



United States Copyright Office

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

October 20, 2020

E. Kenly Ames, Esq.
English, Lucas, Priest & Owsley, LLP
1101 College Street, PO Box 770
Bowling Green, KY 42101

Re: Second Requests for Reconsideration for Refusal to Register Air Mesh Tank Designs; Correspondence IDs: 1-3REUKJ8; 1-3OI9MCY; 1-3PQMG23; 1-3S8DPIT SR Numbers: 1-6797687431; 1-6959663675; 1-6822495962; 1-6822496154; 1-6959663482; 1-6959663579

Dear Ms. Ames:

The Review Board of the United States Copyright Office (“Board”) has considered Bench Clearers, LLC’s (“Bench Clearers”) second requests for reconsideration of the Registration Program’s refusal to register two-dimensional artwork claims in the works titled “Air Mesh Tank Designs” (“Works”). After reviewing the applications, deposit copies, and relevant correspondence, along with the arguments in the second requests for reconsideration, the Board affirms the Registration Program’s denials of registration.

I. DESCRIPTION OF THE WORKS

The Works are six different colored tank top designs with stacked curved lines outlining the collar and sleeve holes and stacked straight lines on the bottom of the tank top. The Works are as follows:



(‘431)

(‘962)

(‘154)



II. ADMINISTRATIVE RECORD

On July 25, 2018, Bench Clearers filed an application to register a copyright claim in the Work SR 1-6797687431. On August 1, 2018, Bench Clearers filed an application to register copyright claims in the Works SR 1-6822496154 and 1-6822495962. On September 17, 2018, Bench Clearers filed an application to register copyright claims in the Works SR 1-6959663579, 1-6959663482, and 1-6959663675. In six separate letters, Copyright Office registration specialists refused to register the claims, finding that each design was “a useful article that does not contain any copyrightable authorship needed to sustain a claim to copyright.” Initial Letters Refusing Registration from U.S. Copyright Office to E. Kenly Ames (Feb. 21, 2019; Mar. 6, 2019; Apr. 20, 2019; Apr. 25, 2019).

In six separate letters, Bench Clearers requested that the Office reconsider its initial refusals to register the Works. Letters from E. Kenly Ames to U.S. Copyright Office (May 2, 2019; June 4, 2019; July 18, 2019; July 23, 2019) (collectively “First Requests”). After reviewing the Works in light of the points raised in the First Requests, the Office re-evaluated the claims and again concluded that, while the blocks and bands of color in the designs have graphic qualities that can be conceptually separated from the tank tops, these separable features are “common and familiar” and “the overall combination and arrangement of these shapes does not contain a sufficient amount of creativity to support a copyright claim.” Refusals of First Request for Reconsideration from U.S. Copyright Office, to E. Kenly Ames, at 3, 5 (August 27, 2019; September 20, 2019; October 23, 2019; November 8, 2019).

In six letters, Bench Clearers 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 E. Kenly Ames, to U.S. Copyright Office (Nov. 25, 2019; Dec. 20, 2019; Jan. 22, 2020; February 7, 2020) (collectively “Second Requests”)¹. In those letters, Bench Clearers asserts that the Works “self-evidently possess[] that minimal degree of creativity in the overall arrangement of the colors, curves, angles, stripes and shapes that make up the design as a whole.” *Id.* at 3. Bench Cleaners

¹ Bench Clearers sent six separate letters regarding the six designs. Because the letters were functionally identical, the Board will treat them as the same letter for citation purposes, using the pagination of the letter for SR 1-6797687431.

emphasizes that the configuration of elements in the designs is original as the Works are an arrangement consisting of “colored stripes, curves, angles, and various sizes of shapes of geometric shapes.” *Id.*

III. DISCUSSION

A. *The Legal Framework*

1) *Useful Articles and Separability*

Copyright does not protect useful articles as such, which are defined in the Copyright Act as “article[s] having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” 17 U.S.C. § 101. Importantly, however, artistic features applied on or incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works under sections 101 and 102(a)(5) of the Copyright Act. This protection is limited to the “‘pictorial, graphic, or sculptural features’ [that] ‘can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.’” *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017) (quoting 17 U.S.C. § 101).

To assess whether an artistic feature incorporated into the design of a useful article is protected by copyright, the Office examines whether the feature “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.” *Id.* at 1007; *see also* COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924 (3d ed. 2017) (“COMPENDIUM (THIRD)”). This analysis focuses on “the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction [because the] statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature.” *Star Athletica*, 137 S. Ct. at 1013. Put another way, while useful articles as such are not copyrightable, if an artistic feature “would have been copyrightable as a standalone pictorial, graphic, or sculptural work, it is copyrightable if created first as part of a useful article.” *Star Athletica*, 137 S. Ct. at 1011; 17 U.S.C. § 113(a) (“[T]he exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.”); *see also Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978) (holding that copyright protection is not available for the “overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape . . . may be”).

2) *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. *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 (THIRD) § 906.1; *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 Works

After carefully examining the Works and applying the legal standards discussed above, the Board finds that the Works are useful articles that do not contain the requisite separable authorship necessary to sustain a claim to copyright.

The Works are useful articles (tank tops), which the Copyright Act does not protect as such. 17 U.S.C. § 101 (defining “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information”). *See* 137 S. Ct. at 1008. For aspects of a useful article to warrant copyright protection, the work must contain features that “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.” *Id.* at 1008, 1012.

Both the Copyright Office and Bench Clearers agree that the blocks of color and stripes are separable graphic design elements applied to the surface of the Works, satisfying the first prong of the *Star Athletica* test. Refusals of First Requests at 2; Second Requests at 2. Thus, the Office focuses on whether the separable pictorial or graphic elements contain sufficient creativity to be copyrightable. Here, the separable elements consist of different geometrically-shaped blocks of color forming both straight and curved lines. These separable elements are common and familiar geometric shapes, individually lacking the necessary creative authorship to support a copyright registration. *See* C.F.R. § 202.1(a) (prohibiting registration of “familiar symbols or designs . . . or colors”); COMPENDIUM (THIRD) § 906.1 (“[T]he Copyright Act does not protect common geometric shapes, either in two-dimensional or three-dimensional form . . . including . . . straight or curved lines . . . [and] rectangles”).

Next, the Office examines whether the separable elements of each Work, as a whole, are sufficiently creative to support a claim to copyright. COMPENDIUM (THIRD) § 906.1. The separable features of the Works consist of a solid color augmented by blocks of different colors stacked one atop another forming both straight lines around the bottom of the design and curved lines that outline the collar and sleeve holes of the tank-top-shape. Stacking colored blocks on top of each other is an obvious, basic configuration that is insufficiently creative to warrant copyright protection. *See* COMPENDIUM (THIRD) § 905 (“In all cases, a visual art work must

contain a sufficient amount of creative expression. Merely bringing together only a few standard forms or shapes with minor linear or spatial variations does not satisfy this requirement.”); *see also The Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q. 2d 1074 (D.D.C. 1991) (upholding refusal to register a chinaware “gothic” design pattern composed of simple variations and combinations of geometric shapes due to insufficient creative authorship to merit copyright protection); *John Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988) (upholding refusal to register a fabric design consisting of striped cloth with small grid squares superimposed on the stripes).

Stacking colored lines atop each other and using colored lines to outline the collar and sleeves of a tank top are both stock features of athletic jersey and tank top designs.² Without more, the use of color blocks and outlining the sleeve and neck openings of a tank top with curved stacked lines constitute *scènes à faire* in the athletic apparel industry and are unprotectable by copyright law. *See, e.g., Zaleski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 106 (2d Cir. 2014) (denying copyright protection for elements that are “features of all colonial homes, or houses generally”); *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1st Cir. 1988) (noting that “as idea and expression merge, fewer and fewer aspects of a work embody a unique and creative expression of the idea; a copyright holder must then prove substantial similarity to those few aspects of the work that are expression not *required* by the idea”). Because the separable aspects of the design consist of common geometric shapes arranged in an obvious configuration composed of elements that constitute *scènes à faire* within the athletic apparel industry, the Works do not contain more than a *de minimis* amount of creative expression. *Feist*, 499 U.S. at 363.

Lastly, Bench Clearers cites cases involving copyrightable designs that include combinations of shapes and lines. *See* Second Requests at 2–3 (citing *Silvertop Assocs. v. Kangaroo Mfg.*, 931 F.3d 215 (3d Cir. 2019); *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir. 1974); *Tennessee Fabricating Co. v. Moultrie Mfg. Co.*, 421 F.2d 279, 282 (5th Cir. 1970); *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1316 (2d Cir. 1969); *In Design v. Lynch Knitting Mills, Inc.*, 689 F. Supp. 176, 178–79 (S.D.N.Y. 1988)). The Office, however, considers each work submitted for copyright registration on its own merits in accordance with the statute and relevant legal principles, as any differences between two works can lead to different results. *See* COMPENDIUM (THIRD) §

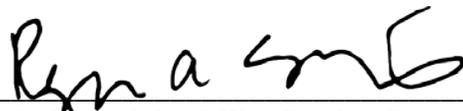
²*See, e.g., Mesh Black Jersey Tank Top*, ZUMIEZ.COM, <https://www.zumiez.com/champion-city-mesh-black-jersey-tank-top.html> (last visited Oct. 9, 2020); *3D Casual Basketball-Player-Logo-Graphics 8/24 Mesh Athletic Sports Basketball Jersey Fashion Tank Top Suitable for Mens/Kid*, AMAZON.COM, <https://www.amazon.com/Basketball-Player-Logo-Graphics-Athletic-Basketball-Fashion-8-Black/dp/B086CBZ2KH/> (last visited Oct. 9, 2020); *Fadeaway Men’s Basketball Jersey*, PUMA.COM, <https://us.puma.com/en/us/pd/fadeaway-mens-basketball-jersey/193527925076.html> (last visited Oct. 9, 2020); *Legacy Jersey Pittsburgh Steelers 2005 Hines Ward*, MITCHELLANDNESS.COM, <https://www.mitchellandness.com/legacy-jersey-pittsburgh-steelers-2005-hines-ward-lgvygs1> (last visited Oct. 9, 2020); *Under Armour WI Replica Hockey Jersey (Red)*, UWBOOKSTORE.COM, <https://www.uwbookstore.com/Wisconsin-Badgers/Mens/Jerseys/Under-Armour-WI-Replica-Hockey-Jersey-Red-2064275> (last visited Oct. 9, 2020); *Michigan Wolverines Nike Women's Circle Performance Racerback Tank Top – White*, FANATICS.COM, <https://www.fanatics.com/college/michigan-wolverines/michigan-wolverines-nike-womens-circle-performance-racerback-tank-top-white/o-38+t-12081697+p-136198983328+z-9-2539836260> (last visited Oct. 9, 2020).

602.4(C) (“When examining a claim to copyright, the U.S. Copyright Office generally does not compare deposit[s] to determine whether the work for which registration is sought is substantially similar to another work”); *see also Homer Laughlin China Co. v. Oman*, No.90 Civ. 3160, 1991 WL 154540, at *2 (D.D.C. July 30, 1991) (stating that the court was not aware of “any authority which provides that the Register must compare works when determining whether a submission is copyrightable”); *accord Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 499 (indicating the Office “does not compare works that have gone through the registration process”).

Even if the Office did do such a comparison, each of the works at issue in the cases cited by Bench Clearers are distinguishable, as those works involved creative elements not found in the Works here. For example, in *Silvertop Assocs*, the Court relied upon the combination of colors, lines, shape, and length to find that the depiction of a natural object had a minimal level of creativity. *Id.* Similarly, the copyrightable fabric design in *Soptra Fabrics Corp.* consisted of “a strip of crescents scalloping or ribbons between strip and rows of semicircles.” *Soptra Fabrics Corp.*, 490 F.2d at 1094. The cited works consist of sufficiently creative combinations of elements to warrant copyright protection, whereas the Works here consist of a combination of geometric shapes and standard coloring. *See e.g., In Design*, 689 F. Supp. at 177; *Tennessee Fabricating Co.*, 421 F.2d at 281–82; *Concord Fabrics, Inc.*, 409 F.2d at 1316.³

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 Works. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.



U.S. Copyright Office Review Board

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

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

Kimberley Isbell, Deputy Director of Policy and
International Affairs

³ Applicant also cited a Review Board letter that reversed a refusal to register a two-dimensional and sculptural claim in the works titled “Yeezy Boost 350” (version 1 and 2). Second Requests at 4. Again, the Office does not compare works that have been previously registered or refused registration. See COMPENDIUM (THIRD) § 309.3. Nevertheless, the Yeezy Boost 350 works are distinguishable from the Works here, as they are comprised of more numerous artistic features that collectively create a design creative enough to warrant copyright protection.