



United States Copyright Office

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

September 3, 2019

Susan Upton Douglass, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
4 Times Square, 17th Floor
New York, NY 10036

**Re: Second Request for Reconsideration for Refusal to Register Engine Turn;
Correspondence ID: 1-3EL9NY4; SR 1-6013032961**

Dear Ms. Douglass:

The Review Board of the United States Copyright Office (“Board”) has considered Alfred Dunhill Limited’s (“Alfred Dunhill’s”) second request for reconsideration of the Registration Program’s refusal to register a fabric pattern claim in the work titled “Engine Turn” (“Work”). After reviewing the application, deposit copy, and relevant correspondence, along with the arguments in the second request for reconsideration, the Board affirms the Registration Program’s denial of registration.

I. DESCRIPTION OF THE WORK

The Work¹ is a two-dimensional design consisting of diamonds repeated in symmetrical rows and columns. The diamond design contains a smaller diamond in the center of a larger diamond. The smaller diamond is brown and the larger diamond surrounding the smaller diamond is dark blue on the left and light blue on the right. The blue portions of the larger design can also be described as a six-sided arrowhead-shaped polygon. An image of the Work is below:



¹ The Office notes that the Work is a two-dimensional fabric design in and of itself. The deposit copy depicts the Work as applied to a backpack, which is a useful article but the Office need not conduct a useful article and separability analysis. The application describes the Work as a fabric pattern and the Office interprets the backpack in the deposit copy as the medium upon which the Work is displayed, as opposed to a useful article in which the applicant is claiming separable features.

II. ADMINISTRATIVE RECORD

On November 17, 2017, Alfred Dunhill filed an application to register a copyright claim in the Work. In a May 31, 2018, letter, a Copyright Office registration specialist refused to register the claim, finding that it lacks the authorship necessary to support a copyright claim. Letter from Examiner Proctor, Registration Specialist, to Susan Douglass (May 31, 2018).

In a letter dated July 31, 2018, Alfred Dunhill requested that the Office reconsider its initial refusal to register the Work. Letter from Susan Upton Douglass to U.S. Copyright Office (July 31, 2018) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claim and again concluded that the Work is a “simple arrangement of geometric shapes into a basic, garden-variety configuration,” which “lacks the creativity to support a registration.” Letter from Stephanie Mason, Attorney-Advisor, to Susan Douglass (Feb. 12, 2019).

In a letter dated April 17, 2019, Alfred Dunhill 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 Susan Upton Douglass to U.S. Copyright Office (Apr. 17, 2019) (“Second Request”). In that letter, Alfred Dunhill again argued that the Work has sufficient creative authorship and amply meets the minimal test for copyright protection. *Id.* Specifically, Alfred Dunhill argued that the placement of the brown diamond “creates an impression of three-dimensional negative space on a two-dimensional fabric” and compared this effect to two works registered on second appeal: the *American Airlines Flight Symbol* registered under VA 2-130-520 and the repeating double block design titled *Pattern for Paper and Textile Products* registered under VA 2-009-878. *Id.* Alfred Dunhill argued that the pattern here shows “far more depth, three-dimensional effect and creativity than the American Airlines Flight Symbol,” and that “[a] design comprised of double blocks of repeating diamonds . . . is no more original than . . . repeating diamonds in three colors that create an optical illusion of sloping sides, negative space and a three-dimensional effect . . .” *Id.*

III. DISCUSSION

A. *The Legal Framework – Originality*

A work may be registered if it qualifies as an “original work[] of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102(a). In this context, the term “original” consists of two components: independent creation and sufficient creativity. *See Feist Publ’ns, Inc. 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.* Only a modicum of creativity is necessary, but the

Supreme Court has ruled that some works (such as the alphabetized telephone directory at issue in *Feist*) fail to meet even this low 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 virtually nonexistent.” *Id.* at 359.

The Office’s regulations implement the longstanding requirement of originality set forth in the Copyright Act and described in the *Feist* decision. *See, e.g.*, 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”); *id.* § 202.10(a) (stating “to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form”). 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 test. *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”). A determination of copyrightability in the combination of standard design elements depends 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.C. Cir. 1989).

A mere simplistic arrangement of non-protectable elements does not demonstrate the level of creativity necessary to warrant protection. For example, the United States District Court for the Southern District of New York upheld the Copyright Office’s refusal to register simple designs consisting of two linked letter “C” shapes “facing each other in a mirrored relationship” and two unlinked letter “C” shapes “in a mirrored relationship and positioned perpendicular to the linked elements.” *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 496 (S.D.N.Y. 2005). Likewise, the Ninth Circuit has held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, 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 language in *Satava* is particularly instructive:

It 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).

Similarly, while the Office may register a work that consists merely of geometric shapes, for such a work to be registrable, the “author’s use of those shapes [must] result[] in a work that, as a whole, is sufficiently creative.” COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 906.1 (3d ed 2017) (“COMPENDIUM (THIRD)”); *see also Atari Games Corp.*, 888 F.2d at 883 (“[S]imple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and in court.”). Thus, the Office would register, for example, a wrapping paper design that consists of circles, triangles, and stars arranged in an unusual pattern with each element portrayed in a different color, but would not register a picture consisting merely of a purple background and evenly-spaced white circles. COMPENDIUM (THIRD) § 906.1.]

B. Analysis of the Work

After carefully examining the Work and applying the legal standards discussed above, the Board finds that the Work does not contain the requisite originality necessary to sustain a claim to copyright.

The Work merely consists of uncopyrightable elements arranged in an unoriginal manner. The individual elements, diamonds and a six-sided arrowhead shaped polygon, are uncopyrightable standard geometric shapes. *See* 37 C.F.R. § 202.1(a) (stating that “familiar symbols or designs” are not registerable); COMPENDIUM (THIRD) § 906.1. Likewise, the simple blue and brown coloring is not copyrightable. 37 C.F.R. § 202.1(a) (stating that “coloring” is not registrable).

When viewed as a whole, the Work still does not contain enough creativity to support registration. Alfred Dunhill compares the Work here to the cheerleading uniforms at issue in *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017), stating that the “cheerleader uniforms were held to be copyrightable even though they comprise simple geometric shapes” and that the Work here “clearly shows a higher level of creativity...” Second Request at 2. Alfred Dunhill further concludes, “the *Star Athletica* case demonstrates that works comprised of simple geometric shapes are not precluded from copyright protection.” *Id.* Alfred Dunhill then cites the sufficiently creative wrapping paper example in *Compendium* section 906.1 to further support its argument that works comprised of geometric shapes are not precluded from registration. This argument is not persuasive.

The Office does not assert that works comprised of simple geometric shapes are precluded from copyright protection. To the contrary, as explained above the Office agrees that certain combinations of simple geometric shapes may be registered, but only if combined or arranged in a sufficiently creative manner. The Work here is merely a “display of a few geometric shapes in a preordained or obvious arrangement.” COMPENDIUM (THIRD) § 906.1. The elements combined create yet another geometric shape and the result is a single graphic design element repeated in symmetrical straight diagonal lines with standard coloring. This configuration of a repeating single design element in straight lines is a typical arrangement and demonstrates insufficient creativity to support a claim to copyright.

Additionally, Alfred Dunhill focuses on the three-dimensional effect and optical illusion created by the arrangement and coloring, and relies on the Board’s decision in *American Airlines Flight Symbol*, to support the argument that the three-dimensional effect is evidence of sufficient creativity. Second Request at 3-4. Alfred Dunhill also relies on the Board’s decision in *Pattern for Paper and Textile Products* to support its argument that the Work here contains a sufficient amount of creativity. *Id.* This reliance, however, is misplaced. The Office does not compare works that have been previously registered or refused registration. See COMPENDIUM (THIRD) § 309.3. Instead, the Office examines each claim on its own merits applying uniform standards of copyrightability at each stage of registration. Because copyrightability involves a mixed question of law and fact, differences between any two works can lead to different results. Thus, the fact that the Office registered a work containing allegedly similar elements does not require the Office to find that the contested Work itself is protected by copyright. See *Homer Laughlin China Co. v. Oman*, 2 U.S.P.Q.2d (BNA) 1074, 1076 (D.D.C. 1991) (stating that it was not aware of “any authority which provides that the Register must compare works when determining whether a submission is copyrightable”); *accord, Coach, Inc.*, 386 F. Supp. 2d at 499 (indicating the Office “does not compare works that have gone through the registration process.”).

Nonetheless, even if a comparison were required, the Work is not the same as the works at issue in the cited registrations. The works there contained creative elements not present in the design here. In *American Airlines*, the Board noted the three-dimensional appearance of the work but did not go so far as to determine that a three-dimensional effect in and of itself is evidence of creativity. See Letter from Review Board, U.S. Copyright Office, to Eric F. Leon, Latham & Watkins LLP (Dec. 7, 2018). The effect that a work conveys suggests some aspect of mental activity that goes into the mind of the viewer rather than to the composition of the work itself. Mental impression is not a factor considered in determining whether a work is sufficiently creative. COMPENDIUM (THIRD) § 310.3 (3d ed. 2017). Instead, the Board identified the creativity involved in the composition of the work itself, describing specific creative elements in the shading combined with adjusted shapes. See Letter from Review Board, U.S. Copyright

Office, to Eric F. Leon, at 6. This creative combination of elements is not present in the Work here. Likewise, in *Pattern for Paper and Textile Products* the Board specifically identified “original spacing variations between the repeating diamond patterns” as a creative element of the entire compilation of the work. Letter from Review Board, U.S. Copyright Office to Amy Brozenic, Lathrop & Gage LLP (June 30, 2016). No such element exists here.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claim in the Work. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.



U.S. Copyright Office Review Board

Karyn A. Temple, Register of Copyrights
and Director, U.S. Copyright Office

Regan A. Smith, General Counsel and
Associate Register of Copyrights

Catherine Zaller Rowland, Associate Register of
Copyrights and Director, Public Information and
Education