United States Copyright Office
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September 3, 2013

Procopio, Cory, Hargraves and Savitch, LLP
Attn: Lisel M. Ferguson
525 B Street, Suite 2200
San Diego, CA 92101

Re: WD-40 Can & WD-40 20% Can
Correspondence ID: 1-BQFUYS

Dear Ms. Ferguson:

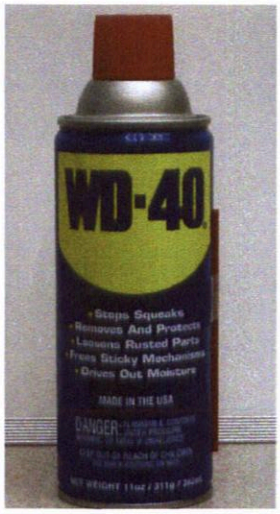
The Review Board of the United States Copyright Office (the "Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the works entitled: *WD-40 Can & WD-40 20% Can* (the "Works"). You submitted this request on behalf of your client, The WD-40 Company, on September 27, 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 these copyright claims. 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 WORKS

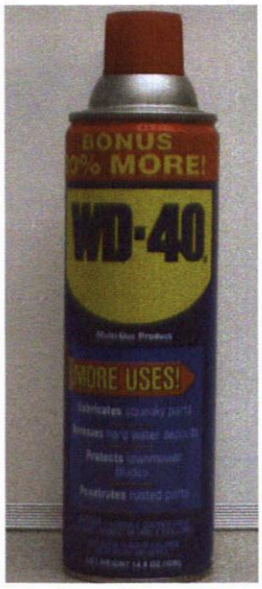
The Applicant's claim of copyright in the *WD-40 Can* consists of the following elements arranged on a cylindrical tube or can: (1) a red cap; (2) a dark blue background; (3) a yellow rectangular shape with a rounded bottom and the phrase "WD-40" printed on it in a blue, stylized font; and, (4) five short phrases printed in white text and arranged vertically below the yellow rectangle. The five short phrases are: "Stops Squeaks," "Removes And Protects," "Loosens Rusted Parts," "Frees Sticky Mechanisms," and "Drives Out Moisture."

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



The Applicant's claim of copyright in the *WD-40 20% Can* consists of a slightly larger cylindrical tube or can with the same red cap, dark blue background, and yellow rectangular shape with the phrase "WD-40" printed on it as the above *WD-40 Can*, combined with the following elements: (1) a red border with yellow text that reads "BONUS 20% MORE!"; (2) a light blue rectangle with four short phrases printed on it in white text; and, (3) a red arrow shape with the phrase "MORE USES!" printed on it in yellow text. The four short phrases are: "Lubricates squeaky parts," "Removes hard water deposits," "Protects lawnmower blades," and "Penetrates rusted parts."

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



II. ADMINISTRATIVE RECORD

On January 11, 2012, the United States Copyright Office (the "Office") issued a letter notifying The WD-40 Company (the "Applicant") that it had refused registration of the above mentioned Works. *Letter from Registration Specialist, Shawn Thompson, to Lisel Ferguson* (January 11, 2012). In its letter, the Office stated that it could not register the Works because they lack the authorship necessary to support a copyright claim. *Id.*

In a letter dated March 13, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Works. *Letter from Lisel Ferguson to Copyright RAC Division* (March 13, 2012) ("First Request"). Your letter set forth your reasons as to why the Office improperly refused registration. *Id.* Upon reviewing the Works in light of the points raised in your letter, the Office concluded that the Works "do not contain a sufficient amount of original and creative artistic, graphic or literary authorship" and again refused registration. *Letter from Attorney-Advisor, Stephanie Mason, to Lisel Ferguson* (June 29, 2012).

Finally, in a letter dated September 27, 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 Works. *Letter from Lisel Ferguson to Copyright R&P Division* (September 27, 2012) ("Second Request"). In arguing that the Office improperly refused registration, you claim the Works include 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 3-5. In support of this argument, you claim that product labels are eligible for copyright protection and Applicant's careful selection and arrangement of the elements that comprise the Works' labels are sufficiently creative to warrant protection under the Copyright Act. You also indicate that the Applicant's WD-40 can designs have a "long history" of being recognizable to the public and are designed to "catch the public's eyes." *Second Request* at 4, Exhibit B.

In addition to *Feist*, your argument references *Kitchens of Sara Lee v. Nifty Foods Corp.*, 266 F.2d 541 (2d Cir. 1959) and several other cases that support the general principle that product labels containing sufficient creative authorship are eligible for copyright registration. *Id.* at 5-6 (citing *Dropdead Co. v. S.C. Johnson & Son, Inc.*, 326 F.2d 87 (9th Cir. 1963); *Tienshan, Inc. v. C.C.A. Int'l., Inc.*, 895 F. Supp. 651 (S.D.N.Y. 1995); *S.C. Johnson & Son v. Turtle Wax, Inc.*, No. 89 C 5792 (N.D.Ill. Oct. 17, 1989); *Sebastian, Int'l v. Consumer Contact (PTY) Ltd.*, 664 F. Supp. 909 (D. Minn. 1986); *Ford Motor Co. v. B & H Supply, Inc.*, 646 F. Supp. 975 (D. Minn. 1986)).

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. 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 unprotectable 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).

This same principle applies to product labels. In other words, not all product labels are *per se* copyrightable. In order to qualify for protection under the Copyright Act, product labels comprised primarily of unprotectable elements (such as "brand names, slogans, short phrases or expressions") must possess a sufficient amount of creative authorship in the selection, combination,

and arrangement of those elements to be eligible for copyright registration. *Kitchens of Sara Lee v. Nifty Foods Corp.*, 266 F.2d at 544; *see also Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705 (7th Cir. 1972) (finding sufficiently creative product labels may be copyrightable, but protection of the label does not extend to short phrases, slogans or elements that merely describe or tout the product).

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 Works***

After carefully examining the Works, and applying the legal standards discussed above, the Board finds that both *WD-40* can designs fail to satisfy the requirement of creative authorship.

First, the Board finds that none of the Works' constituent elements, considered individually, are sufficiently creative to warrant protection. The Works are comprised of the following elements: (1) the colors red, blue, yellow, and white; (2) several short phrases; (3) the stylized text that makes up those phrases; and, (4) two shapes – a rectangle with a rounded edge and an arrow.

As noted, 37 C.F.R § 202.1(a), identifies certain elements that are not copyrightable. These elements include: "familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring." *Id.* Here, the Works' color scheme includes standard colors prohibited from registration. *Id.; see also Boisson v. Banian, Ltd.*, 273 F.3d 262, 271 (2d Cir. 2001) (indicating mere coloration cannot support a copyright claim). The Works also include a basic rectangular shape with a rounded edge and a basic arrow shape, both of which are prohibited from registration as common "familiar symbols or designs." 37 C.F.R. § 202.1(a); *see also Feist*, 499 U.S. at 363. Finally, neither the short phrases in the Works, nor the simple, stylized font the Applicant used to create the lettering that makes up the phrases are eligible for copyright protection. *See Coach,* 386 F. Supp. 2d 495, 498-99 (S.D.N.Y. 2005) (indicating mere variations in typographic ornamentation or lettering cannot support a copyright claim); *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 Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705 (finding short phrases, slogans, or other elements that appear on product labels to merely describe or tout the product are ineligible for copyright protection). Thus, consistent with section 202.1(a), we find the Works' constituent elements do not qualify for registration under the Copyright Act.

Second, the Board finds that the Works, each considered as a whole, fail to meet the creativity threshold set forth in *Feist*. 499 U.S at 359. As explained, the Board accepts the principle that product labels or product packaging designs comprised of combinations of unprotectable elements may be eligible for copyright registration. *See Kitchens of Sara Lee v. Nifty Foods Corp.*, 266 F.2d at 544. 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." *See Id.* (finding that to qualify for protection a product label must possess either "an appreciable amount of original text and/or pictorial material" or sufficient creativity in the selection and arrangement its constituent elements); *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 interrelatedness within the work as a whole)

Viewed as a whole, the *WD-40 Can* consists of the simple arrangement of an unprotectable logo[1] positioned atop a list of *de minimis*, short phases. Likewise, the *WD-40 20% Can* consists of the same simple arrangement with a red arrow and a red boarder added to it. This ordinary configuration of a basic color scheme, unprotectable shapes, and short phrases, all obviously arranged so that they are visible when a viewer looks upon the front of the can, fails to meet the threshold for copyrightable authorship. *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883. Thus, because the Works, each considered as a whole, lack the requisite "creative spark" necessary for copyright protection, we find them ineligible for registration. *Feist,* 499 U.S at 359; *Satava*, 323 F.3d at 811.

Finally, your assertion that the designs embodied in the Works have a "long history" of being recognizable to the public does not add to your claim of sufficient creativity. *Second Request* at 4, Exhibit B. Nor does your assertion that the Works are designed to "catch the public's eyes." *Id.* As discussed above, the Board does not assess the attractiveness of a design, the espoused intentions of the author, the design's visual effect or appearance, 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 Works consists of an eye-catching, historic arrangement of familiar shapes and short phrases would not qualify them as copyrightable.

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

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[1] The Board is not persuaded by your argument that the WD-40 Company's logo (the yellow rectangular shape with a rounded bottom and the phrase "WD-40" printed on it in a blue, stylized font) is, alone, sufficiently creative to warrant registration. This basic pairing of a simple unprotectable shape, two ordinary colors, and a short phrase is, at best, *de minimis* and fails to meet the grade for registration. *See* 37 C.F.R. § 202.1(a); *and see John Muller & Co*, 802 F.2d 989.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the works entitled: *WD-40 Can & WD-40 20% Can*. This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: /
Andrea Zizzi
Copyright Office Review Board