United States Copyright Office
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July 16, 2013

Michaud-Kinney Group LLP
Attn: Michael K. Kinney
306 Industrial Park Road, Suite 206
Middletown, CT 06457-1532

Re: SUBWAY LOGO
Correspondence ID: 1-7V60DL

Dear Mr. Kinney:

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: *Subway Logo* (the "Work"). You submitted this request on behalf of your client, Doctor's Associates, Inc., on June 1, 2011. 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 Review 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

The Work consists of the word "SUBWAY." The word's text is outlined in the color green and is slightly slanted to the right. The letters "SUB" are colored white. The letters "WAY" are colored yellow. The bottom curve of the letter "S" is extended to form an arrow pointing to the left. The upper, right portion of the letter "Y" is extended to form an arrow pointing to the right.

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



II. ADMINISTRATIVE RECORD

On August 23, 2010, the Copyright Office (the "Office") issued a letter notifying Doctor's Associates, Inc. (the "Applicant") that it had refused registration of the above mentioned Work. *Letter from Registration Specialist Melissa Crawford to Valerie Pochron* (August 23, 2010). In its letter, the Office indicated that it could not register the Work because it "lacks the authorship necessary to support a copyright claim." *Id.*

In a letter dated December 6, 2010, your firm requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Work. *Letter from Alaine Dolan to Attorney-Advisor Virginia Giroux-Rollow* (December 6, 2010) ("First Request"). Your letter set forth the reasons you believed the Office improperly refused registration. *Id.* 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 and/or textual authorship upon which to support a copyright registration" and again refused registration. *Letter from Attorney-Advisor Virginia Giroux-Rollow to Alaine Dolan* (March 31, 2011) ("Second Request").

Finally, in a letter dated June 1, 2011, 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 Richard R. Michaud to Copyrigtht R&P Division* (June 1, 2011).

In arguing that the Work should be registered, you maintain that the Work, as a whole, includes at least the minimum amount of creativity required to support registration. *Id.* In support of this argument, you claim that the Applicant carefully selected and combined the individual elements that comprise the Work to give it a meaning that is not present when the elements are evaluated independently. *Id.* Specifically, that the Applicant's arrangement of the word "SUBWAY"; the colors green, white, and yellow; and the stylized "S" and "Y" is symbolic of the Applicant's business' "freshness," "boldness," and connection to the subterranean train system of the same name. *See First Request.*

You also claim that the Work is not entirely comprised of noncopyrightable elements. To support this assertion, you argue that, regarding the stylized "S" and "Y" elements, the Applicant has taken a "geometric design" (the common arrow shape) and two letters (the "S" and "Y") and turned them into "uncommon or unfamiliar symbols." *Second Request* at 3.

Finally, you argue that the Office erred in denying your first reconsideration of its initial refusal to register the Work because it improperly considered the Work's trademark status in its evaluation. *Id.*

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 Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). 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. However, 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.*, 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 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 the Work fails to satisfy the requirement of creativity.

First, 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 status as a trademark played no role in this determination.

Second, we accept the principle that logos containing words or short phrases may be protectable under the Copyright Act. This principle, however, is not at all inconsistent with the express language in 37 C.F.R § 202.1(a) prohibiting the 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." The examination of a logo or pictorial work does not end upon a determination that it contains a word, color, familiar symbol, or typesetting. Rather, once it is established that a work or logo is comprised solely of one or more of these types of unprotectable elements, the analysis shifts to whether the work, as a whole, contains some distinguishable variation in the selection, coordination, or arrangement of its elements that is not so obvious or minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883 (finding a work should be viewed in its entirety, with individual noncopyrightable elements judged not separately, but in their overall inter-relatedness within the work as a whole).

Here, the Applicant's Work is comprised of the following elements: (1) the word "SUBWAY"; (2) the colors green, white, and yellow; and (3) two basic arrow shapes that extend from the top and bottom of the letters "S" and "Y", respectively. We conclude that these individual elements, in and of themselves, are not eligible for copyright protection. *See* 37 C.F.R. § 202.1(a); *see 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 Boisson v. Banian, Ltd.*, 273 F.3d 262, 271 (2d Cir. 2001) (indicating mere coloration 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).

We further conclude that the Applicant's simple arrangement of these constituent elements lacks the requisite "creative spark" necessary for registration. *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883. As noted, the work depicts the word "SUBWAY," outlined in green, with the first half of the word's text colored white and the second half of the word's text colored yellow. The letters "S" and "Y" both have a common arrow shape extending from them. This basic arrangement of a word, a typographic ornamentation, and a simple color scheme 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 argument that the Applicant has taken a geometric design (the basic arrow shape) and two letters ("S" and "Y") and combined them to form "uncommon or unfamiliar symbols" is unpersuasive. The law is clear in that a mere distinctiveness in typographic ornamentation will not ordinarily qualify otherwise unregisterable material for copyright protection. *See* 37 C.F.R. § 202.1(a); *see also Coach, Inc.*, 386 F. Supp. 2d at 498-99. Even with the familiar arrow shapes added to them, the "S" and "Y" elements remain simple variations of the letters "S" and "Y." Because it is well settled that ornamentation of this nature is insufficient to qualify a stylized letter design for registration, this argument fails. *See Coach, Inc.*, 386 F. Supp. 2d at 498-99 (denying protection to the stylized letter "C" as it appeared on the applicant's line of fashion accessories).

Finally, your assertions that the Applicant's arrangement of the word "SUBWAY," the colors green, white, and yellow, and the stylized "S" and "Y" is symbolic of the Applicant's business' "freshness," "boldness," and connection to the subterranean train system of the same name, do not add to your claim of sufficient creativity. *See First Request at* 4. Nor does your assertion that the Applicant designed a new font to use in the Work's lettering. *Id.* As discussed above, the Board does not assess 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 in determining whether a work contains the requisite minimal amount of original authorship necessary for registration. *See* 17 U.S.C. § 102(b); *see also Bleistein*, 188 U.S. 239. Thus, even if accurate, the mere fact that the Applicant's Work consists of a unique, aesthetically appealing, commercially successful arrangement of a familiar word, shape, and colors would not qualify the Work, as a whole, as copyrightable.

In sum, the Board finds that the Applicant's selection and arrangement of the common elements that comprise the *Subway Logo* lack a sufficient level of creativity to make the Work registerable under the Copyright Act.

IV. CONCLUSION

For the reasons stated herein, the United States Copyright Office Review Board affirms the refusal to register the work entitled: *Subway Logo*. 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