United States Copyright Office
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June 21, 2012

Via First Class Mail and Fax

Nelson, Mullins, Riley & Scarborough, LLP
ATTN: Neil C. Jones
100 North Tryon Street, 42nd Floor
Charlotte, NC 28202-4000

Re: BAR 1 ICON and BAR 3 ICON
(SR Numbers 1-507432968 and 1-507448461)

Dear Mr. Jones:

I am writing on behalf of the U.S. Copyright Office Review Board ("Board") in response to your letters in which you requested a second reconsideration of the Copyright Office's ("Office") refusal to register your client's copyright claims in the 2-D Artwork for the designs entitled "Bar 1 Icon" and "Bar 3 Icon" ("Works"). The Board has carefully examined the copyright registration applications, electronic deposits, and related correspondence, and affirms the denial of your client's applications to register the claims to copyright in the Works.

I. DESCRIPTION OF THE WORKS

Each of the Works involves a two-dimensional design. One of the two designs, "Bar 1 Icon," consists of a purple circle placed underneath the word "bar." The word "bar" is in gray capital letters, centered in a black rectangle. The number "1," colored in with shades of hot orange which become progressively lighter from top to bottom, is centered over the word "bar." The other design, "Bar 3 Icon," consists of a blue circle placed underneath the word "bar." The word "bar" is in gray capital letters, centered in a black rectangle. The number "3," colored in with shades of yellow-green which become progressively lighter from top to bottom, is centered over the word "bar." The designs are depicted as follows:



II. ADMINISTRATIVE RECORD

A. Initial Submission

The applications to register the copyright claims in the Works were submitted on October 22, 2010 under SR Numbers 1-507432968 and 1-507448461. On both applications, the work for hire author, Gateway Gaming, LLC, claimed copyright in "2-D artwork." The electronic deposit for each application consisted of one page that contained its respective graphic as depicted above.

The applications were examined by Guy Messier, a copyright registration specialist ("specialist") in the Copyright Office's Visual Arts Division. He determined that the Office could not register the claims because the Works lacked "the authorship necessary to support a copyright claim." Letters from Messier of 11/19/2010 ("First Refusal Letters") at 1. In each letter, the specialist explained that copyright protection extends to original works of authorship that are fixed in physical form. *Id.* He further explained that the word "original" in the context of copyright law means a work was independently created by the author and possesses at least a minimal degree of creativity. *Id.* (citing *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340 (1991)).

The specialist then explained that a visual arts work must contain a minimum amount of pictorial, graphic, or sculptural authorship, and that copyright does not protect "familiar symbols or designs; basic geometric shapes...mere variations of typographic ornamentation, letter or coloring." *Id.* (quoting 37 C.F.R. §202.1). Nor, as provided in 17 U.S.C. §102(b), does copyright extend to any idea, concept, system, or process which may be embodied in a work. *Id.* Following *Feist* and *Bleistein v. Donaldson*, 188 U.S. 239 (1903), the specialist stated that the aesthetic appeal of a work, its commercial value, and the time and effort expended to create a work, are not factors considered under copyright law to determine the copyrightability of a work. *Id.* The specialist concluded that your client's Works do not contain sufficient creative authorship within the meaning of the copyright statute and settled case law and therefore refused the registrations. *Id.*

B. First Request for Reconsideration

In First Request for Reconsideration letters dated February 24, 2011, you argued that the Works "are created independently" by your client and "sufficiently unique to support a claim to copyright" and that the Works are "protectable" because "differences and unique aspects of authorship are depicted in the use of the particular colors, the arrangement of the word and number, the shading on the items, and the overall concept shown in the visual work." Letters from Neil C. Jones of 2/24/2011 ("First Request Letters") at 1. You urged the Office to register the copyright claims in your client's Works because a copyright registration had already been made for one of your client's similar designs, Bar 2 Icon. *Id.*

C. Registration Program's Response to First Requests for Reconsideration

In a letter dated July 6, 2011, Attorney-Advisor Virginia Giroux-Rollow of the Registration Program upheld the Office's first refusal to register your client's claims in the Works because the Works "do not contain a sufficient amount of original and creative artistic and/or textual authorship upon which to support a copyright registration." Letter from Giroux-Rollow of 7/6/2011 ("Second Refusal Letter") at 1. Ms. Giroux-Rollow informed you that copyright protection does not extend to

combinations of geometric shapes because the creative authorship was insufficient to merit copyright protection); and *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988) (upholding refusal to register a fabric design consisting of striped cloth with small grid squares superimposed on the stripes where Register of Copyrights concluded that the design did not meet the minimal level of creative authorship necessary for copyright protection). *Id.* at 2 - 3.

She agreed that courts have held that a slight amount of creativity will suffice to obtain copyright protection and that the vast majority of works "make the grade easily if they possess some creative spark," adding the caveat that "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright." Second Refusal Letter at 3 (quoting *Nimmer on Copyright* § 2.01(b)). Ms. Giroux-Rollow stated that your client's Works fall within that narrow area of original authorship that is so trivial that it is insufficient to support a claim to copyright. *Id.* She also stated that, though the requisite level of creativity for copyright protection is very low, your client's Works did not satisfy that low threshold because "the few elements embodied in these icons, coupled with their coloring, as well as their particular arrangement and configuration, do not meet even the low threshold for copyrightable authorship set forth in the *Feist* case." *Id.* Additionally, when your client's Works were viewed in their entirety and the noncopyrightable elements of the Works judged "not separately, but rather in their overall interrelatedness within the work as a whole" she found "the simple 'treatment and arrangement' of the few geometric shapes and other noncopyrightable elements coupled with their coloring" failed to support a registrable claim to copyright. *Id.* (citing *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989).

In the end, Ms. Giroux-Rollow supported the refusal to register your client's copyright claims in the Works and noted that your client's copyright registration for a similar work, which you referred to in your First Request Letter, had been registered in error. She informed you that the Office was in the process of cancelling the erroneous copyright registration because the creative authorship in that work, as in the Works at issue here, is insufficient to support a copyright registration. *Id.* at 3. That registration (VA 1-745-570) has since been canceled. *See* Bar 2 Icon Canceled Registration, http://cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?Search_Arg=Bar+2+Icon&Search_Code=TALL&PID=Ue43DHfF1s4QmsLCkMUdvFYjDNlQ&SEQ=20120122195902&CNT=25&HIST=1. The Board understands that you have submitted a request for reconsideration of that cancellation. That request will be addressed separately by the Copyright Office Registration Program.

D. Second Requests for Reconsideration

In your response to Ms. Giroux-Rollow's Second Refusal Letter you argued that, according to *Nimmer on Copyright* § 2.08[B][2], the requirements for originality and creativity must be distinguished, that the Works possess both the requisite amount of originality and creativity to satisfy claims to copyright. You then distinguished your client's Works from the cases cited in Ms. Giroux-Rollow's Second Refusal Letter and asked the Office to reconsider registration of the copyright claims in the Works. Second Request for Reconsideration Letter ("Second Request Letter") at 1.

You argued that the Works meet the minimum requirement for creative authorship and that "the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how

crude, humble or obvious' it might be." Second Request Letter at 2 (citing *Feist*, 499 U.S. 340 at 345 quoting *Nimmer* at § 1.08[C][1]). You asserted that Ms. Giroux-Rollow, in her Second Refusal Letter, did not considered your client's Works as a whole but focused instead on the individual parts, and you cited *Diamond Direct, LLC v. Star Diamond Group, Inc.*, 116 F. Supp. 2d (S.D.N.Y. 2000), and *Atari Games Corp. v. Oman* to support that assertion. *Id.* at 2-3. You claimed the works at issue in the *Kitchens of Sara Lee v. Nifty Foods Corp.* are analogous to your client's Works, because, in your opinion, your client's Works are "not merely a recitation of serving directions, a license number, or any other equivalent," and because your client "put time, creative thought, and money into creating the icon[s]." *Id.* at 3. You distinguished your client's case from *Jon Muller & Co. v. New York Arrows*, *Forstmann Woolen Co. v. J.W. Mays, Inc.*, *The Homer Laughlin China Co. v. Oman*, and *Jon Woods Fashions, Inc. v. Curran*, because, in your opinion, the works in those cases did not "have the unique coloring, shading, overlaying of elements, and layout" present in your client's Works, which you argued contain "a level of creativity above and beyond that utilized in the cited cases." *Id.* at 4. You then cited to *Sadhu Singh Hamdad Trust v. Ajit Newspaper Adver. Mktg. & Communs., Inc.*, 503 F.Supp. 2d 577 (E.D.N.Y. 2007), and *Boisson v. Banian, Ltd.*, 273 F.3d 262 (2d Cir. 2001), to support your argument that your client's Works are copyrightable because the courts in these cases "found sufficient creativity in works of art that are similar to the one[s] at issue herein." *Id.* at 4-5.

III. DECISION

After reviewing the application and arguments in favor of registering your client's Works, the Board affirms the decision to refuse registration of the copyright claims because the Works do not contain sufficient copyrightable authorship. Each of the Works involves a similar two-dimensional design. As noted above, ne of the two designs, "Bar 1 Icon," consists of a purple circle placed underneath the word "bar." The word "bar" is in gray capital letters, centered in a black rectangle. The number "1," colored in with shades of hot orange which become progressively lighter from top to bottom, is centered over the word "bar." The other design, "Bar 3 Icon," consists of a blue circle placed underneath the word "bar." The word "bar" is in gray capital letters, centered in a black rectangle. The number "3," colored in with shades of yellow-green which become progressively lighter from top to bottom, is centered over the word "bar."

A. Legal Framework

1. *Feist* Standard of Originality

Designs can fall under copyright protection if they are original. The Supreme Court made it clear in *Feist* that the concept of originality in the context of copyright law requires a work to be independently created by the author and possess a minimal degree of creativity. *See Feist*, 499 U.S. at 345. The Board assumes that the designs at issue were independently created by your client. The Board does not, however, see the minimal degree of creativity required under the second prong of the *Feist* test for originality. In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the standard set forth in *Feist*, which states that the "requisite level of creativity is extremely low; even a small amount will suffice." *See Feist*, 499 U.S. at 345. The Board also looks to Copyright Office regulations which state that designs that consist merely of names, titles, words, short phrases or expressions, as well as typographic ornamentation, typeface, and lettering are not copyrightable. *See* 37 C.F.R. §202.1. The

Office's regulations add that familiar symbols or designs are not subject to copyright protection. *See* 37 C.F.R. § 202.1(a). Further, the Office's *Compendium II, Copyright Office Practices*, §503.03(b) clearly states, "No registration is possible where the work consists solely of elements which are incapable of supporting a copyright claim. Uncopyrightable elements include common geometric figures or symbols, such as a hexagon, an arrow, or a five-pointed star..."

The Board approaches the analysis of any given work of authorship by judging it in its entirety, with an analysis of the combination of the constituent elements of a work of authorship as well as the relationship of such elements to each other. The selection and arrangement of individual design elements that are *de minimis* in themselves (*i.e.*, carry no copyright protection) within an overall design may be protected, depending on the use of such elements and whether the chosen elements are sufficient in quantity within the design as a whole. Not all combinations of unprotectable elements, however, will be afforded copyright protection.

You indicated that *Feist* supports your argument that your client's Works are copyrightable because the Works meet the requisite level of creativity required for copyrightability, i.e., "extremely low; even a slight amount will suffice...'however crude, humble or obvious.'" Second Request Letter at 2 (quoting *Feist* at 499 U.S. 340, 345-347 (1991)). *Feist* also states that preexisting noncopyrightable elements, such as facts and words and familiar shapes, may be copyrightable "so long as they are made independently by the compiler and entail a minimal degree of creativity" and that the "*vast* majority of works make the grade quite easily, as they possess some creative spark." *See Feist* at 346 (emphasis added). Though a "vast majority" of works are copyrightable, there still remains a small minority of works, like your client's Works, that are uncopyrightable because they do not possess that minimal degree of creativity. And although you asserted that in her Second Refusal Letter, Ms. Giroux-Rollow only examined the individual elements of your client's Works and not the Works as a whole to determine whether they contained the minimal level of creativity required to be copyrightable, Ms. Giroux-Rollow did examine your client's Works as a whole and determined that the level of creativity in the designs as a whole is *de minimis* because the Works are merely "*composed* of two common and familiar geometric shapes and a noncopyrightable word and number, coupled with some minor shading and coloring *arranged in a rather simple configuration*." Second Refusal Letter at 2 (emphases added). The Board concurs with that analysis.

2. Case Law Does Not Support Your Claim of Copyrightability

You argue that the creativity exhibited in the Works is analogous to that in the photographs that the court found to be copyrightable in *Kitchens of Sara Lee*. Second Request Letter at 3. However, the opinion in *Kitchens of Sara Lee* offers insufficient information about those pictures upon which to form any conclusions as to the quantum of creativity in them. The court concluded that the plaintiff "has put time, some creative thought and money into its pictorial representations of its cakes and for the copying it is entitled to damages" and that "[t]he pictures of the cakes used by plaintiff on its labels although possibly not achieving the quality of a Leonardo 'Still Life' nevertheless have sufficient commercial artistry to entitle them to protection against obvious copying." 266 F.2d at 545. Whether the pictures would be considered sufficiently creative post-*Feist* is not at all clear; without examining the pictures, no conclusion can be made.

More pertinent, however, is the disposition in *Kitchens of Sara Lee* of the claims of infringement of elements of the plaintiff's labels other than the pictures: "Plaintiff under the

particular facts here involved may have relief as to the pictures but not as to the circular, rectangular or octagonal shapes or the serving directions or the ingredients." 266 F.2d at 545. The court also quoted with approval the plaintiff's admission that it could not "claim any exclusive right in cellophane windows, pictures of cakes, colors, type styles, circular and rectangular shapes, positions of the various elements, pictures of Wedgwood style plates and heavily ornamented silverware, or scalloped border designs, as such." *Id.*[1] Those uncopyrightable aspects of the Sara Lee label are analogous to the claimed authorship in the Works before the Board.

You distinguished your client's Works from the works in *Jon Muller & Co. v. New York Arrows Soccer Team, Inc.*, *Forstmann Woolen Co. v. J.W. Mays, Inc.*, *Homer Laughlin China Co v. Oman*, and *Jon Woods Fashions, Inc. v. Curran* because, you claimed, the works in those cases "did not involve a work having the unique coloring, shading, overlaying of elements, and layout." Second Request Letter at 4. But the works in *Jon Muller & Co.* (logo design consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below), *Forstmann Woolen Co.* (label with words "Forstmann 100% Virgin Wool" interwoven with three fleur-de-lis held not copyrightable), *Homer Laughlin* (simple variations and combinations of public domain elements), and *Jon Woods Fashions, Inc.* (a striped cloth with small grid squares superimposed on the stripes), were all deemed uncopyrightable because, like your client's Works, they were composed of simple variations and combinations of public domain elements insufficient to merit copyright protection. And though you place great emphasis on the fact that your client's Works contain "unique coloring" and "shading," in addition to the simple configuration of the word and numbers that make up each design, "[w]ords...familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering or *coloring*" are not copyrightable. *See* 37 C.F.R. § 202.1(a) (emphasis added).

You stated that courts "have found sufficient creativity in works of art that are similar to the one at issue herein," and cited *Sadhu Singh Hamdad Trust v. Ajit Newspaper Adver., Mktg, & Communs., Inc.*, and *Boisson v. Banian* to support that assertion. Second Request Letter at 4-5. The court in *Sadhu Singh*, however, never determined whether the stylized words at issue in the case were copyrightable, but simply denied cross-motions for summary judgment while expressing doubt whether the masthead at issue, consisting of a "stylized and colorful rendering" of the Punjabi word "Ajit," the name of the plaitiff's newspaper, is copyrightable. 503 F.Supp.2d at 587-590.

In *Boisson*, the court based its conclusion in part on the fact that the Copyright Office had issued a certificate of registration, noting that therefore "we must presume [the plaintiff] holds valid copyrights." 273 F.3d at 267; *see also id.* at 268. Moreover, the decision that the "alphabetical arrangement of the letters in the five-by-six block format" is sufficiently creative was not supported by any analysis, but was based simply on (1) the certificates of registration, (2) the unsupported assertion that the arrangement of letters in a five-by-six block format "required some minimal degree of creativity," and (3) the fact that "no federal regulation establishes that the use of this layout is unprotectible." While the court concluded that the arrangement was original to the author, *see* 273

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[1] The Board understands the reference to "pictures of cakes" and "pictures of Wedgwood style plates" to be references to the idea of including pictures of cakes and of Wedgwood style cakes on the labels, rather than references to the particular pictures that appeared on the labels. In light of the court's conclusion that the pictures were copyrightable, that appears to be the only reasonable conclusion.

F.3d at 269-270, it did not explain why such an arrangement consists of more than *de minimis* creativity.

Thus, *Boisson*, with its dearth of analysis, offers little useful guidance as to how to determine whether a work meets the creativity requirement. The Board can say that the work found in that case to be copyrightable falls, at best, barely over the requisite creativity threshold. In contrast, the Works at issue here do not cross that threshold.

B. Analysis of the Works

1. Individual Elements in the Design are Uncopyrightable

As stated throughout the course of correspondence in your client's case, the individual elements of your client's Works are not copyrightable. Each design contains a colored-in circle and number (with the coloring in the number becoming progressively lighter from top to bottom), the word "bar," and a blacked-out rectangle – all public domain elements. Because the individual elements in your client's Works fall within the public domain, the Works are not copyrightable. *See* 37 C.F.R. § 202.1.

2 Elements Taken as a Whole are Uncopyrightable

The Board has examined your client's Works as a whole and finds that each design fails to rise to the level of creativity required to support a copyright registration. The individual, uncopyrightable elements are arranged in such a trivial manner – a number placed on top of a word which has been placed on top of a circle—revealing a *de minimis* creative authorship that is insufficient to support a copyright claim. *See Feist* at 346; *see also* 37 C.F.R. § 202.1. And though your client "put time…and money into creating the icon[s]," the amount of time and money an author puts into creating a work are not factors in determining whether the work is copyrightable.

IV. CONCLUSION

The Review Board has reviewed the Works as to their individual elements and in their entirety and has determined that the claims to copyright in the Works cannot be registered because the Works contain insufficient creative authorship to support copyright registrations. Accordingly, for the reasons stated above, the Review Board affirms the Registration Program's refusal to register the Works.

Sincerely,

David O. Carson
General Counsel
for the Review Board
United States Copyright Office