United States Copyright Office
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August 15, 2016

Justin E. Pierce, Esq.
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575 Seventh St. NW
Washington, D.C. 20004

RE: Second Request for Reconsideration for Refusal to Register BBM Icon; Correspondence ID: 1-PY74TZ

Dear Mr. Pierce:

The Review Board of the United States Copyright Office ("Board") has considered BlackBerry Limited's ("BlackBerry's") second request for reconsideration of the Registration Program's refusal to register a two-dimensional artwork copyright claim in the work titled "BBM Icon" ("Work"). After reviewing the application, deposit copies, 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 two-dimensional, black and white graphic logo design. The design consists of two overlapping, square speech balloons with rounded edges that frame the well-known BlackBerry logo, consisting of seven half-ovals. *See, e.g.*, BLACKBERRY, Trademark Registration No. 3,105,797 (filed September 3, 2004, registered June 20, 2006). The speech balloon in the foreground has a white border and is colored black, with shading dissecting the icon from the top-left to midway through the icon with the balloon originating from the left. The speech balloon in the background is in grey and originates from the right. The BlackBerry logo appears within the foreground balloon in white.

A reproduction of the Work is set forth below:

II. ADMINISTRATIVE RECORD

On September 13, 2013, BlackBerry filed an application to register a copyright claim in the Work. In a December 9, 2013 letter, a Copyright Office registration specialist refused to register the Work, finding that it "lacks the authorship necessary to support a copyright claim." Letter from Shawn Thompson, Registration Specialist, to Justin E. Pierce, Venable LLP (Dec. 9, 2013).

In a March 7, 2013 letter, BlackBerry requested that the Office reconsider its initial refusal to register the Work. Letter from Justin E. Pierce, Venable LLP, to U.S. Copyright Office (Mar. 7, 2013) ("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 does not contain a sufficient amount of original and creative artistic authorship to support copyright registration. Letter from Stephanie Mason, Attorney-Advisor, to Justin E. Pierce, Venable LLP (July 7, 2014).

In an October 7, 2014 letter, BlackBerry 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 Justin E. Pierce, Venable LLP, to U.S. Copyright Office (Oct. 7, 2014) ("Second Request"). In that letter, BlackBerry disagreed with the Office's conclusion that the Work, as a whole, does not include the minimum amount of creativity required to support registration under the Copyright Act. Specifically, BlackBerry claimed that the Work "is unique, and unlike any other, and possesses the necessary pictorial and graphic authorship, and creativity necessary to support a copyright claim." *Id.* at 1. Further, BlackBerry claimed that "even relatively simple works are entitled to copyright protection so long as the necessary quantum of originality is present." *Id.* at 2.

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 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).

Accordingly, 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." 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. *See id.* § 310.2. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design's visual effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). Thus, the fact that a work required effort to create, or has commercial or aesthetic appeal, does not necessarily mean that the work 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.

Here, it is indisputable that the Work's constituent elements—seven half-ovals framed by two overlapping, square speech balloons with rounded edges, and black and white coloring and shading—are not individually subject to copyright protection. As explained in the *Compendium*, neither "common geometric shapes, including . . . ovals [and] squares" nor "[w]ell-known and commonly used symbols that contain a *de minimis* amount of expression or that are in the public domain" satisfy the requirements for copyright registration. COMPENDIUM (THIRD) §§ 313.4(J), 906.1. The seven half-ovals consist of common shapes and the speech balloons are a well-known design commonly used to depict communication.

The question then is whether the combination of those elements is protectable, based on the legal standards set forth above. The Board finds that, viewed as a whole, the seven half-ovals, speech balloons, coloring and shading that comprise the Work are not sufficient to render the Work original. The Office will not register a work consisting of "a simple combination of a few familiar symbols or designs with minor linear or spatial variations." *Id.* § 313.4(J). Neither will the Office register a graphic logo design that consists only of "spatial placement or format of trademark, logo, or label elements" or "[u]ncopyrightable use of color, frames, [or] borders." *Id.* § 913.1. Accordingly, the Work lacks the requisite amount of creativity in selection, coordination, or arrangement to warrant copyright protection. *See Feist*, 499 U.S. at 358.

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.

BY: _____

Chris Weston
Copyright Office Review Board