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6 **IN THE UNITED STATES DISTRICT COURT**  
7 **FOR THE DISTRICT OF ARIZONA**  
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9 SellPoolSuppliesOnline.com LLC,

10 Plaintiff,

11 v.

12 Ugly Pools Arizona Inc., et al.,

13 Defendants.  
14

No. CV-15-01856-PHX-BSB

**ORDER**

15 Plaintiff SellPoolSuppliesOnline.com LLC (“Plaintiff” or “SPSO”) and  
16 Defendants Ugly Pools Arizona, Inc. and Brian Morris (“Defendants”) have filed second  
17 cross-motions for summary judgment on Count One of the First Amended Complaint  
18 (“FAC”), in which Plaintiff asserted a claim for copyright infringement under the United  
19 States Copyright Act, 17 U.S.C. § 501(a) (the “Copyright Act”). (Docs. 78, 79.) For the  
20 reasons below, the Court grants Defendants’ motion and denies Plaintiff’s motion.

21 **I. Factual and Procedural Background**

22 Plaintiff asserted the following three counts in the FAC: (1) copyright  
23 infringement under the Copyright Act, 17 U.S.C. § 501(a) (Count One); (2) unfair  
24 competition under Arizona law (Count Two); and (3) violation of the Digital Millennium  
25 Copyright Act, integrity of copyright management information under 17 U.S.C. § 1202  
26 (Count Three). (Doc. 39.) The parties previously filed cross-motions for summary  
27 judgment on all three counts of the FAC, including Count One. (Docs. 43, 45.) On June  
28 9, 2017, the Court denied both motions for summary judgment on Count One without

1 prejudice.<sup>1</sup> (Doc. 64 at 42.) The Court granted summary judgment in favor of  
2 Defendants on Count Two. (*Id.*) The Court granted summary judgment in favor of  
3 Defendants on Plaintiff’s removal claim under 17 U.S.C. § 1202(b), asserted in Count  
4 Three. (Doc. 64 at 42.) The Court denied both motions for summary judgment on  
5 Plaintiff’s falsification claim under 17 U.S.C. § 1202(a), asserted in Count Three. (*Id.*)  
6 This order addresses only the parties’ second cross-motions for summary judgment on  
7 Count One. In a separate order the Court addresses Defendants’ third motion for  
8 summary judgment on Plaintiff’s falsification claim, asserted in Count Three. (Doc. 86.)

9 **A. General Background Regarding the Copyright Dispute**

10 Plaintiff describes its business as licensing pre-made websites that it refers to as  
11 “the Platform.” (Doc. 78-1 ¶ 1.)<sup>2</sup> Plaintiff alleges that the Platform consists of “a  
12 compilation of programs, representations, originally authored works, writings, hundreds  
13 of photos taken by the principals of SPSO, and computer architecture and design, which  
14 provide SPSO licensees the infrastructure to configure, implement, and maintain fully  
15 functional and attractive websites based on the Platform that are personalized to each  
16 customer’s business.” (*Id.*, ¶ 2.) As delivered to customers, the Platform incorporates  
17 and effectively uses search engine optimization (“SEO”) and provides “drop-ship”  
18 delivery that dispenses with the need for customers to maintain inventory. (*Id.*) Plaintiff  
19 alleges that it spent three years and “hundreds of thousands of dollars developing the  
20 Platform.” (*Id.*, ¶ 3.) However, Plaintiff has admitted that “much of the website code” is  
21 licensed from BigCommerce, a non-party entity that provides “backend electronic  
22 storefront” services. (Doc. 53, Ex. Q.)

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25 <sup>1</sup> Defendants also filed a motion for an order directing Plaintiff to cancel or  
26 amend its copyright registration. (Doc. 53.) The Court denied that motion, but  
considered Defendants’ arguments in its analysis of the parties’ first cross-motions for  
summary judgment on Count One. (Doc. 64 at 9, 13-14.)

27 <sup>2</sup> Docket 78-1 is Plaintiff’s Separate Statement of Facts in Support of Plaintiff’s  
28 Second Motion for Summary Judgment. Plaintiff cites to this document as “SSOF.”  
(Doc. 78.) Because there are multiple motions for summary judgment in this case, the  
Court cites to the CM/ECF docket and page numbers to avoid confusion.

1           In July 2014, SPSO employed Mark Kesler as a salesperson to sell licenses to use  
2 the Platform; the licenses sold for an average of \$15,000. (Doc. 78-1 ¶¶ 5, 6.) Plaintiff  
3 alleges that it charged monthly maintenance fees and required licensees to host their  
4 websites on SPSO’s servers. (*Id.*, ¶ 7.) Plaintiff paid Kesler a commission for each  
5 license he sold, and Kesler purchased a license for use on his own site,  
6 “allpoolandspaparts.com” (“Kesler’s site”). (*Id.*, ¶ 8.)

7           During 2014, Kesler introduced Defendant Brian Morris, owner of Defendant  
8 Ugly Pools Arizona, Inc., and the trade name “We Fix Ugly Pools” (“WFUP”), to  
9 Plaintiff as a potential licensee. (*Id.*, ¶ 13.) Defendants build and remodel swimming  
10 pools, and sell pool supplies and accessories in Maricopa County, Arizona and  
11 surrounding areas. (*Id.*, ¶ 14.) Defendants represented themselves to Plaintiff as  
12 prospective customers who were considering purchasing a license of SPSO’s Platform to  
13 create a website for their business. (*Id.*, 15.)

14           Plaintiff provided Defendants access to Kesler’s copy of the Platform to assist  
15 them in making a purchasing decision. (*Id.*, ¶ 16.) Plaintiff alleges that “Defendants  
16 were aware that they would have to purchase a license to be authorized to have further  
17 access to the Platform—that is, to use it commercially—and that the SPSO license  
18 governed the nature of their use of the Platform.” (*Id.*) Unbeknownst to Plaintiff,  
19 Defendants and Kesler were working together and had formed a partnership for Morris to  
20 manage and redesign Kesler’s site. (*Id.*, ¶ 18, Ex. 2 at 37.) Plaintiff alleges that  
21 Defendants downloaded “a complete copy of SPSO’s Platform.” (*Id.*, ¶ 20.) Plaintiff  
22 alleges that after the download, Defendants stopped communicating with Plaintiff. (*Id.*)

23           Plaintiff alleges that nearly one year later, Defendants published a website located  
24 at allpoolsupplies.com (“APS”), which was nearly identical to the Platform. (*Id.*, ¶ 22.)  
25 Plaintiff asserts that Defendants admitted to copying the Platform and creating APS, a  
26 derivative site. (*Id.*) The site was “launched live on the internet as a fully functioning  
27 site through which customers could, and did place orders.” (*Id.*, ¶ 24.) Plaintiff alleges  
28 that Defendants’ site “wholly incorporated the original photos which are registered with

1 the U.S. Copyright Office under Registration Number TX 8-268-803 (“Registered  
2 Photos”) and other content from the Platform into APS.” (*Id.*, ¶¶ 28-29). Plaintiff alleges  
3 that Kesler’s license was granted specifically for use on his site located at  
4 “allpoolandspaparts.com” and that the license strictly limited use of the Platform to that  
5 site. (*Id.*, ¶¶ 9, 30.) Plaintiff discovered Defendants’ allegedly infringing website on July  
6 15, 2015 and notified Defendants of the alleged infringement that same day. (*Id.*, ¶ 35.)

7 **B. Background related to Plaintiff’s Copyright Registration**

8 On September 13, 2015, four days before filings its original complaint, Plaintiff  
9 filed a copyright registration application with the copyright office for a work titled  
10 “SPSO Website www.poolandspapartsnow.com” (the “Work”).<sup>3</sup> (Doc. 53, Ex. A.) The  
11 registration application identified the Work’s year of completion as 2015, and the date of  
12 first publication as August 26, 2015. (*Id.*) The application identified the copyright claim  
13 in the Work as including “new material” identified as “text, photograph(s), computer  
14 program” and excluding “text, photograph(s), computer program, artwork.” (Doc. 50,  
15 Ex. 9; Doc. 80 ¶ 31.)<sup>4</sup>

16 On September 20, 2016, the copyright office contacted Plaintiff’s counsel  
17 regarding “problems” with information in the application related to the identity of the  
18 original copyright owner. (Doc. 53, Ex. E; Doc. 53-5 at 2.) Plaintiff responded that  
19 SPSO was the owner of the text, photographs, and computer programs claimed in the  
20 application. (Doc. 53, Ex. E; Doc. 53-5 at 3-5.)

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23 <sup>3</sup> “To register a claim to copyright, an applicant must submit the following items  
24 to the U.S. Copyright Office: [1] Completed application; [2] Full filing fee; and [3] The  
25 requisite deposit copy(ies) of the work.” *Compendium of U.S. Copyright Office Practices*  
§ 204 (3d ed. 2017) (cited as COMPENDIUM (THIRD).) The “deposit . . . refers to the copy  
or copies of a work that are submitted to the U.S. Copyright Office.” *Id.* at § 204.3.

26 The COMPENDIUM (THIRD) is an “administrative manual” that “explains many of  
27 the practices and procedures concerning the [Copyright] Office’s mandate and statutory  
28 duties under title 17 of the United States Code.” (Doc. 72-1 at 3 (quoting 37 C.F.R.  
§ 201.2(b)(7)).)

<sup>4</sup> Docket 80 is Defendants’ Separate Statement of Facts in Support of their Second  
Motion for Summary Judgment. (Docs. 80, 80-1, 80-2, 80-3.)

1           On October 6, 2016, the copyright office again contacted Plaintiff and asked  
2 “[s]ince this application is to register the website as it appeared (published) on 8/26/2015,  
3 was any of the computer code or were any of the photographs from an earlier version of  
4 the website?” (Doc. 53, Ex. F; Doc. 80 ¶ 33.) The copyright office explained that any  
5 photographs or code that appeared in earlier website versions “must be excluded from  
6 this claim since the extent of claim for a revised, or derivative, work is based only on the  
7 new and revised material contained in the later version of the work.” (Doc. 53, Ex. F.)  
8 Plaintiff’s counsel responded that some of the deposit’s content “may have been from an  
9 earlier version of the website BUT we need special dispensation because this is the first  
10 time registration of the website and no copy (i.e., mirror or backup) of the prior website  
11 exists.” (Doc. 53, Ex. H; Doc. 80 ¶ 34.)

12           On October 14, 2016, the copyright office denied the requested exception.  
13 (Doc. 53, Ex. I; Doc. 80 ¶ 35.) The copyright office explained that “[w]e can only  
14 register the website as it appeared on the date on which it was printed, not for any past or  
15 future versions.” (Doc. 53, Ex. I; Doc. 80 ¶ 35.) The copyright office also stated “if any  
16 of the content of the website ever appeared online or in any other form previous to the  
17 version submitted, please authorize me to exclude all of the preexisting material and to  
18 limit the claim to the new and revised material in this version of the website.” (Doc. 53,  
19 Ex. I; Doc. 80 ¶ 35.) In response, Plaintiff’s counsel inquired “[o]n what grounds is  
20 special dispensation denied? Websites aren’t copyrighted usually until they are mature.  
21 Therefore, this policy excludes almost every conceivable website that is nontrivial from  
22 being copyrighted.” (Doc. 53, Ex. J; Doc. 80 ¶ 36.)

23           On November 16, 2016, before the copyright office responded to Plaintiff’s  
24 inquiry about the denial of its request for a special dispensation, Plaintiff submitted to the  
25 copyright office an affidavit from one of its principals, Aaron Hagen. (Doc. 53, Exs. K,  
26 L; Doc. 80 ¶ 38; Doc. 72, Ex. A at 4.) The Hagen affidavit stated that “SPSO first  
27 published the Platform on or about July 3, 2014. It was completed on or about June 25,  
28 2014.” (Doc. 53, Ex. K at ¶ 4; Doc. 80 ¶ 38.) The Hagen affidavit further stated that

1 “[t]he sample of the Platform provided to the United States Copyright Office with  
2 SPSO’s Copyright application in 2015 is the same as the website first appeared when  
3 published on July 3, 2014.” (Doc. 53, Ex. K at ¶ 5; Doc. 80 ¶ 39.) In an accompanying  
4 email, Plaintiff’s counsel confirmed that “[t]he Deposit that was submitted correctly  
5 represents the copy that was first published on July 3, 2014. Counsel did not have  
6 sufficient facts at the time of application.” (Doc. 53, Ex. L; Doc. 80 ¶ 40.)

7 On November 17, 2016, a supervisor at the copyright office contacted Plaintiff’s  
8 counsel, stating “[t]he signed affidavit that you provided states that the website was  
9 completed on June 25, 2014 and published on July 3, 2014. The original application lists  
10 the Year of Completion as 2015 and the date of first publication as August 36 [sic], 2015.  
11 Please confirm that we should update the information on your original application with  
12 that which is provided in the [affidavit]. Please do note that the copyright notice on the  
13 bottom of each webpage submitted as deposit material bears the year 2015.” (Doc. 53,  
14 Ex. Q at 1-2; Doc. 80 ¶ 41.) Plaintiff’s counsel responded, “[y]es the information should  
15 be updated as per the affidavit.” (Doc. 53, Ex. Q at 2; Doc. 80 ¶ 41.)

16 On November 17, 2016, Plaintiff also informed the copyright office that its  
17 copyright claim was for “the photographs and computer code related to the photographs  
18 that enabled the latter to present a 360 degree view of the product to a prospective  
19 customer. The Hagens also provided text descriptions of the products. That is the extent  
20 of the claim.” (Doc. 53, Ex. Q; Doc. 80 ¶ 42.) Plaintiff explained that “[m]uch of the  
21 website code is licensed from a third party (i.e. BigCommerce) and SPSO obviously  
22 makes no claims with respect to that.” (Doc. 53, Ex. Q; Doc. 80 ¶ 42.) A few days later,  
23 Plaintiff advised the copyright office that it was “no longer interested in registering the  
24 code . . . .” (Doc. 53, Ex. CC; Doc. 80 ¶ 43.) Plaintiff specified that it was “interested in  
25 registering the website as is with the current deposit and the modifications to the  
26 application already agreed to.” (Doc. 53, Ex. CC; Doc. 80 ¶ 43.)

27 On November 29, 2016, the copyright office issued a certificate of registration.  
28 (Doc. 50, Ex. 1; Doc. 80 ¶ 44.) The certificate of registration identifies the year of

1 completion as 2014, the date of first publication as July 3, 2014, and the authors of the  
2 text and photographs as Aaron Hagen and David Hagen. (Doc. 50, Ex. 1.) It identifies  
3 the title of the Work as the SPSO Website www.poolandspapartsnow.com. (*Id.*) Under  
4 the heading “limitation of copyright claim,” the certificate of registration lists “new  
5 material included in the claim” as “text, photographs.” (*Id.*)

6 **C. The Court’s Inquiry to the Copyright Office**

7 In their first cross-motions for summary judgment on Count One of the FAC, the  
8 parties disputed whether Plaintiff had properly registered its copyright and met the  
9 registration precondition for filing a copyright infringement suit. (Doc. 45 at 7; Doc. 49  
10 at 2; Doc. 64 at 12-13; *see also* 17 U.S.C. § 411(a) (“no action for infringement of the  
11 copyright in any United States work may be instituted until registration of the copyright  
12 has been made in accordance with this title.”).) The Court found that Plaintiff’s  
13 copyright registration was effective September 16, 2015, one day before Plaintiff filed its  
14 original complaint on September 17, 2015. (Doc. 64 at 12-13.)

15 Defendants, however, argued that Plaintiff knowingly provided false information  
16 to the copyright office about the date of first publication and the contents of the deposit  
17 that it submitted to the copyright office. (*Id.* at 13; Doc. 53 at 2) Therefore, the Court  
18 also considered whether the registration should be considered invalid under 17 U.S.C.  
19 § 411(b). (Doc. 64 at 14-25.) The Court concluded that it was undisputed that the  
20 deposit did not match Plaintiff’s copyright claim and that Plaintiff knew of the  
21 discrepancies, but nonetheless represented to the copyright office in the Hagen affidavit  
22 that the deposit (defined as the sample of the Platform provided to the copyright office in  
23 September 2015), was the same as the website appeared on July 3, 2014. (*Id.* at 18, 24.)  
24 The Court found that the statutory criteria for mandatory referral to the copyright office  
25 had been satisfied because the deposit did not match the material claimed in the  
26 application and Plaintiff did not argue that it unknowingly provided false information, but  
27 instead argued that the inclusion of additional material in the deposit was immaterial. The  
28 Court stated that:

1 It is undisputed that the [d]eposit material did not match the material  
2 claimed in [Plaintiff's] copyright application. The application was to  
3 register content (photographs and text) on the website as of the date of  
4 publication specified during the registration process, July 3, 2014, but  
5 Plaintiff deposited the content that appeared on the website on a later date.  
6 Plaintiff, however, represented to the copyright office that the [d]eposit was  
7 the same as the website appeared on July 3, 2014. Plaintiff does not argue  
8 that it unknowingly provided false information to the copyright office.  
9 Instead, Plaintiff argues that its inclusion of additional material in the  
10 [d]eposit is "of no moment."

11 (*Id.* at 24.) Although Plaintiff argued that the inaccuracies in the information it presented  
12 to the copyright officer were "of no moment," or in other words, immaterial, the Court  
13 found that the statutory referral procedures of 17 U.S.C. § 411(b)(2) applied and required  
14 the Court to ask the Register of Copyrights if it considered the inaccurate information  
15 material to its decision to register the copyright. (*Id.* at 24-25.)

16 Therefore, on June 27, 2017, the Court sent a request for the advice of the Register  
17 of Copyrights on the following question:

18 1. If the Register of Copyrights had known that the Deposit underlying  
19 Registration Number TX 8-268-803 does not depict the content that existed  
20 on the SPSO website www.poolandspaparts.now on July 3, 2014, which is  
21 the date of publication identified on the certificate of registration, but  
22 instead depicts a version of the website that includes copyrightable content  
23 that was added to the website at a later date, would the Register of  
24 Copyrights have refused to issue a registration with a July 3, 2014  
25 publication date?

26 (Doc. 67.)

27 On September 5, 2017, the Register of Copyrights responded to the Court's  
28 inquiry and stated that it would have refused registration of Plaintiff's copyright with a  
29 July 3, 2014 publication date had it known that the submitted website included  
30 copyrightable content that was added after July 3, 2014.<sup>5</sup> (Doc. 72-1 at 8.) The Register

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31 <sup>5</sup> The Register assumed, based on the Court's question, that the content added to  
32 the website after July 3, 2014 was copyrightable. (Doc. 72-1 at 8, n.43; Doc. 67.)  
33 Plaintiff moved for reconsideration of the Court's question to the Register, but did not  
34 object to the reference to "copyrightable content." (Doc. 68.) The Register's assumption  
35 is correct because the content added to the website after July 3, 2014 included  
36 photographs, which Plaintiff admits are copyrightable. (Doc. 80 ¶¶ 5, 6, 20; Doc. 82  
37 ¶¶ 5, 6, 20.<sup>5</sup>) Furthermore, Plaintiff admits that the website submitted to the copyright  
38 office includes additional copyrightable content added after July 3, 2014. (Doc. 80 ¶ 18;  
39 Doc. 82 ¶ 18.)



1 of Copyrights further stated that it “would have demanded a copy of the deposit as  
2 published on July 3, 2014 . . . .”<sup>6</sup> (*Id.*) The Register of Copyrights stated that,  
3 alternatively, it would have “asked Plaintiff to limit its claim to material published on  
4 August 26, 2015, and to revert back to the 2015 year of completion, and the August 26,  
5 2015 date of publication, for the original application.” (*Id.*) If Plaintiff had “refused to  
6 limit the claim and revert back to the August 26, 2015 date of first publication and 2015  
7 year of completion, the Acting Register would have refused registration.”<sup>7</sup> (*Id.*)

8 After receiving the Register of Copyrights’ response, the Court permitted the  
9 parties to file second motions for summary judgment on Plaintiff’s copyright  
10 infringement claim asserted in Count One of the FAC. (Doc. 73.) The Court directed the  
11 parties to address how the Register of Copyrights’ response to the Court’s inquiry  
12 affected Plaintiff’s copyright claim, including whether Plaintiff satisfied the registration  
13 precondition for bringing a civil action for copyright infringement. (*Id.* at 2.)

## 14 **II. Summary Judgment Standard**

15 A party seeking summary judgment “bears the initial responsibility of informing  
16 the district court of the basis for its motion, and identifying those portions of [the record]  
17 which it believes demonstrate the absence of a genuine issue of material fact.” *Celotex*  
18 *Corp. v. Catrett*, 477 U.S. 317, 323 (1986). Summary judgment is appropriate if the  
19 evidence, viewed in the light most favorable to the nonmoving party, shows “that there is  
20 no genuine dispute as to any material fact and that the movant is entitled to judgment as a  
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22 <sup>6</sup> Plaintiff’s prior correspondence with the copyright office indicated that it did  
23 not have a copy of the website as it existed in July 2014. (*See* Doc. 53, Ex. H (October 6,  
24 2016 email to the copyright office from Plaintiff’s counsel stating that some of the  
25 Deposit’s content “may have been from an earlier version of the website BUT we need  
26 special dispensation because this is the first time registration of the website and no copy  
(i.e., mirror or backup) of the prior website exists.”).) Based on this evidence, Plaintiff  
would have been unable to “provide a copy of the work as published on July 3, 2014.”  
(Doc. 72-1 at 8.) Therefore, the Court concludes that the Register of Copyrights would  
have refused registration with the July 3, 2014 publication date.

27 <sup>7</sup> If Plaintiff had limited its claim to material published on August 26, 2015, a  
28 certificate of registration based on that date could not support Plaintiff’s copyright  
infringement claim that is based on an alleged infringement that occurred in 2014. (*See*  
Doc. 79 at 13-14.)

1 matter of law.” Fed. R. Civ. P. 56(a). Only disputes over facts that might affect the  
2 outcome of the suit will preclude the entry of summary judgment, and the disputed  
3 evidence must be “such that a reasonable jury could return a verdict for the nonmoving  
4 party.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

5 The nonmoving party may not rely on the mere allegations in the pleadings, but  
6 must set forth by affidavit, or other appropriate evidence, specific facts showing there is a  
7 genuine issue for trial. *Id.* at 249. The nonmoving party must produce at least some  
8 “significant probative evidence tending to support” its position. *Smolen v. Deloitte,*  
9 *Haskins, & Sells*, 921 F.2d 959, 963 (9th Cir. 1990). The issue is not whether the  
10 “evidence unmistakably favors one side or the other but whether a fair-minded jury  
11 could return a verdict for the [nonmoving party] on the evidence presented.” *United*  
12 *States ex rel. Anderson v. N. Telecom, Inc.*, 52 F.3d 810, 815 (9th Cir. 1995) (quoting  
13 *Liberty Lobby*, 477 U.S. at 252). “If a moving party fails to carry its initial burden of  
14 production, the nonmoving party has no obligation to produce anything, even if the  
15 nonmoving party would have the ultimate burden of persuasion at trial.” *Nissan Fire &*  
16 *Marine Ins. Co. v. Fritz Cos.*, 210 F.3d 1099, 1102-03 (9th Cir. 2000). The Court  
17 considers the motion for summary judgment under this standard.

### 18 **III. Plaintiff’s Copyright Infringement Claim**

19 Plaintiff alleges that Defendants committed copyright infringement by “willfully  
20 and unlawfully reproduc[ing], publicly display[ing], and creat[ing] derivative versions of  
21 copyrighted elements of the Platform verbatim.” (Doc. 39 at ¶ 38.) In its second motion  
22 for summary judgment, Plaintiff argues that it is entitled to summary judgment on this  
23 claim because it satisfied the procedural requirements of 17 U.S.C. § 411(a) and  
24 Defendants admitted to reproducing and distributing SPSO’s Platform. (Doc. 78 at 8.)  
25 Defendants seek summary judgment on Plaintiff’s copyright infringement claim on the  
26 ground that Plaintiff did not satisfy the copyright registration precondition to bringing a  
27 copyright infringement action. (Doc. 79 at 1.)

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1           **A.     The Copyright Act**

2           Copyright protection applies to “original works of authorship fixed in any tangible  
3 medium of expression.” 17 U.S.C. § 102(a). A copyright, as a right, “subsists from its  
4 creation . . . .” See 17 U.S.C. § 302(a). “Under the Copyright Act, copyright protection  
5 provides an owner with exclusive rights to reproduce the copyrighted work, to prepare  
6 derivative works from the copyrighted work, to distribute copies of the copyrighted work,  
7 and to perform or display the copyrighted work.” 17 U.S.C. § 106. Anyone who violates  
8 any of those exclusive rights is an infringer of the copyright of the author, and the legal or  
9 beneficial owner of the exclusive right is entitled to sue for infringement under  
10 17 U.S.C. § 501(a)-(b).

11           To establish a prima facie case of copyright infringement, a plaintiff must prove  
12 (1) ownership of a valid copyright, and (2) that the alleged infringer violated at least one  
13 of the exclusive rights granted under § 106. See *A & M Records, Inc. v. Napster, Inc.*,  
14 239 F.3d 1004, 1013 (9th Cir. 2001). Copyright “registration [is also] an element of an  
15 infringement claim.” *Unicolors, Inc. v. Urban Outfitters, Inc.*, 853 F.3d 980, 988 (9th  
16 Cir. 2017) (citing *Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 615 (9th  
17 Cir. 2010)).

18                   **1.     Registration of Website Content**

19           “A website in and of itself is not explicitly recognized as copyrightable subject  
20 matter.” COMPENDIUM (THIRD), Glossary, §1006.<sup>8</sup> Rather “[a] website is merely a  
21 medium of fixation for works of original authorship . . . it is a vehicle for the  
22 dissemination of content, which may or may not be copyrightable.” *Id.* “[I]t is the  
23 content of the website—not the medium of expression—that comprises the copyrightable  
24 authorship that may be registered with the U.S. Copyright Office.” *Id.* However,  
25 “[w]ebsites are somewhat unique as vehicles for the dissemination of content. Unlike a  
26 tangible object, such as a printed magazine or a roll of film, websites are not static

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28           <sup>8</sup> When interpreting the Copyright Act, the Court defers to the copyright office’s  
interpretations, such as the Compendium, in the appropriate circumstances. *Alaska Stock,  
LLC v. Houghton Mifflin Harcourt Publ’g Co.*, 747 F.3d 673, 684 (9th Cir. 2014).

1 containers for content. They are dynamic containers that may change over time as often  
2 and to the extent that the website owners wish.” *Id.* “Although websites are dynamic,  
3 copyright protection in the United States extends only to fixed works of authorship that  
4 fall under the categories provided in . . . the Copyright Act.” Thus, the copyright office  
5 “will register a claim in website content only as it exists at the time the application is  
6 received.” *Id.*

7 Therefore, “a registration for website content does not extend to any unclaimable  
8 materials that may be contained within that content. . . . [and] unclaimable material  
9 includes material that . . . was previously published or registered.” *Id.* at § 1008.2; *see*  
10 *also* § 1009.8 (“[a] registration for a website or website content does not cover any  
11 materials that has been previously published . . .”). “If the deposit contains an  
12 appreciable amount of previously published . . . material, the applicant must expressly  
13 exclude that material from the claim.” *Id.* at § 1008.2 “Asserting a claim in previously  
14 published material is one of the most common mistakes that applicants make when  
15 completing an application to register website content.” *Id.*

16 As the copyright office advised Plaintiff, if website “content has been published,  
17 the applicant may register all of the copyrightable material that was first published on the  
18 date of publication specified in the application. If the content contains copyrightable  
19 materials that was published before that date, the application must exclude that  
20 previously published material from the claim.” *Id.* at § 1008.6(A). “[T]he deposit should  
21 contain a copy of the content as it existed on the date of publication that is specified in  
22 the application. *Id.*; *see also* § 1010.5 (“[t]o register material from the initial version or  
23 any subsequent version of a published website, the applicant must deposit an acceptable  
24 copy . . . of the specific version that the applicant intends to register and the applicant  
25 must provide the correct date of first publication for that version.”).

## 26 **2. Registration Precondition to Filing Infringement Action**

27 Upon application, a copyright claim may be registered with the copyright office if  
28 it is determined that the work “constitutes copyrightable subject matter” under the Act.

1 17 U.S.C. §§ 408, 410. Copyright registration serves as a public record of the authorship  
2 and ownership of the claimed work. *Brownstein v. Lindsey*, 742 F.3d 55, 66 (3d Cir.  
3 2014). Copyright registration is not required for copyright protection and is not  
4 jurisdictional. See 17 U.S.C. § 408(a); *Cosmetic Ideas*, 606 F.3d at 614-15 (citing *Reed*  
5 *Elsevier, Inc., v. Muchnick*, 559 U.S. 154 (2010)). However, “[c]opyright registration is a  
6 precondition to filing a copyright infringement action.” *L.A. Printex Indus. Inc. v.*  
7 *Aeropostale, Inc.* 676 F.3d 841, 852-53 (9th Cir. 2012), *as amended* (June 13, 2012);  
8 *Cosmetic Ideas, Inc.*, 606 F.3d at 614-15 (stating that “registration is required for U.S.  
9 works prior to bringing any infringement action.”); 17 U.S.C. § 411(a) (providing that  
10 “no action for infringement of the copyright in any United States work may be instituted  
11 until registration of the copyright has been made in accordance with this title.”).<sup>9</sup>

12 The Ninth Circuit has held that the copyright office’s receipt of a completed  
13 application is sufficient for purposes of initiating copyright infringement litigation, and  
14 that the processes of copyright registration and an infringement case can proceed  
15 concurrently. *Cosmetic Ideas, Inc.*, 606 F.3d at 619-21. After a copyright registration  
16 certificate is issued, it dates back to the date of the application and the certificate includes  
17 the effective date of the registration. 17 U.S.C. § 401(a), (d). Section 411(a) provides  
18 that rejection of a registration application does not bar a civil suit, if the copyright office

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19  
20 <sup>9</sup> The Ninth Circuit further explained why registration is a precondition to filing a  
21 copyright infringement action, even though registration is not required for copyright  
22 protection:

23 Although registration was made optional [in the 1976 amendments to the  
24 copyright act], Congress still valued having a robust federal register of  
25 existing copyrights. To this end, it chose to encourage copyright holders to  
26 register with the Office of Copyright through various statutory incentives.  
27 For instances, if a copyright holder secures a registration certificate within  
28 five years after first publication, such certificate will constitute prima facie  
evidence of both the validity of the copyright and the facts stated in the  
certificate. Moreover certain remedies, such as statutory damages and  
attorney’s fees, are available only after registration. Finally, registration is  
required for U.S. works prior to bringing an infringement action. Indeed,  
because registration is not mandatory under the Act, copyright holders  
frequently register specifically for the purpose of being able to bring suit.

*Cosmetic Ideas, Inc.*, 606 F.3d at 619 (internal citations omitted).

1 has been notified of the litigation and served with a copy of the complaint. 17 U.S.C.  
2 § 411(a) (permitting an applicant to bring an infringement action after the register has  
3 rejected the applicant’s registration if the register is notified of the suit and served with  
4 the complaint)). The copyright office may become a party to the suit, but it is the court’s  
5 responsibility to determine the validity of a plaintiff’s copyright claim. 17 U.S.C.  
6 § 411(a).

### 7 **3. Invalidation of Copyright Registration**

8 “To prevent plaintiffs from abusing the registration process . . . , the Copyright Act  
9 allows for the invalidation of registrations obtained by knowing misrepresentations of  
10 material facts.” *Delivermed Holdings, LLC v. Schaltenbrand*, 734 F.3d 616 (7th Cir.  
11 2013) (citing 17 U.S.C. § 411(b)(1)(A)-(B)). In 2008, as part of the Prioritizing  
12 Resources and Organization for Intellectual Property Act (the “2008 PRO IP Act”),  
13 Congress codified a court-made standard for invalidating a copyright registration. *See*  
14 *Lennar Homes of Texas Sales and Mktg. v. Perry Homes, LLC*, 117 F. Supp. 3d 913,  
15 (S.D. Texas 2015) (discussing the Fifth Circuit’s standard for finding a copyright  
16 registration invalid).

17 Under the amended statute, a certificate of registration is sufficient to bring a  
18 copyright infringement action “regardless of whether the certificate contains inaccurate  
19 information,” unless the following conditions are met: (A) “the inaccurate information  
20 was included on the application for copyright registration with knowledge that it was  
21 inaccurate,” and (B) “the inaccuracy of the information, if known, would have caused the  
22 Register of Copyrights to refuse registration.” 17 U.S.C. § 411(b)(1)(A) and (B); *see L.A.*  
23 *Printex*, 676 F.3d at 853.

24 The 2008 PRO IP Act amended § 411 to include § 411(b)(2), which requires  
25 courts to seek the advice of the Register of Copyrights before finding that a certificate of  
26 registration does not support an infringement action. *See DeliverMed Holdings*, 734 F.3d  
27 at 623 (stating that “[i]nstead of relying solely on the court’s own assessment of the  
28 Register’s response to an inaccuracy, the statute obligates courts to obtain an opinion

1 from the Register on the matter.”); *Palmer/Kane LLC v. Rosen Book Works LLC*, 2016  
2 WL 3042895, at \*1 (S.D.N.Y. May 27, 2016) (“[C]ourts are in agreement that the  
3 provision is mandatory in nature . . .”). In other words, before finding that knowingly  
4 inaccurate information would have caused the Register of Copyrights to refuse  
5 registration, a court must ask the Register whether that would have been the case.

6 **B. Sufficiency of Plaintiff’s Copyright Registration**

7 In its analysis of the parties’ second cross-motions for summary judgment, the  
8 Court first considers whether Plaintiff’s copyright registration supports its copyright  
9 infringement claim asserted in Count One. The Court has previously concluded that for  
10 purposes of its infringement claim, the relevant copyrighted content is the “text and  
11 photographs” that appear on Plaintiff’s website [www.poolandspapartsnow.com](http://www.poolandspapartsnow.com). (Doc. 64  
12 at 11-12; Doc. 78 at 12.) Defendants argue that Plaintiff’s copyright infringement claim  
13 fails because Plaintiff did not satisfy the registration precondition for filing a claim for  
14 copyright infringement (Doc. 79 at 4), and Plaintiff disputes that assertion. (Doc. 78.)  
15 As discussed below, the Court concludes that Plaintiff did not satisfy the registration  
16 precondition because the registration is invalid under § 411(b).

17 The record reflects that Plaintiff’s application for registration of copyright was  
18 dated September 13, 2015, for a work titled “SPSO Website  
19 [www.poolandspapartsnow.com](http://www.poolandspapartsnow.com),” and that the copyright office received the application on  
20 September 15, 2015. (Doc. 50, Ex. 9; Doc. 53, Ex. B.) The copyright office eventually  
21 issued a certificate of registration for “text, photographs,” with September 16, 2015 as the  
22 effective date of registration. (Doc. 50, Ex. 1.) After a certificate of registration of  
23 copyright is issued, the registration dates back to the date of application. *Cosmetic Ideas*,  
24 606 F.3d at 616 (citing 17 U.S.C. § 410(d) (concluding that plaintiff satisfied the  
25 registration requirement when plaintiff submitted an application for registration of  
26 copyright before it filed suit and the copyright office subsequently issued a registration  
27 certificate)). Thus, the registration was effective September 16, 2015, before Plaintiff  
28 filed the original complaint. However, the Court finds that registration is not sufficient to

1 support Plaintiff's copyright infringement claim under the two-part test of 17 U.S.C.  
2 § 411(b), as set forth below.

3 **1. The Copyright Application Included Inaccurate Information**

4 As discussed in detail in the June 2017 Order, the copyright application, which  
5 includes the correspondence between Plaintiff and the copyright office, included  
6 inaccurate information that was incorporated into the copyright registration. (Doc. 64 at  
7 17-25.) The inaccurate information is the July 3, 2014 publication date for the deposit,  
8 which included the text and photographs at issue in the copyright infringement claim.  
9 (*Id.* at 24; Doc. 78 at 10; 78-1 ¶ 39.) Deposit material for website content must contain  
10 "the copyrightable material that is claimed in the application," and "the deposit should  
11 contain a copy of the content as it existed on the date of publication that is specified in  
12 the application." (Doc. 72-1 at 6 (quoting COMPENDIUM (THIRD) §§ 1010.1 and  
13 1008.6(A)).

14 For registration of website content that has been revised after the date of first  
15 publication, the copyright application should include the "month, day, and year that the  
16 revised content was first posted on that site." (Doc. 72-1 at 6 (quoting COMPENDIUM  
17 (THIRD) § 1009.4(A)(2)).) As the copyright office advised Plaintiff during the  
18 registration process, registration of a revised version of a website covers only the new or  
19 revised material added. (Doc. 53, Ex G. p.2.) "[I]t is the responsibility of the applicant  
20 to determine whether a work has been published prior to an application and to make this  
21 determination based on the applicable terms of the Copyright Act." *Gold Value Int'l*  
22 *Textile, Inc. v. Sanctuary Clothing, LLC*, 2017 WL 2903180, at \*9 (C.D. Cal. Mar. 24,  
23 2017).

24 As explained in the Court's June 2017 Order, the July 3, 2014 publication date is  
25 inaccurate because "[i]t is undisputed that the [d]eposit material did not match the  
26 material claimed in the application. The application was to register content (photographs  
27 and text) on the website as of the date of publication specified during the registration  
28 process, July 3, 2014, but Plaintiff deposited the content that appeared on the website on



1 a later date. Plaintiff, however, represented to the copyright office that the deposit was  
2 the same as the website appeared on July 3, 2014.” (Doc. 64 at 24.) The additional  
3 content includes, in part, photographs of Nemo products added on October 14, 2014,  
4 including entire webpages displaying the Nemo products. (Doc. 80 at ¶¶ 1-5.)

5 Plaintiff admits that the website submitted to the Copyright Office included  
6 additional copyrightable content added after July 3, 2014. (*Id.* at ¶ 18 (citing Doc. 68 at  
7 3, 5; Doc. 56 at 6).) Plaintiff does not dispute Defendants’ assertion, and the Court’s  
8 finding in the June 2017 Order, that photographs of Nemo products were added to  
9 Plaintiff’s website after July 3, 2014, the date Plaintiff represented as the publication date  
10 for the deposit submitted to the copyright office. (*See* Doc. 64 at 20-24.)

11 Instead, Plaintiff previously argued that “the deposit copy submitted by SPSO . . .  
12 was the *best available copy* of the Work as it subsisted on the Publication Date, July 3,  
13 2014,” and stated that “[t]he fact that *there is additional information contained on the*  
14 *Deposit is of no moment.*” (Doc. 56 at 6 (emphasis added).) Plaintiff also attempted to  
15 minimize any inaccurate statements in the Hagen affidavit by stating that when Hagen  
16 said the sample Platform submitted as the deposit with Plaintiff’s copyright registration  
17 was the “‘same as the website appeared when published on July 3, 2014,’ he [was]  
18 referring to what is claimed on the registration, namely ‘text, photographs.’” (*Id.* at 9.)  
19 “He is not referring to additional information that may have been contained in the  
20 medium (i.e. the website). As far as what is claimed in the Registration, the ‘text and  
21 photographs’ are the *same or essentially the same* as in the Deposit as they existed on  
22 July 3, 2014.” (*Id.* (emphasis by italics and bold text in original).)

23 Plaintiff now asserts that the deposit is not required to match the “medium in  
24 which it is contained,” and therefore Defendants’ arguments that there is “other material  
25 in the medium is rendered moot.” (Doc. 90 at 9; *see also* Doc. 81 at 7 (asserting that the  
26 medium and the Work are not required to match and stating “there may have been  
27 additional copyrightable subject matter on the medium that Plaintiff elected not to claim  
28 in its registration.”).) Plaintiff specifically refers to “[N]emo products” in this argument.

1 (Doc. 90. at 9-10.) Thus, throughout the briefing on several motions in this case, Plaintiff  
2 has admitted that the photographs of Nemo products were added to the SPSO website  
3 after July 3, 2014, and were included in the deposit submitted to the copyright office in  
4 September 2015.

5 Plaintiff's argument that the SPSO website is only the medium for copyrightable  
6 material, and the copyrighted material is limited to certain content on that website,  
7 specifically photographs and text, does not establish that the photographs of Nemo  
8 products added to the website after the asserted July 3, 2014 publication date are "moot."  
9 Plaintiff does not explain how these photographs, and the text describing these products,  
10 are simply part of the website medium, and not part of its content and not part of the  
11 unspecified "photographs, text" listed on the registration.

12 Furthermore, Defendants submitted evidence indicating that they had identified  
13 photographs of the Nemo products that were added to Plaintiff's website after July 3,  
14 2014 by using the Internet Archive to capture pages of Plaintiff's website as it existed in  
15 July 2014 and in the deposit. (Doc. 80 at §§ 1-5; Doc. 53, Exs. M-1, M-2, M3, N-1, N-2,  
16 N-3, N-4, FF.) Plaintiff does not dispute this evidence, but instead asserts that this  
17 evidence is "irrelevant" because it did not register a website and "the Nemo products are  
18 not part of what was registered with the USCO and not part of what Plaintiff claims was  
19 infringed." (Doc. 82 at ¶¶ 1-5.) Thus, it appears that Plaintiff may be arguing that  
20 although the deposit included photographs added to the SPSO website after July 3, 2014,  
21 the asserted publication date, it did not intend to register these photographs, or assert  
22 copyright infringement based on the copying of these photographs and, therefore, the  
23 additional content in the deposit is immaterial.

24 This argument, however, ignores the significance of the addition of new  
25 copyrightable content to the website. As previously discussed, the Register of Copyrights  
26 would have refused registration of Plaintiff's copyright with a July 3, 2014 publication  
27 date had it known that the submitted website included copyrightable content added after  
28 July 3, 2014. (Doc. 72-1 at 8.) Thus, the addition of new copyrightable content on the

1 website is significant in determining the publication date. (See Doc. 64 at 23 (citing  
2 COMPENDIUM (THIRD) at §§ 1008.5, 1008.6.) Because the registration includes  
3 inaccurate information, the Court considers whether “the inaccurate information was  
4 included on the application . . . with knowledge that it was inaccurate.” 17 U.S.C.  
5 § 411(b)(1)(A).

## 6 **2. Plaintiff Knowingly Included the Inaccurate Information**

7 Under § 411(b), a certificate of registration that contains inaccurate information is  
8 insufficient to bring a copyright infringement suit when the registrant knowingly included  
9 the inaccurate information, and “the inaccuracy of the information, if known, would have  
10 caused the Register of Copyrights to refuse registration.” 17 U.S.C. § 411(b)(1)(A) and  
11 (B); see *Unicolors*, 853 F.3d at 991 (stating that a registration error bars an infringement  
12 action if “the inaccurate information was included on the application . . . with knowledge  
13 that it was inaccurate” and the inaccuracy, “if known, would have caused the Register of  
14 Copyrights to refuse registration.”) (internal quotation marks and citation omitted);  
15 *Schenck v. Orosz*, 105 F. Supp. 3d 812, (M.D. Tenn. 2015) (stating that “a plaintiff  
16 cannot maintain a copyright infringement action premised on a registered copyright if the  
17 plaintiff both (1) included inaccurate information on a registration application and (2) the  
18 Copyright Office would have refused registration had the inaccurate information not been  
19 included.”).

20 In its June 2017 Order, the Court found that Plaintiff had not “argue[d] that it  
21 unknowingly provided false information to the copyright office.” (Doc. 64 at 24.)  
22 Plaintiff does not dispute that finding. (Doc. 80 ¶ 27; Doc. 82 ¶ 27.)<sup>10</sup> Rather, Plaintiff  
23 argues that § 411(b) does not apply because it did not make fraudulent statements to the  
24 copyright office. (Doc. 81 at 14-16; Doc. 90 at 3-5, 6-8.) Plaintiff argues that § 411(b)

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25  
26 <sup>10</sup> Plaintiff objects to this statement as irrelevant on the ground that “Plaintiff’s  
27 communications with the USCO . . . [have] been fully litigated.” (Doc. 82 ¶¶ 9, 27.)  
28 Plaintiff also asserts that this issue is beyond the scope of the Court’s order permitting  
second motions for summary judgment. (*Id.* at ¶ 9.) The Court agrees that the issue of  
Plaintiff’s communications with the copyright office was addressed in the June 2017  
Order. (Doc. 64.) However, those communications continue to be relevant to the  
resolution of Plaintiff’s copyright infringement claim. See § 411(b)(1).

1 requires a showing of fraudulent misrepresentation under state law. (Doc. 90 at 2-3, n.1  
2 (citing *Neilson v. Flashberg*, 419 P.2d 514, 517-18 (Ariz. 1966).) Plaintiff further argues  
3 that § 411(b) requires that the party challenging whether the registration satisfies the  
4 registration precondition to filing suit must “meet the heightened pleading standards” for  
5 fraud in Rule 9(b) of the Federal Rules of Civil Procedure. (Doc. 90 at 3-4.) Plaintiff  
6 asserts that its counsel made only “inadvertent technical errors during the registration  
7 process.” (*Id.* at 5.)

8 “[I]nadvertent mistakes on a registration certificate do not invalidate a copyright  
9 and thus do not bar infringement actions, unless the alleged infringer has relied to its  
10 detriment on the mistake or the claimant intended to defraud the Copyright Office by  
11 making the misstatement.” *Urantia Found. v. Maaherra*, 114 F.3d 955, 963 (9th Cir.  
12 1997). However, the Ninth Circuit has found that “a showing of fraud is not required  
13 when the inaccurate information was knowingly included on the application, as opposed  
14 to being an inadvertent mistake.” *Gold Value Int’l Textile, Inc. v. Sanctuary Clothing,*  
15 *LLC*, 2017 WL 2903180, at \*10 ) (C.D. Cal. Mar. 24, 2017) (citing *L.A. Printex Indus.,*  
16 *Inc.*, 676 F.3d at 854; *see also Palmer/Kane LLC v. Gareth Stevens Pub’g*, 2016 WL  
17 6238612, at \*4 (S.D.N.Y. Oct. 24, 2016) (“To the extent that Plaintiff argues that the  
18 statute requires a showing of ‘fraudulent intent’ separate and apart from a showing of  
19 knowing inaccuracy, the Court agrees with Judge Rakoff and declines to graft this  
20 additional requirement onto the plain statutory text.”). The Court, therefore, concludes  
21 that it is not necessary to show fraud on the copyright office for § 411(b)(1)(A) and (B) to  
22 apply, and rejects Plaintiff’s contrary argument. *See L.A. Printex*, 673 F.3d at 852-53.

23 Plaintiff also now argues that it has “never wavered” in its assertion of July 3,  
24 2014 as the first publication date because it alleged in its complaint, filed September 17,  
25 2015, that the Platform was first published in July 2014, and it submitted the Hagen  
26 affidavit to the copyright office on November 14, 2016 and stated that the Platform was  
27 first published on July 3, 2014. (Doc. 78 at 6; Doc. 81 at 3.) Plaintiff asserts that “[t]he  
28 fact that Plaintiff’s counsel made a mistake as to the publication date in the registration

1 process in neither material, relevant, nor dispositive.” (Doc. 81 at 3-4.) Thus, Plaintiff  
2 attempts to minimize the significance of its registration application, which listed the first  
3 publication date as August 26, 2015.

4 This argument, however, ignores the record of Plaintiff’s communications with the  
5 copyright office in which counsel stated, in response to the copyright office’s inquiry  
6 whether the content of the deposit included material from an earlier version of the  
7 website, that some of the deposit “may have been from an earlier version of the website  
8 BUT we need special dispensation because this is the first time registration of the website  
9 and no copy (i.e. mirror or backup) of the prior website exists.” (Doc. 53, Ex. H, Doc. 80  
10 ¶ 4.) Plaintiff has never contradicted those statements or claimed that it has a copy of the  
11 website content as it was published in July 2014.

12 Furthermore, the declarations Plaintiff submitted with the briefing on the various  
13 motions for summary judgment further establish that Plaintiff did not have a copy of the  
14 website as it was published in July 2014. Plaintiff’s counsel submitted a declaration  
15 stating that the “‘mirror copy’ of the SPSO website was created on or about August 26,  
16 2015.” (Doc. 56, Ex. D at ¶ 2.) The director of operations for the law firm of Plaintiff’s  
17 counsel, Martin Gwynn, also submitted a declaration stating that he made the deposit  
18 copy of the SPSO website to be sent to the copyright office for copyright registration on  
19 or about September 13, 2015. (Doc. 78-1, Ex. 9.) Mr. Gwynn also states that on  
20 September 7, 2017, he began using Internet Archives to capture screen shots of the SPSO  
21 website as it appeared on or before July 3, 2014.<sup>11</sup> (*Id.* at ¶ 6.)

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22  
23  
24 <sup>11</sup> Importantly, Plaintiff did not obtain screen shots of the SPSO website as it  
25 appeared in July 2014 as part of its copyright registration application in September 2015.  
26 Instead, Plaintiff waited for two years and until after the Court entered its June 2017  
27 Order, and until after the Register of Copyrights responded to the Court’s inquiry, before  
28 it began to search for this information. Plaintiff now apparently suggests that these  
screen shots establish that the SPSO website, as it was published on July 3, 2014, was the  
same as the copy of the website submitted as the deposit with the copyright application.  
(Doc. 78 at 7.) However, Mr. Gwynn’s declaration discusses comparisons of  
representative categories of photographs and text on the SPSO website in 2014 and 2015,  
and the WFUP website, but he does not state that the SPSO website in 2014 was the same  
as the SPSO website in 2015, as submitted to the copyright office. (Doc. 78-1, Ex. 9.)

1           Additionally, Plaintiff submitted the Hagen affidavit to the copyright office on  
2 November 14, 2016, which was after Defendants had filed their first motion for summary  
3 judgment and their motion for an order for Plaintiff to cancel or amend its copyright  
4 registration. (Doc. 53, Ex. K.) In that declaration, Hagen states that “[t]he sample of *the*  
5 *Platform* provided to the United States Copyright Office with SPSO’s Copyright  
6 application in 2015 is the same as the website first appeared when published on July 3,  
7 2014. (*Id.* at ¶ 4)(emphasis added). In the same declaration, Hagen described *the*  
8 *Platform* as “a compilation of programs, representations, originally authored works,  
9 writings, hundreds of photographs taken by myself and my brother, as well as computer  
10 architecture and design.” (*Id.* at ¶ 3.) The Hagen declaration did *not* state that certain  
11 photographs and text in the deposit were the same as photographs and text published on  
12 the website in July 2014. Instead, he represented that the copy of the Platform submitted  
13 as the deposit, which he defined to include programs, photographs, and computer  
14 architecture and design, was the same as the website appeared in July 2014. However, in  
15 his deposition taken a few months earlier on August 8, 2016, he testified that the website  
16 content was the same, but he had updated the copyrighted code on the website. (Doc. 80,  
17 Ex. 3 at 203-04.)

18           Therefore, as discussed in the June 2017 Order, and as confirmed in this Order, the  
19 record reflects that Plaintiff knowingly included inaccurate information in the copyright  
20 application. (Doc. 64 at 21-24.) As noted in the June 2017 Order, the timing of Hagen’s  
21 affidavit indicates that Plaintiff knowingly provided inaccurate information to the  
22 copyright office because it was submitted (1) after the copyright office advised Plaintiff  
23 that material published on the website before the August 26, 2015 date of first publication  
24 would be excluded from the claim, and (2) after Defendants filed a motion for summary  
25 judgment arguing that if the copyrightable material was completed and published on  
26 August 26, 2015, then Plaintiff’s infringement claim would fail because Defendants’  
27 allegedly infringing conduct occurred in 2014. (Doc. 64 at 21-24 (citing Doc. 53 at 4-7).)

28

1           The record indicates that after this defect was raised in this litigation, Plaintiff  
2 submitted Hagen’s affidavit to the copyright office to support its claim that the date of  
3 first publication was July 3, 2014, and inaccurately stated that the deposit submitted to  
4 the copyright office was the same as the website appeared on July 3, 2014. (Doc. 51,  
5 Ex. K at ¶ 5; Doc. 53, Ex. L; Doc. 56 at 6 (SPSO admits that the sample platform  
6 provided to the copyright office was not the same as the website appeared on July 3,  
7 2014.)) Evidence in the record shows that Plaintiff changed the content of its website  
8 after July 3, 2014. (Doc. 53, Exs. M-1, M-2, M-3, N-1, N-2, N-3; Doc. 53, Ex. O.)  
9 Further, Plaintiff does not argue that it was unaware that after July 3, 2014 additional  
10 copyrightable material was added to the website and was included in the version of the  
11 website that Plaintiff submitted to the copyright office. (Doc. 51, Ex. K; Doc. 54, Ex. D;  
12 Doc. 80 ¶ 28; Doc. 82 ¶ 28.)

13           Plaintiff admitted to the copyright office that some of the deposit’s content “may  
14 have been from an earlier version of the website BUT we need special dispensation  
15 because this is the first time registration of the website and no copy (i.e., mirror or  
16 backup) of the prior website exists.” (Doc. 80 ¶ 34; Doc. 82 ¶ 34.) This undisputed  
17 statement indicates that Plaintiff knew that some content in the deposit “may have been  
18 from an earlier version of the website,” but there is no evidence that, during the  
19 registration process, Plaintiff investigated to determine the dates on which copyrightable  
20 content was added. Rather, Plaintiff requested a “special dispensation,” and, when that  
21 was denied, it submitted Hagen’s affidavit to the copyright office declaring that “[t]he  
22 sample of the Platform provided to the United States Copyright Office with SPSO’s  
23 Copyright application in 2015 is the same as the website first appeared when published  
24 on July 3, 2014.” (Doc. 80 at ¶ 39; Doc. 82 at ¶ 39.)

25           Plaintiff had knowledge that the Hagen affidavit, which was part of the copyright  
26 application, was inaccurate because Plaintiff either knew that the statement in the  
27 affidavit was inaccurate or, had uncertainty regarding the facts, but submitted an affidavit  
28 stating those facts with certainty. Therefore, consistent with the June 2017 Order, the

1 Court concludes that Plaintiff knowingly included inaccurate information in the  
2 application to the copyright office. (Doc. 64 at 17-25); *see* 17 U.S.C. § 411(b)(1)(A).

### 3 **3. The Copyright Office Would Have Refused Registration**

4 After concluding that Plaintiff knowingly provided false information to the  
5 copyright office, the Court submitted a request to the Register of Copyrights to advise the  
6 court whether the inaccurate information, if known, would have caused the Register of  
7 Copyrights to refuse registration. (Doc. 64 at 24-25; Doc. 67.) In response, the copyright  
8 office informed the Court that had it known of the inaccuracy, it would have refused the  
9 registration with a July 3, 2014 publication date.<sup>12</sup> (Doc. 72-1 at 8.)

10 Pursuant to § 411(b)(1), a plaintiff cannot maintain a copyright infringement claim  
11 based on a registered copyright if (1) the plaintiff knowingly included inaccurate  
12 information on the copyright registration application, and (2) the Register of Copyrights  
13 would have refused the registration had it known of the inaccuracy of the information.  
14 *Schenck*, 105 F. Supp. 3d at 816 (citing 17 U.S.C. § 411(b)(1)). “The knowing failure to  
15 advise the Copyright Office of facts which might have occasioned a rejection of the  
16 application constitutes reason for holding the registration invalid and thus incapable of  
17 supporting an infringement action.” *Russ Berrie & Co. v. Jerry Elsner Co.*, 482 F. Supp.  
18 980, 988 (S.D.N.Y. 1980); *see also Unicolors*, 853 F.3d at 991 (stating that a registration  
19 error bars an infringement action if “the inaccurate information was included on the  
20 application . . . with knowledge that it was inaccurate” and the inaccuracy, “if known,  
21 would have caused the Register of Copyrights to refuse registration.”); *Roberts v. Gordy*,  
22 181 F. Supp. 3d 997, 1010, 1014 (S.D. Fla. Apr. 8, 2016) (concluding that registration

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23  
24 <sup>12</sup> Plaintiff argues that the copyright office “refused” to change the status of the  
25 registration. (Doc. 78 at 11; Doc. 81 at 16.) The Court, however, asked the copyright  
26 office a specific question under § 411(b)(1), and did not ask the copyright office to cancel  
27 the registration. (*See* Doc. 67.) Under § 411(b)(1), the issue is whether “the inaccuracy  
28 of the information, if known, would have caused the Register of Copyrights to refuse  
registration.” 17 U.S.C. § 411(b)(1). Nonetheless, whether the copyright office changed  
the status of the registration is irrelevant to the Court’s determination of the validity of  
the registration to satisfy the registration precondition to filing suit. Therefore, the Court  
rejects Plaintiff’s argument that because its registration “remains valid . . . the threshold  
procedural requirement of § 411(a) of the Act is met.” (Doc. 78 at 5.)



1 was invalid and incapable of supporting an infringement action after receiving response  
2 from the Register of Copyrights that it would have refused registration had it known of  
3 inaccuracies on the application).<sup>13</sup>

4 Therefore, the Court concludes that, pursuant to § 411(b)(1), Plaintiff’s certificate  
5 of registration is not sufficient to bring a copyright infringement claim because the  
6 registration application includes inaccurate information, Plaintiff included the inaccurate  
7 information “with knowledge that it was inaccurate,” and “the inaccuracy of the  
8 information, if known, would have caused the Register of Copyrights to refuse  
9 registration” with a July 2014 publication date. *See* 17 U.S.C. § 411(b)(1). “[T]he failure  
10 to properly register a work will preclude an infringement action predicated on that work.”  
11 *Roberts*, 181 F. Supp. 3d 997 at 1014; *see Olander Enters., Inc. v. Spencer Gifts, LLC*,  
12 812 F. Supp. 2d 1070, 1078 (C.D. Cal. 2011) (copyright registration was invalid when it  
13 did not properly identify publication date of belt buckles in a “single unit of publication,”  
14 and therefore, the plaintiff could not prove an essential element of its copyright  
15 infringement claim). The Court’s ruling does not cancel the copyright registration.<sup>14</sup>  
16 However, it bars Plaintiff from bringing an infringement action because there is no valid  
17 registration. *See id.*

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19  
20 <sup>13</sup> *See also Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 667-68  
21 (3d Cir. 1990) (“It has been consistently held that a plaintiff’s knowing failure to advise  
22 the Copyright Office of facts which might have led to the rejection of a registration  
23 application constitutes grounds for holding the registration invalid and incapable of  
24 supporting an infringement action.”); *Raquel v. Educ. Mgmt. Corp.*, 196 F.3d 171, 176  
25 (3d Cir. 1999) *vacated on other grounds*, 531 U.S. 952 (2000) (“Although a failure  
26 properly to register a work does not invalidate the copyright itself, it does preclude the  
27 maintenance of an infringement action until such time as the purported copyright holder  
28 obtains a valid registration.”); *R. Ready Prods., Inc. v. Cantrell*, 85 F. Supp. 2d 672, 691  
(S.D. Tex. 2000) (Under copyright law, “the knowing failure to advise the Copyright  
Office of material facts constitutes grounds for holding the registration invalid and  
incapable of supporting an infringement action.”); *GB Mktg. USA Inc. v. Gerolsteiner  
Brunnen GmbH & Co.*, 782 F. Supp. 763, 776 (W.D.N.Y. 1991) (declining to enforce a  
copyright because the registration contained inaccurate information).

<sup>14</sup> The Register of Copyrights has primary jurisdiction to cancel a copyright  
registration. *See Syntek Semiconductor Co., Ltd. v. Microchip Tech. Inc.*, 307 F.3d 775,  
780-82 (9th Cir. 2002).

1 **IV. Conclusion**

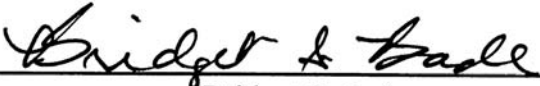
2 Because Plaintiff did not properly register the work at issue in this case, the  
3 copyright registration is insufficient to support a copyright infringement claim and the  
4 Court grants summary judgment in favor of Defendants on Count One on that basis. *See*  
5 *Cosmetic Ideas, Inc.*, 606 F.3d at 615 (stating that § 411(a)'s registration precondition is  
6 an element of an infringement claim); *Roberts*, 181 F. Supp. 3d at 1014 (dismissing a  
7 copyright claim under § 411(b) after consulting the copyright office). The Court,  
8 therefore, does not consider the parties' alternative arguments in support of their motions  
9 for summary judgment. (Doc. 78 at 11-17; Doc. 79 at 10-17.)

10 Accordingly,

11 **IT IS ORDERED** that Defendants' Second Motion for Summary Judgment on  
12 Plaintiff's Copyright Claim (Doc. 79) is **GRANTED**.

13 **IT IS FURTHER ORDERED** that Plaintiff's Second Motion for Summary  
14 Judgment (Doc. 78) is **DENIED**.

15 Dated this 24th day of September, 2018.

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20 Bridget S. Bade  
21 United States Magistrate Judge  
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