United States Copyright Office
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April 22, 2004

Townsend and Townsend and Crew, LLP
Attn: Anthony J. Malutta, Esq., and
John A. Hughes, Esq.
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834

RE: Paris Expo and Thirteen Others
Control No. 60-719-0269 (T)

Dear Mr. Malutta and Mr. Hughes:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated November 2, 2001 in which you requested that the Copyright Office reconsider its refusal to register 14 clock faces, compilations of graphic images. The Board of Appeals decided that the following three works have sufficient creativity to be copyrightable: Emily's Garden, Paris Expo and Old World. However, after carefully considering the applications and your arguments, the Board is upholding the Examining Division's refusal to register eight of the works: French Gallery, French Hotel, Hotel Venetia, Italian Villa, Running Rabbit, Swiss Watchmaker, Bond Street, Italian Harvest and Shanghai. Applicant withdrew two works from the Board's consideration: English Astronomer and New World. The Examining Division will contact the applicant to obtain further information to register the three clock faces that the Board determined are copyrightable.

ADMINISTRATIVE RECORD

Initial Submission and Rejection

On August 7, 2000, the Copyright Office received 14 Form VA applications from Applicant, Timeworks, Inc., to register 14 compilations of graphic images for clock faces, entitled:

1. Bond Street
2. English Astronomer
3. Emily's Garden
4. French Gallery
5. French Hotel
6. Hotel Venetia
7. Italian Harvest
8. Italian Villa
9. New World
10. Old World
11. Paris Expo
12. Running Rabbit
13. Shanghai
14. Swiss Watchmaker

In a letter dated December 28, 2000, from Visual Arts Section Examiner, Helen Livanios, the Examining Division refused registration for all fourteen works on the basis that each of the graphic compilations lack the original artistic authorship necessary for copyright protection.

Ms. Livanios explained that because a compilation is formed by the collection or assemblage of preexisting materials or data, the minimum level of creativity must be based on the selection, coordination and arrangement of the component parts. Ms. Livanios pointed out that Applicant stated in each application that the graphic images are in the public domain and the contribution by the author, Red Bridge, Inc., consists in selection and arrangement. Registration was denied on the basis that each pictorial work is "merely set in traditional layout--within a circular frame with linearly aligned, familiar symbols." She concluded that the level of authorship in the selection and arrangement does not meet the level of creativity required for copyright protection.

First Request for Reconsideration

In a letter dated April 27, 2001, you requested that the Copyright Office reconsider its refusal to register the 14 compilations of graphic drawings. In your letter, you stated that the 14 works are entitled to be registered because they possess the minimum amount of artistic authorship that is necessary for compilations to be copyrightable. You argued that the works demonstrate a sufficient level of selection, coordination and arrangement to merit protection as required by Feist Publications, Inc. v. Rural Tel. Service Co., 499 U.S. 340 (1991), citing cases in which the courts found compilations to be copyrightable. In support of this argument you stated that:

> [T]here are numerous disparate elements that have been selected and arranged to create these works. These elements include the individual background artworks, the clock dials, the borders, and various other miscellaneous graphical images. Not only has Applicant uniquely selected and arranged these graphical images, but Applicant has added creative artistic finishes such a antique washes and crackle texturing that require significant artistic contribution. ... Adapting the background artwork, adding graphical images, and selecting and applying finishes, required significant artistic effort and creativity.

Letter from Malutta to Livanios of 4/27/01, at 2. In closing you stated that Applicant is seeking protection for the particular arrangement of artistic elements in the 14 compilations of graphic images and related artistic efforts, not the idea of arranging numbers in a circle to create a clock face. *Id.* at 2-3, citing. Folio Impressions, Inc. v. Byer California, 937 F.2d 759, 765 (2d Cir. 1991). *Id.*

In a letter dated July 5, 2001, from Attorney Advisor Virginia Giroux, the Examining Division again refused to register the 14 compilations of graphic images because they do not contain the type of selective judgment necessary to support a copyright claim. Ms. Giroux stated that, under 17 U.S.C. § 102(b), the process or technique of antique washing and crackle finishing is not subject to copyright protection. After stating the definition of compilation in 17 U.S.C. § 101, Ms. Giroux stated that compilations are only

copyrightable if they have the minimum level of originality that is required in the selection, arrangement or coordination of elements. She stated that:

> Determinative factors are the presence of editorial judgment in the selection of the information compared to taking all or very little of the material in a given universe, and the arrangement of that material in other than a standard, or mechanical ordering such as an alphabetical, sequential, or chronological arrangement. For example, a compilation of three favorite public domain poems might involve selectivity in choosing which ones to include in the compilation, but the resulting compilation of only three items would not represent enough selectivity to be copyrightable. Therefore, both tests--selectivity and sufficient quantity of selected items--must be met to have a copyrightable compilation. (Citations omitted.)

Letter from Giroux to Malutta of 7/5/01, at 1-2.

Ms. Giroux discussed the requirements of Feist regarding selection, coordination and arrangement. She also discussed the meaning of "coordinated and arranged" in 17 U.S. C. § 101 with regard to book design. *Id.* at 2.

Finding that each of the 14 works of graphic compilations are primarily composed of three basic elements: 1) background artwork; 2) a clock dial and 3) a border, Ms. Giroux stated that there is not sufficient authorship in the selection and arrangement as required by Feist for the works to be copyrightable. She also stated that, "The selection and arrangement of only three items as embodied in each work simply lacks the creative and original authorship necessary to warrant copyright protection." *Id.* at 2.

In closing, she distinguished the cases you cited in support of the copyrightability of the 14 works by finding that the works in the cited cases had sufficient selection, coordination or arrangement of the material or data, in sufficient quantity, to meet the minimum requirements for creativity required by Feist, whereas, Applicant's 14 works do not.

Second Request for Reconsideration

In a second letter requesting reconsideration, dated November 2, 2001, you again requested that the Copyright Office reconsider its refusal to register the 14 compilations. In your second letter, you stated that for a compilation to be eligible for copyright, the selection, coordination and arrangement of the preexisting materials or data must not encompass the entire relevant universe of materials. Warren Pub., Inc. v. Microdos Data Corp., 115 F.3d 1509 (11th Cir. 1997). You also stated that an "author must show that he or she displayed creativity in the selecting [sic] the particular materials comprising the work, as well as in the way he or she arranged those materials." Letter from Malutta to the Copyright Office Board of Appeals of 11/2/01, at 1. In support of this proposition you cited Greenberg v. National Geographic Society, 244 F.3d 1267 (11th Cir. 2001), Publications Intern., Ltd. v. Meredith Corp., 88 F.3d 473 (7th Cir. 1996), Key Publications v. Chinatown Today Pub. Ent., 945 F.2d 509 (2d Cir. 1991). You also stated that courts "have continually minimized the creative originality required for compilations to be granted copyright protection," citing the following cases, CDN, Inc. v. Kapes, 197 F.3d 1256 (9th Cir. 1999); Cantor v. NYP Holdings, Inc.,

51 F.Supp.2d 309 (S.D.N.Y 1999); CCC Information Serv. v. Maclean Hunter Mkt. Rep., 44 F.3d 61 (2d Cir. 1994). *Id.* at 3.

Based on the foregoing criteria, you argued that Applicant has demonstrated sufficient originality in both selecting elements from the available universe and in the way the elements were arranged. In support of that point you cited both Bouchat v. Baltimore Ravens, Inc., 241 F.3d 350 (4th Cir. 2001) and Reader's Digest v. Conservative Digest, Inc., 821 F.2d 800 (D.C.Cir. 1987). Citing Whimsicality, Inc. v. Rubie's Costume Co., Inc., 891 F.2d 452 (2d Cir. 1989), you also stated that the 14 compilations of graphic images are separable from the useful object of a clock into which they will be incorporated. As such, they are copyrightable.

You argued on Applicant's behalf that:

> There are numerous disparate elements [in the 14 compilations of graphic images] that have been selected and arranged to create these works. These elements include the individual background artworks (often a combination of several different graphic elements), the borders, and the various other miscellaneous graphical images. Not only has Applicant uniquely selected and arranged these graphical images from an extremely wide universe of potential choices, but Applicant has also added creative artistic finishes such as antique washes and crackle texturing that require significant artistic contribution. ... Applicant's selection, coordination, and arrangement of these images therefore *is* copyrightable authorship.

Id.

A final point you made for the Office's consideration was to argue that seven similar works by Applicant had been previously registered. On page four you listed those works, and also attached copies of their registrations and deposit material to your letter.

The Appeals Board met on July 29, 2002 to review the 14 clock faces for Applicant's second request for reconsideration. Following that meeting, counsel for the Board sent a letter to you, dated August 6, 2002, requesting clarification regarding the graphics that were used to compile the 14 works. After a second letter of request, dated September 17, 2003, Applicant submitted the requested information in a written response, dated October 17, 2003. Counsel made a second, oral request for further information which you provided by e-mail on December 11, 2003. As part of those responses, Applicant withdrew from the Board's consideration two of the works, New World and Shanghai. Letter from Malutta and Hughes to Coe of 10/17/03, at 3.

DECISION

The Copyright Office Board of Appeals decided that three of the clock faces are copyrightable: Emily's Garden, Paris Expo and Old World. However, after carefully considering the applications and your arguments, the Board is upholding the Examining Division's refusal to register the following nine works: French Gallery, French Hotel, Hotel Venetia, Italian Villa, Running Rabbit, Swiss Watchmaker, Bond Street,

Italian Harvest and Shanghai. Applicant withdrew two works from the Board's consideration: English Astronomer and New World.

The Board of Appeals' decision that the nine clock faces are not copyrightable is not a determination about the aesthetic merits of these works. The analysis used by the Copyright Office to determine copyrightability does not take into account a work's artistic merit or commercial value. The quality of the individual choices in the selection or arrangement of elements in a compilation is not relevant to a determination of whether it is copyrightable. *See* Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 249 (1903) (Where the Supreme Court warned of the dangers of "persons trained only in the law" judging the artistic merits of works.). Here, the Board of Appeals considered only the question of whether there was a sufficient level of choices or complexity in the exercise of judgment that was used in selecting and arranging preexisting materials. Where, as here, the choices involved in selection and arrangement are too few or too obvious, the level of creativity is considered to be *de minimis* which does not meet the minimum requirement for copyrightability. The Board's reasoning for refusing to register the nine clock faces is set forth below.

Compilations

In the applications for the nine clock faces that the Copyright Office Board of Appeals is refusing to register, each of the works is described as a "compilation of graphic images." Each application for the clock faces entitled, French Gallery, French Hotel, Hotel Venetia, Italian Villa, Running Rabbit, Swiss Watchmaker, Bond Street, Italian Harvest and Shanghai, states that the work is a derivative work based on preexisting images in the public domain. The claimant, Timeworks, Inc., is seeking copyright protection for the selection and arrangement of the graphic images.

Under copyright law, compilations of preexisting materials may receive copyright protection. As you identified, the nature of the authorship in a compilation is in its selection and arrangement. The definition of "compilation" states that it is "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101 (Definition of compilation.) Section 103(b) of title 17 of the United States Code underscores the limited nature of a claim to authorship in a compilation. Section 103(b) states that:

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.

An important Supreme Court decision interpreting these statutory provisions is Feist Publications, Inc. v. Rural Tel. Service Co., 499 U.S. 340 (1991). In Feist, the issue before the Supreme Court was whether the selection, coordination and arrangement of telephone white pages were entitled to copyright protection. The Court stated that originality as used in copyright "means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity." *Id.* at 345. The Court explained what originality entails for compilations, saying that, "choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original." *Id.* at 348. "[T]he

principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection." *Id.* at 358. "Originality requires only that the author make the selection or arrangement independently (i.e., without copying that selection or arrangement from another work), and that it displays some minimal level of creativity." *Id.*

However, the Court also cautioned that "not every selection, coordination or arrangement will pass muster." *Id.* at 358. "Presumably, the vast majority of compilations will pass this test, but not all will. There remains a very narrow category of works in which the creative spark is so utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 358-359. "It is equally true, however, that the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever." *Id.* at 362. After finding that the selection, coordination and arrangement of the white pages of a telephone book merely involved listing all subscribers' names alphabetically, the Court stated that, "The end product is a garden-variety white pages directory, devoid of even the slightest trace of creativity. *Id.* "[T]here is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course. It is not only unoriginal, it is practically inevitable. This time-honored tradition does not possess the minimal creative spark required by the Copyright Act and the Constitution." *Id.* at 363.

In your requests for reconsideration, you cited many cases in support of the principle that copyrightability in a compilation must be based on a determination of whether there is adequate creativity in the selection, coordination or arrangement of the work. You also argued that the case law establishes the principle that, with regard to compilations, courts have distinguished between those criteria. Works may be copyrightable on the basis of selection, alone, or on the basis of coordination and arrangement, alone. *See* Warren Pub., Inc. v. Microdos Data Corp., 115 F.3d 1509 (11th Cir. 1997); Greenberg v. National Geographic Society, 244 F.3d 1267 (11th Cir. 2001); Publications International, Ltd. v. Meredith Corp., 88 F.3d 473 (7th Cir. 1996); Key Publications v. Chinatown Today Pub. Ent., 945 F.2d 509 (2d Cir. 1991).

In Feist, the Supreme Court also did a two part analysis of the work which involved separately analyzing selection and arrangement. The Court determined that the telephone white pages failed to be copyrightable on the basis of its selection for two reasons. Feist at 363. Not only was the selection nothing more than a decision to include information for every person for whom telephone service was provided but also state law dictated that the service provider publish the names and telephone numbers of its subscribers. *Id.* Therefore, the Court found that there was very little exercise of judgment in selecting the data. With regard to coordination and arrangement, the Supreme Court decided in Feist that the arrangement of the names of subscribers alphabetically by last name was an "age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course." *Id.* at 363.

The Appeals Board applied a similar analysis to the nine clock faces, entitled, French Gallery, French Hotel, Hotel Venetia, Italian Villa, Running Rabbit, Swiss Watchmaker, Bond Street, Italian Harvest and Shanghai. Although, the Board of Appeals considered each work separately, the nine clock faces that are being denied registration are so similar in their basic selection and arrangement that the same arguments apply to each one.

Coordination and Arrangement

The Board of Appeals concluded that each of the nine works at issue here has an obvious coordination and arrangement that could be characterized as "garden variety." Each compilation of graphic works is arranged to have the appearance of a traditional and customary clock face. Customary numeric symbols, including Roman numerals and Asian characters designating time, are arranged to divide two dimensional circles into equal segments of time based on a 24 hour day. Each clock face also has a few very minor details for borders, including simple lines arranged concentrically, at the edges of the circular areas. Arranged symmetrically, in the center of each clock face, are a few graphic details pertaining to business establishments, such as what appears to be trademarks, business locations or dates of establishment. For three of the works, Hotel Venetia, Italian Villa and Italian Harvest, a portion of public domain paintings was placed into the centers of the faces with no evidence of additional, new authorship to the preexisting paintings. While Hotel Venetia also has a script around the outside edge of the horological border, the text is another public domain graphic. The antique finishes do not exhibit authorship but are the result of aging processes on different types of surfaces. 37 C.F.R. § 202.1. Considering each work as a whole, placing a few public domain graphics in the center of a clock face that has a few simple elements comprising a border is an obvious arrangement.

In support of your argument that the nine clock faces are copyrightable, you cited Reader's Digest v. Conservative Digest, Inc., 821 F.2d 800 (D.C. Cir. 1987). As with these nine clock faces, the work in that case, a magazine cover design, consisted of elements that were not individually copyrightable. In Reader's Digest, the court ruled that the common forms had been combined and arranged in the cover design so that it was a unique graphic design and layout. Whereas the court in that case found the lay out and arrangement sufficiently distinctive to be entitled to protection, the Board of Appeals does not find anything distinctive about the arrangement of public domain elements in the nine clock faces which are rather traditional and customary.

The Board of Appeals concluded that the coordination and arrangement of the nine clock faces is commonplace. The arrangement of elements is so mechanical or routine as to lead to the conclusion that the level of creativity is *de minimis*. The end product of these nine clock faces is so inevitable as to be garden variety.

Selection

The Board of Appeals also determined that the author's exercise of judgment in the selection of the elements that are included in the works is of *de minimis* creativity. Each clock face contains four basic parts for which public domain elements have been selected: a clock dial, a decorative border, an antique finish and miscellaneous graphics in the center of the clock face.

For the clock dials, the characters or symbols that were selected to symbolize the equal division of time in a day does not reflect more than a *de minimis* level of creativity and therefore does not have sufficient originality. Essentially, the choices made for the clock dial in each work are obvious and traditional.

Similarly, the author's selection of the few additional details that are arranged to form a border around, or as part of, the clock dial reflects *de minimis* creativity. There are only a few details in each work. The borders are essentially simple circular lines or else simple hatch marks that appear to indicate the

intervals for seconds, minutes or portions of an hour. One clock face, Hotel Venetia, has text around its horological border which was taken from a public domain text. It was merely rearranged into a circular arrangement around the clock face. The choices involved in each clock face for the borders are very few and too simple or obvious to have more than a *de minimis* level of creativity.

Each clock face also has an antique finish that has markings or shading which add texture to the works. The antique finishes are not only typical for antique clock faces, they are required and, therefore, are an obvious choice. The finish is a single element and, as the product of a process or choice of chemical application, does not represent a sufficient quantum of authorship, certainly not individually nor in conjunction with the few other elements of the clock face designs.

The last major element consists of graphic images placed within the circles of the clock dials, the creativity involved in the selections is also *de minimis*. The clocks have graphics that consist of only a few simple elements that are trademarks and business names or locations. As mentioned before, three of them have artwork that was copied from public domain works without any changes made to them. The type of graphic that appears on the antique clock faces is commonly selected for such use and is therefore *de minimis* in creative expression.

You analogized the selectivity in Applicant's nine clock faces to the work at issue in Key Publications v. Chinatown Today Pub. Ent., 945 F.2d 509 (2d Cir. 1991), in which the author selected from a multitude of businesses to compile a specialized telephone directory. That case is particularly relevant with regard to the selection of graphic images in the nine clock faces. The court in Key Publications stated, "Selection implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation," the court identified two criteria that were the author's basis for exercising judgment in selecting businesses to include in the telephone directory. *Id.* at 513. The author in Key Publications only included businesses that were of interest to Chinese Americans living in New York City. *Id.* She also excluded businesses that she believed would not stay open for long. *Id.* Based on those criteria, the author made many, many choices that required the exercise of judgment.

Unlike the multiplicity of choices made in Key Publications, Applicant's works required very few choices for exercising judgment about which graphic elements to place in the center of each clock face. Selecting a few business names and addresses does not reflect sufficient compilation authorship under Feist. There are no discernable criteria apparent that guided the author to select the graphics for a particular business that is used for each clock, other than that the graphics were in the public domain. Considering (1) the few choices made for the graphics positioned in the center of each work along with the fact that (2) it is not unusual to display graphics relating to a business on clock faces, the Board of Appeals found that the level of creativity is *de minimis*.

Although each of these three basic components of the work do not have sufficient creativity when evaluated separately, the Copyright Office also considered the entirety of selection in each clock face to determine whether there was sufficient creativity as a whole to be copyrightable. However, the Board of Appeals still concluded that each has only a *de minimis* level of creativity. The selection is so minimal and obvious as to be almost mechanical. Even considering the selection involved in each work as a whole, each clock face has only a few traditional or commonplace elements. The choices involved do not require sufficient exercise of judgment to be more than a *de minimis* level of creativity.

In support of your argument that the nine clock faces are copyrightable, you also cite Bouchat v. Baltimore Ravens, Inc., 241 F.3d 350 (4th Cir. 2001). In that case, the court concluded, in *dicta*, without any analysis, that the work was entitled to copyright protection because the public domain elements were sufficiently selected, coordinated and arranged to render the work original. *Id.* at 356. It appears from the discussion that the court was clarifying the basic principle that the copyright claim in a work based on preexisting materials is in the selection, coordination or arrangement. Nevertheless, the issue before the court, on appeal, was not whether the work was copyrightable but whether mistakes or errors in the application to register the work divested the court of its subject matter jurisdiction. Therefore, the court did not provide any analysis relevant to the issues raised here.

Previously Registered Works

You submitted information regarding works previously registered by the Copyright Office that you argue are similar to the works being reviewed here. When the Copyright Office Board of Appeals considers a work, it reviews the work on the basis of whether it has sufficient creative authorship, without regard to other registered works. A previously registered work that is not before the Board is not relevant to its considerations. The Copyright Office does not compare applications for copyright registrations to previous registrations. Compendium of Copyright Office Practices, Compendium II, § 108.03 (1984).

CONCLUSION

The Copyright Office Board of Appeals decided that the following three titles meet the minimum standard for creativity to be copyrightable: Emily's Garden, Paris Expo and Old World. However, for the reasons stated in this letter, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register the nine clock faces, entitled, French Gallery, French Hotel, Hotel Venetia, Italian Villa, Running Rabbit, Swiss Watchmaker, Bond Street, Italian Harvest and Shanghai. This written decision constitutes final agency action on this matter.

As stated at the beginning of this letter, the Examining Division will contact the applicant to obtain further information for registering the three clock faces that the Board determined are copyrightable.

Sincerely,

/s/

Marilyn J. Kretsinger
Associate General
for the Appeals Board
United States Copyright Office