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

September 11, 2013

Cowan, Liebowitz & Latman, P.C.
Attn: Thomas Kjellberg
1133 Avenue of the Americas
New York, NY 10036

Re: Discover It Design
Correspondence ID: 1-F1FGW4

Dear Mr. Kjellberg:

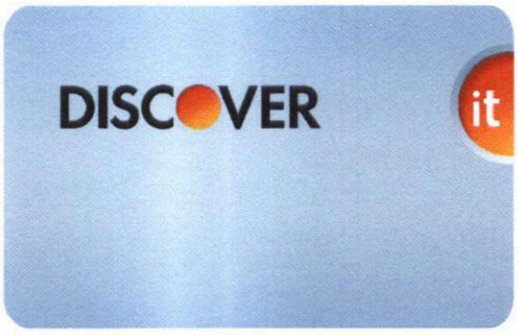
The Review Board of the United States Copyright Office (the "Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the work entitled: *Discover It Design*. You submitted this request on behalf of your client, Discover Financial Services, (the "Applicant") on June 19, 2013.

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

Discover It Design (the "Work") consists of a metallic blue rectangle with rounded corners. The metallic blue coloring is "shaded" so that it appears to be reflecting light. There is a small, orange semi-circle on the upper portion of the rectangle's right edge. The orange coloring is also "shaded" so that it appears to be reflecting light. White text spelling out the word "it" is printed inside the orange semi-circle. A version of the Applicant's pre-existing logo (the word "DISCOVER" printed in black letters with an orange circle replacing the "O") is printed on the rectangle's upper-left portion.

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



II. ADMINISTRATIVE RECORD

On September 6, 2012, the United States Copyright Office (the "Office") issued a letter notifying Discover Financial Services (the "Applicant") that it had refused registration of the above mentioned Work. *Letter from Registration Specialist, Larisa Pastuchiv, to Aryn Emert* (September 6, 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 December 5, 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 Thomas Kjellberg to Copyright RAC Division* (December 5, 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 Thomas Kjellberg* (March 22, 2013).

Finally, in a letter dated June 19, 2013, 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 Thomas Kjellberg to Copyright R&P Division* (June 19, 2013) ("Second Request"). In arguing that the Office improperly refused registration, you claim the Office erroneously analyzed the Work under a "heightened standard of originality." *Id.* at 1. Specifically, you argue that the Office incorrectly characterized the Work as a "commercial label" and wrongly factored the Work's purported use for commercial and advertising purposes into its determination that the Work is not sufficiently creative to warrant copyright registration. *Id.* at 1-2. You reference several cases standing for the proposition that otherwise copyrightable works will not be denied copyright simply because they were designed for commercial or advertising purposes. *Id.* at 1-2 (referencing *Kitchens of Sara Lee v. Nifty Foods Corp.*, 266 F.2d 541 (2d Cir. 1959) and *Bleistein v. Donaldson*, 188 U.S. 239 (1903), among other cases).

You also maintain 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 4. In support of this argument, you claim that the Applicant's careful selection and arrangement of the Works' constituent elements possess a sufficient amount of creative authorship to warrant registration under the Copyright Act. *Id.* at 4-6. Along with *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 4-6. Your argument also reference several cases that demonstrate works comprised of otherwise unprotectable elements are acceptable for copyright protection if the selection and arrangement of their elements satisfies the requisite level of creative authorship. *Id.* (referencing *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003), among other cases).

III. DECISION

A. *The Legal Framework*

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. NY 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 at 811. 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 *Discover It Design* fails to satisfy the requirement of creative authorship.

As a preliminary matter, our decision to deny registration rests firmly on our conclusion that the Work lacks a sufficient amount of original and creative authorship to warrant copyright protection. The Work's purported use for commercial or advertising purposes has no bearing on this determination. To the extent that the Office has referred to the Work as a logo, a "commercial label," or even a credit-card design, these terms are for descriptive purposes only. They play no role in our analysis of whether the Work is sufficiently creative to support registration under the provisions of the Copyright Act explained herein.

The Board finds that none of the Work's constituent elements, considered individually, are sufficiently creative to warrant protection. As noted, 37 C.F. R § 202.1(a), identifies certain elements that are not copyrightable. These elements include: "[w]ords and short phrases such as names, titles, slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring." *Id.* Here, the Applicant's Work consists of a public domain rectangle with rounded corners; a public domain semi-circle; the colors metallic blue, orange, and white; the word "it"; and a pre-existing logo. Consistent with the above regulations, the public domain shapes, the single word "it"; the font the Applicant used to create the word "it," and the Work's simple color scheme are all, in and of themselves, ineligible for copyright registration. *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); *see also Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 498-99 (indicating mere variations in typographic ornamentation or lettering cannot support a copyright claim); *and see Boisson v. Banian, Ltd.*, 273 F.3d 262, 271 (2d Cir. 2001) (indicating mere coloration cannot support a copyright claim). Thus, we conclude the Work's constituent elements do not qualify for registration under the Copyright Act.

Further, the Board finds that the Work, considered as a whole, fails to meet the creativity threshold set forth in *Feist*. 499 U.S. at 359. As explained, the Board accepts the principle that combinations of unprotectable elements may be eligible for copyright registration. However, in order to be accepted, such combinations must contain some distinguishable variation in the selection, coordination, or arrangement of their elements that is not so obvious or minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Id.*; *see also Atari Games,* 888 F.2d at 883 (finding a work should be viewed in its entirety, with individual uncopyrightable elements judged not separately, but in their overall interrelatedness within the work as a whole). Viewed as a whole,

the Applicant's Work is a two-dimensional design that consists of an orange semi-circle, the word "it," and a simple variation of a pre-existing logo printed inside a blue rectangle. This basic arrangement of two public domain shapes, a common word, an ordinary color scheme (even including the shading effect), and an unprotectable, pre-existing logo is, at best, *de minimis*, and fails to meet the threshold for copyrightable authorship. *Feist,* 499 U.S. at 359; *see also Atari Games,* 888 F.2d at 883. Your repeated assertions that the Office has "misapprehended" and "disregarded" aspects of the Work that should be expressly considered as contributing to the complexity of the Work's selection and arrangement (*i.e.* "shading or shadowing . . . suggestive of depth or dimensionality") do not add to your claim of sufficient creativity. Regardless of how they are tallied or characterized, the selection and arrangement of the Work's constituent elements, as a whole, are little more than a non-creative configuration of unprotectable words, shapes, and colors designed to fit on the face of a standard credit card shape. The resulting authorship of these combinations is *de minimis*, and such an arrangement lacks the requisite "creative spark" necessary for registration. *Feist,* 499 U.S. at 359; *Satava*, 323 F.3d at 811.

In sum, the Board finds that both the individual elements that comprise the Work, as well as the Applicant's selection, organization, and arrangement of those elements lack the sufficient level of creativity to make it 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: *Discover It Design*. 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