United States Copyright Office
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October 12, 2012

Via First Class Mail and Fax

Kay Lyn Schwartz
Gardere Wyne Sewell LLP
3000 Thanksgiving Tower
1601 Elm Street
Dallas, Texas 75201-4761

Re: PROTAPER
(Correspondence ID: Nos. 1-94C84A, 1-AZ46QU)

ANSWER PRO TAPER
(Correspondence ID: Nos. 1-9OH3ZR, 1-B27SZD)

ANSWER PRO TAPER TAPERWALL ALUMINUM HANDLEBARS
(Correspondence ID: Nos. 1-A1YCLA, 1-B29H75)

Dear Ms. Schwartz:

On behalf of the Copyright Office Review Board (the "Board"), I am responding to your request for reconsideration of the Copyright Office's (the "Office") refusal to register PROTAPER, ANSWER PRO TAPER, and ANSWER PRO TAPER TAPERWALL ALUMINUM HANDLEBARS. You submitted these works on behalf of your client, Lacy Distribution, Inc.

The Board affirms the refusal to register, because these works contain an insufficient amount of textual or artistic authorship to support a copyright registration.

I. DESCRIPTION OF THE WORKS

This request for reconsideration involves three logos. You describe each logo as a "two dimensional work of art," and you acknowledge that they "may be characterized" as "prints or labels used for articles of merchandise." *See* Letter from Kay Lyn Schwartz concerning Correspondence ID No. 1-94C84A (May 9, 2011), Correspondence ID No. 1-9OH3ZR (June 7, 2011), and Correspondence ID No. -B29H75 (collectively referred to herein as Applicant's "First Request").

The PROTAPER logo consists of the word PROTAPER printed in a white italic typeface with the letters "P," "T," and "R" extending slightly below the rest of the letters.

This word is superimposed on a black parallelogram that is surrounded by a white border. A picture of this logo is shown below:



The other two logos are very similar to each other. The ANSWER PRO TAPER logo consists of the word PRO printed in white block letters and the words ANSWER and TAPER printed in a white italic typeface. The words ANSWER and PRO are turned on their sides, presented in a vertical orientation, and surrounded by a white border. The word TAPER is presented horizontally with the letters "A" and "P" joined together at the base. All of these elements are superimposed on a black rectangle that is surrounded by a white border. A picture of this logo is shown below:



The logo ANSWER PRO TAPER TAPERWALL ALUMINUM HANDLEBARS contains the exact same elements as ANSWER PRO TAPER. The only difference is that the words TAPERWALL ALUMINUM HANDLEBARS appear in small block letters directly beneath the terms ANSWER PRO TAPER. A picture of this logo is shown below:



The Board takes administrative notice of the fact that your client registered PROTAPER with the U.S. Trademark Office as a trademark for clothing, backpacks,

motorcycle accessories, and motorcycle glues.[1] In a letter to the Trademark Office, you explained that your client's "mark consists of the stylized words 'PROTAPER' surrounded by a rectangle."[2] The Board also takes administrative notice of the fact that your client registered ANSWER PROTAPER and ANSWER PROTAPER TAPERWALL ALUMINUM HANDLEBARS with the U.S. Trademark Office as trademarks for handlebars and clothing, respectively.[3] However, your client disclaimed any exclusive rights in the words ALUMINUM HANDLEBARS.

II. ADMINISTRATIVE RECORD

A. The Applications and the First Refusal to Register

On May 3, 2010 the Office received an application to register the logo PROTAPER, along with the required deposit and fee. On January 3, 2011, the Office received separate applications to register the logos ANSWER PRO TAPER and ANSWER PRO TAPER ALUMINUM HANDLEBARS, along with the required fees and deposits. All of these applications were filed by your firm on behalf of your client, Lacy Distribution, Inc.

These applications were reviewed by two different Registration Specialists. In each case, the Registration Specialist refused registration because the works lack the authorship necessary to support a copyright claim. Each of these letters was essentially identical. *See* Letter from Elizabeth Stringer to Kay Schwartz dated January 20, 2011;[4] Letter from Rebecca L. Barker to Kay Schwartz dated March 22, 2011;[5] Letter from Rebecca L. Barker to Kay Schwartz dated May 11, 2011.[6]

The Registration Specialists explained that copyright protects original works of authorship, which means that the work must possess at least a minimum degree of creativity. A work of the visual arts satisfies this requirement if it contains at least a minimum amount of pictorial, graphic, or sculptural authorship. The Registration Specialists explained that 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. They also noted that copyright does not extend to any

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[1] *See* U.S. Trademark Registration No. 3,596,956, attached hereto as Exhibit A. Compendium II, Compendium of Copyright Office Practices § 108.05(a) states that "[t]he Copyright Office may take notice of matters of general knowledge."

[2] *See* Letter from Kay Lyn Schwartz regarding Trademark Application Serial No. 76687946 dated 10/16/2008, attached hereto as Exhibit B.

[3] *See* U.S. Trademark Registration Nos. 2,565,279; 2,697,212, attached hereto as Exhibit A. The Trademark Office apparently cancelled these registrations in February 2009 and October 2009, because your client failed to submit evidence that these marks were in use as of those dates.

[4] The Office assigned correspondence ID number 1-94C84A to this refusal to register.

[5] The Office assigned correspondence ID number 1-9OH3ZR to this refusal to register.

[6] The Office assigned correspondence ID number 1-A1YCLA to this refusal to register.

idea, concept, system, or process which may be embodied in a work. Applying these standards, the Registration Specialists concluded that these works do not contain sufficient creative authorship within the meaning of the copyright statute or the settled case law to support a copyright claim.

Although names, titles, and slogans are not copyrightable, the Registration Specialists explained that some brand names, trade names, slogans, logos and labels may be entitled to protection under trademark law or the law of unfair competition, and they provided you with a link to the Trademark Office's website.

B. The First Request for Reconsideration

On May 9, 2011 the Office received a first request for reconsideration concerning the refusal to register PROTAPER. *See* Letter from Kay Lyn Schwartz concerning Correspondence ID No. 1-94C84A. On June 7, 2011 the Office received a first request for reconsideration concerning the refusals to register ANSWER PRO TAPER and ANSWER PRO TAPER TAPERWALL ALUMINUM HANDLEBARS. *See* Letters from Kay Lyn Schwartz concerning Correspondence ID Nos. 1-9OH3ZR and 1-B29H75. The requests for reconsideration were essentially identical.

You began by noting that "pictorial, graphic, and sculptural works" may be eligible for copyright protection under Section 102(a)(5) of the Copyright Act, and that this category includes "two-dimensional . . . works of fine, graphic, and applied art, photographs, [and] prints." *See* First Request at 1 (citing 17 U.S.C. § 101). You noted that the term "prints" includes "prints and labels used for articles of merchandise" and you acknowledge that your client's works "may be characterized" as a commercial print or label. *See id.* at 1.

You noted that a work may qualify for copyright protection if it "was independently created by the author (as opposed to copied from other works)" and if "it possesses at least some minimal degree of creativity." *See id.* at 2 (quoting *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)). You also noted that "the requisite level of creativity is extremely low," that "even a slight amount will suffice," and that "the originality required to support a copyright claim may be of a most minimal nature." *See id.* (quoting *Feist*, 499 U.S. at 1287 and citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903)).

You asserted that each work is not merely a word or a short phrase, but rather, two-dimensional artwork that embodies "various elements and design features." You contended that the "individual components of Claimant's original artwork creates a unique visual impression" through "a combination of letters, words, and graphical elements." *See id.* The

specific elements that you identified in your first request for reconsideration include the following:

- The word ANSWER is depicted in a "highly stylized" font, and the letters in TAPER and PROTAPER are slanted to the right, which gives the word a "tapered" appearance.
- The letters "A" and "P" in TAPER "are joined together at the bottom forming a combined base . . . providing a central focal point to the artwork."
- The letters "P," "T," and "R" in PROTAPER are slightly longer than the rest of the letters in this word "and extend 'below' the design."
- The vertical orientation of the words ANSWER and PRO.
- The terms PRO and TAPER are shown in a white font that is superimposed on a black background, while the word ANSWER is shown in a black font that is outlined in white on a black background.
- The use of a white border surrounding the words ANSWER and PRO, and a white "double border" that frames the entire design.

You also asserted that each work is unique. You described each logo as a "unique artwork embodying various elements and design features," including "a unique black and white artistic display of a combination of letters, words and graphical elements." You also noted that the "letters and words in Claimant's artwork are depicted uniquely" and that the "individual components of Claimant's original artwork creates a unique visual impression." *See id.*

You acknowledged that "familiar symbols or designs" and "mere variations" of typographic ornamentation, lettering or coloring" are not subject to copyright protection. *See id.* at 2, 3 (citing 37 C.F.R. § 202.1). However, you contended that the Applicant's works are eligible for copyright protection, because they do not consist of "plain text in Times Roman Font (which might be considered a mere variation of typographic ornamentation)." *See id.*

C. The Response to the Applicant's First Request for Reconsideration

In letters dated September 21, 2011 and October 3, 2011, Attorney Advisor Virginia Giroux-Rollow of the Registration Program responded to the Applicant's first request for reconsideration concerning PROTAPER, ANSWER PRO TAPER, and ANSWER PRO TAPER TAPERWALL ALUMINUM HANDLEBARS. In each case, Ms. Giroux-Rollow upheld the refusal to register, because these works do not contain a sufficient amount of

original, creative, and artistic authorship to support a copyright registration. *See* Letters from Virginia Giroux-Rollow to Kay Lyn Schwartz concerning Correspondence ID Nos. 1-B27SZD, 1-B29H75, 1-AZ46QU (collectively referred to herein as the "First Response").[7]

Ms. Giroux-Rollow conceded that prints and labels may be subject to copyright protection if they contain an appreciable amount of original text and/or pictorial expression. However, "not every commercial label is copyrightable." *See* First Response at 1 (quoting *Kitchens of Sara Lee v. Nifty Foods Corp.*, 266 F.2d 541 (2d Cir. 1959)). This principle is reflected in 37 C.F.R. § 202.1, which states that brand names, titles, words, short phrases, or expressions are not subject to copyright protection, even if they are distinctively printed or arranged. Ms. Giroux-Rollow noted that the Second Circuit found the Copyright Office's regulation to be "a fair summary of the law" in *Kitchens of Sara Lee*. *See id.* at 1.

In order to be copyrightable, Ms. Giroux-Rollow explained that a work must be independently created by the author and it must "possess more than a de minimis quantum of creativity." *See id.* at 1 (quoting *Feist*). In the case of a label, the work must contain a certain minimum amount of pictorial, graphic, and/or textual expression that originated with the author. She explained that "originality, as interpreted by the courts, means that the authorship must constitute more than a trivial variation or arrangement of public domain, pre-existing, or noncopyrightable elements." *See id.* (citing *Alfred Bell v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951)). In applying these standards, the Office examines the work to determine if it contains any elements – either alone or in combination – which would support a registration. Ms. Giroux-Rollow explained that the uniqueness or attractiveness of the work, the symbolic meaning or visual impression of the work, the time, effort, and expense involved in creating the work, or its commercial success in the marketplace are irrelevant to the examination process. Instead, the relevant question is whether the work contains a sufficient amount of original and creative authorship within the meaning of the copyright law and settled case law. *See id.* at 1-2.

Ms. Giroux-Rollow described the works at issue in this appeal as a label design consisting of the words TAPER or PROTAPER in white lettering slightly slanted to the right and inscribed on a black rectangle surrounded by a thin white border. Two of these works also contain the words PRO and ANSWER inscribed vertically in a smaller black rectangle with a white border, and one of them contains the words TAPERWALL ALUMINUM HANDLEBARS shown in white lettering beneath the words ANSWER, PRO, and TAPER. *See id.* at 2.

Citing 37 C.F.R. § 202.1, Ms. Giroux-Rollow stated that names, titles, words, short phrases and expressions are not copyrightable. Citing the same regulation, she stated that rectangles – no matter what their size – are common and familiar shapes that are not copyrightable. Likewise, "[t]he fact that lettering may be stylized or embellished in size,

[7] The Office assigned correspondence ID numbers 1-AZ46QU, 1-B27SZD, and 1-A1YCLA to these letters, and each letter was essentially identical.

shape, font, coloring, and positioning does not transform the work into a copyrightable 'work of art,'" because typographic ornamentation, type font, lettering, and coloring are not copyrightable. *See id.* at 2. Applying these principles, Ms. Giroux-Rollow concluded that each work is a *de minimis* graphic design "involving noncopyrightable text, lettering, and coloring coupled with common and familiar rectangular shapes arranged in a rather simple configuration." She also concluded that the combination and arrangement of these elements "is not sufficiently creative to constitute a copyrightable 'work of art.'" *See id.* at 2 (citing Compendium II, § 503.02(a)).

In support of her decision, Ms. Giroux-Rollow cited a number of cases where the courts upheld the Office's refusal to register claims involving *de minimis* designs. *See id.* at 2 (citing *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986) (upholding the Office's refusal to register a logo consisting of four angled lines forming an arrow combined with the word "arrows" in a cursive script, noting that the design lacked the minimal creativity necessary to support a copyright); *Forstmann Woolen Co. v. J.W. Mays, Inc.*, 89 F. Supp. 964 (E.D.N.Y. 1950) (holding that a label containing the words "Forstmann 100% Virgin Wool" interwoven with three fleur-de-lis was not copyrightable); *Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q.2d 1074 (D.D.C. 1991) (upholding the Office's refusal to register a "gothic" dinnerware pattern containing simple variations and combinations of geometric shapes because the creative authorship was insufficient to merit copyright protection); *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988) (upholding the Office's refusal to register a fabric design consisting of a small grid of squares superimposed on a series of stripes because the design did not meet the minimal level of creative authorship necessary for copyright protection); *Magic Marketing, Inc. v. Mailing Servs. of Pittsburgh, Inc.*, 634 F. Supp 959 (W.D. Pa. 1986) (envelopes printed with black stripes and a few words and lettering did not exhibit the minimal level of creativity to support a copyright registration)).

Ms. Giroux-Rollow conceded that the requisite level of creativity is very low and that even a slight amount of original authorship will suffice (citing *Feist* and *Bleistein*). However, she noted that "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright." *See id.* at 2 (quoting *Nimmer on Copyright*, § 2.01(B)). She concluded that the works at issue in this appeal – consisting of a few words in white lettering on a black rectangular background surrounded by a white border – fail to meet even the low threshold for copyrightable authorship articulated in *Feist*. Likewise, when your client's works are viewed in their entirety and the noncopyrightable elements of each work are judged "not separately, but rather in their overall inter-relatedness within the work as a whole," Ms. Giroux-Rollow found "that the treatment and combination of the few elements" in these works failed to support a registrable claim to copyright. *See id.* at 3 (citing *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989)).

Ms. Giroux-Rollow also addressed your contention that the positioning, physical layout, and arrangement of elements on these labels contain sufficient creativity and

originality to warrant registration. The Office has determined that "the arrangement, spacing, sizing, and juxtaposition of the textual matter" in a book design is not copyrightable. *See id.* at 3 (citing Compendium II, §§ 305.06, 305.07). Applying these same principles, Ms. Giroux-Rollow found that the "simple arrangement of graphics" in these labels is likewise non-copyrightable. *See id.*

Although there may have been other ways to design these works, Ms. Giroux-Rollow explained that this does not affect the copyrightability calculus. "All designs involve choices," she wrote, "[i]t is not the possibility of choices that determines copyrightability, but rather whether the particular resulting expression contains copyrightable authorship." *See id.* at 3.

Finally, Ms. Giroux-Rollow noted that some label designs may be entitled to protection under trademark or unfair competition law, but she noted that the Copyright Office has no jurisdiction in such matters. *See id.* at 3.

D. The Second Request for Reconsideration

In December 2011 the Office received a second request for reconsideration concerning the refusal to register PROTAPER, ANSWER PRO TAPER, and ANSWER PRO TAPER TAPERWALL ALUMINUM HANDLEBARS. Each letter was essentially identical. *See* Letter from Kay Lyn Schwartz dated December 20, 2011 concerning Correspondence ID No. 1-AZ46QU; Letter from Kay Lyn Schwartz dated December 27, 2011 concerning Correspondence ID Nos. 1-B27SZD and 1-B29H75 (collectively referred to herein as the "Second Request").

You acknowledge that originality is a Constitutional requirement and that originality requires "at least some minimal degree of creativity." Quoting *Feist*, you state that the requisite level of creativity is "extremely low," that even a "slight amount" will suffice, and that the "vast majority" of works will meet the test if the work reveals some "creative spark" "no matter how crude, humble, or obvious" it might be. *See* Second Request at 1. You state that a work does not have to be strikingly unique or novel in order to satisfy the creativity requirement. "All that 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." *See id.* at 2 (quoting *Alfred Bell & Co.*).

You then question the Office's reliance on 37 C.F.R. § 202.1(a) as a basis for refusing to register these works. This regulation states that "words and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents" are not subject to copyright. You assert that this regulation "and the implicit generalization that no 'word' or 'phrase' can ever satisfy the originality requirement of copyright law is inaccurate and not supportable under the law." *See id.* at 2.

You acknowledge that "there are many case examples" where the courts have denied copyright protection to short phrases. *See id.* For instance, you note that the phrase "Hang in there" has been held to be a "stereotypic phrase" that is not subject to copyright protection. *See Perma Greetings, Inc. v. Russ Berrie & Co.*, 598 F. Supp. 445 (E.D. Mo. 1984). You also note that the phrase "You've got to stand for something or you'll fall for anything" was found to be unoriginal, because it was widely used by the public, which made it unlikely that the plaintiff independently created the phrase. *See Acuff-Rose Music, Inc. v. Jostens, Inc.*, 47 U.S.P.Q.2d 1953 (2d Cir. 1998).

You assert that your client's work is neither a "stereotypic phrase" nor "a single word or short phrase." Instead, you contend that each work constitutes "a two-dimensional artwork that incorporates the coined term 'PROTAPER' as well as unique artistic elements . . . which as a whole form a copyrightable work of unique expression." *See id.* at 2. In addition to the elements that you identified in your first request for reconsideration, you state that your client's works contain the following artistic elements:

- The use of the "coined term PROTAPER."
- The juxtaposition of the letters in PROTAPER (which are slanted to the right) with the black, rectangular background (which is slanted to the left).[8]

You assert that these elements – when "taken individually" and when considered "as a whole" – contain a sufficient "creative spark" that each work "as a whole constitutes an original work meritorious of copyright protection." *See id.* at 3.

III. DECISION

When considering a second request for reconsideration, the Review Board carefully reviews the works that have been submitted for registration, the application to register each work, and all of the correspondence between the Applicant and the Copyright Office, including the arguments set forth in the Applicant's first and second requests for reconsideration. The refusal to register is subject to *de novo* review, which means that the Board will take a fresh look at whether each work is copyrightable and whether it can be registered.

The Board upholds the refusal to register these works, because they do not contain sufficient creative authorship to support a registration. In evaluating these works, the Review Board considered both the individual elements of each work as well as the works as a whole.

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[8] You also contend that the artistic elements of your client's works include "other things," but these unspecified "things" are not identified in any of your letters. *See id.* at 3.

A. The Legal Framework for Evaluating Copyrightability

The copyright law only protects "original works of authorship." 17 U.S.C. § 102(a). As the Supreme Court explained in *Feist*, originality requires "independent creation plus a modicum of creativity." *Feist*, 499 U.S. at 346. In this context, "independent creation" means that the author created his or her work without copying from another. *Id.* at 345. Based on your representation that Lacy Distribution, Inc. is the author of these works, the Board finds that the independent creation requirement has been met. Therefore, the Board focuses on the second aspect of the originality requirement, namely, that the work must possess a sufficient amount of creativity.

1. The Creativity Requirement

In *Feist*, the Supreme Court reaffirmed that originality is a Constitutional requirement and that a work must possess "some minimal degree of creativity" in order to sustain a copyright claim. 499 U.S. at 362. You correctly state that the requisite level of creativity is "extremely low" and that "even a slight amount" of creative expression will suffice. Second Request at 1 (quoting *Feist*, 111 S. Ct. 1282, 1287). You also correctly state that the "vast majority" of works will meet this requirement, provided that they contain "some creative spark" "no matter how crude, humble or obvious it might be." *Id.* (quoting 111 S. Ct. at 1287).

While this standard is broad, it is not limitless. The Supreme Court recognized that "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity," 499 U.S. at 363, and that there can be no copyright in a work where the "creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359 (citing *Nimmer* § 2.01[B] ("there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright").

Cases decided before *Feist* used a similar standard to evaluate works of the visual arts, such as the mezzotint engraving at issue in *Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951). As you note, "[a]ll that 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.'" Second Request at 2 (quoting *Alfred Bell & Co.*). However, that does not mean that every work of the visual arts is automatically copyrightable, or that a minimum standard for copyrightability does not exist. The Second Circuit clearly stated that an author must contribute "something more than a 'merely trivial' variation" in order to satisfy the originality requirement. 191 F.2d at 103. Forty years later, *Feist* confirmed that the "standard of originality is low, but it does exist." 499 U.S. at 362.

2. Words, Short Phrases, Geometric Shapes, and Mere Variations of Typographic Lettering or Coloring are not Copyrightable

In refusing to register these works, both the Registration Specialists and Ms. Giroux-Rollow cited the *Feist* decision as one of the authorities for their decision that these works lack sufficient creativity to support a registration. In addition, Ms. Giroux-Rollow relied on the Second Circuit's decision in *Kitchens of Sara Lee v. Nifty Foods Corp.*, 266 F.2d 541 (2d Cir. 1951). The Board agrees that this case is directly on point. In *Kitchens of Sara Lee*, the plaintiff sought to protect the labels for three pre-packaged frozen cakes. Each label contained the "brand name 'Sara Lee' in bold white letters" superimposed on a "bright red" background," a pictorial representation of the product together with a "superfluous" tagline such as "all butter pound cake," a list of the ingredients and weight for each cake, and instructions on how to serve the product. *See id.* at 544. The Second Circuit held that the pictorial representations were copyrightable, but the rest of the elements on the labels were not:

> Not every commercial label is copyrightable; it must contain "an appreciable amount of original text or pictorial material." "Brand names, trade names, slogans, and other short phrases or expressions cannot be copyrighted, even if they are distinctively arranged or printed." The Copyright Office does not regard as sufficient to warrant copyright registration "familiar symbols or designs, mere variations of typographic ornamentation, lettering or coloring, and mere listings of ingredients or contents." Although the publication of these views (Copyright Office Publication, No. 46, Sept. 1958) does not have the force of statute, it is a fair summary of the law. . . . Plaintiff recognizes this principles, saying "Of course, plaintiff can have no monopoly in words as such, nor can it claim any exclusive rights in . . . colors, type styles, circular and rectangular shapes, [or] positions of the various elements . . . ."

Id. The Copyright Office Publication quoted by the Second Circuit is a direct predecessor of the Copyright Office's current regulation which is set forth in 37 C.F.R. § 202.1, and the Office adheres to the standards announced in *Feist*, *Alfred Bell & Catalda*, and *Kitchens of Sara Lee* in determining whether a work is eligible for registration.

Section 202.1(a) of the regulations currently states that "words and short phrases such as names, titles, and slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering or coloring" are "not subject to copyright and applications for registration of such works cannot be entertained." 37 C.F.R. § 202.1(a). With respect to pictorial, graphic, and sculptural works – the relevant class for the works at

issue in this appeal – the Compendium of Copyright Office Practices states that common geometric figures or shapes are not eligible for copyright protection. *See* Compendium II, § 503.02(a) ("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"). The same is true of a minor alteration or simple variation on a standard shape or a simple combination of a few standard symbols. *See id.* ("a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations" is not copyrightable). With respect to labels and commercial prints, the Office has determined that a "copyright claim cannot be based solely upon mere variations of typographic ornamentation, lettering, or coloring." *See id.* § 506.03. "Likewise, the arrangement of type on a printed page cannot support a copyright claim." *Id.*

3. Selection, Coordination, and Arrangement of Unprotectable Elements

Although words, short phrases, geometric shapes, and mere variations of typographic lettering or coloring are not eligible for copyright protection on an individual basis, a work that combines these elements in a creative manner may be copyrightable in some cases. For example, a combination of common shapes may satisfy the low standard for copyrightability if there is sufficient creativity in the selection, coordination, or arrangement of elements, or if there is recognizable creative authorship in the overall design of the work as a whole. *See Atari Games Corp. v. Oman,* 979 F.2d 242, 245 (D.C. Cir. 1992). However, it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. As the Ninth Circuit explained, "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." *Satava v. Lowry,* 323 F.3d 805, 811 (9th Cir. 2003). Merely combining non-protectable elements does not satisfy this requirement where the combination or arrangement is simplistic or trivial. *See id.*

B. The Applicant's Works Are Not Copyrightable

You contend that "many aspects" of your client's works – when "taken individually" and when considered "as a whole" – contain a sufficient "creative spark" such that each work "constitutes an original work meritorious of copyright protection." Second Request at 3. The Board disagrees on both counts. None of the arguments presented in your first or second request for reconsideration support the proposition that these works contain sufficient creative authorship to warrant a registration. While the amount of creative expression needed to establish copyrightable authorship is admittedly low, the logos at issue in this appeal fall within the narrow category of works that are "too trivial or insignificant to support a copyright." *Feist,* 499 U.S. at 359.

1. The Individual Elements of Each Logo are Uncopyrightable

a. Geometric shapes

You contend that the Applicant's works are copyrightable, in part, because they contain "unique artistic elements." Second Request at 2. These elements include the white border that surrounds the words ANSWER and PRO in two of these logos, and the so-called "double border" that surrounds all three logos. You also point to the juxtaposition of the background in the PROTAPER logo (which is slanted to the left) with the letters that appear in that logo (which are slanted to the right).

Squares, rectangles, and parallelograms are common and familiar geometric shapes. They are among of the simplest building blocks for pictorial and graphic works, and as such, they are not copyrightable when considered individually. *See* Compendium II, § 202.02(j) ("Familiar symbols or designs . . . are not copyrightable."); *see also* Compendium II, § 503.02(a) ("[I]t is not possible to copyright common geometric figures or shapes . . . ."). Likewise, a trivial combination of common geometric shapes – in and of itself – does not demonstrate the requisite amount of creativity to support a registration. Compendium II, § 503.02(a) ("It is not possible to copyright . . . a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations.").

Each of these logos contains one or two geometric shapes that have not been altered in any way. The PROTAPER logo is nothing more than a black parallelogram with rounded edges and surrounded by a thin white border. There is simply no creativity in smoothing the edges of a four-sided geometric shape or placing a thin border around that shape, particularly when it is done in a uniform manner. Nor is there any creativity in combining a parallelogram that is slanted in one direction with a single word that is slanted in the other direction. The other logos feature a simple white square inside a simple black rectangular surrounded by a thin white border. This combination and arrangement of two geometric shapes lacks sufficient creativity to support a copyright. *See* Compendium II, § 503.02(b) ("[T]he creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations"). In fact, you acknowledge that the rectangular border that surrounds each logo "is substantially the same proportion" as the square border surrounding the words 'ANSWER' and 'PRO.'" First Request at 3.

These types of trivial decisions have been found to be uncopyrightable time and time again by the courts. For example, in *Yankee Candle Co. v. Bridgewater Candle Co.*, the district court rejected a copyright claim in the label for a line of scented candles. "The name of the fragrance appear[ed] at the center of the label, in a gold-outlined title plate with a white background." 99 F. Supp. 2d 140, 143 (D. Mass. 2000). The court determined that this "rectangular, gold-bordered name plate" was a "crude physical" element that did not enjoy copyright protection. *Id.* at 148. On appeal, the plaintiff argued that these elements

should be protected, because they were "discretionary" design decisions. The First Circuit disagreed. "The 'discretion' claimed by Yankee involves (i) the use of a rectangular 'title plate' with block lettering on a white background; (ii) the imposition of that title plate, centered, on a photographic representation of the candle fragrance; and (iii) a rectangular border around the photograph. This collection of common geometric shapes within a particular photographic technique is not sufficiently original to qualify for copyright protection." 259 F.3d 25, 34-35 (1st Cir. 2001) (citations omitted).

In the Board's view, the commercial labels at issue in *Yankee Candle* are indistinguishable from the geometric shape and the surrounding borders found in the Applicant's logos.

b. Typeface and mere variations of typographic ornamentation and lettering

You contend that your client's works merit copyright protection, because some of the words and letters in each logo are presented in a unique typeface. Specifically, you state that the word ANSWER is "uniquely" "depicted in a highly stylized font" and that the letters in TAPER and PROTAPER are slanted to the right. You note that the letters "A" and "P" in TAPER and PROTAPER "are joined together at the bottom," which provides a "central focal point" for each logo. You also note that the letters "P," "T," and "R" in the PROTAPER logo extend below the rest of the letters, while the base of the letter "P" merges with the white border that surrounds the logo.

Neither typeface nor "variations in typographic ornamentation [or] lettering" are copyrightable. *See* 37 C.F.R. §§ 202.1(a), (3). In *Eltra Corp. v. Ringer*, 579 F.2d 294 (4th Cir. 1978) the Office refused to register a typeface design under the 1909 Act.[9] Both the district court and the court of appeals affirmed the Office's decision, noting that "typeface has never been considered entitled to copyright under the provisions of [the 1909 Act]." 579 F.2d at 298. The Fourth Circuit noted that many parties have asked "Congress to amend the law in order to provide copyright protection to typeface," and "[j]ust as consistently Congress has refused to grant the protection." *Id.* Congress specifically addressed this issue when it drafted the current statute – the Copyright Act of 1976 – and concluded that typeface is not copyrightable. As the House Report explained: "The Committee does not regard the design of typeface, as thus defined, to be a copyrightable 'pictorial, graphic, or

[9] To this list could be added appellate decisions, such as *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 683 (2d Cir. 1998) ("Even if these choices regarding which words to capitalize and shorten to form the West digest title were an original inspiration, we doubt the decisions to shorten the titles or capitalize certain letters would be copyrightable.") and numerous district court decisions, such as *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495 (S.D.N.Y. 2005) (upholding the Office's refusal to register a logo consisting of the letter C in a stylized typeface) and *Secure Servs. Tech., Inc. v. Time & Space Processing, Inc.*, 722 F. Supp. 1354, 1363 n.25 (E.D. Va. 1989) ("Size of print . . . is not copyrightable").

sculptural work' within the meaning of this bill . . . ." H.R. Rep. No. 94-1476, 94th Cong., 2d Session at 55 (Sept. 3, 1976).

The words PRO, TAPERWALL, ALUMINUM, and HANDLEBARS are presented in block letters, while the words TAPER and PROTAPER are presented in standard italics, which is a mere variation in typographic ornamentation or lettering. These elements are devoid of creative authorship. As for the word ANSWER, the Board notes that many typefaces use a monospaced, sans-serif style, and the pointed edges in the letters "A" and "R" or the extended curves in the letter "S" do not constitute copyrightable variations of such letterforms. Likewise, the Board finds no creative expression in the vertical orientation of the words ANSWER and PRO, or the different font sizes that the Applicant used for the various elements of these logos.

You contend that these logos do not fall within § 202.1 of the regulations, because they are not depicted in "plain text in Times Roman Font (which might be considered a mere variation of typographic ornamentation)." First Request at 2. You seem to be suggesting that the prohibition against "typeface" only applies to the standard fonts that are typically found in word processing programs, such as Arial, Courier, and Helvetica, and that the prohibition against "mere variations in typographic ornamentation [or] lettering" only applies to the standard variations on those fonts, such as, roman, **boldface**, and *italic*. That is incorrect. Section 202.1 of the regulations applies to any typeface or any variation in typographic ornamentation or lettering, regardless of whether it is commonly used or truly unique.

The fact that some of the letters in TAPER and PROTAPER are linked together or extend below the rest of the letters, is no more than a trivial variation of a standard typeface. The Board accepts your representation that these elements may create a central focal point for each logo, but the aesthetic appeal of these works is irrelevant to the issue of copyrightability. *See* Compendium II, § 503.01 ("Copyrightability depends upon the presence of creative expression in a work, and not upon aesthetic merit, commercial appeal, or symbolic value."). The relevant question is whether the Applicant has submitted a work that contains a sufficient amount of creative expression to warrant copyright protection, and the caselaw and the legislative history is clear that mere typeface or mere variations of typographic ornamentation do not satisfy this requirement.

c. Mere Variations of Coloring

You contend that the Applicant's logos are copyrightable, in part, because the words ANSWER, PRO, and TAPER are shown in black or white letters superimposed on a black background. You also note that each logo contains a white border that frames the entire design.

All of these elements are presented in a uniform black or white color. Simply put, there is no creativity in a label that features monochrome letters on a monochrome background. *See Kitchens of Sara Lee*, 266 F.2d at 544 (no copyright protection for a commercial label featuring the "brand name 'Sara Lee' in bold white letters" superimposed on a "bright red" background). Likewise, the use of a white border is a functional design choice that is not protected by copyright, because it merely separates the brand name for the Applicant's products from the background of the logo. *See Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 35 (1st Cir. 2001) (extending copyright protection to the border of a commercial label "would impermissibly narrow the possibilities available to other label designers").

d. Words and Short Phrases

The works at issue in this appeal are commercial logos that contain no more than six words. The PROTAPER logo contains a single word, the ANSWER PRO TAPER logo contains three words, and the logo ANSWER PRO TAPER TAPERWALL ALUMINUM HANDLEBARS contains a half dozen words.[10]

You cite no cases where a court extended copyright protection to a commercial label containing half a dozen words – much less a case involving a label consisting solely of a single word such as PROTAPER. Instead, you contend that each logo is not simply a word or short phrase, but rather a "unique artwork embodying various elements and design features." First Request at 2. The Board agrees that a holistic analysis is appropriate when the Applicant seeks to register a work based on the selection, coordination, and arrangement of its constituent elements, and the Board analyzes the works as a whole in Section B.2 below. However, you contend that "the elements of [the Applicant's] artwork, *taken individually*, exhibit a 'creative spark,'" such that each logo "constitutes an original work meritorious of copyright protection." Second Request at 3 (emphasis added). Therefore, it is appropriate to consider the individual elements that appear in each logo, particularly where – as here – those elements are uncopyrightable regardless of whether they are viewed separately or in combination with each other.

Section 202.1(a) of the regulations provides that "words and short phrases such as names, titles, and slogans" are not subject to copyright protection. Each of these logos falls squarely within the meaning of a "word" or a "short phrase" and each logo lacks the creativity necessary to support a registration. In *Kitchens of Sara Lee*, the Second Circuit explained that copyright protection for a commercial label requires "an appreciable amount of original text." 266 F2d at 544. The court found that brand names or trade names, such as

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[10] The Board accepts your representation that PROTAPER is a coined term, and giving your client the benefit of the doubt, the Board assumes that TAPERWALL is also coined. *See* Second Request at 2. Therefore, the Board treats PROTAPER as a logo consisting of a single word, and ANSWER PRO TAPER TAPERWALL ALUMINUM HANDLEBARS as a logo consisting of no more than six words.

SARA LEE, do not satisfy this requirement. Likewise, short phrases or expressions that identify or describe the nature of a commercial product, such as "cream cheese cake" or "all butter pound cake" "cannot be copyrighted even if they are distinctively arranged or printed." *Id.* (quoting Copyright Office Publication No. 46, Sept. 1958, which was the immediate predecessor to the current version of Copyright Office regulation § 202.1(a)).

Other appellate courts have applied the same test. In *Alberto-Culver Co. v. Andrea Damon, Inc.*, 466 F.2d 705 (7th Cir. 1972), the Seventh Circuit held that the phrase "the most personal sort of deodorant" on a commercial label was an uncopyrightable short phrase or expression lacking an "appreciable amount of original text." *Id.* at 711. In *CMM Cable Rep, Inc. v. Ocean Coast Props, Inc.*, 97 F.3d 1504 (1st Cir.1996), the First Circuit found that the slogans "call in, clock in, and win," "if you're still 'on the clock' at quitting time," and "clock in and make $50 an hour" lacked the minimal level originality. *Id.* at 1520 & n.21. Likewise, the Sixth Circuit found the phrase "Good Morning Detroit. This is J.P on JR in the A.M. Have a swell day," to be "a phrase or slogan not worthy of copyright protection in its own right." *Murray Hill Publ'ns v. ABC Commc'ns*, 264 F.3d 622, 633 (6th Cir. 2001).

The logos at issue in this appeal do not contain an appreciable amount of text. Indeed, they contain less text than the commercial labels at issue in *Kitchens of Sara Lee* and *Alberto-Culver*, or the advertising slogans at issue in *CMM Cable Rep* and *Murray Hill Publ'ns*. Moreover, the text that appears in each logo is not merely a collection of uncopyrightable word or short phrases. PRO, PROTAPER and ANSWER PROTAPER are the brand names for the Applicant's products, as demonstrated by the fact that your client registered these terms with the U.S. Trademark Office for clothing, backpacks, handlebars, motorcycle accessories, and motorcycle glues. ALUMINUM HANDLEBARS is presumably the generic name for the Applicant's products. As the Second Circuit explained, brand names and the generic name for a particular product "cannot be copyrighted even if they are distinctively arranged or printed." 266 F.2d at 544.

Finally, the Board notes that the logo ANSWER PRO TAPER is virtually identical to the logo ANSWER PRO TAPER TAPERWALL ALUMINUM HANDLEBARS. The only difference is one logo contains the words TAPERWALL ALUMINUM HANDLEBARS while the other does not. The Board assumes that one of these logos is derivative, which means that any claim in that work would have to be based on the material that has been added to or subtracted from the preexisting work. Even if these logos contained a sufficient amount of creative expression to support a copyright registration, merely adding or subtracting three words is simply a trivial variation that is not subject to copyright protection. *See Alfred Bell & Co.*, 191 F.2d 99 (a derivative work may be copyrightable if it contains more than a trivial variation or arrangement of public domain, pre-existing, or noncopyrightable elements).

e. Legal Precedents

In your Second Request for Reconsideration you challenge the validity of § 202.1(a) of the regulations. You assert that this regulation "and the implicit generalization that no 'word' or 'phrase' can ever satisfy the originality requirement of copyright law is inaccurate and not supportable under the law." Second Request at 2. However, you do not cite any cases or other legal authorities to support this remarkable assertion. Nor do you attempt to distinguish any of the cases that Ms. Giroux-Rollow cited in her letters.[11]

The Office adopted § 202.1(a) in 1959 and subparagraph (a) of the regulation has not changed since then. *See* 24 Fed. Reg. 4956 (June 18, 1959). Over the past 53 years, numerous appellate and district courts have upheld this regulation and the basic principle that words and short phrases are not copyrightable. *See, e.g., Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 286-87 (3d Cir. 2004) (holding that the Office's regulation and "long-standing practice against registering short phrases" "merits deference"); *Kitchens of Sara Lee,* 266 F.2d at 544 (stating that Copyright Office Publication No. 46 – the immediate predecessor to § 202.1(a) of the current regulations – was "a fair summary of the law," including the refusal to register "short phrases or expressions"); *Coach, Inc. v. Peters*, 386 F. Supp.2d 495 (S.D.N.Y. 2005) (upholding the Office's refusal to register a logo consisting of a stylized letter C under § 202.1 of the regulations); *Sweet v. City of Chicago*, 953 F. Supp. 225, 229 (N.D. Ill. 1996) (Citing § 202.1 and stating that "[i]t is well established that titles and short phrases are not protected by copyright").

In your Second Request for Reconsideration you acknowledge – as you must – that "there are many case examples where short phrases were denied copyright protection . . . ." Second Request at 2. However, you seem to be suggesting that the courts will refuse to protect a short phrase *only* if it "is in widespread usage by the public" such that it was "unlikely that the [plaintiff] had independently created the phrase." *Id.* You cite two cases in support of this proposition, namely, *Perma Greetings, Inc. v. Russ Berrie & Co.*, 598 F. Supp. 445 (E.D. Mo. 1984) and *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 988 F. Supp. 289 (S.D.N.Y. 1997), *aff'd*, 155 F.3d 140 (2d Cir. 1998).

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[11] *See* Letters from Virginia Giroux-Rollow to Kay Lyn Schwartz concerning Correspondence ID Nos. 1-B27SZD, 1-B29H75, 1-AZ46QU, citing *Kitchens of Sara Lee*, 266 F.2d 541 (2d Cir. 1959) (recognizing that brand names, trade names, and slogans are not copyrightable); *John Muller & Co.,* 802 F.2d 989 (8th Cir. 1986) (upholding a refusal to register a logo consisting of a trademark combined with a graphic image); *Forstmann Woolen Co.*, 89 F. Supp. 964 (S.D.N.Y. 1950) (clothing label combining the "Forstmann" trademark with the phrase "100% Virgin Wool" and three fleur-de-lis not copyrightable); *Mktg, Inc. v. Mailing Serv. of Pittsburgh, Inc.*, 634 F. Supp. 969 (W.D. Pa. 1986) (envelopes printed with black stripes and short phrases such as "contents require immediate attention," "telegram," "gift check," and "priority message," did not exhibit the minimal level of creativity to support copyright protection under § 202.1 of the regulations).

The Board accepts your representation that Lacy Distribution, Inc. independently created the logos at issue in this appeal. The Board also accepts your representation that PROTAPER, ANSWER PRO TAPER, and ANSWER PRO TAPER ALUMINUM HANDLEBARS are not "stereotypic phrases." However, the Board finds nothing in *Acuff-Rose Music* or *Perma Greetings* to support your contention that an independently created phrase can be registered, regardless of whether it contains copyrightable authorship.

In *Acuff-Rose Music*, a record company registered the words and music for a country music song, which included the lyric "You've got to stand for something or you'll fall for anything." When a jewelry manufacturer used that same line in an advertising brochure, the record company sued for copyright infringement. The district court recognized that the line was a "common saying" that appeared in many other works long before it appeared in this particular song. However, that was not the only basis for the court's decision. Judge Denny Chin found that copyright "extends to [the artist's] vocal rendition of the phrase, but in this case, not to the unoriginal line alone." 988 F. Supp. at 295. He explained that "the lyric at issue lacks the requisite originality," because the composer and lyricist "did not embellish the words in any way or otherwise infuse them with any 'creative spark.'" 988 F. Supp. at 294, 295.

In *Perma Greetings* the plaintiff accused the defendant of infringing fifteen coaster designs. Three of these works merely contained a short phrase, while the rest combined a short phrase with a drawing.[12] 598 F. Supp. at 447. Citing § 202.1 of the regulations, the district court noted that words and short phrases are not copyrightable and that the Office refused to register three of the designs on that basis.[13] Although the defendant adopted one of these phrases before the plaintiff, the court's decision was not based on the issue of independent creation. Instead, the court found that these phrases "are not subject to copyright protection" because they conveyed "an idea that is typically expressed in a limited number of stereotypic fashions." *Id.* at 448, 449. In other words, the court rejected the plaintiff's copyright claim due to a lack of creativity, rather than a lack of independent creation.

Finally, the Board notes that the lyric at issue in *Acuff-Rose Music* contained eleven words while the coasters at issue in *Perma Greetings* contained no more than six words. The logos at issue in this appeal contain a similar amount of text, and as such, both of these cases do not support the Applicant's request for reconsideration in this appeal.

3. The Works as a Whole are Uncopyrightable

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[12] Some of the phrases at issue in the case included "Enjoy" vs. "I'd enjoy the day more;" "Mug me" vs. "I love my mug;" "A good friend is someone special" vs. "Good friends are hard to find;" "Hang in there" vs. "Hang in there" and "Along the way take time to smell the flowers." *See* 598 F. Supp. at 449.

[13] It is likely that the Office refused to register the three coasters that contained a short phrase without any artwork, although this is not clearly stated in the court's opinion.

The logos at issue in this appeal contain only a few elements. Specifically, each logo contains one to six words presented in a specific typeface and combined with one or two geometric shapes. As discussed above, individual words, geometric shapes, and mere variations in typographic ornamentation, lettering, and coloring do not contain a sufficient amount of authorship to sustain a registration when examined individually.

You contend that when these elements are considered as a whole, each logo exhibits a "creative spark, such that the work as a whole constitutes an original work meritorious of copyright protection." Second Request at 3. The Board accepts the principle that eligibility for copyright protection is not necessarily limited to the constituent parts of a work. Some combinations of words and geometric shapes may be eligible for copyright protection if they contain some distinguishable variation in the selection, coordination, or arrangement of elements that is not so obvious or minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Feist*, 499 U.S. at 359; *see also Atari Games Corp.*, 888 F.2d at 883 ("simple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection by both the Register and in court"). However, merely combining a few unprotectable elements does not satisfy this requirement if the combination or arrangement is obvious.

The Board finds that the logos at issue in this appeal do not contain a sufficient amount of creative authorship under the standard set forth in *Feist* – even when they are viewed as a whole. Each work is a commonplace logo that combines a handful of words with one or two geometric shapes. Squares, rectangles, and parallelograms are not capable of supporting a copyright claim, and the words PRO, TAPER, PROTAPER, TAPERWALL, ANSWER, ALUMINUM, and HANDLEBARS are words or short phrases that are not subject to copyright. The typeface that the Applicant selected for these words and the use of white lettering on a black background are devoid of copyrightable authorship. Moreover, the combination of these elements is precisely the type of "routine" and "garden variety" arrangement that has been found to be uncopyrightable in cases involving commercial labels.

In *Kitchens of Sara Lee*, the Second Circuit rejected a copyright claim in a commercial label that combined the brand name SARA LEE "in bold white letters" with a "bright red" background, noting that "[b]rand names, trade names slogans, and other short phrases or expressions cannot be copyrighted, *even if they are distinctively arranged or printed.*" 266 F.2d at 544 (emphasis added) (quoting Copyright Office Publication No. 46 concerning the copyrightability of words and short phrases as "a fair summary of the law"). Likewise, in *John Muller & Co.* the Eighth Circuit upheld the Office's refusal to register the logo for a professional soccer team that combined the name ARROWS in a cursive script positioned above four angled lines that formed a geometric shape, namely, an arrow. 802 F.2d at 990. Likewise, in *Forstmann Woolen Co.*, a district court held that a clothing label that combined the brand name FORSTMANN with the generic term "100% Virgin Wool" and a geometric design, namely, a fleur-de-lis, was not copyrightable. 89 F. Supp. 964

(E.D.N.Y. 1950). To this list could be added *Yankee Candle*, where the First Circuit rejected a copyright claim in a rectangular label surrounded by a thin border, noting that "the use of a border element is an essentially functional design choice not protected by copyright." 259 F.3d at 35. More recently, a district court upheld the Office's refusal to register a logo consisting of the letter "C," noting that "[t]he elements embodied in this work, individually and in their particular combination and arrangement simply do not contain a sufficient amount of original and creative authorship to be copyrightable." *Coach*, 386 F. Supp. 2d at 499.

Like the labels and logos at issue in these cases, the Applicant's works consist of a brand name combined with one or two geometric shapes. Certain variations have been made in the lettering for these words, either by presenting them in block letters or an italic typeface. However, the selection of typeface, the horizontal and vertical orientation of these words, and the borders surrounding the various elements are entirely typical for a commercial label. The commonplace and predictable arrangement of these elements is too minimal to support a copyright claim. In the Board's view, all of these logos fall within the "narrow" category of works that do not demonstrate the modicum of creativity necessary for copyright protection under *Feist*. 499 U.S. at 359.

4. Novelty and Symbolic Meaning are Irrelevant to the Issue of Copyrightability

As discussed above, the Board accepts your representation that the Applicant independently created these logos. Therefore, the Board has no reason to question your contention that PROTAPER is a "coined term." *See* Second Request at 2. Nor is there any need to address your contention that each logo constitutes "unique artwork" that "creates a unique visual impression" with "a unique black and white artistic display." *See* First Request at 2. The fact that a logo may be novel or unique is irrelevant to the issue of copyrightability. *See* Compendium II, § 503.02(a). In fact, you admitted that "[N]othing in the Constitution commands that copyrighted matter be strikingly unique or novel," and that the relevant issue in this appeal "does not concern novelty; but rather creativity." *See* Second Request at 1-2 (quoting *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99 (2d Cir. 1951)). While the U.S. Trademark Office is statutorily required to search the Trademark Register to determine whether an applicant's mark is likely to be confused with a previously registered mark, the Board does not engage in this type of comparison. Instead, the Board examines each work in isolation to determine whether the work is eligible for copyright protection. *See* Compendium II, § 503.02(a).

The Board also accepts your representation that the words TAPER and PROTAPER are slanted to the right in order to reinforce the meaning of the word "taper," and your representation that the letters "A" and "P" in TAPER are joined at the base in order to create "a 'tapering' effect." First Request at 2-3. Evaluating an author's creative intent is not the type of determination that the Board undertakes in a request for reconsideration. In order to

make this type of judgment the Board would have to consider the author's state of mind or the specific process that the author used to create the work. Any investigation into the author's creative methodology or the circumstances surrounding the creation of the work is beyond the administrative capability of the Board. Because the Board does not consider the creative inspiration for these works or the mental images that they are intended to evoke, the fact that they are intended to reinforce the meaning of the word "taper" is irrelevant to the issue of copyrightability. *See* Compendium II, § 503.02(a) ("Copyrightability depends upon the presence of creative expression in a work, and not upon aesthetic merit, commercial appeal, or symbolic value."). Instead, the Board focuses solely on the works that have been submitted for registration, including the individual elements of those works and the works as a whole. In this case, the individual elements are not "numerous enough" nor is the "selection and arrangement [of those elements] original enough" to warrant a copyright registration. *See Satava*, 323 F.3d at 811.

CONCLUSION

For the foregoing reasons, the Copyright Office Review Board concludes that none of the Applicant's logos can be registered for copyright protection. This decision constitutes the final agency action on this matter.

Sincerely,

Tanya M. Sandros
Deputy General Counsel
for the Review Board
United States Copyright Office

EXHIBIT A

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,697,212

United States Patent and Trademark Office Registered Mar. 18, 2003

TRADEMARK
PRINCIPAL REGISTER



LACY DISTRIBUTION, INC. (INDIANA CORPORATION)
54 MONUMENT CIRCLE, SUITE 800
INDIANAPOLIS, IN 46204

FOR: CLOTHING, NAMELY, HATS, SUITS, PANTS, SHORTS, JACKETS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 0-0-1996; IN COMMERCE 0-0-1996.

OWNER OF U.S. REG. NOS. 1,349,539 AND 1,868,002.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ALUMINUM HANDLEBARS", APART FROM THE MARK AS SHOWN.

SER. NO. 76-268,900, FILED 6-8-2001.

WILLIAM VERHOSEK, EXAMINING ATTORNEY

Int. Cl.: 12

Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44

Reg. No. 2,565,279

United States Patent and Trademark Office

Registered Apr. 30, 2002

TRADEMARK
PRINCIPAL REGISTER



LACY DISTRIBUTION, INC. (INDIANA CORPORATION)
54 MONUMENT CIRCLE, SUITE 800
INDIANAPOLIS, IN 46204

FOR: HANDLEBARS USED IN CONNECTION WITH MOTORCYCLES, DIRT BIKES AND ALL TERRAIN VEHICLES, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

FIRST USE 0-0-1992; IN COMMERCE 0-0-1992.

OWNER OF U.S. REG. NOS. 1,740,563, 1,868,002, AND 2,277,577.

SER. NO. 76-269,524, FILED 6-8-2001.

WILLIAM VERHOSEK, EXAMINING ATTORNEY

Int. Cls.: 1, 12, 18 and 25

Prior U.S. Cls.: 1, 2, 3, 5, 6, 10, 19, 21, 22, 23, 26, 31, 35, 39, 41, 44 and 46

Reg. No. 3,596,956

United States Patent and Trademark Office

Registered Mar. 31, 2009

TRADEMARK
PRINCIPAL REGISTER



LACY DISTRIBUTION, INC. (INDIANA CORPORATION)
54 MONUMENT CIRCLE, SUITE 800
INDIANAPOLIS, IN 46204

FOR: GLUE FOR USE IN THE MOTORCYCLE AND ATV INDUSTRY, IN CLASS 1 (U.S. CLS. 1, 5, 6, 10, 26 AND 46).

FIRST USE 2-0-2007; IN COMMERCE 2-0-2007.

FOR: MOTORCYCLE AND ATV ACCESSORIES, NAMELY, HANDLEBARS, HANDLEBAR TRIP CLAMP, HANDLEBAR GRIPS, MOTORCYCLE BRAKE AND CLUTCH LEVERS, HANDLEBAR CLAMPS, HANDLEBAR PADS, HANDLEBAR MOUNTS, SPROCKETS, THROTTLES, STEERING COLUMNS AND STEERING STEMS MADE OF STEEL OR ALUMINUM, FOOT PEGS AND FOOT RESTS, GEAR SHIFT LEVERS, REAR BRAKE LEVERS, DRIVE CHAIN, DISK BRAKE ROTORS, DISK BRAKE MOUNTS, BRAKE CALIPERS, BRAKE LINES, WHEELS, HAND GUARDS AND PROTECTORS, MOTORCYCLE GRIP TAPE CONSISTING OF FLAT FOAM IN A DOUGHNUT SHAPE HAVING CLOTH BACKING ON BOTH SIDES, LEVER COVERS, LEVER PERCHES AND CONTROL CABLES, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

FIRST USE 2-0-2007; IN COMMERCE 2-0-2007.

FOR: BACKPACKS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FIRST USE 2-0-2007; IN COMMERCE 2-0-2007.

FOR: CLOTHING, NAMELY, HATS, SHIRTS AND JACKETS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 2-0-2007; IN COMMERCE 2-0-2007.

OWNER OF U.S. REG. NOS. 1,740,563, 3,124,114 AND OTHERS.

THE MARK CONSISTS OF THE STYLIZED WORDS "PROTAPER" SURROUNDED BY A RECTANGLE.

SER. NO. 76-687,946, FILED 3-21-2008.

KOURTNEE HODGES, EXAMINING ATTORNEY

EXHIBIT B

GARDERE

attorneys and counselors ▪ www.gardere.com

Direct: 214-999-4702
Direct Fax: 214-999-3702
kschwartz@gardere.com

October 16, 2008

Commissioner for Trademarks
1451 Box 1451
Alexandria, VA 22313-1451

Re: Applicant: Lacy Distribution, Inc.

Mark: PROTAPER

Serial No.: 76687946
Filing Date: March 21, 2008
Our File No.: 124170-3013

10-20-2008

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #38

Sir:

Enclosed for filing with respect to the above-listed mark are the following items:

1. Response to Office Action dated July 7, 2008,
2. Declaration In Support of Substitute Specimen;
3. Specimen for added Class 01;
4. USPTO Credit Card Form in the amount of $375 for one additional class; and
5. Return postcard.

Please address all correspondence to **GARDERE WYNNE SEWELL LLP, IP SECTION,** 1601 Elm Street, Suite 3000, Dallas, Texas 75201.

It is believed that no additional fee is due. However, if this is incorrect, the Commissioner for Trademarks is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 07-0153.

Respectfully submitted,

GARDERE WYNNE SEWELL LLP

Kay Lyn Schwartz

KLS/la
Enclosures
DALLAS 1982824v.1

Certificate of Mailing

Date of Deposit: 10-16-08

I hereby certify that this paper or fee is being deposited with the United States Postal Service First Class Mail service under 37 CFR 1.10 on the date indicated above and is addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

(Printed Name) Lisa Alcala

(Signature) Lisa A. Alcala

124170-3013 TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Lacy Distribution, Inc.
Mark:	PROTAPER and design
Serial Number:	76/687946
Filed:	March 21, 2008
Examining Attorney:	Kourtnee C. Hodges Law Office 108 (571) 272-2816

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

RESPONSE TO OFFICE ACTION

Applicant, by and through its undersigned attorney, submits its response to the Office Action dated July 7, 2008 due for response by January 7, 2009.

Identification and Classification of Goods

Applicant adopts the following identification of goods:

Class 01: Glue for use in the motorcycle and ATV industry;

Class 12: Motorcycle and ATV accessories, namely, handlebars, handle trip clamp, handlebar grips, motorcycle brake and clutch levers, handlebar clamps, handlebar pads, handlebar mounts, sprockets, throttles, steering columns and steering stems made of steel or aluminum, foot pegs and foot rests, gear shift levers, rear brake levers, drive chain, disk brake rotors, disk brake mounts, brake calipers, brake lines, wheels, hand guards and protectors, blister busters consisting of flat foam in a doughnut shape having cloth backing on both sides, lever covers, lever perches and control cables;

Class 18: Backpacks; and

Class 25: Clothing, namely, hats, shirts and jackets.

Additional Specimen

Applicant submits a new specimen for glue in Class 01. The dates of use for the added class are the same as the dates of use specified in the initial application; however, the applicant submits an additional specimen and declaration in support for the added class.

Mark Description

The mark consists of the stylized words "PROTAPER" surrounded by a rectangle.

Claim of Ownership of Prior Registrations

Applicant is the owner of U.S. Registration Nos. 1740563, 3043857, 3124114 and others.

It is believed that an additional fee of $375 for one additional class is due. If this is incorrect, the Commissioner is hereby authorized to charge any fees that may be required by this paper to Deposit Account No. 07-0153.

Respectfully submitted,

GARDERE WYNNE SEWELL LLP

Date: 10/16/08

By: Kay Lyn Schwartz
Attorneys for Applicant

3000 Thanksgiving Tower
1601 Elm Street
Dallas, Texas 75201
(214) 999-3000
(214) 999-4667 (FAX)

124170-3013 TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lacy Distribution, Inc.

Serial No.: 76687946

Mark: PROTAPER

Trademark Attorney: Kourtnee C. Hodges
Law Office 108
571-272-9108

Assistant Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

DECLARATION IN SUPPORT OF SUBSTITUTE SPECIMENS

The undersigned being hereby warned that willful false statement and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the Application, document or any registration resulting therefrom, declares that she is properly authorized to execute this Declaration on behalf of Applicant; she believes Applicant to be the owner of the mark sought to be registered; *that the substitute specimens submitted herewith in the above-referenced Application for Trademark were in use in commerce at least as early as the filing date of the Application*, and is now in such use in commerce; and all statements made of her own knowledge are true and all statements made on information and belief are believed to be true.

LACY DISTRIBUTION, INC.

By: _____

Printed Name: Michael P. Hutson
Title: Sr. VP + CFO

Date: 10-16-08

PROTAPER

HOME | PRODUCTS | RIDERS | COMPANY | DEALERS | LINKS

ODUCTS

kets
lebars
clamps & risers
bike clamps
accessories
tle tubes
accessories
glue
wraps
er busters
guards
d xtenders casualwear
bags
ssories
ay



grip glue

1 oz
instant 10 to 25 second adhesive
no need for wiring grips
Part # 02-2882
Retail : $7.99