



United States Copyright Office

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March 16, 2017

Masahiro Noda, Esq.
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200 Park Ave.
New York, NY 10166

**RE: Second Request for Reconsideration for Refusal to Register Nikon Brand Logo;
Correspondence ID 1-1TDG0E8; SR# 1-3221016404**

Dear Mr. Noda:

The Review Board of the United States Copyright Office (the “Board”) has considered Nikon Corporation’s (“Nikon’s”) second request for reconsideration of the Registration Program’s refusal to register a two-dimensional artwork copyright claim in the work titled “Nikon Logo” (the “Work”). After reviewing the application, deposit copy, and relevant correspondence in the case, 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 Work is a square graphic logo with yellow-colored background. The bottom of the Work contains the word “Nikon” in a black italic font. Behind the word Nikon, from the bottom-left to top-center portion to the top-middle portion of the Work are ten elongated, white ovals that fade into the yellow background at the edge of each oval. The white ovals give the overall impression of being bands of light.

The Work is depicted below:



II. ADMINISTRATIVE RECORD

On March 23, 2016, Nikon filed an application to register a copyright claim in the Work. In a March 25, 2016 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 Wilbur King, Registration Specialist, to Masahiro Noda, Greenberg Traurig, LLP (Mar. 25, 2016).

In a letter dated May 23, 2016, Nikon requested that the Office reconsider its initial refusal to register the Work. Letter from Masahiro Noda, Greenberg Traurig, LLP, to U.S. Copyright Office (May 23, 2016) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and again concluded that the Work lacked a sufficient amount of original and creative artistic authorship to support copyright registration. Letter from Stephanie Mason, Attorney-Advisor, to Masahiro Noda, Greenberg Traurig, LLP (Aug. 30, 2016).

In a letter dated November 23, 2016, Nikon 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 Masahiro Noda, Greenberg Traurig, LLP, to U.S. Copyright Office (Nov. 23, 2016) (“Second Request”). Nikon disagreed with the Office’s conclusion that the Work, as a whole, did not include the minimum amount of creativity required to support registration under the Copyright Act. Specifically, Nikon claimed that, “the original combination and arrangement of design elements are sufficient to meet the low bar of a [*de*] *minimis* level of creativity required to support a copyright claim.” *Id.* at 2. Nikon offered that the Work’s yellow background “is a representation of the emotional images unique to Nikon, such as joy, depth, and passion.” *Id.* at 6. Further, the word Nikon in black font “represents the high quality, reliability and trustworthiness that Nikon has come to represent to clients and customers through decades of effort.” *Id.* Taken together, Nikon claimed that the black word and yellow background “express the concepts of ‘innovative technology’ and ‘a sense of the times’ to the notions of superior product quality and reliability” *Id.* Finally, Nikon described the oval designs as “white rays” that “are symbolic of rays of light,” “represent the future possibilities for the brand,” and “represent innovation and modernity.” *Id.* at 6-7.

III. DECISION

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 long-standing requirement of originality set forth in the Copyright Act and described in the *Feist* decision. *See, e.g.*, 37 C.F.R. § 202.11(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 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.” U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES, § 906.1 (3d ed. 2014) (“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.

Finally, Copyright Office registration specialists (and the Board) 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); *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 necessarily mean that the work, as a whole, constitutes a copyrightable work of art.

B. Analysis of the Work

After careful examination, the Board finds that the Work fails to satisfy the requirement of creative authorship and thus is not copyrightable.

The Work’s constituent elements—the stylized brand name, the yellow background, and white ovals—are not individually subject to copyright protection. 37 C.F.R. § 202.1(a) (e). Neither individual words nor typeface are copyrightable. *Id.*; see also COMPENDIUM (THIRD) § 313.4(C) (using examples of a name of an individual, a business, a product, and other short expressions as not being copyrightable), § 313.3(D) (noting the Office will not register typeface “regardless of whether the typeface is commonly used or truly unique”). Nor are basic shapes, symbols, or coloring copyrightable, such as the ten white ovals and the yellow square. 37 C.F.R. § 202.1(a) (prohibiting registration of “familiar symbols or designs; . . . lettering or coloring”); see also COMPENDIUM (THIRD) § 313.4(J) (“Well-known and commonly used symbols that contain a *de minimis* amount of expression” are not copyrightable.), § 906.1 (noting that simple shapes, such as “ovals” and “squares,” are not copyrightable).

The question then is whether the combination of elements is protectable viewed as a whole. The Board finds that, viewed as a whole, the Work simply is not sufficiently creative from a copyright perspective. See *Feist*, 499 U.S. at 359. Here, the combination of a square, yellow background, ten elongated white ovals, and the brand name “Nikon” simply do not rise to the level of creativity necessary for copyright protection. The placement of the word towards the bottom of Work is typical of many companies’ designs, and the use of a bright background color similarly does not evidence sufficient creativity. The use of a series of similar geometric shapes such as the elongated ovals also is not in itself creative. See, e.g., Adidas logo (series of three rhomboids), and Minolta logo (circle with curved bands). The Office finds that the Work thus does not evince enough creativity for protection under the Copyright Act and that the selection and placement of the Work’s elements are not the product of even *de minimis* creative choices.

Nikon urges that “logos have been found to have sufficient creativity in certain instances.” Second Request at 3-4. That is true, and the Office does not discriminate against creative works that also are used as trademarks or logos. Indeed, the Office does not consider a work’s trademark status when evaluating whether the Copyright Act also should provide protection. 37 C.F.R. § 202.10(c) (Office will register a trademark and logo only if it “contains the requisite qualifications for copyright”); COMPENDIUM (THIRD) § 913.1 (“the Office will not consider whether the work has been or can be registered with the U.S. Patent and Trademark Office”). Copyright law and trademark law serve different purposes and use different legal tests. A powerful trademark or logo may well warrant protection under the Lanham Act, 15 U.S.C. 1051 *et seq.*, while not rising to the level of creativity under the Copyright Act. The difference between these types of intellectual property explains why the Office does not provide special treatment, either positive or negative, to trademarks or logos. Thus, the Office reviews trademarks and logos as it does any other work, and will not register “trademarks, logos, or labels that consist of only . . . [m]ere spatial placement or format of trademark, logo, or label elements . . . [u]ncopyrightable use of color, frames, borders, or differently sized font, [and] [m]ere use of different fonts or functional colors, frames, or borders, either standing alone or in combination.” COMPENDIUM (THIRD) § 913.1.

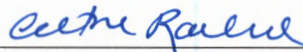
To aid its argument, Nikon cites to several inapposite and unpersuasive commercial logo cases. In two of those cases, the courts relied on the fact that the works at issue had already been registered by the Copyright Office and each work displayed more creative authorship than the Work

at issue here. Second Request at 3 (citing *Jada Toys, Inc. v. Mattel, Inc.* 518 F.3d 628 (9th Cir. 2008) and *Bouchat v. Baltimore Ravens, Inc.* 241 F.3d 350 (4th Cir. 2001)). The third case, *Amplex Manufacturing Co. v. A.B.C. Plastic Fabricators, Inc.*, 184 F. Supp. 285 (E.D. Pa. 1960), was decided under the Copyright Act of 1909, before the Supreme Court's decision in *Feist*, and is in direct conflict with *Eltra Corp. v. Ringer*, 579 F.2d 294 (4th Cir. 1978). In *Eltra*, the Fourth Circuit observed that "typeface has never been considered entitled to copyright under the provisions of [the 1909 Copyright Act]" and though many parties have asked Congress to amend the law to provide copyright protection to typeface, "[j]ust as consistently Congress has refused to grant the protection." *Eltra Corp.*, 579 F.2d at 298. The House Report to the Copyright Act of 1976 reflects this congressional choice, stating: "The Committee does not regard the design of typeface, as thus defined, to be a copyrightable 'pictorial, graphic, or sculptural work' within the meaning of this bill . . ." H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5668-69. Therefore, Nikon's reliance on *Amplex* is unpersuasive. In contrast, the United States District Court for the Eastern District of New York recently agreed with the Copyright Office in declining registration for a work consisting of the name of the product in a scripted font with a yellow background, blue waves, and vertical lines colored blue-white-red-white-blue, which duplicated a portion of the Icelandic flag. See *Threeline Imp., Inc. v. Vernikov*, No. 1:15-cv-02333, slip op. at 28, 30 (E.D.N.Y. Oct. 28, 2016). There, the court found that the design "did not rise to a level of creativity that may be copyrighted" in either its design elements or as a compilation. *Id.*

Finally, Nikon contends that the Work conveys the messages of "joy, depth, and passion," "innovative technology and a sense of the times," or "innovation and modernity." Second Request at 6-7. The intangible attributes that Nikon ascribes to the Work are not evident in the deposit itself and therefore cannot be examined in an objective manner. Even if these attributes were present in the deposit, the Board does not assess the espoused intentions of a design's author, or a design's visual impact, in determining whether a design contains the requisite minimal amount of original authorship necessary for registration. See *Bleistein*, 188 U.S. at 251; COMPENDIUM (THIRD) § 310.3 ("symbolic meaning or impression of a work is irrelevant to" whether a work is copyrightable and "[t]he fact that creative thought may take place in the mind of the person who encounters a work has no bearing on the issue of originality"); *id.* § 310.5 ("When examining a work for original authorship, the U.S. Copyright Office will not consider the author's inspiration for the work, creative intent, or intended meaning."). Accordingly, the fact that Nikon attributes such characteristics to design elements of the Work does not qualify the Work for copyright protection.

V. 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.

BY: 
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Copyright Office Review Board