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14 UNITED STATES DISTRICT COURT  
15 FOR THE CENTRAL DISTRICT OF CALIFORNIA  
16 WESTERN DIVISION

17 IMEX LEADER, INC. ET AL.,  
18 Plaintiffs,  
19 v.  
20 ZEST US WHOLESALE, INC.,  
21 ET AL.,,  
22 Defendants.

No. 22-cv-01432-FWS-JDE

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

Honorable Fred W. Slaughter  
United States District Judge

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1 PLEASE TAKE NOTICE that the United States Copyright Office, by and through  
2 undersigned counsel, hereby responds to the questions posed in the Court’s Request to  
3 the Register of Copyrights Pursuant to 17 U.S.C. Section 411(b)(2), dated September 20,  
4 2023 (ECF 84).

5 The Complaint in this action asserts claims for copyright infringement in  
6 numerous works of visual art appearing on candy and toys packaged in egg-shaped  
7 containers. (ECF 84). The Court, by its Request dated September 20, 2023, sought the  
8 views of the Register of Copyright pursuant to 17 U.S.C. §411(b)(2) as to whether the  
9 disclosure of copyrighted visual works included on specified applications as  
10 “unpublished” when those works were previously “published” as a factual matter would,  
11 if known to the Register, have caused the Register to refuse registration. Id.

12 The Response of the Register of Copyrights to the question posed by the Court is  
13 attached hereto as Exhibit A and filed herewith.

14 Dated: May 15, 2024

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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

IMEX LEADER, INC. ET AL.,  
Plaintiffs,  
vs.  
ZEST US WHOLESALE, INC. ET  
AL.,  
Defendants.

Case No. 22-cv-01432-FWS-JDE

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

On September 20, 2023, pursuant to 17 U.S.C. § 411(b)(2), the Court requested advice from the Register of Copyrights (the “Register”) on the following question:

Whether the disclosure of copyrighted visual works included on the applications for Copyright Registration No. VAu001405148, Copyright Registration No. VAu001405147, Copyright Registration No. VAu001406848 and Copyright Registration No.

1 VAu001405142 as “unpublished” when those works were  
2 previously “published” as a factual matter would, if known  
3 to the Register, have caused the Register to refuse  
4 registration.<sup>1</sup>

5 The Register hereby submits her response. Based on the legal standards and  
6 examining practices set forth below, the U.S. Copyright Office (“Copyright  
7 Office” or “Office”) would have refused to register the works as part of a group  
8 registration for unpublished works (“GRUW”), the registration option through  
9 which they were registered. Moreover, because these works were ineligible for  
10 registration as part of a GRUW, a supplementary registration could not correct this  
11 error.

## 12 **BACKGROUND**

### 13 **I. Examination History**

14 A review of the records of the Copyright Office reveals that on June 14,  
15 2020, the Office received four GRUW applications for a group of two-dimensional  
16 art works. The first application, titled “King Egg ‘Beauty’ and 9 Other  
17 Unpublished Works,” comprised ten illustrations. The application identified Irina  
18 Grant as the sole author of, and copyright claimant for, all ten illustrations. The  
19 application stated that the illustrations were completed in 2018 and that they were  
20 unpublished. Based on the representations that all ten illustrations were  
21 unpublished and created by the same author who is also named as the copyright  
22 claimant, the Office registered them as a group of unpublished works on  
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25 <sup>1</sup> Order Granting Defs.’ Mot. for Issuance of Req. to the Reg. of Copyrights  
26 Pursuant to 17 U.S.C. § 411(b)(2) at 10 (Sept. 20, 2023) (“Order”), ECF No. 84.

1 September 9, 2020, under registration number VAu001405142 with an effective  
2 date of registration (“EDR”)<sup>2</sup> of June 14, 2020.

3 The second application, titled “King Egg ‘Snoopy’ and 3 Other Unpublished  
4 Works,” comprised four illustrations. The application identified Irina Grant as the  
5 sole author of, and copyright claimant for, all four illustrations. The application  
6 stated that the illustrations were completed in 2018 and that they were unpublished.  
7 Based on the representations that all four illustrations were unpublished and  
8 created by the same author who is also named as the copyright claimant, the Office  
9 registered them as a group of unpublished works on September 9, 2020, under  
10 registration number VAu001405147 with an EDR of June 14, 2020.

11 The third application, titled “Magik Egg ‘Autumn’ and 9 Other Unpublished  
12 Works,” comprised ten illustrations. The application identified Irina Grant as the  
13 sole author of, and copyright claimant for, all ten illustrations. The application  
14 stated that the illustrations were completed in 2018 and that they were unpublished.  
15 Based on the representations that all ten illustrations were unpublished and created  
16 by the same author who is also named as the copyright claimant, the Office  
17 registered them as a group of unpublished works on September 9, 2020, under  
18 registration number VAu001405148 with an EDR of June 14, 2020.

19 Finally, the fourth application, titled “Skazka Egg ‘Pinokio’ and 8 Other  
20 Unpublished Works,” comprised nine illustrations. The application identified Irina  
21 Grant as the sole author of, and copyright claimant for, all nine illustrations. The  
22 application stated that the illustrations were completed in 2019 and that they were  
23 unpublished. Based on the representations that all nine illustrations were  
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25 <sup>2</sup> The EDR is the date that the Office received a completed application, the  
26 correct deposit copy, and the proper filing fee. 17 U.S.C. § 410(d).

1 unpublished and created by the same author who is also named as the copyright  
2 claimant, the Office registered them as a group of unpublished works on  
3 September 25, 2020, under registration number VAu001406848 with an EDR of  
4 June 14, 2020.

5 The Office had no reason to question the representations in any of the  
6 applications and accepted them as true and accurate.

## 7 **II. The Court’s Request**

8 In this case, Plaintiffs Imex Leader, Inc. and Irina Grant (collectively,  
9 “Plaintiffs”) allege that Defendants Zest US Wholesale, Inc., Zest US, Adil Al  
10 Hourani, Omar Al Hourani, KGR Distribution Corp., Ravi Kommi, and Shims  
11 Bargain, Inc. d/b/a JC Sales (collectively, “Defendants”) infringed their copyrights  
12 in illustrations registered under numbers VAu001405148, VAu001405147,  
13 VAu001406848, and VAu001405142 (collectively, the “Registrations”).<sup>3</sup>  
14 Defendants challenged the validity of the Registrations, arguing that Grant  
15 knowingly provided materially false information to the Office by registering the  
16 illustrations using GRUW applications, even though they had previously been  
17 published.<sup>4</sup>

18 Registration (or a refusal to register) is a prerequisite for bringing an  
19 infringement action involving a U.S. work and for the availability of certain  
20 remedies under the Copyright Act.<sup>5</sup> Pursuant to section 411(b)(1) of the Act, even

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22 <sup>3</sup> Order at 1 (citing Second Am. Compl. ¶¶ 2, 16–17, 30–34 (May 19, 2023), ECF  
No. 58).

23 <sup>4</sup> Defs.’ Notice of Mot. and Mot. for Issuance of Req. to Reg. of Copyrights  
24 Pursuant to 17 U.S.C. § 411(b)(2) at 3–8 (July 6, 2023), ECF No. 63.

25 <sup>5</sup> 17 U.S.C. § 411 (“[N]o civil action for infringement of the copyright in any  
26 United States work shall be instituted until preregistration or registration of the  
copyright claim has been made.”); *id.* § 412 (discussing available damages).

1 a certificate of registration that includes inaccurate information satisfies this  
2 requirement unless:

3 (A) the inaccurate information was included on the  
4 application for copyright registration with knowledge that  
5 it was inaccurate; and

6 (B) the inaccuracy of the information, if known, would  
7 have caused the Register of Copyrights to refuse  
8 registration.<sup>6</sup>

9 Defendants filed a motion with the Court, arguing that Grant included inaccurate  
10 information on the registration applications with knowledge that it was inaccurate.<sup>7</sup>

11 Defendants further asked the Court to request that the Register advise it as to  
12 whether the inaccurate information, if known, would have caused the Register to  
13 refuse registration.<sup>8</sup> Section 411(b)(2) requires courts to seek such guidance in  
14 “any case in which inaccurate information described [in § 411(b)(1)] is alleged.”<sup>9</sup>

15 On September 20, 2023, the Court granted Defendants’ motion. The Court  
16 concluded that “the record supports a finding [that Grant] was willfully blind in  
17 failing to disclose the copyrighted works in Registration Nos. VAu001405148,  
18 VAu001405147, VAu001406848, and VAu001405142 were previously

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21 <sup>6</sup> 17 U.S.C § 411(b)(1).

22 <sup>7</sup> Defs.’ Notice of Mot. and Mot. for Issuance of Req. to Reg. of Copyrights  
Pursuant to 17 U.S.C. § 411(b)(2) at 3–8.

23 <sup>8</sup> 17 U.S.C. § 411(b)(2).

24 <sup>9</sup> *Id.* (“[T]he court shall request the Register of Copyrights to advise the court  
25 whether the inaccurate information, if known, would have caused the Register of  
26 Copyrights to refuse registration”). Although permissible, a motion by a party is  
not required.

1 published.”<sup>10</sup> Specifically, the Court found that Grant had previously registered  
2 published works without any confusion and that, even if she did fail to understand  
3 the meaning of “published,” she did not avail herself of the resources provided by  
4 the Copyright Office.<sup>11</sup>

5 Finding that the conditions set forth in 17 U.S.C. § 411(b)(2) had been met,  
6 the Court also granted Defendants’ motion to refer the above question to the  
7 Register to consider whether the inaccuracies identified in the applications would  
8 have caused the Register to refuse registration.<sup>12</sup>

### 9 ANALYSIS

#### 10 **I. Relevant Statutes, Regulations, and Agency Practices**

11 An application for copyright registration must comply with the requirements  
12 of the Copyright Act set forth in 17 U.S.C. §§ 408(a), 408(d), 409, and 410.  
13 Regulations governing applications for registration are codified at 37 C.F.R.  
14 §§ 202.1 to 202.24. Further, principles that govern how the Office examines  
15 registration applications are set out in the *Compendium of U.S. Copyright Office*  
16 *Practices*, an administrative manual that instructs agency staff regarding their  
17 statutory and regulatory duties and provides expert guidance to copyright  
18 applicants, practitioners, scholars, courts, and members of the general public  
19 regarding Office practices and related principles of law. The Office publishes  
20 periodic revisions to the *Compendium* to provide additional guidance where  
21 necessary and to reflect changes in the law or Office practices; these revisions are  
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23 <sup>10</sup> Order at 6, 9.

24 <sup>11</sup> *Id.* at 6–8. Due to an apparent oversight, neither the Order nor a separate request  
25 was transmitted to the Office when the Order issued. The Office first received  
notification of the Order on February 6, 2024.

26 <sup>12</sup> *Id.* at 10.



1 made available for public comment prior to finalization. Because Grant filed her  
2 registration applications in 2020, the governing principles the Office would have  
3 applied to evaluate the applications are set forth in the version of the third edition  
4 of the *Compendium* (“COMPENDIUM (THIRD)”) that was released in September  
5 2017.<sup>13</sup> In 2021, the Office published a revised version of the COMPENDIUM  
6 (THIRD); any supplementary registration application filed today would be subject to  
7 the practices set forth in this current edition.<sup>14</sup>

8 **A. Publication**

9 The statutory provisions governing copyright registration dictate that “if the  
10 work has been published,” an application for registration shall include “the date  
11 and nation of its first publication.”<sup>15</sup> The Copyright Act defines “publication” as:

12 [T]he distribution of copies or phonorecords of a work to  
13 the public by sale or other transfer of ownership, or by  
14 rental, lease, or lending. The offering to distribute copies  
15 or phonorecords to a group of persons for purposes of  
16 further distribution, public performance, or public display,  
17 constitutes publication. A public performance or display  
18 of a work does not of itself constitute publication.<sup>16</sup>

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21 <sup>13</sup> U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES  
22 (3d ed. 2017) (“2017 COMPENDIUM (THIRD)”), <https://www.copyright.gov/comp3/2017version/docs/compendium.pdf>.

23 <sup>14</sup> U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES  
24 (3d ed. 2021) (“2021 COMPENDIUM (THIRD)”), <https://copyright.gov/comp3/docs/compendium.pdf>.

25 <sup>15</sup> 17 U.S.C. § 409(8).

26 <sup>16</sup> *Id.* § 101 (defining “publication”).

1 The COMPENDIUM (THIRD) explains that “publication occurs when one or  
2 more copies or phonorecords are distributed to a member of the public who is not  
3 subject to any express or implied restrictions concerning the disclosure of the  
4 content of that work.”<sup>17</sup> For example, “[s]elling a product with copyrightable  
5 artwork on the packaging and label constitutes publication of that artwork.”<sup>18</sup>  
6 Likewise “[l]ending, renting, or leasing copies of a work constitutes publication of  
7 that work.”<sup>19</sup>

8 But distribution is not always required. The mere “offering” of copies of a  
9 work to “a group of persons” for “further distribution, public performance, or  
10 public display” constitutes publication, even if distribution has not occurred.<sup>20</sup> For  
11 example, the COMPENDIUM (THIRD) explains that “[p]ublication occurs when  
12 copies of a photograph are offered to stock photography agencies for the purpose  
13 of licensing those copies to newspapers, magazines, and websites.”<sup>21</sup>

14 ***B. Registration Requirements for a GRUW***

15 The Copyright Act authorizes the Register of Copyrights to issue regulations  
16 permitting “a single registration for a group of related works.”<sup>22</sup> On March 15,

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18 <sup>17</sup> 2017 COMPENDIUM (THIRD) § 1905.1.

19 <sup>18</sup> *Id.*

20 <sup>19</sup> *Id.* The current version of COMPENDIUM (THIRD) adds that “[t]ransmitting a copy  
21 of an illustration to a client constitutes publication of that work, if the copyright  
22 owner authorized the client to use that image and did not impose any restrictions  
23 on the client’s ability to disclose that work to the public.” 2021 COMPENDIUM  
(THIRD) § 1905.1.

24 <sup>20</sup> 2017 COMPENDIUM (THIRD) § 1906.1.

25 <sup>21</sup> *Id.* The current version of COMPENDIUM (THIRD) adds that “[p]ublication occurs  
26 when copies of a photograph are offered to clients . . . with a license permitting  
further distribution or display of the photograph.” 2021 COMPENDIUM (THIRD)  
§ 1906.1.

<sup>22</sup> 17 U.S.C. § 408(c)(1).

1 2019, the Office issued a regulation providing that “a group of unpublished works  
2 may be registered . . . with one application.”<sup>23</sup> Among other requirements, 37  
3 C.F.R. § 202.4(c) states that “[a]ll the works in the group must be unpublished,”  
4 that “the applicant may include up to ten works in the group,” that “[t]he applicant  
5 must provide a title for each work in the group,” and that “[a]ll the works must be  
6 created by the same author or the same joint authors, and the author and claimant  
7 information for each work must be the same.”<sup>24</sup> To register a work using the  
8 GRUW application, the applicant must (1) complete the online application, (2) pay  
9 the filing fee, and (3) upload a complete copy of each work in a separate electronic  
10 file.<sup>25</sup> The regulations do not provide an option for group registration of published  
11 visual arts works other than photographs.<sup>26</sup>

### 12 **C. The Role of Supplementary Registration**

13 The Office recognizes that there may be a need for a registrant to  
14 correct certain errors or provide additional information after the Office has  
15 issued a registration. It therefore permits registrants to file an application for  
16 a supplementary registration to correct certain errors or amplify the  
17 information provided in the original registration.<sup>27</sup> The availability of a  
18 supplementary registration to correct errors is limited, however. According  
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21 <sup>23</sup> *Group Registration of Unpublished Works*, 84 Fed. Reg. 3693 (Feb. 13, 2019)  
(codified at 37 C.F.R. § 202.4(c)).

22 <sup>24</sup> 37 C.F.R. § 202.4(c)(1), (2), (4), (5).

23 <sup>25</sup> *Id.* § 202.4(c), (c)(8)–(9).

24 <sup>26</sup> *See generally id.* § 202.4. The Office recently published a notice of proposed  
25 rulemaking to create a group option for registering published two-dimensional  
26 artwork. *See Group Registration of Two-Dimensional Artwork*, 89 Fed. Reg.  
11789 (Feb. 15, 2024). No final regulation has been issued.

<sup>27</sup> 17 U.S.C. § 408(d); 37 C.F.R. § 202.6; 2021 COMPENDIUM (THIRD) § 1802.

1 to the COMPENDIUM (THIRD), “[w]hen the Office registers multiple works  
2 under a registration accommodation,” such as a group registration, “it will  
3 not accept an application that seeks to reclassify the works under a different  
4 accommodation.”<sup>28</sup> Accordingly, the COMPENDIUM (THIRD) specifies that a  
5 supplementary registration cannot be “used to transform a registration for an  
6 unpublished collection or a group of unpublished works into a registration  
7 for a single published work.”<sup>29</sup> Such a change “would alter the fundamental  
8 nature of the claim, and would undermine the legal presumptions afforded to  
9 the initial examination of the works.”<sup>30</sup> Moreover, these types of changes  
10 “would be inconsistent with the statutory and regulatory provisions stating  
11 that a supplementary registration augments—but does not supersede—the  
12 basic registration.”<sup>31</sup>

13 **REGISTER’S RESPONSE TO THE COURT**

14 Based on the foregoing statutory and regulatory standards and the Office’s  
15 examining practices, the Register responds to the Court’s question as follows:

16 If the Office knew that the visual works included in the four GRUW  
17 applications had been previously published, it would not have issued the  
18 Registrations.<sup>32</sup> As explained above, one of the requirements for using the GRUW  
19 application is that “[a]ll the works in the group must be unpublished.”<sup>33</sup> In court  
20 filings, Defendants asked Plaintiffs to provide “‘the date, if any’ the 33 works  
21

22 <sup>28</sup> 2021 COMPENDIUM (THIRD) § 1802.4.

23 <sup>29</sup> *Id.*

24 <sup>30</sup> *Id.*

25 <sup>31</sup> *Id.* (citing 17 U.S.C. § 408(d); 37 C.F.R. § 202.6(f)(2)).

26 <sup>32</sup> The Office accepts the Court’s findings as stated in the Order and makes no  
determination about whether the distribution in fact amounted to a publication.

<sup>33</sup> 37 C.F.R. § 202.4(c)(1).


1 underlying Registration Nos. VAu001405148, VAu001405147, VAu001406848,  
2 and VAu001405142 ‘were first distributed to the public.’”<sup>34</sup> In response, Plaintiffs  
3 listed January 4, 2017, April 1, 2017, and January 7, 2019, as the applicable  
4 dates.<sup>35</sup> If the registration specialist knew that such distributions amounted to  
5 “publication[s]” under the Copyright Act, he or she would have refused  
6 registration and advised Grant to register each published work separately.<sup>36</sup>

7 Moreover, a supplementary registration could not correct this deficiency.<sup>37</sup>  
8 As noted above, the Office will not accept an application that seeks to transform a  
9 registration for “a group of unpublished works into a registration for a single  
10 published work.”<sup>38</sup>

11 **CONCLUSION**

12 After review of the available facts in this action and application of the  
13 relevant law, regulations, and the Office’s practices, the Register hereby advises  
14 the Court that had the Office been aware that the visual works included in the  
15 applications were previously published, it would not have issued the Registrations.  
16 Moreover, the Office would not accept a supplementary registration filed by  
17 Plaintiffs to correct the error.

18  
19 Dated: May 13, 2024

  
20 **Shira Perlmutter**  
21 Register of Copyrights and Director  
22 of the U.S. Copyright Office

23 <sup>34</sup> Order at 4 (quoting Pls.’ Objs. and Resps. to Defs.’ Second Set of Interrogs. at  
6–8 (July 6, 2023), ECF No. 64-1).

24 <sup>35</sup> *Id.* (quoting Pls.’ Objs. and Resps. to Defs.’ Second Set of Interrogs. at 6–8).

25 <sup>36</sup> *See* 2017 COMPENDIUM (THIRD) § 1104.3.

26 <sup>37</sup> 2021 COMPENDIUM (THIRD) § 1802.4.

<sup>38</sup> *Id.*