United States Copyright Office
Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

August 28, 2013

Lathrop & Gage, LLP
Attn: William A. Scofield, Jr.
28 State Street
Boston, Massachusetts 02109

Re: Collection of Flag Designs
Correspondence ID: 1-DJTHMO

Dear Mr. Scofield:

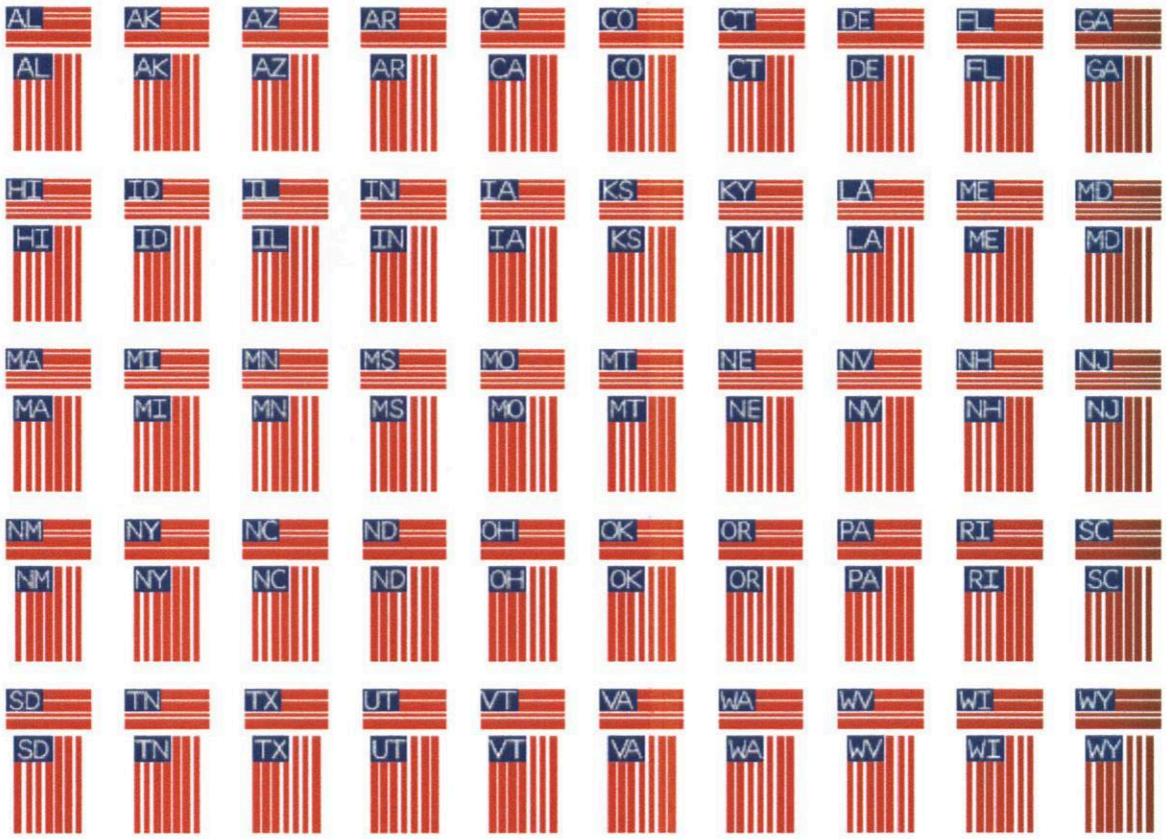
The Review Board of the United States Copyright Office (the "Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the work entitled: *Collection of Flag Designs*. You submitted this request on behalf of your clients, Thomas and John Francis Bachini, on December 5, 2012. I apologize for the delay in the issuance of this determination. After periods of inaction, staff departures, and budgetary restrictions, the Register of Copyrights has appointed a new Board and we are proceeding with second appeals of registration refusals as expeditiously as possible.

The Board has examined the application, the deposit copies, and all of the correspondence in this case. After careful consideration of the arguments in your second request for reconsideration, the Board affirms the Registration Program's denial of registration of this copyright claim. The Board's reasoning is set forth below. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action on this matter.

I. DESCRIPTION OF THE WORK

Collection of Flag Designs (the "Work") consists of a collection of fifty pairs of ornamental flag designs modeled after the traditional flag of the U.S.A. Each pair of flag designs is comprised of one vertical flag and one horizontal flag. Each individual flag design includes seven red stripes, six white stripes, and a blue rectangle with the abbreviation of one of the fifty U.S. states written in small white stars in its top left corner.

The below image is a photographic reproduction of the Work from the deposit materials:



II. ADMINISTRATIVE RECORD

On February 29, 2012, the United States Copyright Office (the "Office") issued a letter notifying Thomas and John Francis Bachini (the "Applicants") that it had refused registration of the above mentioned Work. *Letter from Registration Specialist, Kathryn Sukites, to William Scofield* (February 29, 2012). In its letter, the Office stated that it could not register the Work because it lacks the authorship necessary to support a copyright claim. *Id.*

In a letter dated May 23, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Work. *Letter from William Scofield to Copyright RAC Division* (May 23, 2012) ("First Request"). Upon reviewing the Work in light of the points raised in your letter, the Office concluded that the Work "does not contain a sufficient amount of original and creative artistic or graphic authorship" and again refused registration. *Letter from Attorney-Advisor, Stephanie Mason, to William Scofield* (September 6, 2012).

Finally, in a letter dated December 5, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Work. *Letter from William Scofield to Copyright R&P Division* (December 5, 2012) ("Second Request"). In arguing that the Office improperly refused registration, you first claim that the Office's previous rejections reflect a "fundamental misunderstanding of the nature of the work" and that the Applicants' claim of

copyright is directed to the individual flag designs that comprise the collection, not the selection and arrangement of the collection as it appears in the deposit copy (reproduced above). *Id.* at 2. Specifically, you state:

> For the sake of clarity, [the Applicants] here restate[] that the application was submitted for a collection of designs. The designs within the collection are individual flag designs that invoke certain elements of the American flag, to which the authors added additional symbols in the form of stars appearing in the blue canton arranged, for example so as to spell out the two-letter abbreviation for individual states.

Id.

You also claim that the Work includes at least the minimum amount of creativity required to support registration under the standard for originality set forth in *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340 (1991). *Second Request* at 3. In support of this argument, you maintain that the Applicants' novel selection and arrangement of the Works' constituent elements possess a sufficient amount of creative authorship to warrant registration under the Copyright Act. *Id.* at 5.

In addition to *Feist*, your argument references several cases in support of the general principle that, to be sufficiently creative to warrant copyright protection, a work need only possess a "modicum of creativity." *Id.* at 3-6. Specifically, you direct the Board's attention to the U.S. District Court for the Southern District of Ohio's holding in *Faessler v. U.S. Playing Card Co.*, No. 1:05 CV 581 (S.D. Ohio Feb. 9, 2007), claiming the Applicants' flag designs are more creative than the works found to be copyrightable by the district court. *Id.* at 4.

III. DECISION

A. *The Legal Framework*

(1) Derivative Works

A "derivative work" is a work that is based on or derived from one or more pre-existing works. *See* 17 U.S.C. §101. Section 101 of the Copyright Act defines a derivative work as follows:

> . . . 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".

Id.

Although the Copyright Act expressly protects works derived from pre-existing materials, such protection only covers the distinguishable additions, changes, or otherwise new material authors incorporate into the pre-existing materials. *See* 17 U.S.C. §103(b). The Act's protection does not extend to the pre-existing material itself. *Id.* (stating the copyright in a derivative work "extends only to the material contributed by the author of such work, and does not imply any exclusive right in the pre-existing material"). Examples of unprotectable, pre-existing materials include previously published works, previously registered works, and works in the public domain. *See, e.g., L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir.) (*en banc*), *cert. denied*, 429 U.S. 857, 97 S. Ct. 156, 50 L. Ed. 2 (1976).

Importantly, to qualify for copyright protection as a derivative work, the work must possess distinguishable authorship, other than the mere incorporation of the pre-existing material, that that is more than trivial or *de minimis* in nature. *See Feist*, 499 U.S at 359; *see also Siegel v. Time Warner Inc.*, 496 F. Supp. 2d 1111 (C.D. Cal. 2007). In other words, a derivative work is only eligible for registration if it includes authorship that is both distinguishable from the pre-existing work and sufficiently creative to meet the originality threshold set forth in *Feist*. *See id.*

(2) Originality

All copyrightable works must qualify as "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). As used with respect to copyright, the term "original" consists of two components: independent creation and sufficient creativity. *See Feist*, 499 U.S. at 345. First, the work must have been independently created by the author, *i.e.*, not copied from another work. *Id.* Second, the work must possess sufficient creativity. *Id.* While only a modicum of creativity is necessary to establish the requisite level, the Supreme Court has ruled that some works (such as the telephone directory at issue in *Feist*) fail to meet this threshold. *Id.* The Court observed that "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity." *Id.* at 363. It further found that 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.

The Office's regulations implement the long-standing requirements of originality and creativity set forth in the law and, subsequently, the *Feist* decision. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of "[w]ords and short phrases such as names, titles, slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring"); *see also* 37 C.F.R. § 202.10(a) (stating "[i]n order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form").

Of course, some combinations of common or standard design elements may contain sufficient creativity, with respect to how they are juxtaposed or arranged, to support a copyright. Nevertheless, not every combination or arrangement will be sufficient to meet this grade. *See Feist,* 499 U.S. at 358 (finding the Copyright Act "implies that some ways [of selecting, coordinating, or arranging uncopyrightable material] will trigger copyright, but that others will not"). Ultimately, the determination of copyrightability in the combination of standard design elements rests on whether the selection, coordination, or arrangement is done in such a way as to result in copyrightable authorship. *Id.*; *see also Atari Games Corp. v. Oman*, 888 F.2d 878 (D.D.C. 1989).

To be clear, the mere simplistic arrangement of non-protectable elements does not automatically establish the level of creativity necessary to warrant protection. For example, the

Eighth Circuit upheld the Copyright Office's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in a cursive script below the arrow. *See John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, Inc. et. al.*, 802 F.2d 989 (8th Cir. 1986). Likewise, the Ninth Circuit held that a glass sculpture of a jellyfish that consisted of elements including clear glass, an oblong shroud, bright colors, proportion, vertical orientation, and the stereotypical jellyfish form did not merit copyright protection. *See Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003). The court's language in *Satava* is particularly instructional:

> [i]t is true, of course, that a combination of unprotectable elements may qualify for copyright protection. But it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.

Id. (internal citations omitted) (emphasis in original).

Finally, Copyright Office Registration Specialists (and the Board, as well) do not make aesthetic judgments in evaluating the copyrightability of particular works. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design's uniqueness, its visual effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace. *See* 17 U.S.C. § 102(b); *see also Bleistein v. Donaldson*, 188 U.S. 239 (1903). The fact that a work consists of a unique or distinctive shape or style for purposes of aesthetic appeal does not automatically mean that the work, as a whole, constitutes a copyrightable "work of art."

B. *Analysis of the Work*

After carefully examining the Work and applying the legal standards discussed above, the Board finds that each individual design in the *Collection of Flag Designs* is a derivative work void of any distinguishable authorship that is sufficiently creative to meet the originality threshold set forth in *Feist*. 499 U.S at 359.

As explained, the Board accepts the principle that a work based upon pre-existing material may be eligible for copyright registration as a derivative work. *See also* 17 U.S.C. § 103(b). However, in order to qualify as a derivative work, any additional authorship incorporated into the pre-existing material must possess a level of creativity that is not so *de minimis* that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Feist*, 499 U.S at 359; *see also* 17 U.S.C. § 103(b) (stating the copyright in a derivative work "extends only to the material contributed by the author of such work, and does not imply any exclusive right in the pre-existing material").

Here, each of the Applicants' flag designs is a variation of the pre-existing flag of the U.S.A. (a work unquestionably in the public domain). In each flag design, the Applicants have simply replaced the pre-existing work's traditional array of fifty white stars with white stars arranged into the shape of letters. Consistent with 37 C.F.R. § 202.1(a), stars, letters, and the font the Applicants used to create the letters are all ineligible for copyright protection. *See id.* (prohibiting the

registration of basic symbols or designs); *see also Racenstein & Co., Inc. v. Wallace dba ABC Window Cleaning Supply*, 51 U.S.P.Q. 2d 1031 (S.D.N.Y. 1999) (indicating a word or short phrase, alone, generally cannot support a copyright claim); *and see Coach, Inc. v. Peters*, 386 F. Supp 2d 495, 498-99 (indicating mere variations in typographic ornamentation or lettering cannot support a copyright claim). Thus, because the only distinguishable authorship the Applicants have incorporated into the pre-existing flag of the U.S.A. is the addition of unprotectable letters printed in a font comprised of unprotectable star shapes, we find that none of the designs in the collection are sufficiently creative to support a claim of copyright. *Feist,* 499 U.S at 359.

The Board is not persuaded by your assertion that the court's decision in *Faessler* supports registration. *Second Request* at 4. We agree with the general principle that "a work may be protected by copyright even though it is based on something already in the public domain if the author . . . has contributed a distinguishable variation [to it]." *Faessler*, No. 1:05 CV 581 (S.D. Ohio Feb. 9, 2007). However, as explained above, we find that none of the flag designs in the Work include distinguishable authorship that is sufficiently creative to warrant registration.

In sum, the Board finds that the collection of flag designs that you identify as the subject matter of your copyright claim are derivative of the traditional flag of the U.S.A. and lack distinguishable authorship that is sufficiently creative to make any aspect of the Work eligible for registration under the Copyright Act.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the work entitled: *Collection of Flag Designs*. This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: _____
William J. Roberts, Jr.
Copyright Office Review Board