United States Copyright Office
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August 27, 2013

Ms. Eleanor M. Lackman
Hogan Lovells US LLP
875 Third Avenue
New York, New York 10022

Re: Request for Reconsideration (Second Reconsideration)
Visual Arts Works:

Correspondence ID # 1-2JKAEB
SECOND Request for Reconsideration dated February 19, 2010
Application Received: October 24, 2008:

1. **chat29 (speech bubbles)**
2. **einstellung14 (lighting/sound control panels)**
3. **email35 angle (envelope with @ symbol)**
4. **email35**

Application Received October 27, 2008:

5. **film27 (clap board)**
6. **film23**
7. **home2 (5-sided outline of house shape)**
8. **home5 angle (house shape with line and color perspective)-**
9. **home5 (5-sided house shape with color perspective)**
10. **kalendar27 (one-day flip calendar page)**
11. **kalendar31 (one-day flip calendar page with color)**
12. **kamera17 (outline of camera front view)**

Application Received October 28, 2008:

13. **nachricht36 angle (envelope)**
14. **nachricht36**
15. **nachricht 32**
16. **notes28**
17. **organizer 26**
18. **organizer 30 angle**
19. **speaker21**

Application Received October 23, 2008:

20. **wetter3 angle**
21. **wetter3**

Correspondence ID # 1-33SS98
SECOND Request for Reconsideration dated February 19, 2010
Application Received November 18, 2008:
22. polaroid green
23. polaroid red

Correspondence ID # 1-4RCDZN
SECOND Request for Reconsideration dated July 7, 2010
Application Received: October 24, 2008:
24. adressbuch25 (address book)

Correspondence ID # 1-4Q7XJQ
SECOND Request for Reconsideration dated July 7, 2010
Application Received: October 27, 2008:
25. hoerer35 (phone hand held receiver, gray tones)

Correspondence ID # 1-468MYH
SECOND Request for Reconsideration dated July 7, 2010
Application Received: October 28, 2008:
26. sms30 (envelope back/letters SMS)
27. sms 34
28. sms 34 angle
29. uhr15 (vintage flip clock)
Application Received: October 29, 2008:
30. uhr18 angle (vintage flip clock)
31. wuerfel 10 (die)

Dear Ms. Lackman:

The Copyright Review Board ("Board" or "Review Board") of the United States Copyright Office ("Copyright Office" or "Office") is in receipt of your second appeal of the decision of the Office to refuse registration of the above-referenced works. You submitted the second appeal on behalf of your client, Deutsche Telekom AG ("DTAG"). You filed the second appeal of the first 23 works listed above on July 10, 2010, and the second appeal of the remaining works listed above on February 19, 2010. All listed works were first received by the Office during the period from October 23, 2008 and November 18, 2008.

The Review Board has also taken note of your works not listed above that were registered by this Office. Your firm brought these works to the attention of the Office in your First Requests for Consideration. *See* Letter of Brian J. Vogel to the U.S. Copyright Office dated April 21, 2009 at 5-27, Exhibits A and B ("First Request Letter 1"); Letter of Brian J. Vogel to U.S. Copyright Office dated July 27, 2009 at Exhibits A and B ("First Request Letter 2"). The Board has carefully examined the two second requests for reconsideration, the pertinent applications and deposits, and correspondence concerning the applications, including the attached exhibits, and, for the reasons stated below, hereby affirms the denial of registration for all works referenced above. This decision constitutes final agency action in this matter. 37 C.F.R. § 202.5(g).

I. DESCRIPTION OF WORKS

The thirty-one works under consideration are visual representations known as "icons." On behalf of your client, your firm filed copyright registration applications (Form VA) for the icons, but none of the applications referenced any preexisting work(s) upon which the icons were based. However, from the materials contained in Exhibits A and B of First Request Letters 1 and 2, it has come to the Board's attention that for most of the subject works, the Office issued registration certificates to DTAG for similar icons, as indicated below.

A. Works addressed in DTAG's Second Request for Reconsideration dated February 19, 2010.

1. On October 24, 2008, you filed a copyright registration application, Form VA, for the design referred to as "chat29." The design consists of a white square depicted by a double outline of gray shading and black lines with two sides of a triangular shape protruding from the left side of the bottom of the outer outline, and with a smaller, white rectangular shape, outlined in gray shading, with a similar triangle protruding from the right side of its bottom line, overlapping the larger square at its upper right corner. An image of "chat 29" appears below:



The application for "chat 29" did not reference, as preexisting works upon which "chat29" was based, the works below, for which the Office issued registration certificates to DTAG:



chat30 dark (VAu 976-942)
effective 2/29/08



chat33 (VAu 974-152)
effective 10/24/08



chat33 angle (VAu 974-15
effective 10/24/08

2. On October 24, 2008, you filed a copyright registration application, Form VA, for the design referred to as "einstellung14." The icon consists of a dark, shaded vertical rectangle with three black vertical lines spaced equidistant within the rectangle. Upon each of the lines is a small horizontal white rectangle. These three rectangles are aligned at different places on the three lines, so that there is a white horizontal rectangle about one-third of the way down the first line, a white

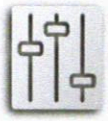
rectangle almost at the top of the second line, and a white rectangle almost at the bottom of the third line. The design appears to be a drawing of a stereo equalizer. An image of "einstellung14" appears below:



The application for "einstellung14" did not reference, as preexisting works upon which "einstellung14" was based, the works below, for which the Office issued registration certificates to DTAG:



mixer11 (VAu 974-425)
effective 12/05/08



equaliiser11 (VAu 974-157)
effective 10/24/08



mixer14 angle (VAu 974-431)
effective 10/28/08

3. On October 24, 2008, you filed a copyright registration application, Form VA, for the design referred to as "email35 angle." The icon consists of a white horizontal trapezoid outlined in black, with V-shaped internal lines suggesting the outline of the back of an envelope, and some minimal shading, all giving the effect that the envelope is tilted. At the upper right corner of the envelope, a blue, thick-lined ampersat symbol ("@") overlaps the corner. An image of "email 35 angle" appears below:



The application for "email35 angle" did not reference, as preexisting works upon which "email35 angle" was based, the work below, for which the Office issued a registration certificate to DTAG. Nor did it reference other similar works filed for registration on the same date as "email35 angle," "email35" (icon 4 below), "nachricht36" (icon 13 below), "nachricht 36 angle" (icon 14 below), and "nachricht32" (icon 15 below).



Email31 (VAu974-154)
Effective 10/24/08

4. The design referred to as "email35" consists of a white rectangle outlined in black, with internal V-shaped lines suggesting the outline of the back of an envelope, and some minimal

shading. Overlapping the upper right corner of the envelope drawing is a blue, thick-lined ampersat symbol ("@"). This design appears to be the same design as "email35 angle," except that the design does not appear to be tilted. An image of "email35" appears below:



The application for "email 35" did not reference, as being a preexisting work upon which "email35" was based, the design "email31, depicted in context with "email35 angle (icon 4 above). Nor did it reference other similar works filed for registration on the same date, entitled "email35 angle," "nachricht36," "nachricht36 angle," and "nachricht32" (each listed below under separate numbers in this second appeal).

5. On October 27, 2008, you filed a copyright registration application, Form VA, for the design referred to as "film27." The design consists of a dark horizontal rectangle forming the base of the design, with another horizontal rectangle, which is about one-fifth the width of and the same length as the first rectangle, seemingly joined to the first at the upper left corner of the first (and lower left corner of the second). The second, "thinner" rectangle is placed at an angle of approximately twenty-five degrees above the first, The lower, larger rectangle has drawn on it three white, horizontal lines, evenly spaced, with the top one-fifth of the rectangle drawn as a bar of alternating black and white thick, vertical stripes, which appear to lean up to the right. The upper, thinner rectangle is similarly striped, with the stripes appearing to lean down to the right. The black and white stripes on each bar appear to be coordinated so that if the upper rectangle were tilted down to be horizontal, the stripes on the two would meet white-to-white and black-to-black. The icon clearly depicts a filmmaker's clapboard. An image of "film27" appears below:



The application for "film27" did not reference, as preexisting works upon which "film27" was based, the works below, for which the Office issued registration certificates to DTAG. Nor did it reference "film23" (icon 5 below), which DTAG filed for registration on the same date.



film24 (VAu 976-533)
effective 12/09/18



film24 dark (VAu 974-933)
effective 12/09/08



film27 angle (VAu 974-485)
effective 10/29/08

6. On October 27, 2008, you filed a copyright registration application, Form VA, for the design referred to as "film23." The icon consists of a design that is a negative version of "film 24." The background of the design of both the bottom rectangle and the upper, thinner, angled rectangle is

The background of the design of both the bottom rectangle and the upper, thinner, angled rectangle is white. The bottom rectangle contains three equidistant, black lines, two that are undivided lines and the upper of the three having a small space about two-thirds of the way across the line, left-to-right. The upper bars have black lines that appear to be shaded rather than solid black. An image of "film 23" appears below:



The application for "film23" did not reference "film24," "film 24 dark," or film 27 angle" (depicted above in the context of "film27"), for which the Office issued registration certificates to DTAG, as preexisting works upon which "email35 angle" was based. Nor did it reference "film27" (icon 5 above), for which a separate application had been filed on the same date that "file23" was filed.

7. On October 27, 2008, you filed a copyright registration application, Form VA, for the design referred to as "home2." The icon consists of the outline of a five-sided geometric design, with the base of the shape being three lines forming the base and two sides of a horizontal rectangle and an isosceles triangle sitting where the top line of the rectangle would be. There is very minimal shading on one side of the base of the shape. The shape looks like the outline of a "home base," or the outline of a simple house. An image of "home2" appears below:



The application for "home2" did not reference, as a preexisting work upon which "home2" was based, the work below, for which the Office issued registration certificates to DTAG. Nor did it reference "home5" (icon 9 below) or "home5 angle" (icon 8 below) for which separate applications had been filed on the same date that "home2" was filed.



home4 – (VAu-974 443)
effective 10/28/08



home4 angle (VAu-974-411)
effective 10/29/08

8. On October 27, 2008, you filed a copyright registration application, Form VA, for the design referred to as "home5 angle." The design consists of a line drawing of a house, beginning with the shape described above for "home2" and adding additional four lines on the left side of the house shape, creating a three-dimensional effect to the line drawing. The inside the original two-dimensional line drawing of a house is colored in shades of yellow and gold, further adding to the three-dimensional effect. There is also slight gray shading under the upper white portion of the

"rooftop." The overall design is drawn to create the illusion that the viewer is seeing the house from an angle. An image of "home5 angle" appears below:



The application for "home5 angle" did not reference, as a preexisting work upon which "home5 angle" was based, the work below, for which the Office issued a registration certificate to DTAG. Nor did it reference "home2" (icon 7 above) or "home5" (icon 9 below), for which separate applications had been filed on the same date that "home5 angle" was filed.

9. On October 27, 2008, you filed a copyright registration application, Form VA, for the design referred to as "home5." The design consists of a line drawing of a house, beginning with the shape described above for "home2." The lines of this shape are slightly thicker than those in "home2" and the inside of the outline is entirely colored in shades of gold and yellow. The coloring adds some perspective and third-dimension to what would otherwise be an entirely two-dimensional drawing. An image of "home5" appears below:



home4 angle (VAu-974-411)
effective 2/29/08

The application for "home5" did not reference, as preexisting works upon which "home5" was based, or "home4" (depicted in the context of icon 8), or "home4 angle" (depicted in the context of icon 7. Nor did it reference "home5 angle" (icon 8) or "home2" (icon7), for which DTAG filed applications on the same date as "home5" (see above).

10. On October 27, 2008, you filed a copyright registration application, Form VA, for the design referred to as "kalendar27." The design is comprised of a line drawing of a rectangle with two small vertical rectangles intersecting the top line of the larger rectangle. Inside the larger rectangle, centered on the page, are two lines of text. The upper line, in smaller black typeface, is the abbreviation "So." On the lower line, in larger black typeface, are the numerals "26." The design resembles one page of a desktop daily calendar. An image of "calendar 27" appears below:



The application for "kalendar27" did not reference, as preexisting works upon which "kalendar27" was based, "kalendar31" (icon 11 below), for which DTAG filed an application on the same date as "kalendar27."

11. On October 27, 2008, you filed a copyright registration application, Form VA, for the design referred to as "kalendar31." The design consists of the identical icon as "kalendar27" above, but with the lettering "So." colored in red, the numerals "26" printed in bolder type, and with black shading under the two small vertical rectangles on the top line of the larger rectangle. The image of "kalendar31" is depicted below:



The application for "kalendar31" did not reference, as preexisting works upon which "kalendar31" was based, "kalendar27" (icon 10 above) or "organizer27" and "organizer30" depicted above in the context of "kalendar27, all three for which the Office issued registration certificates to DTAG. Nor did it reference "organizer26" (icon 17 below), or "organizer30 angle" (icon 18 below), for which DTAG filed an application on October 28, 2008).

12. On October 27, 2008, you filed a copyright registration application, Form VA, for the design referred to as "kamera17." The design consists of the black outline of a horizontal rectangle, with slight shading on the left of the rectangle forming the edge of the left and top lines. In the middle of the rectangle are two concentric circles which together create the illusion of a circular ring. The circles have an approximate height that is only a bit smaller than the height of the outer rectangle. At the top left corner of the rectangle is the outline of a smaller horizontal rectangle. The drawing has the appearance of the front of a camera. The image of "kamera17" is depicted below:



The application for "kamera17" did not reference, as preexisting works upon which "kamera17" was based, the works depicted below, for which the Copyright Office issued registration certificates to DTAG, and which DTAG presented as similar works in Exhibits A of its First Request letter for SRI-196292231, at p. 12



kamera20 (VAu 974-385)
effective 10/28/08



fotoappara20 angle (VAu 974-308)
effective 10/29/08

13. On October 28, 2008, you filed a copyright registration application, Form VA, for the design referred to as "nachricht36 angle." The design consists of a white horizontal trapezoid outlined in black, with internal lines suggesting the outline of the back of an envelope and some minimal

shading, all giving the effect that the envelope is tilted. An image of "nachricht36 angle" appears below:



The application for "nachricht36 angle" did not reference, as preexisting works upon which "nachricht36 angle" was based, "nachricht36" (icon 14 below) or "nachricht32" (icon 15 below) filed on the same date as "nachricht36 angle," (icon 15 below), both for which DTAG filed an application but was denied registration.

14. On October 28, 2008, you filed a copyright registration application, Form VA, for the design referred to as "nachricht36". The icon consists of a white horizontal rectangle with a blurry black line for a base and another for the left side, and very light lines for the top and right sides. There are faint lines and shading depicting the back side of an envelope. An image of "nachricht36" appears below:



The application for "nachtricht36" did not reference as preexisting works upon which "nachricht36" was based, "nachricht36 angle" (icon 13 above), or "nachricht32" (icon 15 below), both for which DTAG filed an application but was denied registration.

15. On October 28, 2008, you filed a copyright registration application, Form VA, for a design referred to as "nachricht32." The icon consists of another white horizontal rectangle depicting the outline of the back of an envelope. This envelope icon has bold, clear lines on the bottom and left sides of the rectangle and also on the internal lines. The top and right sides are not outlined. An image of "nachricht32" appears below:



The application for "nachtricht36" did not reference "email31" (depicted at the description of icon 13 above). Nor did it reference "nachricht36 angle" (icon 13 above), or "nachricht36" (icon 14 above), or the similar icons entitled "email32," "email35" (icon 3 above), and "email35angle" (icon 4 above). *See* First Request letter for SRI-196292231 at Exhibit A, p. 3.

16. On October 28, 2008, you filed a copyright registration application, Form VA, for a design referred to as "notes 28." The icon consists of a thick vertical rectangle, with side lengths approaching a square form, which is colored light yellow, with black lines forming the lower side and a

17. small portion of the lower right side of the rectangle. Half-way across the rectangle, beginning in the middle and moving to the right, is a line of repeated curves, appealing to be abstract short-hand notations. An image of "notes23" appears below:



The application for "notes28" did not reference, as preexisting works upon which "notes28" was based, the works depicted below, for which the Office issued registration certificates to DTAG:



notes28 angle
(VAu-974-383)
effective 10/28/08



notes24 (VAu-974-508)
(VAu-974-427)
effective 10/28/08

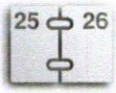


notes25
(VAu-974-427)
effective 10/28/08



notes25 dark
(VAu-976-935)
effective 12/09/08

18. On October 28, 2008, you filed a copyright registration application, Form VA, for a design referred to as "organizer26." The icon consists of outlines of two vertical rectangles separated only by one line. The outline of the rectangles is highlighted by shadowy lines at the bottom of each rectangle and along the left side of the rectangle on the left. Along the vertical line running between the two rectangles, there are two small, horizontal rectangles near the top and the bottom of the lines. The effect is of an open binder. At the top outer corner of each vertical triangle are the numerals "26." The icon appearance is of an open desk calendar. The image of "organizer26" appears below:



The application for "organizer 26" did not reference, as a preexisting work upon which "organizer26" was based, "organizer30," depicted below, which DTAG filed on October 28, 2008 and was registered by the Office. *See* First Request letter for SRI-196292231 at Exhibit A, p 3.



organizer30

19. On October 28, 2008, you filed a copyright registration application, Form VA, for a design referred to as "organizer30 angle." The icon, like "organizer26," appears to depict an open desk calendar, but the two rectangles forming the book-like calendar are of different sizes, together forming a trapezoid, to give a tilted effect to the icon. In this design, the numeral "26" on the right

side rectangle is colored red. The left triangle has a left border that is thicker, and there is some shading on the left side which creates the illusion of perspective. An image of "organizer30 angle" appears below:



The application for "organizer30 angle" did not reference, as preexisting works upon which "organizer30 angle" was based, "organizer 30," which was registered by the Office and is depicted with icon 17 above, or "organizer26" (icon 17 above). *See* First Request letter for SRI-196292231 at Exhibit A, p. 3.

20. On October 28, on behalf of your client, you filed a copyright registration application, Form VA for a design referred to as "speaker21." The icon consists of a small vertical rectangle, with the right line being sharp and distinct, and the bottom and left side lines being more blurred, with an upward slanting line coming from the right upper corner of the rectangle at an obtuse angle, and a downward sloping line from the left right corner of the rectangle at an obtuse angle, and with a straight vertical line connecting the two slanted lines on the right. Additional shading extending from the bottom right corner of the design suggests that the shape extends with another vertical, thin rectangle adjoining the long vertical line on the right. However, most of this suggested rectangle is not drawn, only suggested. The overall effect of the line drawing is of an old fashioned speaker facing out to the right. An image of "speaker21" appears below:



From the materials currently before the Board, we can discern no other similar icon that was registered by the Office. However, in Appendix A to First Request letter for SRI-196292231, at p. 32, you provide evidence that the Office refused to register two other icons depicting speakers. These were filed on October 38, 2008 and December 8, 2008.

21. On October 23, 2008, on behalf of your client, you filed a copyright registration application, Form VA, for a design referred to as "wetter3 angle." The icon consists of a yellow oval shape that has short, gold and yellow lines protruding from around the perimeter of the oval shape like eyelashes. The shape has the appearance of the sun viewed from an angle. Floating above the sun icon to the right is the writing, "29°." An image of "wetter3 angle" is depicted below:



The application for "wetter3 angle" did not reference, as preexisting works upon which "wetter3 angle" was based, the works below, for which the Office issued registration certificates to

DTAG. Nor did it reference "wetter3" (icon 22 below), which was registered on the same day as "wetter3 angle."



wetter1 (VAu-974-314)
effective 10/23/08



wetter1 angle (VAu-975-694)
effective 2/10/09



wetter2 (VAu-974-484)
effective 10/23/08



wetter2 angle (VAu-974-484)
effective 10/23/08

22. On October 23, 2008, on behalf of your client, you filed a copyright application, Form VA, for a design referred to as "wetter3." The icon consists of a yellow circle shape that has short, yellow lines protruding from around the perimeter of the oval shape like eyelashes. The shape has the appearance of the sun. Floating above the sun icon to the right is the writing, "29°." An image of "wetter3" is depicted below:



The application for "wetter3" did not reference, as a preexisting work upon which "wetter3" was based, "wetter3 angle" (icon 21 above). Nor did it reference the other works listed above in the context of "wetter3 angle," which were registered.

23. On behalf of your client, on November 18, 2008, you filed a copyright registration application, Form VA, for the design referred to as "polaroid green." This icon consists of a wide, vertical rectangular shape. A slim border around the top and two sides of the rectangle is colored green. There is a broad horizontal green line, or short horizontal rectangle, at the bottom side of the rectangle. The inner space abutting this green border forms a black square area, with a sweep of lighter shading across the upper left corner. The design has the appearance of a Polaroid photograph. An image of "polaroid green" is depicted below:



The application for "polaroid green" did not reference, as a preexisting work upon which "polaroid green" was based, the work below, for which the Office issued a registration certificate to DTAG. Nor did it reference "polaroid red" (icon 23 below).



polaroid dark (VAu-977-740)
effective 12/23/08

A. Works addressed in DTAG's Second Request for Reconsideration dated July 7, 2010.

24. On behalf of your client, on November 18, 2008, you filed a copyright registration application, Form VA, for the design referred to as "polaroid red." This icon consists of a wide, vertical rectangular shape. A slim border around the top and two sides of the rectangle is colored red. There is a broad horizontal red line, or short horizontal rectangle, at the bottom side of the rectangle. The inner space abutting the green border forms a black square area, with a sweep of lighter shading across the upper left corner. The design has the appearance of a Polaroid photograph. An image of "polaroid red" is depicted below:



The application for "polaroid red" did not reference, as a preexisting work upon which "polaroid green" was based, the "polaroid dark" icon depicted above with "polaroid green," for which the Office issued a registration certificate to DTAG. Nor did it reference "polaroid green" (icon 22 above).

25. On behalf of your client, you filed a copyright registration application, Form VA, for the design referred to as "hoerer35." This icon consists of the faint outline of a longer convex line, with short perpendicular lines at the end of the convex line extending in a downward direction. At the end of the each short line is another perpendicular small line extending towards the inside of the emerging shape, forming an almost rectangular area at either end of the longer convex line. The two inside lines are joined by a smaller concave line. The shape appears to be the handle of a landline office telephone from years past. The bottom concave line running all the way across the bottom of the shape is shaded dark, and the top very faint. There is slight shading on the bottom part of the telephone handle. An image of "hoerer35" is depicted below:



The application for "hoerer35" did not reference, as a preexisting works upon which "hoerer35" was based, the works below, for which the Office issued a registration certificate to DTAG:



rufliste38 (VAu-975-738)
effective 10/28/08



ruflisten38 angle (VAu-974-696)
effective 10/29/08



hoerer41 angle (VAu-974-307)
effective 10/29/08



hoerer45 angle (VAu-974-301)
effective 10/29/08

26. On behalf of your client, you filed a copyright registration application, Form VA, for the design referred to as "sms30." This icon consists of a horizontal white rectangle, with faint gray shading, and black shading along the bottom and left sides of the rectangle. There are internal V-shaped lines suggesting the outline of the back of an envelope. Overlapping the upper right corner of the envelope drawing are the block letters "SMS" which are delineated by dark shading which appears to come from behind to "backlight" the letters, so that the letters are essentially "negative" and not "positive" in perspective. The internal lines also create a negative shape, with the black lines creating a stencil effect. This design appears to be the same design as "email35" (icon 14) with a difference in the thickness and darkness of the internal lines and a negative "SMS" where the positive ampersat appears in "email35."An image of "sms30" appears below:



The application for "sms30" did not reference, as preexisting works upon which "sms30" was based, "horerer35" (icon 24 above) or the four similar registered works depicted with "hoerer35." Nor did it reference "sms34 angle" (icon 26 below) and "sms34" (icon 27 below), which were denied copyright registration.

27. On October 28, 2008, on behalf of your client, you filed a copyright registration application, Form VA, for the design referred to as "sms34 angle." This icon consists of a white horizontal trapezoid outlined in black, with the outlining on the top and right sides of the trapezoid being faint, and the outlines on the bottom and left side made by darker shadowing. There are V-shaped internal lines, made with light gray shading, suggesting the outline of the back of an envelope, and some minimal additional shading on the bottom triangle of the envelope shape. The design appears to be of a tilted envelope. As with "sms30," overlapping the upper right corner of the envelope drawing are the block letters "SMS" which are delineated by dark shading which appears to

come from behind to "backlight" the letters. In "sms34 angle," the lettering is colored yellow. An image of "sms34 angle" appears below:



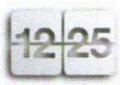
The application for "sms34 angle" did not reference, as preexisting works upon which "email35 angle" was based, any of the icons depicted above with respect to "hoerer35" (icon 24) or "sms30" (icon 25).

28. On October 28, 2008, on behalf of your client, you filed a copyright registration application, Form VA, for the design referred to as "sms34." This icon appears to be very similar to "sms34 angle" (icon 26), except that the underlying shape is of a rectangle, rather than a trapezoid, and the shading throughout the icon is different, so as to convey the envelope being flat, rather than tilted. This icon is also very similar to "email35" (icon 4), and to "email31" (depicted in the context of icon 3), which was registered. The design appears to be of a tilted envelope. As with "sms30," overlapping the upper right corner of the envelope drawing are the block letters "SMS" which are delineated by dark shading which appears to come from behind to "backlight" the letters. However, in "sms," the lettering is colored yellow. An image of "sms34 angle" appears below:



The application for "sms34" did not reference, as preexisting works upon which "email35 angle" was based, any of the icons depicted above with respect to"email35" (icon 4), "hoerer35" (icon 24) or "sms30" (icon 25), all of which were refused for registration, or "email31," which was registered effective October 24, 2008.

29. On October 28, 2008, on behalf of your client, you filed a copyright registration application, Form VA, for the design referred to as "uhr18 angle." This icon consists of four horizontal rectangles placed in a block configuration, with two triangles on top and two directly below. The triangles are white, front lit to form a "negative" design, with flack shading at the bottom and left sides of the rectangle and faint shading on the top and right sides of the rectangle forming the appearance of one outlined rectangle. There are two dark lines of shading running down the middle of the block configuration, one horizontal and one vertical, delineating the four smaller rectangles. In the center of the design, straddling all the triangles, are the black shaded numerals of "12" on the left side of the block and "25" on the right side of the block. The work is reminiscent of a flip clock from some years ago. An image of "uhr18 angle" is depicted below:



The application for "uhr18 angle" did not reference, as a preexisting work upon which "uhr15" was based, the work entitled "uhr18 angle" (icon 29 below). From the materials currently before the Board, we can discern no other similar icon that was registered or refused by the Office.

30. On October 28, 2008, on behalf of your client, you filed a copyright registration application, Form VA, for the design referred to as "uhr18 angle." This icon consists of four horizontal rectangles placed in a block configuration that is similar to that depicted in "uhr15" (icon 28 above), except that the overall block form is shaped like a sideways trapezoid rather than a rectangle. In this icon, the background of the rectangles is black, darker on the bottom rectangles and grayer on the top rectangles. The lettering is formed by white "negative" numerals against the dark background. The lettering gets gradually smaller from right to left. Like "uhr 15," the design of "uhr18 angle" depicts the discs on a flip clock. However, because of the trapezoidal shape of the block, and the declining size of the numerals, the flip clock discs appear to be seen from an angle rather than straight on. An image of "uhr18 angle" is depicted below:



The application for "uhr18 angle" did not reference, as a preexisting work upon which "uhr18 angle" was based, the work entitled "uhr15" (icon 28 above). From the materials currently before the Board, we can discern no other similar icon that was registered or refused by the Office.

31. On October 29, 2008, on behalf of your client, you filed a copyright registration application, Form VA, for the design referred to as "wuerfel10." This icon consists of a white square with rounded corners and three small circles spaced evenly and diagonally from the lower left corner to the upper right corner of the square. The outline of the square is accomplished by dark shadings forming the bottom and left sides of the shape and much fainter, thinner shadings forming the top and right sides. The three interior circles are formed from solid circular lines. The work contains minimal shading. It depicts what appears to be a game die with rounded corners. An image of the "wuerfel10" appears below:



The application for "wuerfel10" did not reference, as a preexisting work upon which "wuerfel10" was based, the work below, for which the Office issued a registration certificate to DTAG:



wuerfel13 (VAu-974-700)
effective October 29, 2008

32. On October 24, 2008, on behalf of your client, you filed a copyright registration application, Form VA, for the design referred to as "addressbuch25." This icon consists of two parallel vertical rectangles placed directly next to one another. The rectangles are delineated by dark shading forming the base and left side of the two conjoined rectangles and lighter shading forming the top and right sides. Cutting out the lower right corner of the right rectangle are two smaller vertical rectangles, one on top of the other and both extending half way up the right side of the right rectangle. There is dark shading between the two vertical rectangles, forming the effect of the left and right sides of a book. The rectangles on the lower right side of the right rectangle form the effect of notebook tabs. At the top right corner is the letter "A" in black and gray lettering. At the top left half of the left rectangle is a dark square, inside which is the outline of the shoulders, neck, and hair of a female. The overall effect of the design is of the outline of an address book. The image of "adressbuch25" is depicted below:



The application for "adressbuch25" did not reference, as preexisting works upon which "adressbuch25" was based, the works depicted below, for which the Office issued registration certificates to DTAG:



adressbuch26 dark (VAu-974-932)
effective 12/09/08



adressbuch25 dark (VAu-976-971)
effective 12/09/08



adressbuch29 angle dark (VAu-976-936)
effective 12/09/08



adressbuch29 (VAu-974-316)
effective 10/28/08

II. ADMINISTRATIVE RECORD

On behalf of your client, DTAG, during the period from October 23 through November 19, 2008, you filed with the Copyright Office applications for copyright registration in the first 23 works referenced and described above. In the months of January through April of 2009, the Office refused registration of those works.

During the period from October 24 through 29, 2008, you filed with the Office applications for copyright registration for the last eight works referenced and described above, which are numbered in this letter as works 24 through 31. In the months of October and November of 2009, the Office declined to register those works as well. The Office's reason for declining to register the 31 works at issue was that the works did not contain more that a *de minimus* amount of copyrightable expression or creativity.

In First Request Letter 1 (for works 1 through 23) and First Request Letter 2 (for works 24 through 31), you filed with the Office first appeals of the Office's refusal to register the works. Pursuant to 37 C.F.R. § 202.5(b)(1), you set forth your reasons as to why the works are copyrightable and should be registered.

On reconsideration, the Office again refused to register the works. Attorney Advisor, Virginia Giroux-Rollow, reviewed the works on first appeal. She found that, "[t]hese icons, with their common and familiar shapes, coupled with the contrast in coloring, simply do not contain a sufficient amount of original and creative artistic authorship upon which to support a copyright registration." Letters from Virginia Giroux-Rollow to Bryan J. Vogel dated November 19, 2009 (for works 1 through 21) ("Giroux-Rollow Letter 1") at 5; December 10, 2009 (for works 22 and 23) ("Giroux-Rollow Letter 2") at 3; and April 7, 2010 ("Giroux-Rollow Letter 3") (for works 24 through 31) at 2-3. Addressing your firm's argument that the works are registrable as compilations, she determined that "the simple treatment and arrangement of any selected or preexisting elements or materials of the few elements in these icons, coupled with their coloring, fail to rise to the level of copyrightability necessary to support a copyright registration." Accordingly, she concluded that "there are no elements or features embodied in th[ese] work[s], either alone or in combination, upon which a copyright registration is possible." Giroux-Rollow Letter 1 at 5; Giroux-Rollow Letter 2 at 3; and Giroux-Rollow Letter 3 at 2-3.

In letters dated February 18, 2010 and July 6, 2010, you filed second appeals of the Office's refusal to register your client's claim for copyright registration of the 31 works referenced and described above. Letters from Eleanor M. Lachman to U.S. Copyright Office dated February 28, 2009 (for works 1 through 23) ("Second Appeal Letter 1") and July 6, 2010 (for works 24 through 31) ("Second Appeal Letter 2"). In support of your position that the icons should be registered, in both Second Appeal Letters your main argument is that the 31 icons in question are sufficiently creative to be deemed copyrightable, under the guidelines set out in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991) ("*Feist*"). Second Appeal Letter 1 at 2; Second Appeal Letter 2 at 4.

In arguing that the 31 icons embody sufficient creativity to warrant a copyright registration, you characterize the works as "small and transformative illustrations of items evocative of objects seen in daily life." Because the Supreme Court held in *Feist* that the level of creativity in a work required for it to be considered an original work of authorship is "extremely low," and "even a slight amount will suffice,"[1] you assert that the icons at issues meet that low standard and are copyrightable. Citing 2 Melvin B. Nimmer, *Nimmer on Copyright* § 2.j08[B][1] (2009), you contend that *Feist* requires that a work be considered a "work of art" if it might arguably be regarded as such by "any meaningful segment of the population." Second Appeal Letter 1 at 2-3.

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[1] *Feist*, 499 U.S. at 345.

You deny that the works in question are akin to "familiar symbols or designs," "mere variations of typographic ornamentation, lettering, or coloring," or "simply common shapes or patterns." Rather, you contend that each of the icons "contains a distinctive combination of elements as a whole that result in products that contain copyrightable authorship, even though such elements may consist of simple shapes, familiar designs, or other elements in the public domain." *Id.* at 3; Second Appeal Letter 2 at 5. You argue that the choices made by the claimant in designing the icons are more original than the photograph of "a common blue bottle" that the court found to have sufficient originality to support a copyright registration in *Ets-Hoken v. Sky Spirits, Inc.*, 225 F.3d 1068, 1076 (9th Cir. 2000). Finally, you assert that "regardless of the public's familiarity with digital icons such as envelopes generally, there is nothing of record to suggest that any "generic icon" is so universally basic and standard as to be akin to "common geometric figures or shapes" such as the hexagon or the ellipse, or "a standard symbol such as an arrow or a five pointed star." Second Appeal Letter 1 at 4; Second Appeal Letter 2 at 4-5.

In Second Appeal Letter 2, in response to the Office's argument that some or all of the icons at issue constitute derivative works and do not demonstrate sufficient creativity beyond what is in the underlying work, you make a secondary argument, contending that in the Office's first reconsideration for the icons designated herein as icons number 24 through 31, the Office erroneously "proceeded on the assumption that the eight Works were derivative works." You maintain that none of the eight icons at issue in Second Appeal Letter 2 would meet the statutory definition of "derivative work."[2] Second Appeal Letter 2 at 2-3. You argue that "[t]he Copyright Office should apply the derivative works analysis only where a 'preexisting work'[3] is present," and you claim that the Copyright Office did not identify any work that could arguably meet the definition of "preexisting." You contend that each of the eight works at issue "are based on nothing but the concepts of these objects, not on someone else's drawing of the objects, and therefore the creativity of the Works should have been analyzed no different than photographs or illustrations of envelopes, clocks, telephones, address books or dice." *Id.*

Regarding the specific example of the work "addressbuch25" (herein designated as work 31), raised by the Office as an example of a derivative work in Giroux-Rollow Letter 3, you contend that it could not possibly be a derivative work, because "all the [eight] works were created at the same time and not in sequence." You suggest that it follows that none of the works could be derivative works.

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[2] The definition of "derivative work" under the Act is set out at 17 U.S.C. § 101:

> A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a "derivative work".

[3] For a definition of a "preexisting work," you quote from the House Report to the 1976 Copyright Revision Act: "the 'preexisting work' must come within the general subject matter of copyright set forth in section 102, regardless of whether it is or was ever copyrighted." H.R. Rep. No. 94-1496, at 57 (1976).

You argue that even if "addressbuch25" was not created at the same time as a "addressbuch26," or it was created in sequence following, "addressbuch26," "adressbuch25" cannot be a derivative work of "addressbuch26" because "the differences between the two works constitute "more than a 'merely trivial variation' between what the examiner identified as the "preexisting work" and the "derivative work." *Id.* at 3.

III. DECISION

The Review Board has carefully considered all of your arguments why the 31 icons at issue are entitled to copyright registration and all of the material presented in support of your claims, and affirms the Office's refusal to register the works at issue.

A. The Legal Framework

1. Creativity requirement

To be eligible for copyright protection, a work must qualify as an original work of authorship fixed in any tangible medium of expression. 17 U.S.C. § 102(a). In the copyright context, the term "original" includes both independent creation and sufficient creativity. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). While the Supreme Court held in *Feist* that only a modicum of creativity is necessary to support a copyright, it ruled that the telephone directory at issue in the case failed to meet that standard. The Court observed that "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimus* quantum of creativity. *Id.* at 363. There can be no copyright in a work in which "the creative spark is utterly lacking or so trivial as to be nonexistent." *Id.* at 359; *see also* 37 C.F.R. § 202.10(a) ("In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form.").

The Copyright Office's regulations implement the well established requirements of originality and creativity set forth in the law and, subsequently the *Feist* decision. The regulations prevent registration of "[w]ords 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." 37 C.F.R. § 202.1(a). These are exceptions to copyright protection because they may be considered basic building blocks for creative works and, so, must remain in the public domain, available to all. Permitting them to be copyrighted would impede the constitutional goals that underlie congressional authority to establish copyright protection. *See Feist*, 499 U.S. at 349. Courts have upheld the Office's regulations and practices and used them as guides in their jurisprudence. *See Atari Games Corp. v. Oman*, 979 F.2d 242, 247 (D.C. Cir. 1992) ("*Atari II*") ("We do not in any way question the Register's position that simple geometric shapes and coloring alone are *per se* not copyrightable…") (internal quotation marks omitted). Too, trivial alterations to otherwise standard shapes or familiar designs may not inject the requisite level of creativity. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-3 (2d Cir. 1951) ("*Alfred Bell*") ("[What] is needed to satisfy both the Constitution and the statute is that the 'author' [have] contributed something more than a 'merely trivial' variation, something recognizably 'his own.'").

As you stress in your letters, it is also well-established that unprotectable elements may be arranged or combined in a work so that they exhibit sufficient creativity to support registration. In *Feist*, the Court instructs that a work that is a compilation based on public domain, standard, commonplace, or trivial elements may be copyrightable if there is some distinguishable element in the author's selection, coordination, arrangement, or overall combination of elements that reflects choice and authorship that is not so obvious or so minor that the "creative spark is utterly lacking or so trivial as to be nonexistent" for the resulting work as a whole. *Feist*, 499 U.S. at 358-59. *See also* 17 U.S.C. § 101 (definitions of "compilation" and "derivative work"). Thus, in any analysis of a work of the visual arts, the Office considers the organization, arrangement, selection, or combination of elements or features as a whole rather than focusing on individual elements in themselves. However, while a combination of unprotectable elements may qualify for copyright protection, it is not true that *any* combination of unprotectable elements automatically qualifies for protection. Such a combination 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).

2. Procedural requirements

The Copyright Act requires that the application for copyright registration be made on a form prescribed by the Register of Copyrights that includes the name and address of the copyright claimant or, in the case of a work made for hire, a statement that the work is a work made for hire. 17 U.S.C. §§ 409(1), 409(4). In the case of registration of a work that is a *compilation or derivative work*, the claimant must identify any preexisting work or works that it is based on or incorporates, and a brief, general statement of the additional material covered by the copyright claim being registered. 17 U.S.C. § 409(9) (emphasis added).

Case law demonstrates that while a claimant's possession of a registration certificate creates a rebuttable presumption that the work in question is copyrightable, that presumption is not overcome by an "innocent misstatement" on the registration form pertaining to the work. However, the presumption may be overcome by proof of a deliberate misrepresentation on the registration form. *See GB Mktg. USA Inc. v. Gerolsteiner Brunnen GmbH & Co.*, 782 F. Supp. 763, 774 (W.D.N.Y. 1991) ("*Gerolsteiner Brunnen*") (citing *Whimsicality, Inc. v. Rubie's Costume Co., Inc.*, 891 F.2d 452, 455 (2d Cir. 1989)). The fact that a derivative design is not registered as such does not automatically invalidate the registration. *Id.* (citing *JBJ Fabrics, Inc. v. Brylane, Inc.*, 714 F. Supp. 107 (S.D.N.Y. 1989)). However, a "'knowing failure to advise the Copyright Office of facts which might have occasioned a rejection of the application constitutes reason for holding the registration invalid and thus incapable of supporting an infringement action . . . or denying enforcement on the ground of 'unclean hands.'" *Id.* (quoting *Eckes v. Card Prices Update*, 736 F.2d 859, 861-62 (2d Cir. 1984)).

According to the *Gerolsteiner Brunnen* decision, the rationale behind this rule is that although the court would ordinarily defer to the judgment of the Copyright Office when the question of originality is a close one, "that is impossible to do when the Copyright Office has not had a fair opportunity to pass on the question because of the copyright claimant's failure to advise the Office of the existence of a prior work." *Id.* at 774-75, citing *Past Pluto Prods. Corp. v. Dana*, 627 F. Supp. 1435, 1440, n.5 (S.D.N.Y. 1986); *Russ Berrie & Co. v. Jerry Elsner Co.*, 482 F. Supp. 980, 987 (S.D.N.Y. 1980). The *Gerolsteiner Brunnen* court observed that a claimant's failure to disclose the

derivative nature of a particular work results in "the consequent inability of the Copyright Office to make an informed decision on the application," and is, therefore, "particularly serious." *Id.* at 775.

B. Examination of Above-Referenced Works on Second Reconsideration

1. Procedural flaws in the registration applications

The Copyright Office does not make comparisons of copyright deposits to determine whether or not particular material has already been registered.[4] However, your firm presented the Office with other works authored by your client which this Office registered, and which are similar to the works under second appeal. You brought these registered works to the Board's attention to support your arguments that the works under review should also be registered. After reviewing the registered works, the Board was concerned that for all of the works at issue in this second appeal, as well as the registered works, a question remains as to whether the works are derivative works and, if so, whether any contains enough non-derivative creative authorship to be eligible for copyright protection.

After close scrutiny of all correspondence concerning the above-referenced and described works, the Review Board concludes that your client submitted incomplete registration applications for all of the works at issue in this case, and also for the many registered works your firm brought to the Board's attention in the Appendices to the First and Second Requests for Reconsideration. Section 409(9) provides that in the case of a derivative work, the party seeking registration include in its application "an identification of any preexisting work or works that it is based on or incorporates, and a brief, general statement of the additional material covered by the copyright claim being registered." Although you argue that none of the icons at issue are derivative from any of the other icons presented, the Board disagrees.

A thorough Review of Appendices A and B of First Request Letter for SRI-196292231 and First Request Letter for SRI-224862415 made very clear to the Board that your firm was less than forthright in arguing in Second Appeal Letter 2 that icons 24-31 above does not contain "previously existing, previously registered, previously published, or public domain material." Nor does the Board find plausible your statement that the works were "independently created icons that [were] derived only from the ideas of what they depict: . . . the artist's fanciful depiction of his perception of everyday items in the form of digital drawings." Second Appeal Letter 2 at 2.

It is obvious from a comparison of all the registered works and the works on second appeal that some of the works are derivative of others, and all of the works incorporate public domain features. Each of the works was submitted individually for registration, and for each DTAG failed to include in the registration application any information about preexisting or derivative material contained in the work. Because this information was lacking on the registration forms, the Board is of the opinion that the Office did not have a fair opportunity to assess properly whether the works – both those registered and those on second appeal - are related to or, in fact, are derivative of, any of the other very similar works that your firm submitted to the Office at approximately the same time. Therefore, in these second appeals, we are not able to fairly assess whether, for each group of icons, the individual works on second appeal are derivative of one or more of the registered and non-

[4] This longtime practice is set forth in U.S. Copyright Office, *Compendium II: Compendium of Copyright Office Practices* § 108.03 (1984).

registered works in the group, or whether one or more of the works in the group are derivative of one of those now on second appeal. As the district court observed in *Gerolsteiner Brunnen*, a registrant's failure to disclose the derivative nature of a particular work results in "the consequent inability of the Copyright Office to make an informed decision on the application," and is, therefore, "particularly serious." *Id.* at 775.

From the facts before us the Board deems it highly unlikely, if not impossible, that of the 31 works under second appeal, "all of the works were created at the same time and not in sequence," as you contend. It also seems apparent to the Board that many of the works at issue are derivative works, and the differences between the individual works grouped by your firm for comparison constitute "merely trivial variations" that do not support registration for new copyrightable material. Because the works were originally submitted to the Office for registration without any reference to any preexisting or coexisting material, resulting in the Office's separate examination of each icon in isolation from the others, it is impossible for the Board to determine which of the works, if any, might contain sufficiently creative, copyrightable elements, or a sufficiently creative selection or arrangement of non-copyrightable elements, for the work to support a copyright claim.

The Board finds that neither the registration applications for the icons on second review, nor the applications for those registered icons that were brought to the attention of the Office by your firm, were in compliance with the requirements of 17 U.S.C. § 409(9). Your firm did not identify in the individual application for each of the 31 icons any preexisting work or works upon which the icon was based, or any preexisting work or works which were incorporated in the icon. Nor did your client offer for each icon a brief, general statement of the additional material incorporated in by each such icon. Because of these omissions, the Copyright Office was not made aware of "facts which might have occasioned a rejection of the application," and it did not have "a fair opportunity to pass on the question" of whether or what material in each icon was derivative of another icon.

The Copyright Office cannot discern from the applications of either the registered works, or from those for which registration was denied, which icon in each cluster of icons identified above was created first, or whether any other work in the cluster added sufficient material to demonstrate the requisite amount of creative expression to support copyrightability. Therefore, the Board finds that for the 31 icons at issue on second appeal, none of the registration applications submitted to the Office are sufficient to support the respective claims for copyright registration in those works.

2. Insufficient copyrightable creativity in the claimed icons

Regardless of whether the copyright registration applications submitted in the 31 claimed icons are sufficient to support copyright registrations, examined one at a time, the Board finds it clear that the creative expression in each icon at issue is, in its own right, insufficient to support copyright registration. The Board assumes that DTAG independently created the works, but finds that the second prong of the *Feist* standard of originality has not been met. While we acknowledge that the requisite level of creativity is low, the *Feist* decision makes clear that there is a requisite level, and some works simply do not reach it. The works at issue do not evidence the original, creative authorship necessary to sustain copyright claims because "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Feist*, 499 U.S. at 359.

The works at issue are simple representations of common items, including envelopes, houses, calendar pages, film director clapboards, stereo equalizers, open address books, file folders, conversation bubbles, weather symbols, cameras, telephone hand pieces, and the like. They are akin to icons used throughout the telecommunications industry which are widely published and disseminated to the public by many companies. Although presumably DTAG's icons are distinguishable from those of other companies, the mere fact that they are distinguishable from their industry counterparts does not alone entitle them to copyright. *See Twentieth Century Fox Film Corp. v. Marvel Enters.*, 155 F. Supp. 2d at 17, n.40 (holding that logos met the standard of "distinguishable variation" that was "*more* than merely trivial") (emphasis added).[5] The works must still satisfy the originality requirement. The Board has decided that the 31 works at issue do not because their distinguishable characteristics are not more than merely trivial variations of "garden variety," familiar symbols and designs.

You allege that the icons' creative features include perspective, shading, angling, and colorization. Second Appeal Letter 1 at 6; Second Appeal Letter 2 at 4-9. However, as applied in the above-depicted icons, none of these "creative features" display the requisite level of creativity to support a copyright claim. *See Darden v. Peters*, 488 F.3d 277 (4th Cir. 2007) (proceeding under the Administrative Procedures Act affirming the Register's refusal to register colored maps containing "shading to give the map a three-dimensional effect."); *Atari II*, 979 F.2d at 247 (simple geometric shapes and coloring alone are *per se* not copyrightable); *Alfred Bell*, 191 F.2d at 102-3 (trivial alterations to otherwise standard shapes or familiar designs may not inject the requisite level of creativity). While the Board does not question that DTAG manually labored over each icon individually, and made many choices in adding perspective, shading and the like, such "sweat of the brow" labor is not a relevant consideration for registration. *Feist*, 499 U.S. at 359.

Each of the 31 icons, at issue fails to reveal the requisite level of creativity as a whole. They appear to exhibit at most a very minimal level of creativity in the selection, coordination, and arrangement of their respective elements, so the combination of elements in each work, whether public domain or derivative from other works, does not result in a work as a whole that constitutes an original work of authorship. The elements that comprise each icon appear to form a combination of standard geometric shapes and lettering, common computer software-generated shading, pixilation, tilting and/or coloring, and generic designs or outlines of common office items or expressions:

- Work 1: Generic white, rectangular "speech" bubble outlines, created with standard lines and shading;
- Work 2: Representation of stereo equalizer comprised of geometric shapes and lines and computer-generated shading;
- Work 3: Common graphic design of envelope comprised of geometric shapes and lines (very standard telecommunications icon) tilted (apparently by use of software program) with blue, fuzzy ampersat sign;

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[5] *See also Axxiom Mfg, Inc. v. McCoy Invs., Inc.*, 846 F. Supp. 2d 732, (plaintiff's design changes in three manuals lacked the "minimal degree of creativity" when compared to their counterparts to constitute "sufficient nontrivial expressive variation in the derivative work).

- Work 4: Same envelope as Work 3 but not tilted;
- Work 5: Familiar rendition of film director clapboard (slightly open) in "negative" version, comprised of geometric shapes, made in "negative" white on black coloring;
- Work 6: Same as Work 5 but in version of white board outlined in black lines;
- Work 7: Minimalist, almost kindergarten-like outline of standard "house" or "home base" shape;
- Work 8: Standard drawing of tilted 3-dimensional outline of house with yellow and orange coloring representing common shape of inside perspective;
- Work 9: Same as Work 8 but front view with no tilting;
- Work 10: Common, simple drawing of one page of day calendar using standard geometric shapes and standard lettering and numbers;
- Work 11: Same as Work 10 with additional red coloring and a small amount of shading;
- Work 12: Standard outline of front of camera made from common rectangles and circles with very minimal shading;
- Work 13: Common drawing of outline of tilted envelope with small amount of shading;
- Work 14: Same as work 14 but not tilted;
- Work 15: Same as work 14 but shape outlined with clear lines rather than shaded lines;
- Work 16: Basic geometric drawing of manila folder of light tan coloring with squiggled line representing shorthand;
- Work 17: Drawing of standard address book opened to one day, comprised of rectangles and numerals;
- Work 18: Same as work 17, tilted, with addition of small amount of shading and color for one date (two numerals);
- Work 19: Minimalist outline of speaker comprised of black lines and slight amount of shading;
- Work 20: Ubiquitous depiction of yellow/gold sun with numerals and degree symbol;
- Work 21: Same as Work 20 with slightly different yellow coloring on sun;

- Work 22: Rectangular drawing of black Polaroid photograph (before subject of photo emerges) with outer rims colored green;
- Work 23: Same as work 22 with outer rims colored red;
- Work 24: Minimalist drawing of telephone hand device comprised of curved and straight lines and shading;
- Work 25: Shaded envelope drawing akin to Works 2 and 3 with outlined block lettering added to upper right corner;
- Work 26: Same as Work 25 but tilted, with block lettering colored yellow;
- Work 27: Same as work 26 but not tilted;
- Work 28: Four rectangles formed to represent "flip clock" discs, outlined in black, with standard shading and numerals;
- Work 29: Negative version of Work 28, tilted;
- Work 30: Line drawing of white square with three inner circles representing a die; and
- Work 31: Open pages of outline of address book, comprised of two rectangles, lines, the letter "A," and a small square in the upper left corner surrounding the outline of a woman's head and shoulders, which outline seems to represent a familiar symbol for "woman."

The Board has considered each icon and has concluded that there is very little creativity in the selection of the items comprising the icons, whether they depict envelopes, flip clocks, address books, houses, or other common items. They appear to be "garden variety" icons. Accepting your comparison of the icons to photographs, the Board must also consider that, "[w]hile the subject of the photograph may be so familiar as to have reached iconic status, novelty of subject matter is not required for copyright protection." *Silverman v. Innovation Luggage, Inc.*, 67 U.S.P.Q. 1489, 1497 (S.D.N.Y. 2003). Nonetheless, the approach to assessing the standard of creativity for photographs is not always analogous to that of assessing the standard of originality for logos or icons.

In *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444 (S.D.N.Y. 2006), the District Court noted that Plaintiff's photographs were entitled to copyright protection because the "relatively unusual angle and distinctive lighting strengthen that aspect of the photograph's originality." 377 F. Supp. 2d at 455.[6] However, the court noted that in determining whether a photograph is copyrightable, courts

[6] In recognizing that ordinarily, "almost any photographic image will possess sufficient originality to support a copyright," the court cited *Tiffany Design, Inc. v. Reno - Tahoe Specialty, Inc.*, 55 F. Supp. 2d 1113, 1119 (D. Nev. 1999). In that case, the court determined that a photograph's angle, lighting, shading, and color gradients did not strengthen the works beyond a *de minimus* amount of creativity, given the works' garden variety status, given its uncreative depiction of familiar symbols and designs.

should distinguish between the decisions that a photographer makes in creating a photograph and the originality of the final product, because, 'Sweat of the brow' is not the touchstone of copyright. Protection derives from the features of the work itself, not the effort that goes into it." *Id.* at 452.

The *Mannion* court discerned three factors that would indicate a photograph is original, which factors are not mutually exclusive. First, there may be originality in the rendition of the photograph, wherein originality resides in such specialties as the angle of the shot, light, shade, exposure, effects achieved by means of filters, developing techniques, etc. For a work with originality in rendition, the copyright protects not what is depicted, but rather how it is depicted. *Id.* at 452-53. Second, there may be originality in timing, when the photographer was "at the right place at the right time," and takes a shot that captures a lifelike scene as it occurs, so that the photograph brings out "the proper setting for both animate and inanimate objects." For such photographs, copyright is limited by the principle that copyright in a photograph ordinarily confers no rights over the subject matter depicted. *Id.* at 453. Third, there may be originality in the creation of the subject of the photograph. Such is the case when the photographer creates "the scene or subject to be photographed." For such photographs, the originality subsides in, and the copyright protects, the subject of the photograph. *Id.* at 443-44.

Applying the three types of originality outlined in *Mannion* reveals that only the first test of originality applies to icons, because icons do share with photographs certain decisions of rendition, such as the author's contribution of deciding upon the angle of the subject matter of a drawing, and other effects such as coloring and shading. This brings the discussion back to the basic question of whether those features of the icons at issue exhibit originality.

While it is true that the items selected as the subject matter of the icons at issue on second appeal are not novel in the cellular telephone context, and that this has no impact on their eligibility for registration, the items as depicted are also not sufficiently original, due to their "garden variety" status. The icons' prototypical construction, which incorporates geometric shapes, lines, angles, and simple shading, perspective, and/or colorization, results in works that, taken as a whole, do not exhibit a sufficient level of creativity to warrant registration. *See Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q. 1074, 1076 (D.D.C.) (holding that the overall authorship on pieces of china was really a familiar chinaware presentation which constituted too minimal an amount of original creative authorship to meet even the low standard of authorship to be copyrightable).

The Board finds that for the icons at issue on second review, DTAG's selection of particular colors, angles, shading, perspective, and addition of letters and numbers, lacks the requisite modicum of creativity necessary to transform mere selection into copyrightable expression and create "more than a merely trivial" and sufficiently distinguishable variation from other "garden variety" icons. The Board also finds that the icons are familiar symbols or designs[7] and do not encompass a sufficient degree of originality more than "merely trivial," *de minimus* contributions and they are, therefore, not entitled to registration. *See* 37 C.F.R. § 202.1(a)

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[7] DTAG contends that the icons at issue are not familiar symbols and designs and are distinguishable from the designs in *John Muller & Co. v. NY Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986) (arrow logo), *Forstman Woolen Co. v. J.W. Mays, Inc.*, 89 F. Supp. 964 (E.D.N.Y. 1950) (fleur de lis design on wool label), and *Homer Laughlin China, supra*. The Board disagrees, for the reasons outlined above. *See* III. Decision, B.2.

IV. CONCLUSION

For the reasons outlined above, the Copyright Review Board concludes that the 31 icons that are the subject of DTAG's applications for registration and requests for second reconsideration cannot be registered. This decision constitutes final agency action. 37 C.F.R. § 202.5(g).

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Register of Copyrights

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