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

July 9, 2007

Butzel Long
Attn: Christopher M. Taylor
350 South Main Street, Ste. 300
Ann Arbor, Michigan 48104

Re: ULTRA MESH SIDE PANEL FABRIC DESIGN
Copyright Control Number: 61-403-4605(B)

Dear Mr. Taylor:

I write on behalf of the Copyright Office Review Board (Board) in response to your letter, received on September 5, 2006, in which you requested a second reconsideration of the Copyright Office's (Office) refusal to register a fabric design entitled ULTRA MESH SIDE PANEL FABRIC DESIGN. 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 THE WORK

"ULTRA MESH SIDE PANEL FABRIC DESIGN," a design on the surface of a shirt, consists of a series of vertical black and white stripes of mostly uniform width. In general, the design can be identified as the sort commonly found on a shirt worn by a sports referee. The difference being the side panel, located in an area running below the sleeve, which consists of a 1" white/3" black/1" white section. A photographic image of "ULTRA MESH SIDE PANEL FABRIC DESIGN" appears below:



II. ADMINISTRATIVE RECORD

A. Initial Submission and Office's Refusal to Register

On June 10, 2005, the Copyright Office received a Form VA application along with the required deposit and fee for the work: "ULTRA MESH SIDE PANEL FABRIC DESIGN" ("the Design"). The submission was made by Beth F. Kinnaird on behalf of your client, Cliff Keen Athletic. In a letter dated November 9, 2005, Supervisory Copyright Examiner, William R. Briganti, refused registration of the Design (Letter from Briganti to Kinnaird of 11/9/05). Mr. Briganti found that the Design was a "useful article" and that while it does contain certain separable features, they are not copyrightable.

Mr. Briganti noted that in order for a work to be copyrightable, it must find its origin or source with the author and contain a certain amount of creative authorship. Citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), he added that the determination of whether a work is copyrightable has nothing to do with aesthetic or commercial value.

In determining that the Design was not copyrightable, Mr. Briganti cited the Supreme Court's discussion of the Copyright Act's originality requirement found in *Feist Publications, Inc. v Rural Telephone Service Co.*, 499 U.S. 340 (1991). Additionally, Mr. Briganti asserted that under section 102(b) of the copyright law, copyright does not extend to any idea, concept, system, or process which may be embodied in a work. Finally, he cited the delineation of material not subject to copyright in 37 C.F.R. § 202.1, which excludes familiar symbols or designs, typographical ornamentation, lettering, coloring and mere variations thereof.

B. First Request for Reconsideration

In a letter dated January 23, 2006, you requested reconsideration of the decision to refuse registration of the Design. (Letter from Taylor to Examining Division of 1/23/06, at 1). In this letter, you argued that the examiner failed to recognize the distinction between a "fabric design", which is copyrightable, and a dress design or clothing, which is not capable of protection. In support of your position, you cited *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759 (2d Cir. 1991) as well as 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright*, § 2.08 [H][2], at 2-14 (2003), which states that "[I]t is now clear that such [fabric] designs are copyrightable." *Id.* You then clarified that contrary to the implication in the Office's initial refusal to register, the Applicant was not seeking to register the article of clothing itself. Rather the Applicant sought to register "its fabric design - in particular, a unique 1" white/3" black/1" white design on the side panel of the shirt." *Id.* You also stated all other striped shirts in the same class (typically shirts worn by referees for athletic events) have had a uniform stripe width around the entire shirt and that the Applicant's design has been well received in the marketplace due to this side panel. *Id.*

Conceding that the design is not particularly complex or intricate, you noted that neither of these attributes is required. *Id.* You then cited the Copyright Act's originality requirement as set out in *Feist*, which states:

> [o]riginal, as the term is 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. 1 M. Nimmer & D. Nimmer, Copyright §§ 2.01[A], [B] (1990) (hereinafter Nimmer). To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, "no matter how crude, humble or obvious" it might be. *Id.*, § 1.08[C][1]. Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.

Id. at 2. Citing *Feist*, 499 U.S. at 345 (1991) (emphasis added). Upon citing *Feist*, you referenced the Declaration of James C. Keen, Sr., which accompanied your letter, noting that Applicant's juxtaposition of the wide and the narrower stripes on a striped shirt was created by Applicant alone. *Id.* at 2. Citing (Declaration of James C. Keen, Sr. signed 12/22/05). You then concluded that the Design possesses the minimal degree of creativity and is, therefore, copyrightable. *Id.* at 2.

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

After receiving your letter dated January 23, 2006, as well as the written Declaration made by James Keen, Sr., Attorney Advisor Virginia Giroux-Rollow of the Examining Division reexamined the application. Ms. Giroux determined that the Design does not contain a sufficient amount of original and creative artistic expression on its surface upon which to support a copyright registration. (Letter from Giroux to Taylor of 6/18/06, at 1).

Ms. Giroux explained that the material from which a work is made does not affect its eligibility for copyright protection. She went on to clarify that the Office does not dispute that the work was independently created by the author. However, citing *Feist*, Ms. Giroux stated that a work must not only be original, but must possess more than a *de minimis* quantum of creativity. And, in the case of a fabric design, a certain amount of graphic material must originate with the author. *Id.* She elaborated that originality, as interpreted by the courts, means that the authorship must constitute more than a trivial variation of public domain elements, citing *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951). *Id.* She stated that in applying that standard, the Copyright Office examines a work to determine whether it contains any elements, either alone or in combination, on which a copyright can be based. She

added that because the Copyright Office does not make aesthetic judgments, the attractiveness of a design, its uniqueness, its visual effect or appearance, the time, effort, and expense it took to create, or its commercial success in the marketplace, are not factors in the examining process. *Id.* The question, she said, is whether there is a sufficient amount of original and creative authorship within the meaning of the copyright law and settled case law. *Id.*

Ms. Giroux described the work in question as a design that consists of a series of black and white stripes of mostly uniform width. The only difference is that each side panel contains a series of a 1" white stripe, a 3" black stripe, and a 1" white stripe. *Id.* at 1-2. She then made note that stripes no matter what their width, thickness, or size are common and familiar shapes, in the public domain, and are not copyrightable, citing Copyright Office regulation 37 C.F.R. § 202.1. *Id.* at 2. Moreover, citing the same regulation, she noted that coloring is not copyrightable *per se*. She elaborated that the simple combination and arrangement of the stripes, coupled with their coloring, did not rise to the level of copyrightable authorship necessary to sustain a copyright registration. *Id.* Finally, she noted that the design is *de minimis* consisting of public domain elements arranged in a rather simple configuration, citing *Compendium of Copyright Office Practices II*, Ch. 500, § 503.02(a). *Id.*

Ms. Giroux stated that the above principles are confirmed by several judicial decisions, including *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986)(a logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below lacked the minimal required creativity to support registration); *Forstmann Woolen Co. v J. W. Mays, Inc.*, 89 F. Supp. 964 (E.D.N.Y. 1950) (label with words "Forstmann 100% Virgin Wool" interwoven with three fleur-de-lis held not copyrightable); *Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q.2d 1074 (D.D.C. 1991) (upholding refusal to register "gothic" pattern composed of simple variations and combinations of geometric designs due to insufficient creative authorship to merit copyright protection); *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988)(upholding refusal to register a design consisting of two inch stripes, with small grid squares superimposed upon the stripes). *Id.*

Ms. Giroux conceded that it is true that even a slight amount of creativity will suffice to obtain copyright protection. However, she went on to cite *Nimmer* § 2.01(B), which states that "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright." *Id.* She also cited *Feist* for its confirmation that some works fail to meet this admittedly low standard. She then concluded the Design at issue fell within this narrow area. In explaining this conclusion, she stated that the Copyright Office believed even the low requisite level of creativity required by *Feist* was not met by the various black and white colored stripes on the surface, either individually or in their particular arrangement and combination. *Id.*

Moreover, she acknowledged your indication that the author, in designing the work, was attempting to create a unique and distinctive expression. However, she noted that while

uniqueness may be applicable to patent protection, the fact that it may be unique or novel does not mean that it is copyrightable. *Id.* at 2-3.

D. Second Request for Reconsideration

In a letter dated September 5, 2006, you submitted a second request for reconsideration (Letter to the Review Board of 8/31/06, at 1). Accompanying your letter was a second declaration of James C. Keen, Sr. (Second Declaration of James C. Keen, Sr. signed 8/28/06).

You first argued that the previous refusal to register errs because it considered the Design's constituent parts rather than the whole. After pointing out your recognition that a stripe in and of itself is common and familiar and incapable of protection, you noted that the Design is not composed of a single stripe but rather is "a series of distinct stripes in original juxtaposition." (Letter to the Review Board of 8/31/06, at 1). Additionally, you stated the black letter law principle that a work comprised of uncopyrightable elements may be copyrightable and cited *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir 1989) (Ginsburg, Ruth Bater, J.), discussing the Register's refusal to register the BREAKOUT video game on the grounds that it was comprised of "common and familiar" matter:

> [t]he level of creativity necessary and sufficient for copyrightability has been described as "very slight," "minimal," "modest." *See, e.g., West Publishing Co.*, 799 F.2d at 1223; *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970), *cert. denied*, 401 U.S. 977, 169 U.S.P.Q. (BNA) 65, 28 L. Ed. 2d 326, 91 S. Ct. 1200 (1971); 1 M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT §§ 1.08[C][1], 2.01[B][1] (1989). In defense of the judgment that BREAKOUT does not pass the "modest" creativity threshold, appellate counsel for the Register pointed to the Copyright Office regulation providing that "familiar symbols or designs" and "mere variations of typographic ornamentation, lettering or coloring" are not subject to copyright. 37 C.F.R. § 202.1. Again, we are concerned that the Register's attention may have trained dominantly on components, not on the work as a whole -- the full "series of related images." 17 U.S.C. § 101 (defining "audiovisual works"); *see supra* pp. 3-4, 9-10.
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> Furthermore, we note that simple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and in court. *See, e.g., Soptra Fabrics Corp. v. Stafford Knitting*

> *Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir. 1974) (concluding that fabric design consisting of strip of crescents with scalloping or ribbons and rows of semicircles "constitutes modest but sufficient originality so as to support the copyright"); *Tennessee Fabricating Co. v. Moultrie Mfg. Co.*, 421 F.2d 279, 282 (5th Cir.) (holding that filigree pattern of intercepting {888 F.2d 884} straight and arc lines "possessed at least the minimal degree of creativity required for a copyright"), *cert. denied*, 398 U.S. 928, 165 U.S.P.Q. (BNA) 609, 26 L. Ed. 2d 91, 90 S. Ct. 1819 (1970); *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1316 (2d Cir. 1969) (treating as subject to copyright protection fabric design consisting of a circle within a square within a circle); *In Design v. Lynch Knitting Mills, Inc.*, 689 F. Supp. 176, 178-79 (S.D.N.Y.) (upholding copyright of rhomboid pattern on a sweater).

Id. at 1-2. Citing *Atari*, 888 F.2d at 883-84. You then asserted that the Design considered as a whole is neither common nor familiar. *Id.*

You go on to argue that the Design embodies the requisite level of originality by law. As authority for the requirement of originality under the law you quote *Drop Dead Co. v. S. C. Johnson & Johnson Son, Inc.*, 326 F.2d 87, 93 (9th Cir. 1963) ("the requirements for the 'originality' necessary to support a copyright are modest. The author must have created the work by his own skill, labor and judgment, contributing something 'recognizably his own' to prior treatments of the same subject. However, neither great novelty nor superior artistic quality is required."); and *Boisson v. Banian, Ltd.*, 273 F.3d 262, 268 (2d Cir. 2001) ("Copyright law does not define the term 'originality' . . .. Originality does not mean that the work for which copyright protection is sought must be either novel or unique, it simply means a work independently created by its author, one not copied from pre-existing works, and a work that comes from the exercise of the creative powers of the author's mind, in other words, the fruits of the author's intellectual labor."). *Id.* at 2. You then go on to assert that the Design displays the stated originality requirements because it was created by claimant and is recognizably his own, at which point you cited the declaration of James C. Keen, Sr. that accompanied Claimant's First Request for Reconsideration. *Id.* Citing (Declaration of James C. Keen Sr. signed 12/22/05).

You then turn to the portion of Ms. Giroux's denial of registration that identifies case law establishing the proposition that a work must meet a minimal level of creative authorship to receive copyright protection and cites *Nimmer*'s observation that "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support copyright" *Nimmer* § 201[B]. *Id.* Without denying this requirement of minimal creative authorship, you asserted that the cases identified by *Nimmer* for this principle address instances

of materially less creativity than is present in the Claimant's creation, the Design. Citing *Magic Marketing, Inc. v. Mailing Services of Pittsburgh, Inc.*, 634 F. Supp. 769 (W.D. Pa. 1986). *Id.*

Finally, you assert that the actions of third parties in the marketplace have ratified the Design's originality. You cite *Nimmer*, which states "in general, it may be concluded that if any author's independent efforts contain sufficient skill to motivate another's copying, there is ipso facto a sufficient quantum of originality to support a copyright." *Nimmer*, § 201[B] at 2-13 (emphasis in original). You further point to *Drop Dead*, 326 F.2d at 93 and *Amplex Manufacturing Comp. v. A.B.C. Plastic Fabricators, Inc.*, 184 F. Supp. 285, 288 (E.D. Pa. 1960) as support for this proposition. *Id.* at 3. You then refer to James C. Keen., Sr.'s declaration as well as archives and examples from website displays regarding referee/umpire uniforms as evidence that the Design was adopted by competitors, thus demonstrating the Design's originality.

III. DECISION

After reviewing the application and deposit submitted for registration and the arguments that you have presented, the Copyright Office Review Board affirms the Examining Division's refusal to register the fabric design entitled "ULTRA MESH SIDE PANEL FABRIC DESIGN." The Board concludes that the Design does not contain sufficient creative authorship to support registration.

A. Analysis of the Work

1. Consideration of the Work as a Whole

While it is true that the Office's thorough analysis of the Design necessarily devoted significant attention to the work's constituent parts, the Office did not err by considering "the Design's constituent parts rather than the whole." (Letter to the Review Board of 9/5/06, at 1). The Office's full measure of consideration encompassed evaluation of the Design as a whole. This is made clear by the Office's description of the Design, as well as its application of relevant statutory and case law to the Design.

The Office's previous denial of registration, stated "[s]tripes no matter what their width, thickness or size are common and familiar shapes or designs in the public domain, and are, therefore not copyrightable." (Letter from Giroux to Taylor of 6/18/06, at 2). However, the denial goes beyond this description of the work's constituent parts and also describes the work as a whole as follows: "The design on the surface of this shirt, consists of a series of black and white stripes of mostly uniform width. The only difference is that each side panel contains a series of a 1" white stripe, a 3" black stripe, and a 1" white stripe in that order." *Id.* The Office also considered the entire work's "arrangement and combination of the stripes coupled with

their black and white coloring" as it concluded that the Design does not contain sufficient creative authorship to support registration. *Id* (Emphasis added). (*See* also, *id* at 2 and 3, the Office's conclusion that "neither the stripes nor their arrangement, coupled with their black and white coloring... meet the even low threshold" and "the stripes on the surface of the shirt, individually and in their particular arrangement and combination, simply do not contain a sufficient amount of original and creative authorship to be copyrightable.") It is clear that the Office's analysis of the work, characterized by the consideration of many stripes (note plural) and their combined orientation to one another, as well as this current analysis, considered the work as a whole.

2. The Originality Threshold

The Office does not dispute the fact that the Design was independently created by the author. However, the Supreme Court made clear in *Feist* that originality as used in copyright means both that the work must be independently created by the author (original to the author) and must possess at least some minimal degree of creativity. This creativity requirement was not reflected in the passage quoted in your recent request for reconsideration from the pre-*Feist* case, *Drop Dead*. *See Drop Dead*, 326 F.2d at 93. However, the *Boisson* passage contained in your request for reconsideration does in fact make note of the mandated requirement of creativity. *See Boisson*, 273 F.3d at 268. It is this requirement of creativity that is the crucial matter in considering the Design.

In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the previously referenced standard set forth in *Feist*, which notes that the "requisite level of creativity is extremely low; even a slight amount will suffice." 499 U.S. at 369. Despite this low requirement level, the *Feist* Court 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," *id.* at 363, and that there can be no copyright in a 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. § 202.1(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."); *Nimmer* § 2.01(B) ("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support 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, "[w]orks that lack even a certain minimum amount of original authorship are not copyrightable." *Compendium II*, § 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." *Compendium II*, § 503.02(a).

Your assertion that the cases cited by *Nimmer* address instances where the works are materially less creative than the Design is not followed by any analysis or comparison of either the instant Design or the works in any of the cases cited by *Nimmer*. You offer only an incomplete reference to *Magic Marketing*. Your reference does not address the envelopes for which registration was being sought in that case, or otherwise compare the level of creative authorship in relation to the Design.

While you state that "the Design is neither fragmentary nor function," (Letter to the Review Board of 8/31/06, at 2), those are but two instances put forward as illustrative of a failure to meet the requisite level of creativity for copyright. Once more, your statement applies an illustrative threshold for creativity for written works to the instant Design, which is a pictorial/graphic work. Instead, more applicable instruction can be found in later portions of the *Magic Marketing* decision, those portions which analyze the creativity of the envelopes as "pictorial, graphic or sculptural works." In finding that the requisite level of creativity was not present in any part of the envelope sufficient to qualify as a copyrightable pictorial, graphic, or sculptural work, the court stated, "Solid black stripes are not copyrightable." *Magic Marketing*, 634 F. Supp. at 772. Like the court in *Magic Marketing*, the Office took note of 37 C.F.R. § 202.1(a) in its consideration of a design consisting of multiple black stripes, set apart against a white background.

In looking beyond the *Magic Marketing* decision, it is clear that the Office and courts have consistently found that standard designs, figures and geometric shapes, such as a square, are not sufficiently creative to sustain a copyright claim. *Compendium II*, § 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 . . ."); *id.* § 202.02(j) ("Familiar symbols or designs . . . or coloring, are not copyrightable."). *See also, id.* § 503.03(b) and 37 C.F.R. § 202.1(a).

Moreover, making simple alterations to otherwise standard shapes or familiar designs will not inject the requisite level of creativity. *Catalda*, 191 F.2d at 102-03. (What "is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'"); *Compendium II*, § 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.").

Additional case law confirms these principles. *See Forstmann* (reproduction of standard fleur-de-lis could not support a copyright claim without original authorship); *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 *Homer Laughlin* (upholding refusal to register chinaware design pattern composed of simple variations of geometric designs due to insufficient creative authorship to support copyright registration).

Finally, in support of the argument that the actions of third parties have ratified the Design's originality, you cite *Nimmer*, which states: "**in general**, it may be concluded that if any author's independent efforts contain sufficient skill to motivate another's copying, there is ipso facto a sufficient quantum of originality to support a copyright." *Nimmer* § 2.01(B) at 2-13 (Underlined Emphasis in original) (Emphasis added in **bold**). However, little attention is paid to the qualification, "in general", placed in front of the quoted statement from *Nimmer*. The following sentence further clarifies the relevant exceptions to this general statement, by explaining that "Despite this seemingly all inclusive measure of originality, there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support copyright... Moreover, the mere fact of success in the marketplace cannot vouchsafe the necessary quantum of originality." *Id.* Given this clarification we are again returned to the principle that there exists at law a narrow area in which creative authorship is too trivial or insignificant to support copyright.

In consideration of the cases cited above, the Board has determined that the Design's simple arrangement of a series of vertical black and white stripes of mostly uniform width combined with a side panel, which consists of 1" white/3" black/1" white section does not contain the requisite level of creative authorship.

IV. CONCLUSION

For the reasons stated above, the Copyright Office Board of Appeals concludes that the "ULTRA MESH SIDE PANEL FABRIC DESIGN" cannot be registered for copyright protection. This decision constitutes final agency action.

Sincerely,

/S/

Maria Pallante
Deputy General Counsel
for the Review Board
United States Copyright Office