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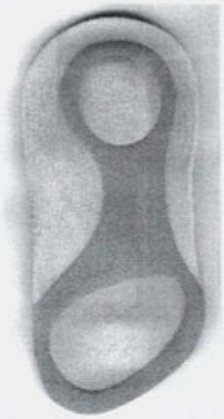
Re: TRIAD-GRAY Fabric Design
Copyright Office Control No. 61-213-7152 (J)

Dear Mr. Vranum:

I write on behalf of the Copyright Office Review Board ("Board") in response to your letter dated January 30, 2004 in which you requested a second reconsideration of the Copyright Office's ("Office") refusal to register a fabric design entitled "Triad-Gray." The Board has carefully examined the application, the deposit and all correspondence concerning this application, and affirms the denial of registration of this work.

I. DESCRIPTION OF WORK

The design at issue is imprinted on the fabric surface of a shoe insole, and as such, is a modified, elongated oval which follows the contours of a typical shoe. The background of the design consists of solid, light gray fabric. In its center appears a dark gray oval, the middle of which is concave and the wider, bottom of which meets the outside edge of the insole, following the general contours of a footprint. Two modified oval "cut-outs" appear within the dark gray shape, reveal the light gray background and track the pressure points of the ball and heel of a foot.



II. ADMINISTRATIVE RECORD

A. Initial Application and Office's Refusal to Register

On December 12, 2002, the Office received a Form VA application from William H. Cox of your firm on behalf of your client, Professional Product Research, Inc., to register a fabric design. In a letter dated March 17, 2003, Visual Arts Section Examiner Joy Mansfield refused registration of this work because she determined it lacks sufficient creative authorship, within the meaning of the copyright statute and settled case law, to support a copyright claim. (Letter from Mansfield to Cox of 3/17/03, at 1.)

Ms. Mansfield explained that copyright protects original works or authorship, where the term original means that the author independently created the work and that the work possesses at least a minimal degree of creativity. (*Id.*) (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)). She noted, however, that copyright does not protect familiar symbols or designs, basic geometric shapes, coloring, ideas or concepts which may be embodied in a work. (*Id.*) (citing 37 C.F.R. § 202.1 (2004) and 17 U.S.C. § 102(b) (2003)). Ms. Mansfield also explained that neither the aesthetic appeal or commercial value of a work, nor the amount of time and effort expended to create a work are factors to be considered under the copyright law. (*Id.*) (citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903)).

B. First Request for Reconsideration

In a letter dated July 15, 2003, you requested reconsideration of the Office's refusal to register the work. (Letter from Vranum to Examining Division of 7/15/03, at 1.) After summarizing the facts and holding in *Feist*, you concluded that such case was inapplicable to the instant application for copyright registration. You argued that the circumstances are clearly different because *Feist* considered a compilation of facts, whereas the subject fabric design consists of "contrasting colors in particular shapes" which contain "a degree of creativity." (*Id.* at 2.) You noted that your client carefully considered, selected and configured the patterns and colors to appeal to consumers, and could have adopted many possible alternative color schemes and design patterns. (*Id.*) To illustrate your point, you included numerous photocopies of other fabric designs appearing on competing products. Finally, you stated that "the Profoot design was independently created and is not copied from any other product or design." (*Id.* at 3.)

C. Examining Division's Response to First Request for Reconsideration

In response to your request and in light of the points raised in your letter of July 15, 2003, Attorney Advisor Virginia Giroux of the Examining Division reexamined the application and determined that this work is a useful article that does not contain any separable authorship which is copyrightable. Ms. Giroux explained in a letter dated October 3, 2003 that with respect to a useful article or part thereof, which by definition has an intrinsic utilitarian function that is not merely to portray the appearance of the article, the design is copyrightable:

> only if and to the extent that such design incorporates pictorial, graphic, or sculptural features that can be identified separately from and are capable of existing independently of the utilitarian aspects of the article without losing its basic shape.

(Letter from Giroux to Vranum of 10/3/03, at 1.) She noted that such separability could exist either physically or conceptually. Ms. Giroux explained that conceptual separability occurs when the pictorial, graphic or sculptural features of the work can, for example, be visualized on paper or as a free-standing sculpture, independent of the shape of the utilitarian article, without destroying the basic shape of the article, such as with respect to a carving on the back of a chair or pictorial matter engraved on a glass vase. (*Id.* at 2) (citing *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied,* 440 U.S. 908 (1979), *Compendium II: Compendium of Copyright Office Practices* § 505.03 (1984) ("*Compendium II*")).

She explained, however, that the test for conceptual separability is not met by merely analogizing a useful article to a work of modern sculpture. Ms. Giroux further noted that even if certain features are non-functional or could have been designed differently, copyright registration is not possible where such features are an integral part of the overall shape or contour of the useful article. She then recounted the holding in *Esquire* wherein the court upheld the Office's refusal to register the shape of a utilitarian outdoor lighting feature, even though it did incorporate some aesthetically pleasing features. In further support of the limits imposed on the copyrightability of useful articles, she also cited *Norris Indus., Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir. 1983), *cert. denied,* 464 U.S. 818 (1983) (holding a wire-spoke wheel cover was not copyrightable because it did not contain any separable sculptural design).

Finally, Ms. Giroux referenced several factors that do not bear upon the Office's determination of copyrightability, including a work's aesthetics, the materials used in a design, a work's visual effect, appearance or commercial success, nor the time and effort expended to create the work. (*Id.* at 1.) She also explained that the possibility of design choices does not determine copyrightability, but rather whether the resulting product contains copyrightable authorship. (*Id.* at 3.)

Evaluating the work at issue, Ms. Giroux concluded that it is a useful article that does not contain any design elements that could be regarded as copyrightable. (*Id.* at 2.) Ms. Giroux expressed her belief that the fabric design provided foot support and was therefore not entirely independent of the insole's utilitarian aspects. (*Id.*) Even if the design were separable from such aspects, Ms. Giroux explained that a design consisting of a simple combination of three geometric shapes in three shades of gray is not copyrightable, and cited the 37 C.F.R. § 202.2, the *Compendium II* and several cases to support this proposition. (*Id.* at 2-3) (citing *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986), *Forstmann Woolen Co. v. J.W. Mays,* Inc., 89 F. Supp. 964 (E.D.N.Y. 1950), *Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q. 1074 (D.D.C. 1991) and *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988)). She also referred you to *Scoa Indus., Inc. v. Famolare, Inc.*, 192 U.S.P.Q. 216 (S.D.N.Y. 1976), where the court found the wavy lines on the sole and side of a shoe to be insufficiently creative to support a copyright. (*Id.* at 3.) Ms. Giroux concluded that although a slight amount of creativity will suffice to obtain copyright protection, the subject insole fabric design falls within the narrow category of works which do not possess the minimum creative spark. (*Id.*)

D. Second Request for Reconsideration

In a letter dated January 30, 2004, you asked the Office to reconsider for a second time its refusal to register the copyright claim in the Triad-Gray fabric design. (Letter from Vranum to Board of 1/30/04, at 1.) You explained that the design imprinted on the insole "bear[s] no relationship to the function of the item as an insole," and cited the fact that other insoles use alternative designs as evidence that the design at issue is not functional with respect to the utility of the insole. (*Id.* at 1-2.) Rather, you argued that the design is ornamental, separable and copyrightable, citing *Norris Indus.* in support. (*Id.* at 2.) You explained that the utilitarian design of the insole lies in its foam construction, not the decorative design imprinted on it, even though such design draws attention to the utilitarian function of the insole. (*Id.* at 2-3.) You stated that without the design, "the insole would still perform its utilitarian function." (*Id.* at 3.) You noted that the design could also be printed on non-utilitarian media such as paper, t-shirts, caps or pins, and cited *Kieselstein-Cord v. Accessories By Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980) and *Pivot Point Int'l v. Charlene Products, Inc.*, 170 F. Supp. 2d 828, 833 (N.D. Ill. 2001) to support your argument that copyright registration is proper in such a case. (*Id.* at 3.) You distinguished *Esquire* which the Office previously cited to you, because you explained that the present applicant seeks to register the design which is imprinted on the article, not the overall shape of the article itself. (*Id.*)

Responding to the Office's determination that the fabric design also does not contain sufficient authorship to sustain a registration, you argued that the design at issue is not the type of item referenced in 37 C.F.R. § 202.1 (material not subject to copyright), and involves more

creativity than a mere variation of coloring. (*Id.* at 4.) You reiterated *Feist*'s articulation of the low requisite level of creativity, and argued that the present design meets the applicable standard. You further argued that the "patterns and colors of the design were carefully considered by Profoot, and selected to be visually appealing." (*Id.* at 2.) You stated that the decisions involved in selecting the colors and patterns constitute sufficient creativity within the meaning of *Feist,* and that the infinite number of design possibilities demonstrates creative effort. (*Id.* at 5.) You cautioned that subjective determinations of what constitutes "art" should not bear on whether a work receives copyright protection, and cited *Bleistein* in support. (*Id.* at 4.) Finally, you reiterated that the design "was independently created and is not adopted or copied from any other product or design." (*Id.* at 5.)

III. DECISION

A. Useful Articles

As a general proposition, copyright protection does not extend to a useful article, defined as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. A shoe insole or other orthotic device qualifies as a useful article. However, works of artistic craftsmanship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic or sculptural works pursuant to 17 U.S.C. § 102(a)(5). This protection is limited, though, in that it extends only "insofar as their form but not their mechanical or utilitarian aspects are concerned." *Id.* § 101. The design of the useful article will be protected "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.* The requisite separability can be physical or conceptual.

In response to Ms. Giroux's letter of October 3, 2003, you have clarified that the applicant does not seek copyright registration of the insole itself or its overall shape, but rather only the fabric design imprinted on the top of the insole. (Letter from Vranum to Board of 1/30/04, at 2-3.) This clarification is consistent with the December 12, 2002 application's designation of the work's "nature of authorship" as "2-Dimensional artwork" as opposed to a three-dimensional object. You also assert in several instances that the fabric design at issue is ornamental and non-functional. (Letter from Vranum to Board of 1/30/04, at 1-3.) The Office accepts your assertion at face value for it has no evidence to the contrary.

Because this clarification renders no functional component of the insole to be presently at issue, the Board need not discuss in detail the legal parameters of the limited copyrightability of useful article components. It suffices for the record to state that should the applicant have sought to register the general contours of the insole itself or were the fabric design to have had a

functional component, *e.g.*, the placement of different types of fabric at particular pressure points in the insole affected foot support, the Board would have had to refuse registration of such a useful article.[1]

B. Original Works of Authorship

Regardless of utility, all copyrightable works, be they fabric designs or otherwise, must qualify as "original works of authorship." 17 U.S.C. § 102(a). The term "original" consists of two components: independent creation and sufficient creativity. *Feist*, 499 U.S. at 345. First, the author must have independently created the work, *i.e.*, not copied it from another work. The Office accepts your assertion that the present "design was independently created and is not adopted or copied from any other product or design." (Letter from Vranum to Board of 1/30/04, at 5; *see also*, Letter from Vranum to Examining Division of 3/17/03, at 3.) Therefore, this prong of the originality analysis is not at issue herein. Second, the work must possess sufficient creativity. In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the standard set forth in *Feist*, 499 U.S. at 345, where the Supreme Court held that only a modicum of creativity is necessary. Although, as you mention, *Feist* evaluated a compilation of facts rather than a fabric design, (letter from Vranum to Examining Division of 3/17/03, at 2), the Court articulated the basic principles of originality applicable to all copyrightable works, regardless of their form.

You properly note that the requisite level of creativity to sustain a copyright is extremely low, (letter from Vranum to Examining Division of 7/15/03, at 2), but the *Feist* Court also ruled that some works (such as the work at issue in that case) fail to meet the standard. 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," 499 U.S. at 363, and that there can be no copyright in work in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359; *see also*, 37 C.F.R. § 202.10(a) ("In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form."); 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.01(b) (2002) ("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.").

Even prior to the *Feist* Court's decision, the Office recognized the modest, but existent, requisite level of creativity necessary to sustain a copyright claim. *Compendium II* states, "Works that lack even a certain minimum amount of original authorship are not copyrightable."

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[1] If a "function" of this design is to indicate that the insole on which it appears was manufactured by Profoot and not some other competitor, then the design may be eligible for trademark protection, but this potential function does not form a proper basis for copyright protection.

Compendium II, *supra*, § 202.02(a). With respect to pictorial, graphic and sculptural works, *Compendium II* states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Id.* § 503.02(a).

In implementing this threshold, the Office and courts have consistently found that standard designs, figures and geometric shapes are not sufficiently creative to support a copyright claim. *Id.* § 503.02(a) ("[R]egistration cannot be based upon the simplicity of standard ornamentation . . . . Similarly, it is not possible to copyright common geometric figures or shapes . . . .").[2] Moreover, making minor alterations to these otherwise standard shapes will not inject the requisite level of creativity. *Id.* § 503.02(a) ("[Registration cannot be based upon] a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations.").

Of course, some combinations of common or standard forms contain sufficient creativity with respect to how they are combined or arranged to support a copyright. *See, Feist*, 499 U.S. at 358 (the Copyright Act "implies that some 'ways' [of compiling or arranging uncopyrightable material] will trigger copyright, but that others will not"; determination of copyright rests on creativity of coordination or arrangement). However, merely combining non-protectible elements does not automatically establish creativity where the combination or arrangement itself is simplistic. For example, the Eight Circuit upheld the Register's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in cursive script below the arrow. *John Muller & Co. v. New York Arrows Soccer Team*, 802 F.2d 989 (8th Cir. 1986). *See also*, *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) ("It is true, of course, that a *combination* of unprotectable elements may qualify for copyright protection. [Citations omitted.] But it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.") (emphasis in the original). After again examining the present fabric designs and in light of the above-described legal framework, the Board has determined that this work does not embody sufficient creativity to support a copyright registration.

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[2] *See also, id.* § 202.02(j) ("Familiar symbols or designs, and mere variations of typographic ornamentation, lettering, or coloring, are not copyrightable."); *Id.* § 503.03(b) ("No registration is possible where the work consists solely of elements which are incapable of supporting a copyright claim. Uncopyrightable elements include common geometric figures or symbols, such as a hexagon, an arrow, or a five-pointed star . . . ."); 37 C.F.R. § 202.1(a) ("[F]amiliar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained.").

The "Triad-Gray" design consists primarily of overlaid ovals. As explained in detail above, common shapes are in the public domain and not afforded copyright protection. It is immaterial whether such shapes are rigidly geometric or more fluid, as evidenced by the court refusing to extend copyright protection to wavy lines appearing on the sole or side of a shoe. *Scoa Indus., Inc. v. Famolare, Inc.*, 192 U.S.P.Q. 216 (S.D.N.Y. 1976). The fact that the design features two[3] shades of gray cannot provide a copyrightable basis, first because gray variations possess little creativity and second because coloring itself is not sufficient to support a copyright registration. 37 C.F.R. § 202.1(a). The Office does recognize that these ovals are somewhat modified or abstract, but minor variations to common geometric shapes will not by themselves inject the requisite amount of creativity, especially where such variations appear to be dictated by factors other than artistic concerns (*e.g.*, to "draw[] attention to the utilitarian function of the insole," (letter from Vranum to Board of 1/30/04, at 3.)).

Section 503 of *Compendium II* states, "If the work consists entirely of uncopyrightable elements, registration is not authorized." Because this fabric design consist entirely of a common geometric shape in two shades of gray, the only means by which these non-protectible elements could possibly sustain a copyright would be if their particular combination or arrangement exhibited a sufficient level of creativity. Unfortunately, they do not. Even when the constituent elements are viewed in combination, the designs consist only of overlaid ovals highlighting the pressure points of a foot. Such a simplistic arrangement of a non-protectible shape cannot rise to the requisite level of creativity. *See, Compendium II, supra,* § 503.02(b) ("[T]he creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations.").

The present fabric design, regardless whether it is evaluated as a whole or by constituent elements, consists entirely of non-protectible shapes in an insufficiently creative arrangement. Therefore, copyright protection is simply not available for this work.

C. Other Considerations

Several other factors that you argue, while perhaps important on personal or commercial levels, have no bearing on the Office's determination of whether or not copyright registration is available for this work. For example, you state that the "patterns and colors of the design were carefully considered by Profoot, and selected to be visually appealing." (Letter from Vranum to Board of 1/30/04, at 2; *see also*, Letter from Vranum to Examining Division of 7/15/03, at 2 ("The patterns and colors were carefully considered by Profoot, and selected and configured to appeal to the consumer of the product.").) While these statements may well be true, aesthetic

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[3] Two shades of gray appear in the deposit material, although the title of the work suggests that the actual insole features three shades. Even if the actual number of shades is three, the analysis and conclusion remain unaltered.

value or commercial appeal of a work cannot be considered in determining whether a work is copyrightable. *See, Compendium II, supra*, § 503.02(b) ("The requisite minimal amount of original sculptural authorship necessary for registration in Class VA does not depend upon the aesthetic merit, commercial appeal, or symbolic value of a work.") Similarly, the amount of time and effort your client expended in selecting the design is immaterial to a copyrightability analysis. *See, Feist* 499 U.S. at 359-60 (finding the "Sweat of the Brow" does not bear on whether copyright protection is available for a work).

You also argue that "Profoot could have adopted many possible alternative color schemes and design patterns," (letter from Vranum to Examining Division of 7/15/03, at 2), and included numerous examples of other fabric designs for competitors' insoles. You state that "[t]he choices made in creating the design at issue, deriving from an infinite number of possibilities[,] demonstrates creative effort." (Letter from Vranum to Board of 1/30/04, at 5.) However, the copyrightability of a work is based on the creativity that is actually embodied in the work, not the number of possibilities nor the effort expended in the selection process.

IV. CONCLUSION

For the reasons stated herein, the Copyright Office Review Board affirms the refusal to register the fabric design, "Triad-Gray." This decision constitutes final agency action on this matter.

Sincerely,

/s/

Marilyn J. Kretsinger,
Associate General Counsel
for the Review Board
United States Copyright Office