



United States Copyright Office

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April 25, 2016

Reitler Kailas & Rosenblatt LLC
Attn: Robert W. Clarida
885 Third Avenue, 20th Floor
New York, NY 10022-4834

Re: Second Request for Reconsideration for Refusal to Register Incipio name, Incipio logo, Incipio name and logo, Incipio name under logo; Correspondence ID: 1-ILT01J

Dear Mr. Clarida:

The Review Board of the United States Copyright Office ("Board") has examined Incipio Technologies, Inc.'s ("Incipio's") second request for reconsideration of the Registration Program's refusals to register the works titled "Incipio name", "Incipio logo", "Incipio name and logo", and "Incipio name under logo" ("Works"). After reviewing the applications, deposit copies, and relevant correspondence in the case, along with the arguments in the second request for reconsideration, the Board affirms the denial of registration.

I. DESCRIPTION OF THE WORKS

Each of the four Works is a two dimensional, graphic logo design. The "Incipio name" design consists of the word Incipio in black lettering. The "Incipio logo" design consists of one rounded-edged square centered within a larger rounded-edged square. The larger rounded-edged square is divided by gaps or spaces into four equal-sized corner pieces. The "Incipio name and logo" design consists of the word Incipio in black lettering followed by the "Incipio logo" design. The "Incipio name under logo" design consists of the "Incipio logo" design with the word Incipio appearing directly beneath it.

Photographic reproductions of the Works are set forth in Appendix A.

II. ADMINISTRATIVE RECORD

On December 19, 2013, Incipio filed four copyright registration applications asserting copyright claims in 2-D artwork for the Works. On January 6, 2014, a Copyright Office registration specialist refused to register the Works, finding they lacked sufficient creative authorship to support a claim to copyright. Letter from Larisa Pastuchiv, Copyright Office, to Stephen Soffen, Dickstein Shapiro LLP (Jan. 6, 2014).

In a letter dated May 5, 2014, Incipio requested that the Office reconsider its initial refusal to register the Works. Letter from Robert W. Clarida, Reitler Kailas & Rosenblatt LLC, to U.S. Copyright Office (May 5, 2014) ("First Request"). After reviewing the Works in light of the points raised in the First Request, the Office re-evaluated the claims and again concluded that the Works do not contain a sufficient amount of original and creative artistic or graphic authorship to support

copyright registration. Letter from Stephanie Mason, Copyright Office, to Robert W. Clarida, Reitler Kailas & Rosenblatt LLC (Sept. 17, 2014). In a letter dated January 20, 2015, Incipio 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 Robert W. Clarida, Reitler Kailas & Rosenblatt LLC, to U.S. Copyright Office (Jan. 20, 2015) (“Second Request”). In that letter, Incipio disagreed with the Office’s conclusion that none of the Works, as individual wholes, include the minimum amount of creativity required to support registration under the Copyright Act. Specifically, Incipio claimed that, in each of the Works, the “unique” selection and arrangement of the Work’s constituent elements is “distinguishable from any known exemplar,” and that “the ornamental design and manner of presentation” of a unique “seven [f]orm composition” demonstrated sufficient creativity for copyright protection. Second Request at 5-6. Incipio conceded it was not seeking protection of the word “Incipio” or the typeface used to portray the word “Incipio.” *Id.* Additionally, Incipio argued that registration of the Works is warranted because the Office has previously registered similar works. Second Request at 4-5.

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 long-standing requirements of originality and creativity in the law, as affirmed by 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”); *id.* at 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”).

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 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 Ninth Circuit rejected a claim of copyright in a piece of jewelry where the manner in which the parties selected and arranged the work's component parts was more inevitable than creative and original. See *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971). Likewise, the Ninth Circuit has held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, 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) (emphasis in original).

Finally, Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. See COMPENDIUM (THIRD) § 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 17 U.S.C. § 102(b); *Bleistein v. Donaldson Lithographing Co.*, 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 Works

After carefully examining the Works and applying the legal standards discussed above, the Board finds that the Works fail to satisfy the requirement of creative authorship and thus are not copyrightable.

Here, it is undisputed that the Works' constituent elements—a square with rounded edges, a segmented square with rounded edges, and the typeface used to portray the word "Incipio"—are not individually subject to copyright protection. See 37 C.F.R. § 202.1(a) (listing "examples of work not subject to copyright" including "familiar symbols or designs" and "mere variations of typographic ornamentation, lettering or coloring"). Further, the Board finds that the selection, combination, and arrangement of the Works' constituent elements do not possess a sufficient amount of creative authorship to warrant copyright protection. In this respect, the Copyright Office follows the principle that works should be judged in their entirety and not based solely on the protectability of individual elements within the work. See *Atari Games Corp. v. Oman*, 979 F.2d 242, 244-45 (D.C. Cir. 1992). Works comprised of public domain elements may be copyrightable but only if the selection, arrangement, or modification of the elements reflects choice and authorial discretion that is not so obvious or minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Feist* 499 U.S. at 359.

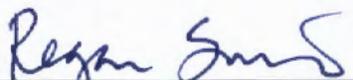
Viewed as individual wholes, none of the Works possesses sufficient creativity in the selection, combination, and arrangement of their constituent elements sufficient to render them original. Two of the Works ("Incipio name and logo" and "Incipio name under logo") consist of little more than combinations of the word Incipio with variations of familiar rounded square shape. The remaining Works consist of either the lone word Incipio ("Incipio name") or a depiction of obvious variations of familiar rounded square shape ("Incipio logo"). These basic combinations of a single word portrayed in simple typographic expression and/or two rounded-edged square shapes lack the requisite amount of creativity to warrant copyright protection. The creative authorship in each of the four configurations of unprotectable elements is, at best, *de minimis*, and too trivial to qualify for copyright protection.

Incipio contends that the selection and arrangement of the Works' elements is unique and "distinguishable from any known exemplar." Second Request. But the supposed uniqueness of a design does not mean that the design contains the requisite amount of original authorship necessary for registration. The Board also finds Incipio's argument that the Office has allegedly registered works similar to ones in contention unpersuasive, as the Office in its examination process compare works that have been previously registered or refused registration. See COMPENDIUM (THIRD) § 602.4(C). Each claim of copyright is reviewed on its own merits. Thus, a prior registration does not require the Board to reverse the denial of a work that it finds lacks sufficient creative authorship. See *Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q.2d (BNA) 1074, 1076 (D.D.C. 1991) (where the court stated 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. v. Peters*, 386 F. Supp. 2d 495, 499 (S.D.N.Y. 2005) (Office "does not compare works that have gone through the registration process").

IV. CONCLUSION

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

BY:



Regan Smith
Copyright Office Review Board

APPENDIX A

Incipio name:

INCIPIO

Incipio logo:



Incipio name and logo:

INCIPIO® 

Incipio name under logo:

