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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

DR. SEUSS ENTERPRISES, L.P.,

Plaintiff,

v.

**COMICMIX LLC; GLENN
HAUMAN; DAVID JERROLD
FRIEDMAN a/k/a DAVID
GERROLD; and TY
TEMPLETON,**

Defendants.

Case No.: 3:16-cv-02779-JLS (BGS)

**DEFENDANTS’ MOTION FOR
RECONSIDERATION OF ORDER
DENYING MOTION FOR ISSUANCE
OF REQUEST TO THE REGISTER
OF COPYRIGHTS PURSUANT TO 17
U.S.C. § 411(b)**

Honorable Janis L. Sammartino

Hearing: June 10, 2021, 1:30 p.m.
Courtroom: 4D

1 **I. Introduction.**

2 Plaintiff alleges infringement of the copyrights in five Dr. Seuss books,
3 primarily *Oh, the Places You'll Go!* (“Go!”) and *The Sneetches and Other Stories*
4 (“*Sneetches*”). The copyright registrations issued for those two books were based
5 on knowing inaccuracies. The registration certificates for both copyrights contain
6 inaccurate information based on knowing failures to disclose, in the applications to
7 the Copyright Office, that the books incorporate and are based on previously
8 published and registered Dr. Seuss works.

9 Therefore Defendants, pursuant to 17 U.S.C. § 411(b)(2), moved this Court
10 in 2017 to request the Register of Copyrights’ advice on whether those inaccuracies
11 would have caused the Register to refuse registration. Doc. 57-1 (“411 Motion”).
12 The Court denied the 411 Motion in 2018, concluding that the preexisting material
13 was not so “substantial” a part of *Sneetches* or *Go!* that the Copyright Office would
14 have required disclosure. Doc. 88 pp. 8-10 (“411 Order”).

15 In a change of controlling law, the Ninth Circuit has since removed the
16 District Court’s discretion and made clear that compliance with a § 411(b) request
17 request is mandatory.

18 In practice, once a defendant alleges that (1) a plaintiff’s certificate of
19 registration contains inaccurate information; (2) “the inaccurate
20 information was included on the application for copyright
21 registration”; and (3) the inaccurate information was included on the
22 application “with knowledge that it was inaccurate,” a district court is
23 then required to submit a request to the Register of Copyrights “to
24 advise the court whether the inaccurate information, if known, would
25 have caused [it] to refuse registration.”

24 *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 959 F.3d 1194, 1198 (9th
25 Cir. 2020) (*quoting* 17 U.S.C. § 411(b)(1)-(2)). This requirement, drawn from a
26 literal reading of § 411, leaves no discretion for a district court to interpose its own
27 analysis about what opinion the Register of Copyrights might form about a
28 registrant’s misrepresentations. “In other words, courts may not consider in the first

1 instance whether the Register of Copyrights would have refused registration due to
2 the inclusion of known inaccuracies in a registration.” *Id.* So any question about the
3 materiality of inaccuracies must be submitted to the Register for her advice.

4 This case is on remand. No party addressed the § 411 issue on appeal and the
5 Ninth Circuit did not decide it. *Unicolors* marks an intervening change in law that
6 requires reconsideration of the 411 Order. Because the Ninth Circuit issued the
7 *Unicolors* ruling only after its hearing in Plaintiff’s appeal, its newly clarified
8 requirements reasonably could not have been raised earlier. Pursuant to Fed. R. Civ.
9 P. 54(b), Defendants move the Court to reconsider the 411 Order and renew their
10 request for issuance of a request to the Register of Copyrights for her advice.

11 **II. Factual Background.**

12 Theodor Seuss Geisel (“Geisel”), a/k/a Dr. Seuss, wrote and illustrated
13 several stories published in *Redbook*, including “The Sneetches” in the July 1953
14 issue and “The Zaks” in the March 1954 issue. Doc. 69-5, Doc. 69-6. The copyright
15 notices for those issues identified only *Redbook*’s publisher McCall Corporation
16 (“McCall”) as the copyright owner, and McCall obtained copyright registrations for
17 both issues. Doc. 57-1 p. 9, Doc. 69 p. 8. Geisel did not independently obtain
18 copyright registrations for either story. Doc. 57-1 p. 9. McCall assigned the
19 copyrights for “The Sneetches” and “The Zaks” to Geisel in 1956. Doc. 69-8, Doc.
20 69 p. 8. The governing Copyright Act of 1909 required a timely renewal in the 28th
21 year after first publication to maintain the copyrights. Act of March 4, 1909, ch.
22 320 § 23, 35 Stat. 1075, 1080; *see* Doc. 57-1 p. 8, Doc. 120 pp. 8-9. Geisel failed to
23 timely obtain renewals of the copyrights in either “The Sneetches” and “The Zaks”
24 28 years after *Redbook* published them. Doc. 57-1 p. 10. As a result, the copyrights
25 in both stories terminated and lapsed into the public domain. Doc. 120 p. 9.

26 Random House published *Sneetches* in 1961 and obtained a copyright
27 registration for the book on behalf of Geisel in 1962. Doc. 57-7, Doc. 69 pp. 8-9.

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1 Line 5 of the copyright application form instructed, “If any substantial part of this
2 work has been previously published, give a brief general statement of the new
3 matter in this version. New matter may consist of compilation, translation,
4 abridgment, editorial revision, and the like, as well as additional text or pictorial
5 matter.” Doc. 57-7 p.1; Doc. 88 p. 2 n. 3. Random House left Line 5 blank. *Id.* Yet
6 two of the four stories in *Sneetches*, “The Sneetches” and “The Zax,” incorporate
7 elements of, and are based on, the stories published in *Redbook*’s July 1953 and
8 March 1954 issues. Doc. 57-1 p. 10; Doc. 69-3, Doc. 69-5, Doc. 69-6.

9 Nevertheless, the copyright registration for *Sneetches* was issued on the basis of an
10 application that omitted reference to the *Redbook* originals. Doc. 57-7, Doc. 88 p. 2.

11 Through his Random House agent, Geisel also applied for and obtained a
12 1989 renewal registration for the *Sneetches* book. Doc. 57-8, Doc. 69-2. The
13 renewal application left the “Contribution to Periodical or Composite Work” line
14 blank, again failing to disclose that two of the four stories derived from work
15 previously published in *Redbook*. *Id.*; Doc. 74 p. 4.

16 Geisel also wrote and illustrated “The economic situation clarified: A
17 prognostic re-evaluation” (“Economic Situation”), which was first published in the
18 June 15, 1975 issue of *The New York Times Magazine*. Doc. 69-4. The publisher
19 obtained a copyright registration for that issue in 1975 and renewed it in 2003. Doc.
20 57-1 pp. 12-13, Doc. 57-10, Doc. 69 p. 9. With slight alterations, the full-page
21 Economic Situation illustration appears in *Go!*, which Random House published in
22 1990. Doc. 57-1 pp. 12-15. Random House applied to register the *Go!* copyright in
23 1990 on behalf of Geisel and his wife Audrey Geisel. Doc. 57-13, Doc. 57-1 p. 16.
24 Random House left blank Line 6 of the application form, which required: “Identify
25 any preexisting work or works that this work is based on or incorporates.” *Id.* As
26 that application omitted reference to Economic Situation, so did the copyright
27 registration for *Go!* issued by the Copyright Office based on that application. *Id.*

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1 In 1991, Random House filed an application to correct the *Go!* registration in
2 part, naming the Geisels as copyright claimants not in their personal capacities but
3 as trustees under a 1984 trust agreement. Doc. 57-1 p. 17, Doc. 57-14, Doc. 107-13.
4 The correction, and the resulting corrected registration, did not identify the
5 preexisting Economic Situation material in *Go! Id.*

6 **III. Procedural History.**

7 Plaintiff raised copyright infringement, trademark infringement, and unfair
8 competition claims against all Defendants. Doc. 1. The Court dismissed the
9 trademark and unfair competition claims without prejudice on June 9, 2017. Doc.
10 38. Plaintiff renewed all claims and added another trademark claim in the operative
11 amended complaint. Doc. 39. The Court denied Defendants' motion to dismiss the
12 amended complaint on December 7, 2017. Doc. 51. Defendants filed their answer
13 and a motion for partial judgment under Rule 12(c) on December 21, 2017, and
14 filed the 411 Motion the next day. Doc. 53, 54, 57. On May 21, 2018, the Court
15 denied the 411 Motion and granted the Rule 12(c) motion in part. Doc. 88, 89. The
16 Court granted Defendants summary judgment on all remaining claims on March 12,
17 2019. Doc. 149. Plaintiff noticed an appeal to the Ninth Circuit. Doc. 151.
18 Defendants sought to recover their fees and costs; the Court denied the fee motion
19 without prejudice to renewal after the appeal. Doc. 154, 155, 163.

20 Briefing on appeal was complete on November 25, 2019. Neither party
21 mentioned § 411, the 411 Motion, or the 411 Order. The Ninth Circuit heard oral
22 argument on April 27, 2020. Again, § 411 was not mentioned. The Ninth Circuit
23 then issued its ruling in *Unicolors* a month later, on May 29, 2020.

24 On December 18, 2020, the Ninth Circuit affirmed this Court's decisions on
25 Plaintiff's trademark and unfair competition claims, but it reversed and remanded
26 the grant of summary judgment on the issue of copyright fair use. The mandate was
27 issued on January 11, 2021.

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1 At the appeal mandate hearing on March 5, 2021, Plaintiff outlined the issues
2 it seeks to resolve: liability for copyright infringement, willful infringement,
3 assessment of damages, and applications for attorneys' fees, in that order.

4 Defendants proposed that in light of *Unicolors*, the § 411 issue should be revisited
5 and resolved before any other issue, and gave notice of their intention to petition the
6 Supreme Court for a writ of certiorari to review the Ninth Circuit's decision. The
7 Court spread the mandate and set a post-appeal briefing schedule. Doc. 173, 174.

8 **IV. Legal Standards.**

9 A plaintiff whose "certificate of registration was invalid ... fail[s] to satisfy
10 the registration precondition under 17 U.S.C. § 411 to bring a copyright
11 infringement claim." *Sellpoolsuppliesonline, LLC v. Ugly Pools Ariz., Inc.*, 804
12 Fed. Appx. 668, 670 (9th Cir. 2020). A plaintiff's "compliance with the Copyright
13 Act's registration requirement is a threshold matter." *Unicolors*, 959 F.3d at 1200 n.
14 4. "[T]he Copyright Act expressly prohibits copyright owners from bringing
15 infringement actions without first properly registering their work." *Id.* at 1197
16 (*citing* 17 U.S.C. § 411(a)). "[A] registration certificate does not satisfy the
17 Copyright Act's registration requirement if the registrant secured the registration by
18 knowingly including inaccurate information in the application for copyright
19 registration that, if known by the Register of Copyrights, would have caused it to
20 deny registration." *Id.* (*citing* 17 U.S.C. § 411(b)(1)).

21 Once such a knowing inaccuracy is alleged, the issue of whether the Register
22 would have refused registration must be referred to the Register. "In any case in
23 which inaccurate information described under [17 U.S.C. § 411(b)(1)] is alleged,
24 the court shall request the Register of Copyrights to advise the court whether the
25 inaccurate information, if known, would have caused the Register of Copyrights to
26 refuse registration." 17 U.S.C. § 411(b)(2). "[C]ourts are in agreement that the
27 provision is mandatory in nature, requiring district courts to solicit the advice of the
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1 Copyright Office when the statutory conditions are satisfied.” *Palmer/Kane LLC v.*
2 *Rosen Book Works LLC*, 188 F. Supp. 3d 347, 348 (S.D.N.Y. 2016) (collecting
3 cases). Thus, “courts may not consider in the first instance whether the Register of
4 Copyrights would have refused registration due to the inclusion of known
5 inaccuracies in a registration.” *Unicolors*, 959 F.3d at 1198. “17 U.S.C. § 411(b)(2)
6 was enacted because a court will not always know what information would or
7 would not make a difference in the Register’s determination whether to register a
8 copyright.” ECF No. 209, Response of the Register of Copyrights to Request
9 Pursuant to 17 U.S.C. § 411(b)(2) p. 11, *Olem Shoe Corp. v. Washington Shoe Co.*,
10 No. 1:09-cv-23494-PCH (S.D. Fla. filed Oct. 14, 2010),
11 [www.copyright.gov/rulings-filings/411/olem-shoe-corp-v-washington-shoe-co-no-](http://www.copyright.gov/rulings-filings/411/olem-shoe-corp-v-washington-shoe-co-no-1-09-cv-23494-sd-fla-oct-14-2010.pdf)
12 [1-09-cv-23494-sd-fla-oct-14-2010.pdf](http://www.copyright.gov/rulings-filings/411/olem-shoe-corp-v-washington-shoe-co-no-1-09-cv-23494-sd-fla-oct-14-2010.pdf). “[I]f the issue depends even in part on
13 interpretation or understanding of the Copyright Office’s registration practices, the
14 more prudent practice—and the practice anticipated in § 411(b)—would be to refer
15 the question to the Register.” *Id.* at 12 n.5.

16 An order on a motion for referral under § 411(b) is interlocutory. *Ronaldo*
17 *Designer Jewelry, Inc. v. Cox*, No. 17-cv-2-DMB, 2019 U.S. Dist. LEXIS 142853,
18 *2-3 (N.D. Miss. Aug. 22, 2019); *Palmer/Kane LLC v. Gareth Stevens Publ’g*, No.
19 15-cv-7404, 2016 U.S. Dist. LEXIS 147336, *9-11 (S.D.N.Y. Oct. 24, 2016). An
20 interlocutory order “may be revised at any time before the entry of a judgment
21 adjudicating all the claims and all the parties’ rights and liabilities.” Fed. R. Civ. P.
22 54(b). See *Ronaldo Designer Jewelry*, 2019 U.S. Dist. LEXIS 142853, *3
23 (reconsidering § 411(b) order under Rule 54(b)). “A district court has plenary
24 power to reconsider interlocutory orders.” *Seals-McClennan v. DreamWorks, Inc.*,
25 120 Fed. Appx. 3, 4 (9th Cir. 2004) (citing *City of Los Angeles v. Santa Monica*
26 *Baykeeper*, 254 F.3d 882, 885 (9th Cir. 2001)). An interlocutory order “is not a
27 conclusive, immutable determination of the issue. It can be revisited if
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1 circumstances warrant.” *Z-Seven Fund, Inc. v. Motorcar Parts & Accessories*, 231
2 F.3d 1215, 1218 (9th Cir. 2000). It may be challenged even after a judgment is
3 appealed and remanded, “because the district court retains the ability to modify it at
4 any time.” *Bahn v. Korean Airlines Co. (In re Korean Airlines Co.)*, 642 F.3d 685,
5 701-02 (9th Cir. 2011) (citing *Z-Seven Fund*, 231 F.3d at 1218-19). Thus, when the
6 Ninth Circuit vacates and remands a judgment while “express[ing] no view as to
7 the correctness of the interlocutory rulings of the district court,” those rulings
8 remain “subject to revision at any time before the entry of final judgment” on
9 remand. *Dewberry v. City of Bakersfield*, No. 93-16456, 1995 U.S. App. LEXIS 89,
10 *15-16 (9th Cir. Jan. 3, 1995) (citing Rule 54(b)). Rule 54(b) reconsideration is
11 “both appropriate and necessary” upon a “significant change in the Ninth Circuit
12 law.” *Aceves v. Allstate Ins. Co.*, 827 F. Supp. 1473, 1476 (S.D. Cal. 1993) (“the
13 court cannot disregard relevant Ninth Circuit authority”).

14 “Lower courts are free to decide issues on remand so long as they were not
15 decided on a prior appeal. ... Any issue not expressly or impliedly disposed of on
16 appeal is left open for the trial court’s reconsideration on remand.” *Beltran v.*
17 *Myers*, 701 F.2d 91, 93 (9th Cir. 1983) (citations omitted). Even an issue expressly
18 or implicitly decided on appeal, making it “the law of the case,” is subject to
19 reconsideration if based on clear error, or “an intervening change in the law has
20 occurred,” or to avoid a manifest injustice. *United States v. Alexander*, 106 F.3d
21 874, 876 (9th Cir. 1997). “While a mandate is controlling as to matters within its
22 compass, on the remand a lower court is free as to other issues.” *Sprague v. Ticonic*
23 *Nat’l Bank*, 307 U.S. 161, 168 (1939).

24 **V. Argument.**

25 **A. The 411 Order is subject to reconsideration on remand.**

26 The interlocutory 411 Order is subject to reconsideration. The parties did not
27 brief or argue the § 411 issue on appeal, and the Ninth Circuit did not exercise
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1 jurisdiction over the issue. It reversed this Court’s grant of summary judgment on
2 the copyright claim without addressing, either expressly or impliedly, the validity
3 of the copyright registrations. It did not instruct the Court to enter judgment on the
4 copyright claim, so the merits remain unsettled. The remand “for proceedings
5 consistent with this opinion” did not restrict the consideration of issues outside the
6 appeal. When the Ninth Circuit does not reach or assert jurisdiction over an
7 interlocutory order, it remains subject to reconsideration on remand until final
8 judgment. *Korean Airlines Co.*, 642 F.3d at 701-02; *Beltran*, 701 F.2d at 93;
9 *Sprague*, 307 U.S. at 168. With summary judgment reversed in part, “the entry of
10 that final judgment no longer has effect and the prior denials are effectively once
11 more interlocutory in nature.” *Marketquest Grp., Inc. v. BIC Corp.*, No. 11-cv-
12 0618-BAS-JLB, 2018 U.S. Dist. LEXIS 62359, *9 (S.D. Cal. Apr. 12, 2018).

13 **B. The *Unicolors* decision marks an intervening change in the law.**

14 After this Court denied the 411 Motion, the Court of Appeals changed the
15 nature of how courts in this Circuit are required to address such § 411(b) requests.
16 As the *Unicolors* decision bares out, § 411 is mandatory by its express terms: “In
17 any case in which inaccurate information ... is alleged, the court *shall* request the
18 Register of Copyrights to advise the court whether the inaccurate information, if
19 known, would have caused the Register of Copyrights to refuse registration.” 17
20 U.S.C. § 411(b)(2) (emphasis added).

21 Other courts have recognized its mandatory nature: “under section 411(b)(2),
22 a court still must request a response from the Register before coming to a
23 conclusion as to the materiality of a particular misrepresentation.” *DeliverMed*
24 *Holdings, LLC v. Schaltenbrand*, 734 F.3d 616, 624 (7th Cir. 2013). “Instead of
25 relying solely on the court’s own assessment of the Register’s response to an
26 inaccuracy, the statute obligates courts to obtain an opinion from the Register on
27 the matter.” *Id.* at 623. *See also Palmer/Kane LLC*, 188 F. Supp. 3d at 348
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1 (collecting cases). Likewise, the Copyright Office recently advised the Ninth
2 Circuit that “failing to follow Congress’s explicit instruction” when § 411(b)(2)
3 inaccuracies are alleged, by deciding the validity of registration “without first
4 seeking the views of the Register of Copyrights” is erroneous. Brief of the United
5 States as Amicus Curiae p. 11, *Univ. Dyeing & Printing, Inc. v. Topson Downs of*
6 *Calif., Inc.*, No. 19-55840 (9th Cir. filed Jan. 16, 2020),
7 [https://www.copyright.gov/rulings-filings/briefs/universal-dyeing-inc-v-topson-](https://www.copyright.gov/rulings-filings/briefs/universal-dyeing-inc-v-topson-downs-2020.pdf)
8 [downs-2020.pdf](https://www.copyright.gov/rulings-filings/briefs/universal-dyeing-inc-v-topson-downs-2020.pdf).

9 The Ninth Circuit clarified in *Unicolors* that it agrees: “courts may not
10 consider in the first instance whether the Register of Copyrights would have refused
11 registration due to the inclusion of known inaccuracies in a registration.” *Unicolors*,
12 959 F.3d at 1198. This approach streamlines the process: “once a defendant
13 alleges” that an error in the registration certificate was included in the application
14 with knowledge that it was inaccurate, “a district court is then required to submit a
15 request to the Register of Copyrights” soliciting her advice on the registration
16 without speculating on what that advice may be. *Id.*

17 *Unicolors* further clarifies the application of § 411(b) in the Ninth Circuit by
18 explaining “that there is [not] an intent-to-defraud requirement for registration
19 invalidation,” despite references in earlier Ninth Circuit decisions that implied such
20 a requirement. *Id.* (citing among others *Gold Value Int’l Textile, Inc. v. Sanctuary*
21 *Clothing, LLC*, 925 F.3d 1140, 1147 (9th Cir. 2019)). At the time of the 411 Order,
22 before it affirmed *Gold Value* and remanded *Unicolors*, the Ninth Circuit’s position
23 on an intent-to-defraud requirement was also unclear. *See* Doc. 57-1 p. 23
24 (Defendants citing lower court’s decision in *Gold Value* as supporting a “knowing
25 errors” standard), Doc. 69 p. 13 n. 4 (Plaintiff arguing, before it was affirmed, that
26 the same decision was “plainly incorrect”).

1 The Ninth Circuit has also made explicit that *Unicolors* marked a material
 2 change in the law. In 2019 another district court reached conclusions about the
 3 significance of inaccuracies in a copyright registration, without the Register of
 4 Copyrights’ input, and issued judgment. *Univ. Dyeing*, No. 17-cv-03879-DDP,
 5 2019 U.S. Dist. LEXIS 1669 (C.D. Cal. Feb. 1, 2019). But after *Unicolors*, the
 6 Ninth Circuit vacated that judgment and remanded with instructions “to seek the
 7 views of the Register of Copyrights.” Order, *Univ. Dyeing*, No. 19-55840, 2020
 8 U.S. App. LEXIS 30300 (9th Cir. Sept. 22, 2020). *Unicolors* had established the
 9 Ninth Circuit’s position that the Register’s input is mandatory: “The district court
 10 did not have the benefit of this court’s opinion in *Unicolors* ... when it issued its
 11 February 1, 2019 judgment.” *Id.*

12 **C. *Unicolors* requires a different result in this case.**

13 As in *Universal Dyeing*, this Court did not have the benefit of the 2020
 14 *Unicolors* opinion when it issued the 411 Order in 2018. In that order, the Court
 15 determined that the previously published materials that Geisel incorporated into
 16 *Sneetches* and *Go!* was not a substantial enough part of either book that disclosure
 17 would have been required. Doc. 88 pp. 8-10. Because the Court exercised its
 18 discretion rather than first soliciting and obtaining the Register of Copyrights’
 19 opinion, the 411 Order contravened both the text of § 411(b) and its application
 20 under *Unicolors*. The 411 Order remains subject to reconsideration on remand.
 21 Under *Unicolors*, it must be altered.

22 **D. Defendants sufficiently alleged the predicates for a § 411 request.**

23 The defendants have made the proper showing that triggers the statutory
 24 mandate that the Court must seek the Register of Copyrights’ advice as to whether
 25 the registration inaccuracies would have been material to the Register.

26 In practice, once a defendant alleges that (1) a plaintiff’s certificate of
 27 registration contains inaccurate information; (2) “the inaccurate
 28 information was included on the application for copyright
 registration”; and (3) the inaccurate information was included on the

1 application “with knowledge that it was inaccurate,” a district court is
2 then required to submit a request to the Register of Copyrights “to
3 advise the court whether the inaccurate information, if known, would
4 have caused [it] to refuse registration.”

5 *Unicolors*, 959 F.3d at 1198. As this Court recognized in the 411 Order,
6 Defendants alleged that the *Go!* and *Sneetches* copyright applications “are based on
7 inaccurate information.” Doc. 88 p. 1. Specifically, Defendants alleged that the
8 registration certificates for those books are invalid because, as Defendants showed
9 in the 411 Motion, they contain inaccurate information that was included in the
10 registration applications with knowledge that it was inaccurate. *See* Doc. 53 pp. 19-
11 26 & 27-30 (Sixteenth and Nineteenth Affirmative Defenses), Doc. 57, Doc. 57-1.
12 Two of the four *Sneetches* stories are derivative works based on Dr. Seuss stories
13 published in *Redbook*, and an illustration in *Go!* is almost identical to one he
14 published in *The New York Times Magazine*. *Id.* The applications and registrations
15 do not disclose their derivative nature or their previously published and previously
16 registered source material. *Id.*

17 Here, “the statutory criteria for a mandatory referral have been satisfied.”
18 *Palmer/Kane LLC*, 188 F. Supp. 3d at 351. Defendants have both alleged and
19 shown that the registration applications “contained inaccurate information. Whether
20 that inaccurate information is material to the Copyright Office is precisely what the
21 procedure codified at § 411(b)(2) is designed to clarify.” *Id.* at 352. Pursuant to 17
22 U.S.C. § 411(b) and *Unicolors*, the Register of Copyrights must be asked to opine
23 on whether registration would have been refused were the errors known.

24 **1. The applications for *Sneetches* and *Go!* contain inaccuracies.**

25 The applications to register the copyrights for *Sneetches* and *Go!* contain
26 inaccuracies because they failed to disclose that both books are based on and
27 incorporate previously published and registered material.

28 When contesting the 411 Motion, Plaintiff argued that what “determines
whether there was a material inaccuracy in the 1961 copyright application for the

1 *Sneetches* Book” was not the application form but the text of the Copyright Act of
2 1909, and that the 1909 Act did not require applicants “to disclose that preexisting
3 works had been used in a new work sought to be registered.” Doc. 69 p. 14.

4 Plaintiff’s argument is misguided, however, because by 1961, the Copyright Office
5 had found the disclosures mandated by statute were inadequate, so it issued
6 application forms that required much more:

7 Section 209 was designed to enumerate the facts to be shown in the
8 certificate, but this enumeration has been proved to be incomplete. ...

9 The Copyright Office has sought to fill these gaps by calling for
10 information in the applications beyond that enumerated in section 209,
11 and by including this additional information in its records and in the
12 certificates.

13 Copyright Law Revision, Report of the Register of Copyrights on the
14 General Revision of the U.S. Copyright Law, 87th Cong., 1st Sess., 142 (House
15 Judiciary Comm. Print 1961),

16 https://www.copyright.gov/history/1961_registers_report.pdf. The “additional
17 information” required included “[t]he limitation of the claim to the new material
18 only, where a work contains both preexisting and new material,” as well as “[d]ata
19 distinguishing the particular work from other editions or versions.” *Id.* Those
20 requirements were specified on the face of the form itself, which required a
21 disclaimer identifying previously published work: “If any substantial part of this
22 work has been previously published, give a brief general statement of the new
23 matter in this version. New matter may consist of compilation, translation,
24 abridgment, editorial revision, and the like, as well as additional text or pictorial
25 matter.” Doc. 57-7 § 5. Yet the application for *Sneetches* did not make the required
26 claim limitation or identify and distinguish the prior works published in *Redbook*.

27 A 1944 manual from the Copyright Office’s Examining Section further
28 explains the Office procedures and registration requirements under the 1909 Act,
before the first Compendium of U.S. Copyright Office Practices issued in 1967.

1 United States Copyright Office Examining Section, Section Manual,
2 <https://archive.org/details/copyrightexamprocedures1944/>.¹ The 1944 examination
3 manual described the Examining Section as “the only fact-finding body which
4 passes upon applications for registration of copyright.” *Id.* p. 1. Among the
5 examiners’ principal duties, then as now, was “[t]o examine the copy and
6 application with the purpose of determining whether the applicant has provided all
7 data necessary to recordation of the claim.” *Id.* p. 4; *see also id.* p. 1. “The data
8 necessary to such recordation,” then as now, included “[a] comprehensive statement
9 to establish the new matter claimed in a work previously published or registered or
10 both.” *Id.* pp. 4-5. Thus, the application forms solicited such “comprehensive”
11 statements about any prior work because the Copyright Office considered it
12 “necessary.” *Id.*; *see* Copyright Law Revision at 142. The *Sneetches* application
13 failed to provide it. Doc. 57-7.

14 Similarly, the copyright renewal form filed for *Sneetches* in 1989 required
15 identification of material that had been a “Contribution to Periodical,” with the
16 volume, issue number, and date. Doc. 57-8 § 2, Doc. 69-2. And the application
17 form filed for *Go!* in 1990 required disclosure of prior work: “Identify *any*
18 preexisting work or works that this work is based on or incorporates.” Doc. 57-13 §
19 6 (emphasis added). The requirement follows from the text of the Copyright Act of
20 1976, which requires applications for derivative works to include “an identification
21 of *any* preexisting work or works that it is based on or incorporates, and a brief
22 general statement of the additional material covered by the copyright claim being
23 registered.” 17 U.S.C. § 409(9) (emphasis added). Despite these requirements the
24 applications failed to disclose and disclaim the original “The Sneetches” and “The
25 Zaks” stories and illustrations published in *Redbook* and adapted in *Sneetches*, and
26

27 _____
28 ¹ Professor Zvi Rosen discovered the manual in the Copyright Office’s files while serving as the
Abraham L. Kaminstein Scholar in Residence.

1 the “Economic Situation” illustration published in the *New York Times Magazine*
2 and incorporated in *Go!*.

3 *Sneetches* and *Go!* are both derivative works because they are “based upon
4 one or more preexisting works.” 17 U.S.C. § 101. Their copyright registrations do
5 not extend to “any copyright protection in the preexisting material.” 17 U.S.C. §
6 103(b); *accord* 17 U.S.C. § 7 (1909 Act). “A typical derivative work registered in
7 the Copyright Office is a primarily new work but incorporates some previously
8 published material. The previously published material makes the work a derivative
9 work under copyright law.” U.S. Copyright Office, Circular No. 14: Copyright
10 Registration for Derivative Works (rev. ed. May 2010). There is no dispute that
11 *Sneetches* and *Go!*, while primarily new, incorporate *some* previously published
12 material. And Plaintiff has not disputed that *Sneetches* and *Go!* are derivative
13 works. *See* Doc. 57-1 pp. 4 & 12, Doc. 74 p. 6, Doc. 88 p. 9.

14 Nor could it. Plaintiff must be estopped from denying that the “Economic
15 Situation” illustration became a “substantial part” of *Go!*, or that the single
16 illustration and text adapted from *Redbook* was a “substantial part” of *Sneetches*,
17 because it maintains that Defendants’ use of the same or lesser amounts of Dr.
18 Seuss books was substantial enough to constitute infringement. Plaintiff alleged
19 that the unpublished book *Oh, the Places You’ll Boldly Go!* (“*Boldly*”) infringed its
20 copyrights in not just *Go!* and *Sneetches*, but also *How the Grinch Stole*
21 *Christmas!*, *The Lorax*, and *Horton Hears a Who*. Doc. 39 p. 30. Plaintiff has never
22 identified more than a single illustration in *Boldly* as drawn from elements of
23 *Grinch*, and claimed that the other two books were the basis for only a second
24 illustration in *Boldly*. *See id.* p. 14 (top, *Grinch*), ECF No. 115-2 at 300:1-307:22
25 (describing a page in *Boldly* as “a combination of ‘Horton Hears a Who!’ and
26 Truffula Trees from *The Lorax*”). Relying on its claim that Defendants used just
27 one illustration from *Grinch* was enough to overcome summary judgment on
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1 appeal, despite the third fair use factor: “the amount and substantiality of the
2 portion used in relation to the copyrighted work as a whole.” 17 U.S.C. § 107; *see*
3 *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 456 (9th Cir. 2020)
4 (quoting Plaintiff’s misleading plural phrasing, “illustrations from *Grinch* and two
5 stories in *Sneetches*”). *Go!* includes almost wholesale “Economic Situation,” a
6 single Dr. Seuss illustration, with only insubstantial changes. Doc. 57-1 pp. 12-15.

7 Plaintiff cannot maintain that *Boldly*’s takings from *Grinch*, *Lorax*, and
8 *Horton* were substantial enough to infringe unless it concedes that Geisel’s taking
9 of the same or greater quantum for *Go!* was substantial enough to have required
10 disclosure. Yet the applications did not disclose that *Go!* and *Sneetches* were
11 derivative works, as the Copyright Office would have required had it known.

12 Plaintiff does not dispute that the applications did not provide the facts about
13 the periodical publications. While Plaintiff has argued that those misstatements
14 were immaterial, under the new governing precedent of *Unicolors*, materiality is an
15 issue for the Register of Copyrights to address once the Court issues the request as
16 mandated. Whether the Register would have considered the preexisting works a
17 “substantial” part of *Sneetches* and *Go!*, and whether the Register would have
18 considered the nondisclosures material, are questions that the Register is uniquely
19 qualified to answer.

20 **2. The registration certificates bear the same inaccurate information.**

21 The Copyright Office accepted the misrepresentations and issued registration
22 certificates for *Sneetches* and *Go!* which contain inaccuracies that reflect the
23 inaccuracies in the applications. The *Sneetches* certificate does not identify the
24 previously published material incorporated from *Redbook*. Doc. 57-7. The renewal
25 certificate does not limit the renewable matter claimed and does not identify any
26 matter that had been a contribution to a periodical. Doc. 57-8. The *Go!* certificate
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1 also does not identify the material previously published in a periodical or “any
2 preexisting work or works that this work is based on or incorporates.” Doc. 57-13.

3 **3. The inaccurate statements in the registration applications were**
4 **made with knowledge of their inaccuracy.**

5 There is no “intent-to-defraud requirement.” *Unicolors*, 959 F.3d at 1198.
6 The “plain language of § 411(b) ... does not require a showing of fraud, but only
7 that the claimant included inaccurate information on the application ‘with
8 knowledge that it was inaccurate.’” *Gold Value*, 925 F.3d at 1147 (quoting 17
9 U.S.C. § 411(b)). And as the Ninth Circuit has further clarified, the “knowledge
10 that it was inaccurate” pertains to whether the claimant’s assertions in the
11 application were accurate as a factual matter, not as a legal matter: “the term
12 ‘knowingly’ does not necessarily have any reference to a culpable state of mind or
13 to knowledge of the law. As Justice Jackson correctly observed, ‘the knowledge
14 requisite to knowing violation of a statute is factual knowledge as distinguished
15 from knowledge of the law.’” *Id.* (quoting *Bryan v. United States*, 524 U.S. 184,
16 192 (1998) (internal citation omitted)). For example, as explained in *Unicolors*,
17 the knowledge inquiry is not whether Unicolors knew that including a
18 mixture of confined and non-confined designs would run afoul of the
19 single-unit registration requirements [under Copyright Office
20 regulations]; the inquiry is merely whether Unicolors knew that certain
21 designs included in the registration were confined and, therefore, were
22 each published separately to exclusive customers.

23 *Unicolors*, 959 F.3d at 1200 (citing *Gold Value*, 925 F.3d at 1147). Any pre-
24 *Unicolors* precedent that construed § 411(b) to require a showing of culpable intent
25 is, to that extent, overruled by *Unicolors* and invalid.

26 A § 411(b) request requires compliance when knowing inaccuracies are duly
27 alleged, even with no supporting evidence. *See Fashion Ave. Sweater Knits, LLC v.*
28 *Poof Apparel Corp.*, No. 2:19-cv-06302-CJC-JEM, 2020 U.S. Dist. LEXIS 245889,
*3-4 (C.D. Cal. Dec. 3, 2020). But here, evidence of knowing inaccuracies is
ample. Plaintiff has not denied that the applications were filed with knowledge of

1 the facts, and that the applications misstated those facts. Geisel wrote and illustrated
2 “The Sneetches” and “The Zaks,” and plainly knew that they had been published in
3 *Redbook*, and that their copyrights had been registered years before the 1962
4 *Sneetches* registration and its 1989 renewal. As Plaintiff showed, when *Redbook*’s
5 publisher assigned the copyrights back to Geisel in 1956, it provided him a list with
6 the publication dates and registration numbers for both stories. Doc. 69-8 pp. 4-5.
7 Geisel also plainly knew when he wrote and illustrated *Go!* that it incorporated his
8 previously published illustration. A Dr. Seuss scholar explains that when preparing
9 his final book Geisel literally “used a photocopy of ‘The economic situation,’ and
10 simply pasted in his main character,” then added color. Doc. 57-1 p. 15 (*quoting*
11 Philip Nel, *Dr. Seuss: American Icon* p. 80 (Continuum Books 2004)).

12 Geisel also knew that the Copyright Office expected disclosure of previously
13 published work. His applications to register the copyright in *Yertle the Turtle and*
14 *Other Stories* in 1958, and to renew it in 1986, disclosed that *Redbook* had
15 published earlier versions of its stories. *See* Doc. 57-9. Yet when he applied to
16 register *Sneetches* in 1962, to renew the registration in 1989, and to register *Go!* in
17 1990, he omitted the expected disclosures. Such knowledge about the law is not
18 necessary; “the knowledge inquiry is not whether [the applicant] knew that [the
19 work] would run afoul of the ... registration requirements.” *Unicolors*, 959 F.3d at
20 1200. But were that higher standard necessary, Defendants’ showing would meet it.

21 **E. Issuing a § 411(b) request is proper at this juncture.**

22 Defendants have shown that both *Sneetches* and *Go!* copied from prior works
23 that were not disclosed on the Copyright Office applications or registration
24 certificates, with knowledge of the inaccuracies. Pursuant to § 411(b) and
25 *Unicolors*, no more need be shown. Defendants have met the statutory requirements
26 and a request for the Register of Copyrights’ opinion is in order. “Instead of relying
27 solely on the court’s own assessment of the Register’s response to an inaccuracy,
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1 the statute obligates courts to obtain an opinion from the Register on the matter.”
2 *DeliverMed Holdings, LLC v. Schaltenbrand*, 734 F.3d 616, 623 (7th Cir. 2013).
3 *Accord Study Edge, LLC v. Skoolers Tutoring Ctr., LLC*, 2018 U.S. Dist. LEXIS
4 227915, *18 (N.D. Fla. May 7, 2018) (“This Court declines to analyze the
5 materiality of these inaccuracies until the Register of Copyrights has offered advice
6 pursuant to 17 U.S.C. § 411(b)(2).”).

7 The time for that request is now. The sole claim pending is copyright
8 infringement and the validity of Plaintiff’s copyright registrations is “a threshold
9 issue.” *Unicolors*, 959 F.3d at 1195-96. Plaintiff alleged copyright infringement of
10 five books and claimed that *Boldly* used fourteen illustrations from *Go!*, two from
11 *Sneetches*, and one apiece from *Grinch*, *Lorax*, and *Horton*. See *Dr. Seuss Enters.*,
12 983 F.3d at 456, ECF No. 115-2 at 300:1-307:22. Plaintiff cannot prevail on its
13 remaining copyright claim without proving valid copyright registration. Resolving
14 the merits of the claim will first require a determination as to whether the
15 registrations for the derivative works *Go!* and *Sneetches* are valid in light of
16 Geisel’s numerous failures to disclose. Under *Unicolors*, that determination
17 requires the Register of Copyrights’ opinion as an initial matter.

18 The Register’s response to the § 411 request is also likely to aid the
19 resolution of Plaintiffs’ copyright claims as to *Sneetches*, *Grinch*, *Lorax*, or *Horton*.
20 Plaintiff cannot prevail on those claims without a determination that the use of any
21 copyright-protected elements of those books is greater than *de minimis* as pleaded.
22 Doc. 53 p. 31 (Twenty-Second Affirmative Defense). Again, Plaintiff’s stated
23 position is that “‘Economic Situation’ plainly is not a ‘substantial amount of the
24 material incorporated in’ *Go!*” Doc. 69 p. 18. That cannot be reconciled with any
25 claim that Defendants’ use of lesser amounts of graphic elements from other Dr.
26 Seuss books in *Boldly* rises to infringement. The Register’s construction of
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1 “substantial amount” under the Copyright Act of 1976, as to *Go!*, is likely to inform
2 the Court’s analysis of the substantiality of Defendants’ uses.

3 In short, this threshold issue will determine the scope of every substantive
4 issue left to resolve. The § 411 request must be fulfilled before any finding of
5 liability for infringement can be considered, and liability is logically precedent to
6 any claim for willful infringement, damages, or fees. Any damages award under the
7 Copyright Act would also hinge on first ascertaining the number of infringed works
8 with valid registrations at issue, because the Copyright Act provides that statutory
9 damages are assessed on a per-work basis. 17 U.S.C. § 504(c); *see Friedman v. Live*
10 *Nation Merch., Inc.*, 833 F.3d 1180, 1189-90 (9th Cir. 2016). While Plaintiff prayed
11 in the alternative for actual damages and Defendants’ profits, Doc. 39 pp. 27-28,
12 such relief is not viable because *Boldly* was never published. 17 U.S.C. § 504(b).
13 Doc. 149 p. 9.

14 Upon issuing the request to the Register of Copyrights, the Court should stay
15 all proceedings pending her response. Such a stay will likely be brief. The Register
16 typically responds to § 411(b) requests with dispatch, often within a month of
17 receipt. *See, e.g.*, Response of the Register of Copyrights, ECF No. 129-1 at 1 n. 1,
18 *Fashion Ave. Sweater Knits, LLC v. Poof Apparel Corp.*, No. 2:19-cv-06302-CJC-
19 JEM (C.D. Cal. filed Feb. 8, 2021), [https://www.copyright.gov/rulings-](https://www.copyright.gov/rulings-filings/411/fashion-avenue-sweater-knits-llc-v-poof-apparel-corp.pdf)
20 [filings/411/fashion-avenue-sweater-knits-llc-v-poof-apparel-corp.pdf](https://www.copyright.gov/rulings-filings/411/fashion-avenue-sweater-knits-llc-v-poof-apparel-corp.pdf) (responding
21 to request submitted via email on January 8, 2021). Because *Boldly* remains
22 unpublished, Plaintiff will not be injured or prejudiced by a brief stay, which should
23 facilitate a prompt resolution of the remaining issues.

24 Therefore, and for the reasons previously given by Defendants in the 411
25 Motion, Doc. 57-1, and their reply in support thereof, Doc. 74, Defendants
26 respectfully request that the Court:

- 1 1. Reconsider the 411 Order, Doc. 88, and grant the 411 Motion, Doc.
- 2 57-1, based on the intervening change in law effected by *Unicolors*;
- 3 2. Submit a request to the Register of Copyrights to advise the Court
- 4 whether the inaccurate information included in the applications for
- 5 *Go!* and *Sneetches*, if known, would have caused it to refuse
- 6 registration pursuant to 17 U.S.C. § 411(b)(2);² and
- 7 3. Stay the proceedings pending the Register’s response.

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April 9, 2021

Respectfully submitted,

/s/ Dan Booth

Dan Booth

DAN BOOTH LAW LLC

Michael Licari

THE LAW OFFICES OF MICHAEL LICARI

Attorneys for Defendants

CERTIFICATE OF SERVICE

I hereby certify that on this April 9, 2021 I electronically filed the foregoing document by using the Court’s ECF system, thereby causing a true copy thereof to be served upon counsel of record for Plaintiff Dr. Seuss Enterprises, L.P., as identified on the Notice of Electronic Filing.

/s/ Dan Booth

² “The request should be sent to the General Counsel of the Copyright Office via email to 411filings@copyright.gov.” 37 C.F.R. § 205.14; see Copyright Office, Email Rule for Statutory Litigation Notices, 85 Fed. Reg. 10,603, 10,605 (Feb. 25, 2020); ECF No. 129-1 at 1 n. 1, *Fashion Ave. Sweater Knits*, No. 2:19-cv-06302-CJC-JEM (C.D. Cal. filed Feb. 8, 2021).