United States Copyright Office
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April 23, 2009

Ms. Vanessa Hew
Duane Morris, LLP
1540 Broadway
New York, NY 10036-4086

Re: ELBOW SLEEVE PLAID PRINTED THERMAL
Copyright Control Number: 61-503-1839(D)

Consisting of the individual works:
1) #650118 Elbow Sleeve Plaid Printed Thermal
2) #APPTF278 Elbow Sleeve Plaid Printed Thermal

Dear Ms. Hew:

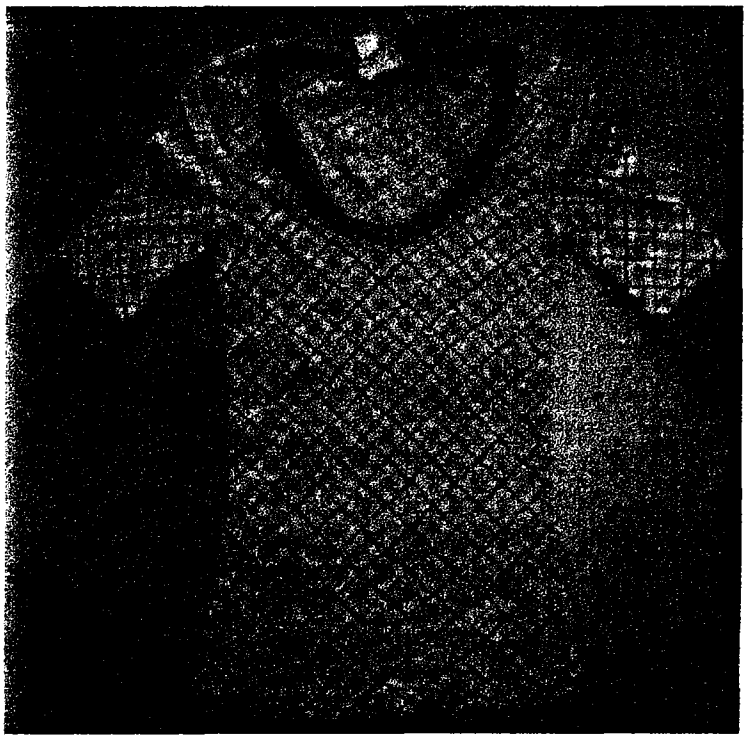
I write on behalf of the Copyright Office Review Board (the "Board") in response to your September 4, 2008, letter in which you requested a second reconsideration of the Copyright Office's refusal to register the fabric designs Elbow Sleeve Plaid Printed Thermal #650118 and #APPTF278. The Board has carefully examined the applications, the deposits, and all correspondence concerning the two works and affirms the denial of registration.

I. DESCRIPTION OF THE WORKS

The fabric design Elbow Sleeve Plaid Printed Thermal #650118 consists of a presentation of green-bordered squares, each containing nine smaller squares in three alternating colors. These squares are juxtaposed to each other and horizontally arranged within the larger square as follows: white, light yellow, white; light yellow, darker yellow, light yellow; and white, light yellow, white. This design is repeated in straight lines and the larger squares are placed next to each other so that the large square may be seen as a diamond shape as it is laid out on the thermal fabric.

The fabric design Elbow Sleeve Plaid Printed Thermal #APPTF278 is a virtually identical design to design #650118, with different colors present. The overall design consists of blue-bordered squares, each containing nine smaller squares in three alternating colors. The squares are juxtaposed to each other and horizontally arranged within the larger square as follows: white, light orange, white; light orange, darker orange, light orange; and white, light orange, white. This design is also repeated in straight lines and the larger squares are placed

next to each other so that the large square may be seen as a diamond shape as it is laid out on the thermal fabric. Photographic images of the Works appear below:





II. ADMINISTRATIVE RECORD

A. Initial Submission and Office's Refusal to Register

On July 30, 2007, the Copyright Office received applications for these works. The applications were submitted by John N. Jennison on behalf of your client, U.O.D. Inc. In a letter dated November 15, 2007, Examiner Ivan Proctor refused registration because the works lacked the authorship necessary to support a copyright claim. (Letter to Gulia at Duane Morris, LLP, from Proctor, of 11/15/2007).

Citing *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), Mr. Proctor noted that to be original, a work must be independently created by the author and possess at least a minimal degree of creativity. *Id.* at 1. He clarified that under 37 C.F.R. § 202.1, familiar symbols or designs and basic geometric shapes cannot receive copyright protection. *Id.* at 1-2. In addition, Mr. Proctor cited *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) and *Feist* to note that aesthetic appeal, commercial value, and amount of time and effort expended to create a work are not factors that are considered under copyright law when determining copyrightability. *Id.* at 2.

B. First Request for Reconsideration

In a letter dated March 14, 2008, John N. Jennison requested reconsideration of the Office's refusal to register the works. (Letter to Examining Division from Jennison of 3/14/2008). In this letter, he argued that the Office applied a higher standard of originality and creativity than was intended by the Copyright Act and the courts. *Id.* at 1. In support of this position, he cited *Feist* and *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992) to show that the level of creativity required for copyrightable subject matter is extremely low. *Id.* at 2-3. He further argued that a work need not be unique or distinctive, but merely constitute a distinguishable variation in the arrangement and manner of presentation of public domain elements. *Id.* at 3. In further support of his position, he cited cases such as *Trebonik v. Grossman Music Corp.*, 305 F. Supp. 339 345-46 (N.D. Ohio 1969) to show that a rearrangement of public domain elements may demonstrate sufficient originality. *Id.* at 4.

Mr. Jennison then argued that the two works at issue here exceed the low required threshold. *Id.* at 5. He described the works as a "creative and complex arrangement of four distinctive colors, several graphic elements arranged with color, geometric shapes and texture designed in different perspectives, all of which combined, constitute an original work of creative authorship." *Id.* Mr. Jennison also supplied additional descriptions of work #650118, such as "The fabric design further creates an original and eye-catching effect by constructing macro wavy green diagonal lines that create green diamond boxes that seem to collapse and expand as they intersect across the underlying elements." *Id.* at 6.

In support of his position, Mr. Jennison cited court decisions in which interpretations of common designs, shapes, geometrical forms and objects in the public domain were copyrightable in instances where more than a trivial variation was found in their arrangement. *Id.* at 9. Citing *Feist*, Mr. Jennison also noted that a refusal based on any resemblance the works may have to plaid designs in the public domain would be erroneous because works may be sufficiently original while closely resembling one another as long as the similarity is not the result of copying. *Id.* at 8.

Finally, in the alternative, Mr. Jennison cited H. Howell, *The Copyright Law*, at 92 and *Compendium of Copyright Office Practices II*, § 108.07 (1984) to argue that the two works at issue here should be registered under the rule of doubt. *Id.* at 10.

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

After receiving Mr. Jennison's March 14, 2008, letter, Attorney Advisor Virginia Giroux-Rollow of the Registration & Recordation Program reexamined the two works at issue. (Letter to Jennison from Giroux-Rollow of 6/4/2008). Ms. Giroux-Rollow upheld the refusal to register the works because the two fabric designs did not contain original and creative artistic or graphic authorship sufficient to support a copyright registration. *Id.* at 1.

Ms. Giroux-Rollow noted that originality requires not only independent creation but also more than a *de minimis* quantum of creativity. *Id.* at 1. She further explained that the Office does not make aesthetic judgments and, therefore, does not consider such factors as the work's visual effect or appearance. *Id.* She also cited 37 C.F.R. § 202.1, Copyright Office Regulations, to explain that simple plaids or checkered designs, squares and diamonds, or minor variation thereof, are common and familiar shapes or designs, are in the public domain, and, therefore, are not copyrightable. *Id.* at 2.

While Ms. Giroux-Rollow agreed with Mr. Jennison's argument that only a slight amount of creativity is required, she found that the two works at issue here do not meet even that low threshold. *Id.* at 2-3. She explained that each design embodies only two or three elements, four colors, and familiar shapes arranged in a simple and repetitive configuration. *Id.* at 3.

Ms. Giroux-Rollow also acknowledged the cases Mr. Jennison provided as support but noted that all of them involved a design that was more than trivial in variation or arrangement, either by selection of a variety of shapes and colors or by arranging them in a creative manner, or both. *Id.* at 3-4. She found that such was not the case here, explaining that the fact that the author made selections is not by itself sufficient, as all designs involve choices. *Id.* at 4. It is not the possibility of choices that determines copyrightability but whether the resulting expression contains copyrightable authorship. *Id.*

Finally, in response to Mr. Jennison's request that the rule of doubt be applied to the registration of these two designs, Ms. Giroux-Rollow noted that the rule is appropriate only when there is reasonable doubt about the action that a court might take concerning whether a work constitutes copyrightable subject matter or whether other legal or formal requirements have been met. *Id.* Because it has been determined that the two fabric designs at issue here clearly are not copyrightable, it is not appropriate to apply the rule of doubt. *Id.*

D. Second Request for Reconsideration

In a letter dated September 4, 2008, you submitted a second request for reconsideration. (Letter to Copyright R & P Division from Hew of 9/4/2008). You based your request on the grounds that the fabric design works contain sufficient originality and authorship in the combination, selection, and arrangement of the elements embodied in the designs to warrant copyright registration. *Id.* at 1. You reiterated that originality requires only a minimal degree of creativity and that the vast majority of works meet this requirement if they possess some creative spark. *Id.* at 2. You cited *Tennessee Fabricating Co. v. Moultrie Mfg. Co.*, 421 F.2d 279, 282 (5th Cir. 1970) to further note that originality "means little more than a prohibition of actual copying." *Id.* You also cited several cases in which designs comprised entirely of elements in the public domain were found to be sufficiently original, given the degree of creativity in the selection, coordination, or arrangement of the elements. *Id.*

You also cited *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), to argue that "if a copyrighted article has merit and value enough to be the object of piracy, it should also be of sufficient importance to be entitled to protection." *Id.* at 3. Therefore, you argued, the fact that the works at issue here are currently the subject of pending litigation is evidence of their originality and importance. *Id.*

You argued that the works displayed sufficient originality and creative artistic or graphic authorship under the applicable standard, *id.* at 3, and specifically disagreed with Ms. Giroux-Rollow's characterization of the works as consisting of two or three elements. Listing elements of each work, you suggested that each work consisted of a combination of a series of complex stripes, *id.* at 3-4, and relied on both graphical and textural elements of the fabric itself to argue that the selection and arrangement reflected the artist's own independent invention. *Id.* at 5. Therefore, you argued, the designs surpass the quantum of originality required in prior cases. *Id.*

You then specifically addressed some of the support Ms. Giroux-Rollow cited in denying registration of the works. *Id.* at 5. First, you argued that 37 C.F.R. § 202.1 refers only to "familiar symbols or designs," not to "plaid or checkered designs, or even geometric shapes, specifically." *Id.* at 6. Second, you attempted to distinguish the works at issue here from those in the cases Ms. Giroux-Rollow cited. You noted that one group of cases involved labels, and asserted that there is controversy over whether any copyright protection should extend to labels. *Id.* You then argued that *Tompkins Graphics, Inc. v. Zipatone, Inc.*, 222

U.S.P.Q. 49 (E.D. Pa. 1983), is distinguishable on the grounds that the holding was inaccurately cited. *Id.* Finally, you argued that in *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988), the designs under review in that case were considerably less original and creative than the two works at issue here. *Id.*

III. DECISION

After reviewing the applications and deposit materials submitted for registration as well as the arguments you have presented, the Board affirms the Examining Division's refusal to register the two fabric designs, #650118 and #APPTF278. The Board considered the works *de novo*, not reviewing past evaluations by the Office of other similar works but determining whether these two designs could, each on its own merits, be registered for copyright protection. The Board concludes that the Office is not able to register claims in the two works at issue here because they do not contain sufficient creative authorship to support registration.

A. Useful Articles and Separability

Although you have not argued the issue, the Board takes this opportunity to state that it finds the fabric of the garments on which the two designs at issue appear to be a useful article. That useful article– the fabric– includes its textural elements; the designs imprinted on the fabric, however, are clearly separable from the underlying fabric. Under copyright law, a useful article is 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. An article qualifies as a "useful article" as long as it has "any intrinsic utilitarian function." *Fabrica, Inc. v. El Dorado Corp.*, 697 F.2d 890, 893 (9th Cir. 1983). Although works of artistic craftsmanship that may themselves be useful articles can receive protection as pictorial, graphic, or sculptural works pursuant to 17 U.S.C. § 102(a)(5), such protection extends only "insofar as their form but not their mechanical or utilitarian aspects are concerned." 17 U.S.C. § 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.*

As indicated by the titles of the works, "Elbow Sleeve Plaid Printed Thermal," as well as the deposit images, the designs are printed on a thermal fabric. The "peaks and valleys" to which you refer [your 9/4/2008 Letter, at 5], while indeed creating texture, are intrinsic utilitarian elements of thermal fabrics themselves, existing, to some degree, for the purpose of insulating the wearer. On the other hand, the plaid designs under review have merely been printed onto the thermal fabric and are capable of being depicted independent of the fabric itself. Therefore, because the plaid designs are separable from the fabric itself, the Board does not consider the texture of the fabric in its analysis of the originality of the design works.

B. The Originality Threshold

The Office does not dispute that the two fabric design works were independently created by the author. Nor does it dispute that they may be unique. However, the fact that the works may be unique or novel does not mean that they are copyrightable. *Compendium of Copyright Office Practices II*, § 503.02(a), (b) (1984). The relevant point of consideration with regard to eligibility for registration is the requirement that the work must contain copyrightable expression. It is true that the cases you cited repeatedly held that a slight amount of creativity may be sufficient to warrant copyright protection. However, these cases have not contradicted the standard established in *Feist*, a standard to which the Office adheres. As Ms. Giroux-Rollow pointed out, "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright." Letter to Jennison from Giroux-Rollow of 6/4/2008, at 2-3 citing 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 2.01 (B) (*Nimmer*).

1. Infringement of a work as indicator of copyrightability

Your argument that the fact that the works are the subject of a copyright infringement suit should serve as probative evidence of the originality of the designs is misplaced. Letter from Hew of 9/4/2008, at 3. The selection you cite from *Bleistein* is itself a quote from *Drone on Copyright*, at 212 (1897). This view, however, enjoys less support in current scholarship and case law. A more current view is reflected in *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. (emphasis added) Particular attention should be 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.* Furthermore, regarding the issue of commercial success, which some might consider tantamount to sufficient proof of a copyright-protected status of a work, case law indicates that:

> Works may experience commercial success even without originality and works with originality may enjoy none whatsoever. Nothing has been presented to us showing any correlation between the two. Moreover, under Morelli's theory a work may not be copyrightable at one point when it enjoys no sales but may later become copyrightable if it experiences an upswing in economic fortune. This cannot be. A work is either original when created or it is not. *Evidence of commercial success simply does not have "any tendency to make the*

> *existence of any fact that is of consequence to the determination of [copyrightability] more probable or less probable than it would be without the evidence.*" (citing Fed. R. Evid. 401.)

Paul Morelli Design, Inc. v. Tiffany & Co., 200 F. Supp. 2d 482, 488-89 (E.D. Pa. 2002) (emphasis added). Given this clarification, we return to the principle that, regardless of marketplace concerns, there exists at law a narrow area in which creative authorship is too trivial or insignificant to support copyright protection.

2. Composition of authorship as indicator of copyrightability

One area of authorship insufficient to command copyright protection consists of familiar symbols or designs which are elements in the public domain. *Compendium II,* § 503.02(a). You attempted to distinguish several cases which the Office had cited in support of the *Compendium II* principle. However, although *Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q. 2d 1074 (D.D.C. 1991) may not be factually identical, it illustrates that the District Court in that case upheld the Office's application of the principle that familiar symbols are not protectable. Similarly, in *Tompkins Graphics,* the District Court confirmed that basic shapes are not protectible in themselves. Likewise, although you distinguished *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986) and *Forstmann Woolen Co. v. J. W. Mays, Inc.*, 89 F. Supp. 964 (E.D.N.Y. 1950) on the grounds that the works involved were labels, the identity of the works as labels did not factor into the Courts' decisions. Indeed, both courts upheld the Office's refusal to register a work based on a lack of minimal creativity.

You also cited a series of cases to demonstrate that works comprised entirely of elements in the public domain may embody sufficient originality if there was some degree of artistic choice in the selection, coordination, or arrangement of the elements. Letter from Hew of 9/4/2008, at 5. However, the holdings in these cases are narrower in scope than you suggest. For example, in *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996, 1003 (2d Cir. 1995), the Court did not rule on whether background stripes would have been copyrightable by themselves and instead noted only that "stripes, *if complex enough*, have been found to possess the modicum of creativity required for copyright protection" (emphasis added). Thus, the arrangement of public domain elements must still attain a threshold of complexity to represent sufficient originality. Merely combining non-protectible elements does not automatically establish creativity where the combination or arrangement itself is simplistic or trivial. *See, e.g., 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. But it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Case law indicates, 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 original)

In the other cases you cited, the works in question displayed far greater complexity than is evidenced in the claimant's two fabric design works, as Ms. Giroux-Rollow previously indicated. Letter to Jennison from Giroux-Rollow of 6/4/2008, at 3-4. In *Stevens Linen Associates, Inc. v. Mastercraft Corp.*, 1980 U.S. Dist. LEXIS 10045 (S.D.N.Y. 1980), the work in question was "a woven fabric made by selecting a variety of yarn sizes, types and colors which are then arranged to form parallel stripes of random widths, colors, bulk, and texture." In *Couleur International, Ltd. v. Opulent Fabrics, Inc.*, 330 F. Supp. 152, 153 (S.D.N.Y. 1971), the "stripes" were actually made up of sequences of figures and patterns, such as spirals, circles surrounded by dots, and small repeating triangles. In *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir. 1974), not only did the design at issue there contain a variety of design symbols, including a strip of crescents, scalloping or ribbons between the strips, and multiple rows of semicircles, but the author also specifically arranged the pattern so as to avoid having an "unsightly joint"when the pattern was extended across an entire bolt of cloth. You also cited *Reader's Digest Ass'n v. Conservative Digest Ass'n*, 821 F.2d 800, 806 (D.C. Cir. 1987) for its specific reference to a description of the work at issue in *Amplex Mfg. Co. v. A.B.C. Plastic Fabricators, Inc.*, 184 F. Supp. 285, 288 (E.D. Pa. 1960). In the *Amplex* case, the work in question combined in its authorship "an arrangement and manner of presentation" [of Egyptian lettering] involving a "dark background, particular size of letters, their spacing, their arrangement into three rows." The Court found that this overall combination gave the product at issue "authorship worthy of protection." In *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 765 (2d Cir. 1991), the work at issue consisted of "clip art" roses placed in horizontal rows and positioned so that the roses faced in varying directions, against an ornate background. In *Tennessee Fabricating*, 421 F.2d at 282, the work was a room divider design made up of intercepting lines and arc lines in a filigree pattern, which could only be described as an intricate ornamental work.

Unlike the works in those cases, the two fabric designs now under the Board's review embody only trivial variations. The Copyright Office views the designs not as a series of complex vertical lines but rather, as described above, as a repetition of one familiar geometric shape—a square. It is beyond dispute that squares are familiar symbols and are therefore within the public domain. The square shape in the two fabric designs before us is repeated to create a pattern, resulting in a simple grid of nine smaller squares. The only variation derives from the colors applied to the squares– in both designs, three colors, with a shading of only one of the colors. However, "mere variations of . . . coloring" are not subject to copyright. 37 C.F.R. § 202.1. Thus, the individual design element does not exhibit more than a trivial amount of creativity and arrangement.

Likewise, the overall arrangement of the nine smaller squares within a larger square represents *de minimis* graphic authorship. Unlike *Folio Impressions*, in which the author imposed randomness by positioning individual roses so that they faced in different directions, the square design in the two fabric design works at issue here is merely repeated in a symmetrical, linear fashion. The works seem to align more closely with the design in *Jon Woods Fashions*, in which the Court upheld the Office's refusal to register a fabric design

consisting of striped cloth with small grid squares superimposed on the stripes. The Review Board acknowledges your disagreement that the works are analogous because the designs you have submitted contain additional design elements beyond stripes and a grid. However, in the Board's view, the only appreciable variation is the very few colors used, which alone is not sufficient to render the overall design copyrightable. *See, e.g., Homer Laughlin*, 22 U.S.P.Q. 2d at 1076 (upholding the Office's refusal to register a design on the grounds that it did not meet the required minimal level of creative authorship and holding that a claimant's disagreement with the Office's description of the work did not undermine the validity of such refusal). Thus, the Board finds that the two fabric designs at issue here do not meet the minimum level of creativity necessary to warrant copyright protection. Additionally, even if the Office accepted your characterization of the work as a series of complex vertical lines, the works would still, for the reasons stated above, fall short of the required minimum level of creativity.

IV. CONCLUSION

For the reasons stated above, the Copyright Office Review Board concludes that the Elbow Sleeve Plaid Printed Thermal #APPTF278 and #650118 cannot be registered. This decision constitutes final agency action in this matter.

Sincerely,

/s/

Nanette Petruzzelli
Associate Register,
Registration & Recordation Program
for the Review Board
United States Copyright Office

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