOWA L. REV. 571 (2018) (analyzing the practices of copyright trolls in bringing infringement suits).

### 1. Congress

A popular proposed solution to deterring the copyright troll has been to reduce or even eliminate statutory damages, a driving incentive in the copyright troll's business model.<sup>121</sup> Statutory damages allow the court to award the copyright holder a fixed fee per work infringed, as it "considers just," between \$750 and \$30,000 per work.<sup>122</sup> The Copyright Act also empowers courts to raise the award to as much as \$150,000 per work when a plaintiff succeeds in establishing willful infringement.<sup>123</sup> These statutory damages are determined independent of any harm, which effectively assures the troll of a worthwhile recovery and induces potential defendants to settle their claims with the troll in advance of a court's decision.<sup>124</sup>

While appealing, either reducing or eliminating statutory damages are aggressive solutions that would likely cause significant harm to other areas of copyright law.<sup>125</sup> This is undesirable as statutory damages were implemented because of the difficulties copyright holders face when seeking to prove damage.<sup>126</sup> Changes to statutory damages would deter copyright trolls, however, given the impact on copyright holders and copyright law, this would be inconsistent with the overall aims of copyright. Notwithstanding, courts ought to scrutinize the election for statutory damages more closely to ensure that the compensatory purpose of statutory damages is not lost in overly punitive awards.<sup>127</sup>

Considering how Congress sought to close the loophole of defendant infringers invalidating registrations based on a technicality via § 411(b), Congress could consider some larger legislative solution to the troll problems,

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121. See Luke S. Curran, *Copyright Trolls, Defining the Line Between Legal Ransom Letters and Defending Digital Rights: Turning Piracy into a Business Model or Protecting Creative from Internet Lawlessness?*, 13 J. MARSHALL REV. INTELL. PROP. L. 170, 195 (2013) (citing to Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439, 510 (2009) ("As part of a more general revision of copyright law, Congress might even reconsider whether statutory damages serve a desirable purpose in copyright law . . . . The compensatory purpose of statutory damages continues to be important, but, owing to the 1976 Act's creation of an enhanced level of authorized statutory damages for willful infringements, and the lack of principles to guide jury or judicial deliberations on statutory damages, awards have too often been arbitrary and inconsistent, and sometimes grossly excessive."). For a view that statutory damages should be eliminated to deter copyright trolls, see generally James DeBriyn, *Shedding Light on Copyright Trolls: An Analysis of Mass Copyright Litigation in the Age of Statutory Damages*, 19 UCLA ENT. L. REV. 79 (2012).

122. 17 U.S.C. § 504(c)(1).

123. *Id.* § 504(c)(2).

124. Balganes, *supra* note 106, at 737.

125. See Curran, *supra* note 121, at 196.

126. See Samuelson & Wheatland, *supra* note 121, at 499.

127. See Balganes, *supra* note 106, at 774.

but this is beyond the scope of this Note. While well-intentioned, Congress simply did not realize that its amendment to § 411 would facilitate trolling. Congress could also seek to address the copyright troll through statutory amendment, perhaps of § 411 itself. However, due to the evolving nature and difficulty of defining a copyright troll, such efforts may be ineffective in deterring the litigation-based business model of a copyright troll.

## 2. *The Courts*

If copyright trolling is suspected, courts should utilize the willful blindness carve-out that the Supreme Court provided. Like Justice Sotomayor questioned during oral arguments, the difference between a truly innocent mistake and an alleged mistake on the part of a sophisticated party with the capacity and wherewithal to know better can be difficult to differentiate.<sup>128</sup> As counsel for Unicolors themselves replied to the inquiry in oral arguments, “that’s the beauty of willful blindness.”<sup>129</sup>

In place of actual knowledge, the Supreme Court expressly stated, “courts need not automatically accept a copyright holder’s claim that it was unaware of the relevant legal requirements of copyright law.”<sup>130</sup> The Supreme Court provided three relevant factors to aid courts in determining willful blindness based on circumstantial evidence in place of actual knowledge: (1) the significance of the legal error; (2) the complexity of the relevant law or rule; and (3) the applicant’s experience with copyright law.<sup>131</sup> Based on the *Unicolors* decision, it appears that the Supreme Court does not intend for these factors to be exhaustive, but rather indicative of willful blindness. Likewise, the Court does not place any assignment of weight to the factors and suggests that the determination should be based on the totality of the circumstances at the court’s discretion.<sup>132</sup> Other such factors that courts can, and should, look to include in their determination are: (1) the applicant’s litigation history; (2) any financial motivations that could explain the mistake; and (3) the line of work or business of the applicant.

While bright line rules and clear definitions are easy for courts to administer, the complexity of copyright law and the concept of copyright trolling requires courts to carefully balance competing aims. If courts utilize the *Unicolors* willful blindness carve-out and address the relevant factors,

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128. Transcript of Oral Argument at 17, *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 142 S. Ct. 941 (2022) (No. 20-915).

129. *Id.* at 18.

130. *Unicolors v. H&M*, 142 S. Ct. at 948.

131. *Id.* (citing to *Intel Corp. Inv. Pol’y Comm. v. Sulyma*, 140 S. Ct. 768, 778–79 (2020)).

132. *Id.* (stating that “other such matters . . . may also lead a court to find that an applicant was actually aware of, or willfully blind to, legally inaccurate information.”).

copyright trolls may be deterred from taking advantage of leniencies in copyright law. At worst, it will force copyright trolls to ensure their registrations are accurate.

### 3. *The Copyright Office*

Lastly, the Copyright Office, in order to protect the integrity of the registration system, should also consider certain efforts to deter the copyright troll from disturbing, and even diluting, the rights of all copyright holders.<sup>133</sup> Most importantly, the Copyright Office needs to provide some clarity as to how it determines referrals under § 411(b)(2).

Although the Supreme Court has now offered some clarity on how to determine if an inaccuracy was knowingly included in an application for registration under § 411(b)(1), it remains unclear how the Register of Copyrights retroactively determines whether a registration would have been refused when asked for advice from courts under § 411(b)(2). As with most areas of law, there is a tension between the law on the books and the law in action. According to the plain language of the statute, it appears that the phrase, “the inaccurate information, *if known*, would have *caused* the Register of Copyrights to refuse registration,” implies a determination of the application as submitted.<sup>134</sup> However, in practice at the moment, if an examiner had known of the inaccuracy on the application, she likely would have corresponded with the applicant to remedy the mistake rather than automatically refuse registration.<sup>135</sup> Based on the Copyright Office’s recent replies to § 411(b)(2) referrals, there does not appear to be a consistent approach.<sup>136</sup> Considering the Court’s holding in *Unicolors*, the Copyright Office should put forth a clear standard, of which an “as submitted” determination seems most appropriate.

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133. While some may argue that the Copyright Office should reform their review of applications for registration to include some sort of prior art search, like the Patent and Trademark Office practices, this is an unrealistic burden on the office. In 2021 alone, the Copyright Office registered 403,593 claims for registration involving millions of works and recorded 11,625 documents containing titles of 961,291 works. See U.S. COPYRIGHT OFF., U.S. COPYRIGHT OFFICE ANNUAL REPORT FISCAL YEAR 2021, at 3 (2021), <https://www.copyright.gov/reports/annual/2021/ar2021.pdf>.

134. 17 U.S.C. § 411(b)(2) (emphasis added).

135. Kasunic, *supra* note 29, at 90.

136. See generally *Copyright Office Filings Under Section 411*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/rulings-filings/411/> (last visited Dec. 20, 2023).

## V. CONCLUSION

The underlying facts of the recent Supreme Court case *Unicolors v. H&M* draw attention to the copyright troll issue that is plaguing much of copyright litigation. In holding that actual knowledge, rather than fraud, is required to disqualify a copyright holder from the § 411(b) safe harbor, Justice Breyer's majority opinion is consistent with Congress's intention to protect and promote the rights of non-lawyer copyright holders against efforts to invalidate their copyright certificate by infringing defendants seeking to escape liability for their infringing acts. At the same time, Justice Breyer indirectly struck a balance between the tension of protecting non-lawyer creatives and deterring copyright trolls from exploiting the leniencies of copyright law and the copyright registration system. To effectively deter copyright trolls, courts should approach a copyright holder's claim that she was unaware of the relevant legal requirements with skepticism. Where appropriate, courts should feel empowered to apply the willful blindness carve-out to determine whether, in the totality of the circumstances, a copyright holder truly made a mistake or knew what she was doing. Likewise, the Copyright Office should provide the courts with clarity on how the Register of Copyrights retroactively determines whether the inaccuracy, if known at the time, would have caused her to refuse registration. The risk of invalidating a copyright troll's certificate of registration and the right to sue it provides is a potent deterrent, especially given that the right to bring suit is a foundational aspect of a copyright troll's business model.