United States Copyright Office
Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

June 9, 2004

Robert M. Angus, Esq.
Westman, Champlin & Kelly
Suite 1600, International Centre
900 Second Ave., South
Minneapolis, Minnesota 55402-3319

RE: Your File No. M86.32-0001
Titles & Control Nos.: Tennis Tail - Raccoon Collection 60-908-7329(M)
Tennis Tail - Fox Collection 60-908-6417(M)
Fido's Favorites Tennis Tail - Squirrel Collection
60-905-6609(M)

Dear Mr. Angus:

I am writing on behalf of the Copyright Office Board of Appeals in response to your three letters, each dated January 7, 2003, each requesting the Office to reconsider its refusal to register one of three dog toys, entitled "Tennis Tail - Raccoon Collection," "Tennis Tail - Fox Collection" and "Fido's Favorites Tennis Tail- Squirrel Collection." (Hereinafter, collectively referred to as "Tennis Tail Collections.") The Board of Appeals affirms the Examining Division's refusal to register these three works.

ADMINISTRATIVE RECORD

Initial Submission

On February 9, 2001, Charles D. Mann submitted an application to register a dog toy, called Fido's Favorites Tennis Tail- Squirrel Collection. On July 9, 2001, Mann Design, Ltd., submitted two additional applications for dog toys called, Tennis Tail - Raccoon Collection and Tennis Tail - Fox Collection. Each of these works was reviewed for compliance with registration guidelines by a different person. In letters dated August 9, 2001, October 25, 2001 and November 1, 2001, Joanna Corwin, William R. Briganti and Helen Livanios, respectively, all examiners in the Examining Division, each refused to register one of these works for the same reason. They each concluded that the work he or she examined does not have sufficient creativity to satisfy the low level of originality required to be copyrightable. Ms. Corwin and Mr. Briganti each stated that the tags for the Squirrel and Fox Tennis Tail Collections do have copyrightable authorship.

First Request for Reconsideration

In a letter dated November 19, 2001, you submitted a first request for reconsideration in response to the Examining Division's initial refusal to register the Tennis Tail Collections. You addressed the initial refusals for all three works in the same correspondence, although each had been separately reviewed, by the Examining Division. You discussed OddzOn Products, Inc. v. Oman, 924 F.2d 326 (D.C. Cir. 1991) as a case in which the court ruled that the tactile aspect of the work at issue there, a koosh ball, was not copyrightable. The court also ruled that the spherical work was not copyrightable because it is a familiar symbol or design without creative authorship. You argued that unlike the koosh ball, Tennis Tail Collections, are not familiar symbols or designs.

You challenged the basis of the Examining Divisions refusals because you argued that the Tennis Tail Collections should be considered as a whole rather than being evaluated on the basis of their individual components, the tennis ball and faux tails. Citing Feist Publications, Inc. v. Rural Telephone Service Company, 499 U.S. 340 (1991) and Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49 (2d Cir. 1936), you observed that to be copyrightable a work must be both original and creative. Moreover, you asserted that courts have interpreted originality to mean that a work is original to an author and that the level of requisite creativity is very low. You stated that the Tennis Tail Collections are animal chew toys that should be considered as three dimensional sculptures. You stated that they combine spheres, resembling a tennis ball, with furry tails resembling those of a fox, squirrel and racoon that are arranged symmetrically.

Fox Tennis Tail **Raccoon Tennis Tail** **Squirrel Tennis Tail**



You also stated that the color of the ball is selected to complement the color of the faux tail. Therefore, you argued, "the visual perception of the resulting work is neither a ball, nor an animal tail, and is not a familiar shape or design as addressed in OddzOn." Appeal brief accompanying letter from Angus to the Copyright Office of 11/19/01, at 3.

Following her review of these three works in light of the points made in your first request for reconsideration Virginia Giroux, Attorney Advisor, Examining Division, again refused, in a letter dated September 17, 2002, to register the Tennis Tail Collections on the basis that each lacks sufficient original authorship. She noted that it was not the idea of the works or the material of which they are made that is the basis for the refusal. She stated that the Copyright Office considers the elements of a work either alone or in combination to evaluate whether a work has the minimum level of creativity to be copyrightable. While Ms Giroux did not disputed that these dog toys are works of art, she observed that even a work of art "must still contain copyrightable authorship." Letter from Giroux to Angus of 9/11/02, at 1. She described the works as, "chew toys for dogs, [which consist] in each case of a sphere made to resemble a tennis ball with seams combined with a fake fur tail made to resemble either the tails of a fox, raccoon, or squirrel."

Following her examination of these works, she determined that they were too simple and unadorned to be copyrightable. She concluded that the design of the works is *de minimis*. Ms. Giroux responded to the cases you cited by saying that OddzOn is applicable to the issues here because it also involved a work that was based on a common shape or symbol that lacked sufficient creativity. She emphasized that the Office does not refuse to register works on the basis that they incorporate preexisting materials. The decision is based on the result of how those elements are combined. In conclusion, she stated that a work may be novel, unique, interesting or may require substantial time, effort and expense to create or may be commercially valuable, but that is not relevant to whether it has sufficient creative authorship to be copyrightable.

Second Request for Reconsideration

On January 7, 2003, you submitted three appeal briefs, one for each Tennis Tail Collection, to the Copyright Office Board of Appeals requesting a second reconsideration. You explained that for each of the works, the faux tail is not an actual representation of a particular species of fox, racoon or squirrel. You said that the tails are attached by a cord extending diagonally through a ball in a central portion of the loop of the ball "seam," so that it is symmetrical to the seam pattern. The ball is an elastomeric ball that is made to resemble a tennis ball by adding a seam pattern. After reviewing the rationale the Examining Division gave for refusing registration, you disagreed with the assertion by Ms. Giroux that the work at issue in OddzOn is similar to Tennis Tail Collections. You cited Dollcraft Industries, Ltd. v. Well-Made Toy Mfg. Co., 479 F.Supp. 1105 (E.D. N.Y. 1978) in support of registering the Tennis Tail Collections on the basis that its ruling supports finding copyrightability based on the combination of elements rather than individual parts. You argued that:

> Like the toy animals in Dollcraft, [each Tennis Tail Collection] takes features readily available and combines them together to form a new work of art. . . . Also, [each Collection] displays creativity in

> the way the two elements are located and oriented. The symmetry between the tail and the "seams" of the ball due to the positioning of the cord through the ball shows more than a trivial amount of intellectual labor.
>
> The original combination of a fake fur tail with a public domain elastomeric sphere possesses unique features because these two elements are not normally associated with each other. In addition, the means, location and orientation of the fake fur tail attached to the elastomeric sphere show at least a minimal amount of creativity necessary to support copyright registration.

Appeal Brief accompanying letter from Angus to Copyright Office Board of Appeals of 1/7/03, at 4.

You analogized the Tennis Tail Collections to the works at issue in E. Mishan & Sons, Inc. v. Marycana, Inc., 662 F.Supp. 1339 (S.D. N.Y. 1987), arguing that, like the kitchen magnets at issue there, Tennis Tail Collections are assembled from commercially available materials. However, you asserted that Tennis Tail Collections have even more creativity because, unlike the kitchen magnets, they are not made of stylistic elements in long-familiar items rather each is a "fanciful abstraction dominated by two selected items not usually associated with each other." *Id.* at 5. You characterized the combination in the Tennis Tail Collections as an "abstractive degree of elements" which is "beyond the similar and long-familiar selection of materials" described in E. Mishan. *Id.*

You also contrasted Tennis Tail Collections to the crystal sculptures at issue in M&D International Corp. v Chan, 901 F.Supp. 1502 (D. Haw. 1995) in which the court ruled that the selection and arrangement of stock pieces were mechanical and inevitable. You distinguished Tennis Tail Collections on the basis that the author selected elements that are "unlike and unassociated." *Id.* Rather, Tennis Tail Collections are compiled of elements "selected from collections without boundaries." *Id.* "The particular elements, the pseudo-tennis ball and fake fur tail, are the resulting expression that is more than a mere trivial variation of the public domain elements." *Id.*

DECISION

After reviewing the application and arguments you presented, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register the Tennis Tail Collections. The Board has determined that none of the works contains the requisite creativity to be copyrightable.

Copyright protection is only available for "original works of authorship." 17 U.S.C. §102(a). The Supreme Court stated that originality consists of two elements, "independent creation plus a modicum of creativity." Feist at 346. Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102 (2nd Cir. 1951) ("'Original' in reference to a copyrighted work means that the particular work 'owes its origin' to the 'author.' No large measure of novelty is necessary."); Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884) (The court defined "author" to mean the originator or original maker and described copyright as being limited to the creative or "intellectual conceptions of the author.").

Even prior to Feist, which was decided in 1991, courts interpreted "original" as requiring a low level of required creativity. Any "distinguishable variation" of a work constituted sufficient originality as long as it was the product of an author's independent efforts, and is "more than a 'merely trivial' variation." Alfred Bell & Co. v. Catalda Fine Arts, at 102-103; Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250 (1903). In Alfred Bell, the Court stated originality for copyright purposes amounts to "little more than a prohibition of actual copying." Alfred Bell, at 103.

However, at the same time that the Supreme Court reaffirmed in Feist the established precedent that only a modicum of originality is required for a work to be copyrightable, it also emphasized that there are works in which the "creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359. Such works are incapable of sustaining copyright protection. *Id.* (citing Nimmer on Copyright.) The Court observed that "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity," *Id.* at 363, and that there can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359. A work that reflects an obvious arrangement fails to meet the low standard of minimum creativity required for copyrightability. *Id.* at 362-363. An example would be alphabetical listings in white pages of telephone directories, the type of work at issue in Feist, which the Supreme Court characterized as "garden variety...devoid of even the slightest trace of creativity." *Id.* at 362.

Even before Feist, Copyright Office registration practices recognized that some works of authorship have a *de minimis* amount of authorship and, thus, are not copyrightable. *See* Compendium II, §202.02(a), (1984). With respect to pictorial, graphic and sculptural works, which are Class VA works, the class to which the cut glass and fluted designs on the tumblers belong, §503.02(a) of Compendium II states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class."

A corollary requirement of copyright law is that there is no protection for familiar designs, shapes or patterns or basic designs, like numbers or letters. 37 C.F.R. §202.1. In addition to incorporating that prohibition, Compendium II, which provides detailed instructions for Copyright

Office procedures, is also based on the principle that creative expression is the basis for determining whether a work is copyrightable, not an assessment of aesthetic merit. Section 503.02(a) of Compendium II states that:

> Copyrightability depends upon the presence of creative expression in a work, and not upon aesthetic merit, commercial appeal, or symbolic value. Thus, registration cannot be based upon the simplicity of standard ornamentation such as chevron stripes, the attractiveness of a conventional fleur-de-lys design, or the religious significance of a plain, ordinary cross. Similarly, it is not possible to copyright common geometric figures or shapes such as the hexagon or the ellipse, a standard symbol such as an arrow or a five-pointed star. Likewise, mere coloration cannot support a copyright even though it may enhance the aesthetic appeal or commercial value of a work.. . . The same is true of a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations.

The Office does not evaluate the aesthetic qualities of works. A work may be highly valued for its aesthetic appeal and, yet, not be copyrightable. Rather, copyright law requires evidence of more than a *de minimis* level of authorship in selection, coordination and arrangement. Works based on public domain elements may be copyrightable if there is some distinguishable element in their selection or arrangement that reflects choices and authorship and that is not so obvious or so minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." Feist at 359.

Although the individual components of a given work may not be copyrightable, the Copyright Office follows the principle that works should be judged in their entirety and not judged in terms of the protectibility of individual elements within the work. Atari Games Corp. v. Oman, 979 F.2d 242, 244-245 (D.C. Cir. 1992). After carefully considering your descriptions and discussion of Tennis Tail Collections, the Board determined that the elements you identified are not copyrightable, either individually or taken as a whole.

The analysis followed in the Office's examining procedure for determining whether there is sufficient creativity for copyright protection does not involve comparing works. Compendium II, §108.03. Rather, registrability is determined by the merits of each work without comparison to prior art or other existing works. It may be that Tennis Tail Collections are very unique. However, they do not necessarily meet the standard of creativity required for copyright protection.

The Tennis Tail Collections each consist of two common shapes or figures. Each includes a tail, which you acknowledge is generic in appearance for each work. Appeal Brief from Angus to Copyright Office Board of Appeals of 1/7/03, at 2, and a ball that looks similar to a tennis ball. The level of creativity in the Tennis Tail Collections is *de minimis*, taking their components separately or considered together as a whole. The selection and arrangement of these two common shapes involves little creative authorship. Considering that these are toys for animals, such as, dogs, it may even be argued that the choice and arrangement is obvious or garden variety.

There is substantial support for the Board's conclusion in cases in which courts have ruled in favor of the Copyright Office's application of the principles enunciated herein. Homer Laughlin China Co. v. Oman, 22 USPQ2d 1074 (D. D.C. 1991) (upholding refusal to register chinaware design pattern composed of simple variations or combinations of geometric designs due to insufficient creative authorship to merit copyright protection); Jon Woods Fashions, Inc. v. Curran, 8 USPQ2d 1870 (S.D. N.Y. 1988) (upholding refusal to register fabric design consisting of striped cloth with small grid squares superimposed on the stripes where Register concluded design did not meet minimal level of creative authorship necessary for copyright); John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986) (upholding refusal to register a logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below, noting that the design lacked the minimal creativity necessary to support a copyright and that a "work of art" or a "pictorial, graphic or sculptural work ... must embody some creative authorship in its delineation of form."); Magic Marketing, Inc. v. Mailing Services of Pittsburgh, Inc., 634 F.Supp. 769 (W.D. Pa. 1986) (envelopes with black lines and words "gift check" or "priority message" did not contain minimal degree of creativity necessary for copyright protection); Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958) (cardboard star with two folding flaps allowing star to stand for retail display not copyrightable work of art); and Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F.Supp. 964 (E.D. N.Y. 1950) (a label with words "Forstmann 100% Virgin Wool" interwoven with three *fleur-de-lis* found not copyrightable).

Among the cases you cited, OddzOn Products, Inc. v. Oman and M&D International Corp. v. Chan have facts comparable to the work at issue here. The koosh ball in OddzOn Products was found to be not copyrightable because it had the familiar shape of a sphere. Similarly, the Tennis Tail Collections are each comprised only of two familiar shapes, a sphere and a tail. The addition of a tail that is symmetrically arranged on the sphere, an arrangement that is almost universal for tails in the natural world, is not sufficient authorship to be copyrightable. M&D International is somewhat comparable because, in that case, the court found that the few components available for the crystal sculptures and the particular designs of those components, limited the possible arrangement of sculptures so that selecting and arranging them was almost mechanical and the results were predictable. The arrangement of the tails on a ball, which has the familiar appearance of a tennis ball, is predictable. Also, the selection and combination of a ball and an animal part, such as the tail, to be a toy for dogs is a garden variety choice.

The other cases you cite, Dollcraft Industries, Ltd. v. Well-Made Toy Mfg. Co. and E. Mishan & Sons, Inc. v. Marycana, Inc. are distinguishable from the facts in this case. The works at issue in those cases, the dolls' features and the kitchen magnets, all involved more complex facts and the works had many elements, unlike Tennis Tail Collections. In Dollcraft Industries, the court was considering the bodies, arms, legs, eyes, noses, mouths and ears that were used in the stuffed animal market. In E. Mishan & Sons, the kitchen magnets included verse, imitation flowers, calico or gingham fabrics, lace and magnets.

The Board is unable to discern authorship in the Tennis Tail Collections, considered individually or as a whole, that is more than merely trivial. The elements you identified do not have the requisite *de minimis* amount of authorship, either individually or taken as a whole. However, the Board agrees that the tags on Tennis Tail Collections are copyrightable, if the Applicant would like to register those.

For the reasons stated in this letter, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register Tennis Tail Collections. This written opinion constitutes final agency action on this matter.

Sincerely yours,

/s/

Marilyn J. Kretsinger
Associate General Counsel