United States Copyright Office
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August 16, 2011

Timothy B. McCormack, Esq.
617 Lee Street
Seattle, WA 98109

Re: SEASIDE CLASSIC
SEASIDE DOTS
STARBOARD STRIPES
CLASSY CLASSIC
Corresp. ID: 1-3FJJK2

Re: POSH DOT
VANGUARD STRIPE
Corresp. ID: 1-3K5VJ2

Dear Mr. McCormack:

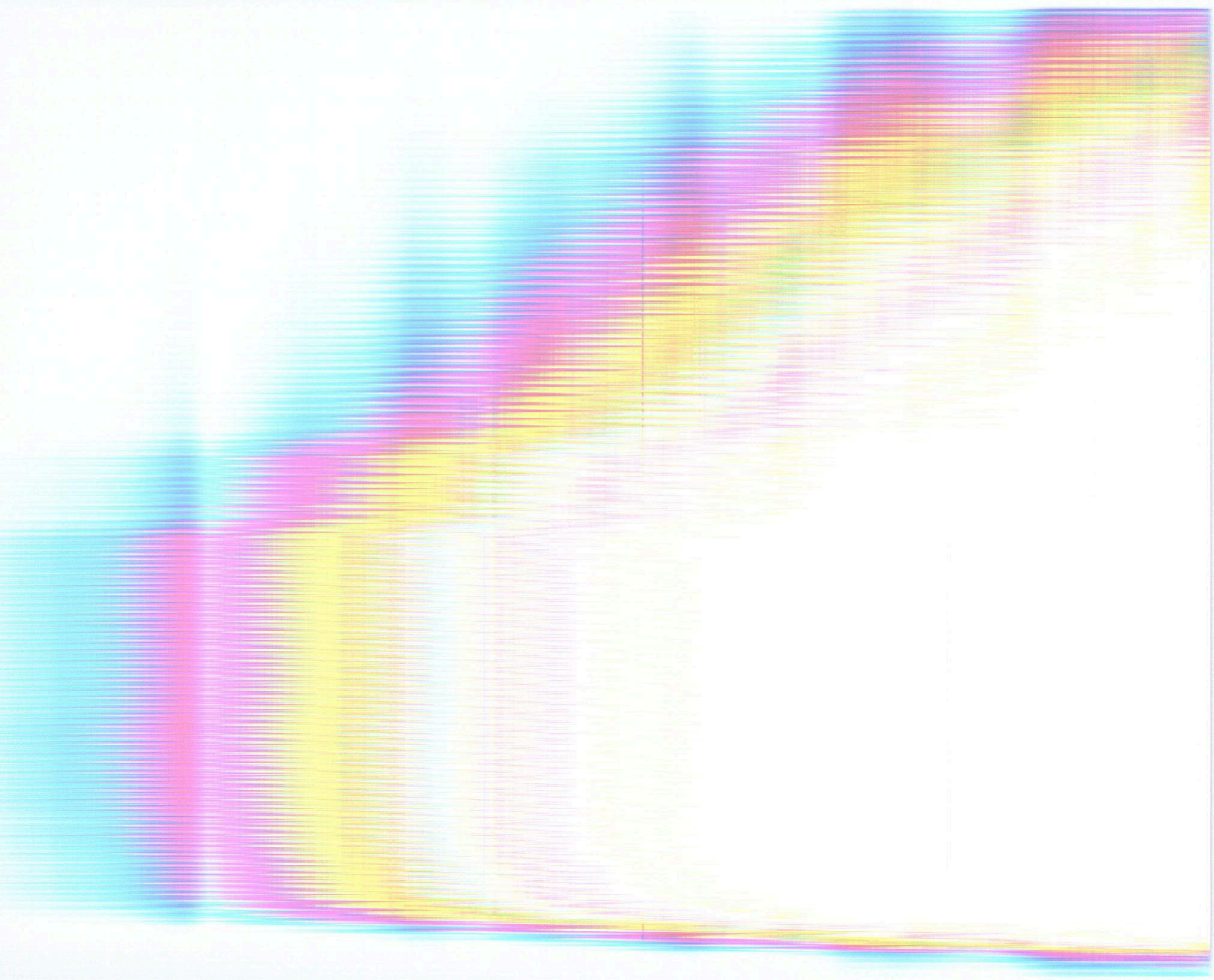
I write on behalf of the United States Copyright Office Review Board ("Board") in response to your letters, dated January 28, 2010, and February 4, 2010, in which you requested a second reconsideration of the Copyright Office's ("Office's") refusal to register designs entitled POSH DOT, VANGUARD STRIPE, SEASIDE CLASSIC, SEASIDE DOTS, STARBOARD STRIPES, and CLASSY CLASSIC. We herein address your two Letters together since each letter presents essentially the same arguments in favor of registration of these six patterns appearing on the surface of boots.

The Board has carefully examined the applications, all deposits materials for these works, and all correspondence concerning the above six titled works, and affirms the denial of registration of these six works.

I. DESCRIPTION OF THE WORKS

We believe the six designs are most accurately described as follows:

SEASIDE CLASSIC is a 2-dimensional design applied to the surface of a boot. The design in question consists of a solid brown-color body of the boot with brown and white thick



horizontal striped trim at the sole portion of the boot and a black trim at the top opening and buckle of the boot. (See thumbnail picture of the submitted deposits below)



SEASIDE DOTS is a 2-dimensional design applied to a boot that consists of white polka dots on a brown-color background with brown and white thick horizontal striped trim at the sole portion of the boot and a black trim at the top opening and buckle of the boot. (See thumbnail picture of the submitted deposits below)

STARBOARD STRIPES is a 2-dimensional design applied to the surface of a boot. The design in question consists of multiple sections of thin blue and white stripes that overlap at various angles and are arranged horizontally, diagonally and in curved orientations with a blue and white thick horizontal striped trim at the sole portion of the boot and a blue trim at the top opening and buckle of the boot. (See thumbnail picture of the submitted deposits below)



CLASSY CLASSIC is a 2-dimensional design applied to a boot that consists of small white dots placed on a black background with narrow black and white striped horizontal trim at both the sole portion of the boot and at the top opening and buckle of the boot. (See thumbnail picture of the submitted deposits below)



POSH DOT is a 2-dimensional design applied to a boot that consists of white polka dots, varying in size, on a lime green background with a lime green sole and top opening and buckle. (See thumbnail picture of the submitted deposit below)



VANGUARD STRIPE is a 2-dimensional design applied to a boot that consists of multiple sections of black and grey stripes of altering thickness arranged horizontally with a black sole and grey trim at the top opening and buckle of the boot. (See thumbnail picture of the submitted deposit below)



II. ADMINISTRATIVE RECORD

A. Initial submission and Office's refusal to register

On May 21, 2009, the Copyright Office received applications along with the required deposit materials and fees for the works: SEASIDE CLASSIC, SEASIDE DOTS, STARBOARD STRIPES, CLASSY CLASSIC, POSH DOT, and VANGUARD STRIPE. The submission was made by your client, Washington Shoe Company. In letters dated July 7 and 14, 2009, a U.S. Copyright Office Registration Specialist refused registration of the designs listed above.

The Registration Specialist explained that while copyright protects original works of authorship fixed in some physical form, a work of visual art is only original if it contains a minimum amount of pictorial, graphic, or sculptural authorship. *Id.* at 1. Copyright does not protect familiar symbols or designs, basic geometric shapes, words and short phrases such as names, titles, and slogans, or mere variations of typographic ornamentation, lettering, or coloring. *Id.* (citing 37 C.F.R. § 202.1). The Registration Specialist also explained that copyright does not extend to any idea, concept, system, or process which may be embodied in a work. *Id.* (citing 17 U.S.C. § 102(b)).

The Registration Specialist noted that neither the aesthetic appeal nor commercial value of a work, nor the amount of time and effort expended to create a work are factors that are considered under copyright law. *Id.* (citing *Bleistein v. Donaldson,* 188 U.S. 239 (1903); *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340 (1991)). The Registration Specialist then noted that the designs at issue here did not contain sufficient creative authorship to support a claim to copyright under the meaning of the copyright statute and settled case law. *Id.*

B. First requests for reconsideration

In letters dated July 28, 2009, you requested reconsideration of the Office's decision to refuse registration of the designs noted above.[1] (Letters from Timothy McCormack to Copyright RAC Division of 7/28/2009). In these letters, you argued that the designs should be registered because the variations of polka dot, solid, and stripe designs meet the requisite level of creativity, thought and planning to satisfy the minimal standards for registration. *Id.* at 3-4.

You noted that in order to be copyrightable, a work requires only a minimal amount of creative authorship. *Id.* at 1. (citing *Feist*, 499 U.S. 340 (1991)). You then stated that, in reviewing the copyrightability of designs, one must "'focus on the overall manner in which

[1] The request for reconsideration dated July 28, 2009 included requests for the Office to reconsider refusal of registration for works entitled HYPERSTRIPE, PINKY PLAID and DAISIES, which were subsequently registered and are not the subject of the instant request for reconsideration.

[plaintiff] selected, coordinated, and arranged the expressive elements.'" *Id.* (citing *Boisson v. Banian, Ltd.*, 273 F.3d 262, 271 (2d Cir. 2001)).

You asserted that variations on familiar designs may be copyrightable in cases where either the design itself or the selection and placement of component parts in "the entirety of the design" demonstrate sufficient creativity on behalf of the author. *Id.* at 2. (citing *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1093 n. 3 (2d Cir. 1977); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995); *Sunham Home Fashions LLC v. Pem-America,* 2002 WL 31834477 at *6 (S.D.N.Y. 2002)). You also note that "variations on basic designs, such as plaid, dots, and check patterns, may be copyrighted if taken as a whole the work has a minimal amount of creative authorship." *Id.* In your conclusion, you further cite Marc J. Rachman & Eric T. Gordon, *Finding Originality in Plaid Fabric Designs*, 230 N.Y.L.J. S6, (col. 1) (2003).

In describing the design STARBOARD STRIPES, you noted that if plaid designs can be copyrighted, stripe designs are also copyrightable. *Id.* at 2. You cited *Sunham Home Fashions* for the proposition that "one must look to the thought that goes into the colors, size, and spacing of the design pattern." *Id.* (citing *Sunham Home Fashions*, WL 31834477 at *6). Similarly, you noted that the selection and arrangement of colors and shapes may be taken together correctly to assess copyrightability. *Id.* Citing *North Coast Industries v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1034 (9th Cir. 1992), you explained that geometric patterns of vertical and horizontal lines may be sufficiently creative to be an issue of fact for a jury. *Id.* at 2-4. You asserted that STARBOARD STRIPE is an example of how lines may create an original design, using creativity and planning.

In describing the designs, you explained that these designs were the result of much thought and planning to determine the placing of the dots and complementary stripe pattern as part of the trim. *Id.* at 2-4. You asserted that polka dots and other familiar designs may be copyrightable in cases where either the design itself or the selection and placement of component elements is sufficiently creative. *Id.* (citing *Prince Group, Inc. v. MTS Products*, 967 F.Supp 121 (S.D.N.Y. 1997); *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759 (2d. Cir. 1991)). *Id.* You also cited to case law that established that certain flower patterns were considered sufficiently creative. *Id.* at 4-5 (citing *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759 (2d. Cir. 1991); *Hamil America v. GFI*, 193 F.3d 92 (2d. Cir. 1999); *L.A. Printex Industries, Inc. v. Global Gold, Inc.*, 2009 WL 453105 (C.D. Cal.).

In overall summary, you stated that the six designs at issue here are variations of polka dot and stripe designs that required creativity, thought, and planning to create. *Id.* You stated that courts have held designs to be minimally, and thus sufficiently, creative based on choice of color, placement, and a combination of design elements. *Id.*

C. Registration Program's response to first requests for reconsideration

After receiving your letters dated July 28, 2009, Attorney Advisor Virginia Giroux-Rollow of the Registration Program reexamined the submissions. Ms. Giroux-Rollow explained that the Copyright Office is willing to register three works (HYPERSTRIPE, PINKY PLAID, and DAISIES) that had been submitted for first reconsideration at the same time as SEASIDE CLASSIC, SEASIDE DOTS, STARBOARD STRIPES, CLASSY CLASSIC, POSH DOT, and VANGUARD STRIPE. (Letters from Virginia Giroux-Rollow, Attorney Advisor, to Timothy McCormack, dated Nov. 4 and 19, 2009). However, Ms. Giroux-Rollow determined that the Copyright Office was not able to register a copyright claim in the remaining designs because they do not contain a sufficient amount of original and creative artistic authorship in either the treatment or arrangement of the shapes or coloring of the constituent elements in the four designs at issue. *Id.* at 1.

Ms. Giroux-Rollow explained the *Feist* standard, noting that copyright registration requires a work to possess "'more than a *de minimis* quantum of creativity.'" *Id.* (citing *Feist,* 499 U.S. 340 (1991)). She also stated that designs in question must have a certain amount of artistic material that originated with the author. *Id.* at 1-2. (citing *Alfred Bell v. Catalda Fine Arts, Inc.* 191 F.2d 99 (2d Cir. 1951)).

Ms. Giroux-Rollow also explained that in order for a useful article – which these boots are – to receive copyright protection, the Copyright Office considers whether the article contains a sufficient amount of original authorship through the inclusion of physically or conceptually separable elements. (citing 17 U.S.C. § 101). She indicated that the Office does not consider as factors of copyrightability the attractiveness of the design, its uniqueness, its visual effect or appearance, the time that it took to create, or its commercial success in the marketplace. *Id.*

Ms. Giroux-Rollow noted that neither familiar shapes (such as dots and stripes in the public domain) nor colors are copyrightable. *Id.* at 2 (citing 37 C.F.R. § 202.1). She then made note that the simple, *de minimis* configuration of familiar shapes is not copyrightable. (citing *Compendium of Copyright Office Practices II,* Ch. 500, § 503.02(a)) (Hereinafter, *Compendium II).* Ms. Giroux-Rollow 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 words "arrows" in cursive script below lacked the minimal required creativity to support registration); *Fortsmann Woolen Co. v. J. W. Mays, Inc.*, 89 F. Supp. 964 (E.D.N.Y. 1950) (label with words "Fortsmann 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.C. Cir. 1991) (upholding refusal to register "gothic" pattern composed of simple variations and combinations of geographic designs due to insufficient creative authorship meant 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.* at 2-3.

In her responses to the first requests for reconsidation, Ms. Giroux-Rollow accepted that even a slight amount of creativity will suffice to obtain copyright protection. However, she went on to cite *Nimmer on Copyright* § 2.01(B)(2005), which states that "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright." She also cited *Feist* for the proposition that a slight amount of original authorship will suffice but even the low level of creativity required by *Feist* was not met by the simple treatment, arrangement, or configuration of the separable elements used to create the designs at issue here. *Id.* at 2-3.

Ms. Giroux-Rollow also noted that designs are not registrable as "compilations," but that the Copyright Office accepts the principle enunciated in *Atari Games Corp. v. Oman,* 888 F.2d 878 (D.C. Cir. 1989) that a work should be viewed in its entirety, with individual non-copyrightable elements judged not separately, but rather in their overall inter-relatedness within the work as a whole. *Id.* at 2-3. Ms. Giroux-Rollow then differentiated the designs at issue here from the pattern designs at issue in the *Prince Group*, *Folio Impressions,* and *Novelty Textile* cases, noting that in those cases, courts found distinguishable creativity and originality in creating designs that were more than a trivial variation of a theme. In *Sunham Home Fashions*, the court determined that decisions about the combination, selection, arrangement, size and color choice of several different "familiar" quilt patterns amounted to distinguishable creativity and originality. *Id.* (citing to *Sunham Home Fashions,* 2002 WL 31834477 at *6). The selection of several different colors and decisions related to the selection and arrangement of icons and letters of the alphabet was also sufficiently original to support a copyright registration in *Boisson v. Bainan, Ltd.*, 273 F.3d 262 (2d. Cir. 2001). (emphasis original). Ms. Giroux-Rollow also noted that the copyrightability of the colored, box pattern at issue in *North Coast Industries* was an issue to be decided by a jury, but was a decision on which the court never made a ruling. *Id.* at 3-4.

In summary, Ms. Giroux-Rollow noted that all designs involve choices, but that the resulting expression in each of the SEASIDE CLASSIC, SEASIDE DOTS, STARBOARD STRIPES, CLASSY CLASSIC, POSH DOT, and VANGUARD STRIPE designs, does not contain a sufficient amount of creative and artistic authorship to support a copyright registration. *Id.*

D. Second requests for reconsideration

In letters dated January 28 and February 4, 2010, you submitted second requests for reconsideration. (Letters from Timothy McCormack, to Virginia Giroux-Rollow, dated January 28 and February 4, 2010). Citing case law, you asserted that an author may obtain copyright registration for works that demonstrate only a minimum level of creativity. (citing *Feist*, 499 U.S. 340 and *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d

509, 513-14 (2d Cir. 1991); *Catalda*, 191 F.2d at 102; *Gerlach-Barklow Co. v. Morris & Bendien*, 23 F.2d 159, 161 (2d Cir. 1927); *Kamar Int'l., Inc. v. Russ Berrie & Co.*, 657 F.2d 1059 (9th Cir. 1981). You also cited *Feist* for the proposition that non-original elements, such as colors and familiar shapes, may be copyrighted if they are included within an original selection and/or arrangement. You have also asserted that Washington Shoe Company took considerable time in its selection and arrangement of familiar shapes and colors for designs to be placed on the exterior of the boots in order to create a visually appealing design for a target female audience. *Id.* at 1-2.

You noted the differences between the designs for POSH DOT, SEASIDE DOTS and CLASSY CLASSIC and that they demonstrate the necessary "originality" and "creativity" of polka dot designs. With regard to CLASSY CLASSIC you indicated that the varying size and shape of the dots, depending on their placement on the toe of the boot, contributed to the work's original authorship. *Id.* at 2-3. You also claimed that designs that are "apparently less original than the ones in this case" have been held to be copyrightable because they "contained the minimum level of creativity required based on selection and arrangement of basic shapes and colors." *Id.* at 3-4. (citing *Reader's Digest Ass'n v. Conservative Digest, Inc.* 821 F.2d 800, 806 (D.C. Cir. 1987); *Apple Barrel Prods., Inc. v. Beard,* 730 F.2d 384, 388 (5th Cir. 1984); *Roth Greeting Cards v. United Card Co.,* 429 F.2d 1106, 1109 (9th Cir. 1970).

You also asserted that the Office, in assessing the designs at issue here, applied a higher standard of "substantial creativity" that should have been reserved for derivative works, even though case law suggests that modestly original designs consisting of simple shapes and lines are worthy of copyright registration. *Id.* at 3-4. (citing *Atari*, 888 F.2d at 882 (D.C. Cir. 1989); *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.* 490 F.2d 1092, 1094 (2d Cir. 1974); *Tennessee Fabricating Co. v. Moultrie Mfg. Co.*, 421 F.2d 279, 282 (5th Cir. 1970); *Concord Fabrics v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1316 (2d Cir. 1969); *In Design v. Lynch Knitting Mills, Inc.*, 689 F. Supp. 176, 178-79 (S.D.N.Y. 1988). You stated that combinations of colors and other uncopyrightable items may be registered when viewed as a whole. *Id.* at 4. (citing *Pantone, Inc. v. A.I. Friedman, Inc.*, 294 F.Supp. 545, 547-548 (S.D.N.Y. 1968); *Bonechi v. Weisdorf,* 1998 WL 193246 at *3, (S.D.N.Y. April 21, 1998); *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F.Supp.2d 542, 548 (S.D.N.Y. 2001).

You have also asserted that the Office's reliance on *John Muller & Co., Inc.* 802 F.2d 989 and *Forstmann Woolen Co.*, 89 F.Supp. 964 (E.D.N.Y. 1950) "leads to the inference that the Copyright Office may have been reviewing the boot designs at issue based on the individual components rather than the works as a whole, as required." *Id.* at 4 (citing *Boisson*, 273 F.3d at 271; *Atari*, 888 F.2d at 880). At the same time, you noted that the designs are not derivative works based on prior boot designs, but were independently created by the Washington Shoe Company. *Id.* at 5. You also cited *North Coast Industries* for the proposition that "mere variations of geometric shape designs can be sufficiently creative to attain copyright in each individual work." *Id.* at 5. You cited to *Sadhu Singh Hamdad Trust v. Ajit Newspaper Advertising, Marketing & Communications, Inc.*, 503 F.Supp.2d 577, 590 (E.D.N.Y. 2007) for

the rule that the summary judgment standard requires a reasonable juror to be able to find that the combinations that constitute a design may have the requisite originality and creativity required by U.S. copyright law. You combined the logic of these two cases to reach the conclusion that a stripe design may have a sufficient level of creativity to warrant copyright registration. *Id.* You argue that the Office should view each submission for the designs at issue here in its entirety in order to assess the minimal level of creativity based on the choice of color, placement, and combination of design elements; you have concluded that the designs at issue here meet the "required creativity, thought, and planning to create." *Id.* at 5-6.

III. DECISION

After reviewing the applications and deposit materials submitted for registration and the arguments that have been presented, the Copyright Office Review Board affirms the refusal to register the designs entitled SEASIDE CLASSIC, SEASIDE DOTS, STARBOARD STRIPES, CLASSY CLASSIC, POSH DOT, and VANGUARD STRIPE. The Board concludes that the Designs at issue here do not contain sufficient creative authorship to support registration.

A. Originality requirement of designs

You have already observed, and Ms. Giroux-Rollow has agreed, that only a minimum level of creativity is required. (Letters from McCormack to Giroux-Rollow, of 7/28/2009, citing *Feist*, 499 U.S. 340.) The Supreme Court has stated, however, 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." *Feist* at 363. 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. And, a work that reflects an obvious arrangement fails to meet the low standard of minimum creativity required for copyrightability. *Id.* at 362-363. Concerning works composed of common or standard elements, originality requires something more than a trivial variation of elements found in the public domain.

Even prior to *Feist*, Copyright Office registration practices following settled precedent recognized that some works of authorship contain only a *de minimis* amount of authorship and, thus, are not copyrightable. We acknowledge that pre-*Feist* case law recognized no demanding standard for copyrightability. *See, e.g., Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951) (" 'Original' in reference to a copyrighted work means that the particular work 'owes it origin' to the 'author.' No large measure of novelty is necessary.") 191 F.2d at 102. This does not mean, however, that no standard at all existed. Although *Catalda* itself stated that "no large measure of novelty is necessary" in a work of authorship in order to enjoy copyright protection, the same Second Circuit opinion also held that the distinguishable variation in a work of authorship for which copyright protection is sought, must be "more than

a 'merely trivial' variation." 191 F.2d at 102-103. Forty years later, *Feist* again confirmed that the "standard of originality is low, but it does exist." 499 U.S. at 362.

The Office's registration practices reflect the principle that works that lack even a certain minimum amount of original authorship are not copyrightable. *Compendium of Copyright Office Practices, Compendium II,* § 202.02[a], (1984). With respect to pictorial, graphic and sculptural works, the class to which the designs at issue here belong, *Compendium II,* § 503.02[a] states:

> A certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class. 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. For example, it is not possible to copyright a new version of a textile design merely because the colors of red and blue appearing in the design have been replaced by green and yellow, respectively. 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.

Compendium II recognizes that it is not aesthetic merit, but the presence of creative expression that is determinative of copyrightability. Section 503.01 states:

> The registrability of a work does not depend upon artistic merit or aesthetic value. For example, a child's drawing may exhibit a very low level of artistic merit and yet be entitled to registration as a pictorial work.

It is true that the cases which you have cited held that a slight amount of creativity may be sufficient to warrant copyright protection. However, these cases do not contradict the *Feist* standard, which states that, in order to be copyrightable, a work must be independently created by the author (original to the author) and must possess at least some minimal degree of creativity. As Ms. Giroux-Rollow pointed out, under *Feist* "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright." Letters to McCormack from Giroux-Rollow of 11/4 and 11/19/2009, at 3-4. Additionally, the *Feist* standard refutes the notion that contributions

of time or effort may be the foundation for copyright protection. Indeed, the *Feist* court stated that "the 'sweat of the brow' doctrine flouted basic copyright principles." *Feist*, 499 U.S. at 354.

B. Boots themselves useful articles to which designs, the subject of possible copyright protection, are applied

In her responses to your first request for reconsideration, Ms. Giroux-Rollow had indicated that the boots in question here do contain separable authorship – the design patterns on the surface of the boots – such that it is the design patterns, the conceptually separable elements, that might be regarded as works of art distinct from the utilitarian boots themselves. Letters from Giroux-Rollow of 11/4 and 11/19/2009, at 1-2. The question, then, becomes whether the design patterns are, indeed, copyrighable artwork.

As artwork – the copyright statute at 17 U.S.C. § 102(a)(5) includes 'pictorial, graphic, and sculptural' works as a category of authorship –, the designs appearing on the surface of the boots are subject to the *Feist* standard, *see above*. These designs in question consist of various arrangements of dots and lines on each chosen color background. The Board takes administrative notice, based on its observations of the deposit materials and other depictions of the work entitled, for one example, CLASSY CLASSIC marketed under the Washington Shoe brand name "Chooka," that the variation of size and shape of the dots appear to be the result of the process of applying the dot pattern design to the shape of the boot, whereby the pattern of dots of otherwise uniform size and shape are stretched to conform to the shape of the boot. Such minimal variation of size and shape of the dots on CLASSY CLASSIC is not the result of creative choices; it is, rather, the result of conforming the boot to the shape of feet for which the boot is manufactured, thus, of necessity, modifying the elements of the surface design. The elements – the dots – are changed in such a minor way that the patterns overall does not rise above a simple polka dot pattern.

Although we have just stated, *above*, that the designs appearing on the surface of the boots are conceptually separable from the utilitarian object, *i.e.*, the boots themselves, there remain as part of the boots' functional aspects such portions as 'buckle' and 'opening.' The Board notes that the 'top of the boot' openings and buckle aspects of the boot designs are functional in nature. One must be able to put the boot on the foot and, thus, an opening that can be adjusted to the individual leg and foot is desirable. We note that the designs appearing on the surface of these functional aspects, *e.g.*, on and proximate to the buckle, differ from the polka dot design pattern that covers the majority of the surface of the boot. The upper buckle and the bottom of the sole portion of the boot is a striped pattern, horizontally placed, with the thin stripes of one color against a white background that follows the shape of the sole of the foot. Again, the placement of particular design pattern elements on and about the particular configuration of these functional aspects appears to be dictated by utilitarian choices, *i.e.*, for the purpose of distinguishing certain portions of the

boot which are utilized differently. Although the pattern appearing on the surface of the functional parts of the boots differs from the overall dot pattern, such a straight-line pattern of two contrasting colors evenly spaced, which has just been described, under *Feist* is not copyrightable. The Review Board finds that individually or together in their particular arrangement, these simple combinations of a few standard shapes and symbols, dots and straight lines, with minor linear or spatial variations, are not copyrightable. *Compendium II,* § 503.02(a). In making this determination, the Board notes that it is not the possibility of available choices in the creation of a work, but, rather, the particular resulting expression which determines whether a work is copyrightable.

We also take the opportunity to comment on the following. You suggest that the Office may have applied a higher standard of "substantial creativity" when considering the designs at issue here and you offer citation to the *Atari* case. That case noted that the Office had been unclear as to the standard of review it had used with respect to the work at issue in *Atari.* Letters from McCormack of 1/28 and 2/4/2010, at 3, citing *Atari Games Corp. v. Oman*, 979 F.2d 242, 243 (D.C. Cir. 1992). *Atari*, in its (second) appellate appearance, coming a year after the 1991 *Feist* decision, referred to *Feist*'s "elucida[tion] of the creativity standard" and proceeded to analyze the video game at issue in that case as a whole, rather than analyzing individual, commonplace elements within the game. 979 F.2d at 244 - 246. The Circuit Court in *Atari* reversed the summary judgment that had agreed with the Register's refusal to register and also remanded the case to the lower court with emphasis that the standard for determining the copyrightability of a work of authorship must be consistent with "the unifying and clarifying instruction furnished by the Supreme Court in *Feist.*" 979 F.2d at 247.

The Circuit Court also gave in its opinion an informative summary of case law decided previously to *Feist* which case law addressed the necessary creativity for copyright protection, citing *Amplex Mfg. Co. v. A.B.C. Plastic Fabricators, Inc.*, 184 F.Supp 285, 288 (E.D.Pa. 1960) as well as the hallmark case *Alfred Bell (*derivative authorship*),* teaching that such derivative authorship is still to be evaluated in terms of *Feist*. This is the standard utilized by the Copyright Office. It may fairly be concluded that the copyrightability standard for derivative works is one that is consistent with *Feist* itself: in order to qualify for protection as a derivative work, the "work must be independently copyrightable." *Woods v. Bourne Co.*, 60 F.3d 978, 990 (2d Cir. 1995). Although this latter case was one concerning termination rights and the preparation of derivative works at both pre- and post-termination points in time, 17 U.S.C. § 304 (c)(6)(A), the case discussed at some length what is needed for a work to qualify as "derivative." Citing *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir) (in banc), *cert. denied*, 429 U.S. 857 (1976), as well as *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980), it quoted *Tomy* in asserting that "to support a copyright, the original aspects of a derivative work must be more than trivial." 630 F.2d at 909.

Although the *Batlin* and *Tomy* decisions are among older cases explaining the extent of creativity for derivative works of authorship, the Second Circuit explicitly stated that more recent decisions such as *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir.), *cert. denied* 493 U.S. 883 (1989), *Gaste v. Kaiserman*, 863 F.2d 1061 (2d Cir. 1988), *Waldman Publishing Corp. v. Landoll, Inc.*, 43 F.3d 775 (2d Cir. 1994), are consistent with *Batlin* and *Tomy*. *Woods,* 60 F.3d at 990. Thus, the standard that derivative authorship must be more than trivial is reflected in the *Feist* basic rule for copyrightability of authorship: "[T]he standard of originality is low, but it does exist." Again, in order for authorship to be copyrightable, the "Constitution mandates some minimal degree of creativity" be present in a work— creativity that is more than trivial. *Feist,* 499 U.S. at 362. This is the copyrightability standard which the Copyright Office applies to **all** works– initially created works as well as works derivative in nature.

C. Designs considered as a whole

While it is true that the Office's analysis of the designs at issue here necessarily devoted attention to the designs' constituent parts, the Office has also considered the works as a whole. Had there been any copyrightable authorship in any of the individual components, the inquiry would have ended at that point with a finding of copyrightability. Since this was not the case, consideration necessarily extended to encompass evaluation of the designs in their entirety. Although you have used in these designs public domain and/or familiar shapes and symbols, the copyright statute says that "a work consisting of ... elaborations, or other modifications which, as a whole represent an original work of authorship, is a derivative work." 17 U.S.C. § 101 (definitions: "derivative work")

The Registration Program's previous denial of your first requests for reconsideration stated that "[p]olka dots and stripes, no matter what their size or thickness, are common and familiar shapes, in the public domain, and are, therefore not per se copyrightable." Letters from Giroux-Rollow of 11/4 and 11/19/2009, at 2-3. However, the refusal to register these designs went beyond this description of the designs' constituent parts and also described the designs as a whole as follows: "Even the treatment and arrangement of the dots and stripes, coupled with their coloring, do not demonstrate the originality and creativity necessary to support a copyright registration" *Id.* Despite your suggestions that the Office may have reviewed the designs at issue here based on their component parts rather than their appearances as a whole, it is clear that past and current analysis of the works, characterized by the consideration of <u>many</u> stripes and dots (note *plural*) and their combined arrangement and orientation to one another, has, indeed, shown the Office to have considered the works as a whole. The Review Board adheres to the conclusion that the simple arrangement of dots and stripes and color on the main body of the boots combined with the trim at the sole portion and the trim at the opening and buckles as presented in the Designs, and consistent with the description stated above, are not sufficient to sustain copyright protection.

You also cited a series of cases where works, which you argue are less original that the designs at issue here, were found to contain the minimum level of creativity based on selection and arrangement of basic shapes and colors. It is true that the cited cases do stand for the principle that the minimum level of creativity may be found based on selection and arrangement of elements such as basic shapes and colors. However, each case involves a work which is distinguishable from your client's designs. As indicated below, in those cases that actually squarely address copyrightability, the works at issue contain *a greater quantum of* authorship than the present designs.

D. Case law

1. Reader's Digest

Reader's Digest v. Conservative Digest. Inc.. 821 F.2d 800 (D.C. Cir. 1987), involved a trade dress issue as well as a copyright count for a work with multiple print elements and colors combined with these textual elements, juxtaposed in an overall design that, according to the Court, resulted in a distinct arrangement and layout, constituting copyrightable authorship. Although the Review Board does, indeed, recognize that print elements may, in some instances, be considered part of graphic designs, this particular principle does not lend credence to your argument that the minimal designs appearing on the surface of these boots should be registered. The Review Board does not find the *Reader's Digest* case, with its stated conclusion that the "distinctive arrangement and layout" of "ordinary lines, typefaces, and colors" [to be a] graphic work, *Reader's Digest*, 821 F.2d at 806, as explanatory or as helpful support for your argument that these very simple and elementary designs of polka dots and straight / parallel lines with minimal variation in themselves, as applied to the surface of the boots, are copyrightable. We do not see a convincing parallel between the litigated cover design of Reader's Digest and the boot surface designs at issue here so that such parallel would argue for registration of the boot designs.

2. Other case law

Roth Greeting Cards v. United Card Co., 429 F.2d 1106 (9th Cir.1970), a pre-*Feist* case, involved greeting cards including text, arrangement of text, art work copyrightable in itself, and association between such art work and text, which, considered as a whole, qualified the cards, according to the Court, as works of copyrightable authorship. The Board does not consider the designs applied to the boots at issue here comparable. *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989) involved an audio-visual work in which the *movement* of individual elements, taken together, comprised a substantial portion of the copyrightable expression. In *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir. 1974), the design in question contained a variety of design symbols, including a strip of crescents, scalloping or ribbons between the strips, and multiple rows of semicircles, where 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. *In Design v. Lynch Knitting Mills, Inc.*, 689 F. Supp. 176, 178 (S.D.N.Y. 1988) involved an abstract, geometric design in which the background consisted of horizontal rows of large rhomboids, all of the same size and all oriented in the same direction. The diamond-like shapes were in two colors -- red, and a black and white blend creating a mottled gray look -- and those in each row were of the same color. They did not intersect, and those of the same color did not touch each other, but were connected by small black diamonds. Superimposed onto this background were the heavy black outlines of a third set of diamond-like rhomboids, of the same size and orientation, which met in the middle of the red and gray-blend ones. The meetings of these black outlines formed diamond shapes of roughly the same size as those linking the background parallelograms. *Pantone, Inc. v. A.I. Friedman*, 294 F.Supp. 545 (S.D.N.Y. 1968) concerned a 75-page color matching booklet consisting of an arrangement of *over 500* colors where each page displayed an arrangement of selected colors and shades.

These cases indicate that the selection and/or arrangement of noncopyrightable elements such as common shapes, a few colors, or preexisting material *may* sustain the minimum level of creativity, a principle adhered to by the Office in its registration activity. However, as indicated in the previously-stated descriptions of the designs at issue here, the currently submitted works involve arrangements of far fewer number and types of constitutive elements, all of which fall short of the requisite minimum level of creativity.

Some of the cases you cited to indicate that the selection and arrangement of non-copyrightable elements such as basic shapes, colors or preexisting material *may* sustain the minimum level of creativity; this copyrightability principle is adhered to by Office. However, these cases do not advance the argument that courts have extended copyright protection to works that were found to contain a minimal level of creativity based on selection and arrangement of basic shapes and colors. In addition, we point out that several of the cases referenced in your January 28 and February 4, 2010 Letters do not represent a definitive comment with respect to the issue of copyrightability of the designs.

Apple Barrel Prods. v. Beard, 730 F.2d 384, 385 (5th Cir. 1984), involved a country music program for television broadcast which included a compilation of preexisting songs and dances. However, the Court found that the plaintiff in that case failed to prove it was entitled to a preliminary injunction. The Fifth Circuit did not analyze the television show in question there in detail but, rather, described the show as a combination of pre-existing songs and dances, of characters and script, which the district court should have examined in its entirety, and made fact findings on the originality and copyrightability of the show as a package, *i.e.*, as a whole. 730 F.2d at 388. Although this general principle is applicable to the designs at issue here, the Fifth Circuit case itself does not lend support to a conclusion that the boot designs at issue here are protectible. *Tennessee Fabricating Co. v. Moultrie Mfg. Co.*, 421 F.2d 279 (5th Cir. 1970), another pre-*Feist* case, involved a "filigree pattern of the [decorative] unit [was] formed entirely of intercepting straight lines and arc lines," but

in a way that the court found "was original with the artist employed by plaintiff." 421 F.2d at 281. However, the Court's opinion, other than stating that the design pattern at issue there "possessed at least the minimal degree of creativity required for copyright," 421 F.2d at 282, sheds no further light on the nature of the pattern, apart from the fact that it appeared on an "architectural metal casting unit intended for use in combination or singly for a decorative screen or room divider to 'finish up' a space." 421 F.2d at 280. *Tennessee Fabricating,* in the Review Board's opinion, does not stand for the proposition that any combination of basic shapes satisfies the originality requirement in copyright law. Some such combinations will be sufficient; others will not. The Fifth Circuit did not specify the exact configuration that met its creativity standard in the *Tennessee Fabricating* case.

Concord Fabrics, Inc. v. Marcus Bros. Textile Corp., 409 F.2d 1315, 1316 (2d Cir. N.Y. 1969) involved fabric designs consisting of a circle within a square within a square. The case opinion sheds no further light on the nature of the pattern. 409 F.2d at 1316. Additionally, the case did not address the issue of copyrightability but, instead, focused on substantial similarity between the plaintiff's and defendant's designs. 409 F.2d at 1316 - 1317. The Review Board does not consider this case as indicative that the designs at issue here should be registered. *Casa Editrice Bonechi, S.R.L. v. Irving Weisdorf & Co.*, 1998 U.S. Dist. LEXIS 5578 (S.D.N.Y. 1998) did not squarely address the copyrightability of the works at issue, but, rather, found that a plausible argument *could* be made regarding the copyrightability of a book cover consisting of a photograph of the Empire State Building and the words "New York" in the upper left corner in order to survive a motion to dismiss the copyright claims as a matter of law. *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 548 (S.D.N.Y. 2001), involved Chinese restaurant menus where the overall design contained the requisite originality to render it a copyrightable work despite the fact that they contained uncopyrightable elements. The case, however, sheds no further light on the nature of the pattern, other than describing the design as a "graphic design" which "contains arrangements of dishes, and in some cases, associated artwork." 175 F. Supp. 2d at 548. Instead, the court focused its analysis squarely on the rare case of a lack of copyrightable authorship in the photographs. 175 F. Supp. 2d at 546 - 548. Thus, again, the Review Board finds no support in *Oriental Art Printing* for your arguments that the designs at issue here should be registered.

The Board also notes the reference in your January 28 and February 4, 2010 Letters to the case *North Coast Industries v. Jason Maxwell, Inc.*, 972 F.2d 1031 (9th Cir. 1992). That case pointed out that a work need not be new nor the subject of a "large measure of novelty" in order to meet the originality requirement. 972 F.2d 1033. *North Coast Industries*, in making that statement, was, as you may know, citing *Catalda*, 191 F.2d 102 - 103, in explaining the necessary but low threshold of creativity. We do not consider *North Coast Industries* to be helpful to the issue of the designs appearing on the boots. The Ninth Circuit reversed the ruling of the district court which had granted summary judgment based on the opinion that the plaintiff's copyright in a design consisting of color blocks in a geometric arrangement with the color blocks bordered, or banded, by heavy lines was

invalid. The district court had found that the plaintiff's work evidenced only trivial differences from similar preexisting works. 972 F.2d at 1033. In remanding the issue of the validity of the copyright, the Ninth Circuit reasoned that the placement of geometric shapes in competing designs, although similar, may each still be sufficiently original to sustain protection and that use of color blocks with defining borders around the blocks does not *per se* mean that sufficient originality is lacking. *Id.* at 1033,1035. The Court concluded that the plaintiff was entitled to have the validity of its copyright determined by a trier-of-fact. *Id.* at 1035. Thus, although *North Coast Industries* provides confirmation of the basic and long-standing low threshold for copyright creativity of artistic works, no further specific guidance is given for such minimal designs as are at issue here. The Review Board does not find the works at issue in *North Coast* sufficiently similar to the designs affixed to the boots at issue here to result in a conclusion of even possibly copyrightable authorship as did the Court regarding the design in *North Coast*.

The Board also notes that in *Sadhu Singh Hamdad Trust v. Ajit Newspaper Advertising, Marketing & Communications, Inc.*, 503 F. Supp. 2d 577, 590 (E.D.N.Y. 2007) the issue of whether or not the arrangement of a newspaper logo and masthead possessed the minimum quantum of creativity required by United States copyright law was a disputed question of material fact, dictating the denial of plaintiff's motion for summary judgment on its copyright claim. The Court's analysis there of the quantum of sufficient creativity required under United States copyright law, although utilizing much of the case law which you and also the Review Board have cited in both arguments, did not render a final result since the Court found the newspaper logo/masthead in question – under U.S. copyright law – to be a close question. The Court declined to grant summary judgment on the copyright claim for either plaintiff or defendant. Because of the non-decision in this case, the Review Board does not consider this case to be supportive of your arguments.

Again, the Board accepts the principle that consideration of a work's eligibility for copyright protection should not be limited to constituent parts, but, rather, should be based on the work's composition as a whole. In *Boisson v. Banian Ltd.*, 273 F.3d 262 (2d Cir. 2001), the quilt design at issue there consisted of alphabet letter shapes with the incorporation of different colors in the Boisson quilt. Although the *Boisson* Court found the letter shapes themselves lay in the public domain, the use of the letter shapes in the particular layout of the quilt combined with "the author's choice in incorporating color with other elements may be copyrighted." 273 F.3d at 271. This lesson is in accord with the holding of *Feist* at 499 U.S. at 348. The overall design met the *Feist* standard. This is not the case in the simple designs at issue here; the designs affixed to the boots consist each of very few elements arranged in commonplace ways and with an additional, second design element of a second commonplace design, itself juxtaposed to the main design so that the contrast is placed at an obvious position on the boot.

We also note *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir.2003): "It is true, of course, that a combination of unprotectible elements may qualify for copyright protection.

But it is not true that *any* combination of unprotectible elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectible 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.") (citations omitted) (emphasis in original). The Board also accepts the general principle that an arrangement of common or geometric shapes *may* be copyrightable. Nevertheless, after reviewing the applications and deposits, the Board concludes that the designs at issue here, which as described above consist only of simple dot and stripe designs, bordered with various, albeit universally, simple striped trim, do not contain sufficient creative authorship to support registration.

CONCLUSION

For the reasons stated above, the Review Board concludes that, as submitted, SEASIDE CLASSIC, SEASIDE DOTS, STARBOARD STRIPES, CLASSY CLASSIC, POSH DOT, and VANGUARD STRIPE cannot be registered for copyright protection. This decision constitutes final agency action.

Sincerely,

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