



United States Copyright Office

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July 31, 2017

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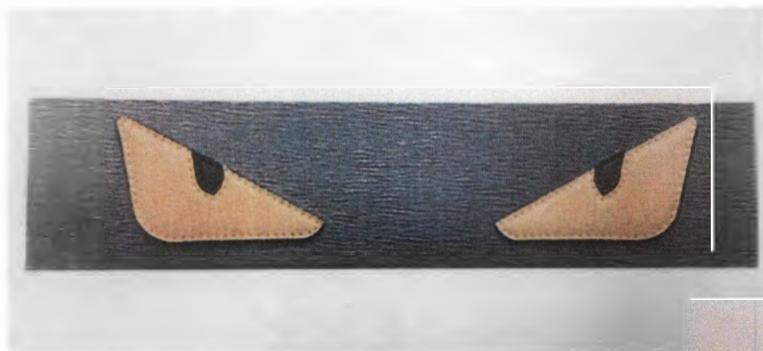
Re: Second Request for Reconsideration of Refusal to Register “Monster Eyes”; Service Request #: 1-3367885347; Correspondence ID: 1-1YBD5VT

Dear Mr. Cathcart:

The Review Board of the United States Copyright Office (“Board”) has considered Fendi Adele S.H.’s (“Fendi”) second request for reconsideration of the Registration Program’s refusal to register a three-dimensional sculpture and two-dimensional artwork claim in the work titled “MONSTER EYES” (“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 Work is a two-dimensional image of a three-dimensional design that consists of common geometric shapes—one blue rectangle; two identical, rounded, obtuse, tan triangles; and two identical, black half-ovals. The shapes are positioned symmetrically so that the left half mirrors the right half of the design, with the half-ovals stitched on top of the triangles which are stitched to the underlying rectangle. The Work is depicted below.



II. ADMINISTRATIVE RECORD

On April 18, 2016, Fendi filed an application to register a copyright claim in the Work. In a May 6, 2016 letter, a Copyright Office registration specialist refused to register the claim, finding that it “lack[ed] the authorship necessary to support a copyright claim.” Letter from Shawn Thompson, Registration Specialist, to Ralph H. Cathcart (May 6, 2016) (citing Copyright Office regulation 37 C.F.R. § 202.1 prohibiting registration of familiar symbols, designs, and coloring, among other things).

In a letter dated June 15, 2016, Fendi requested that the Office reconsider its initial refusal to register the Work. Letter from Ralph H. Cathcart to U.S. Copyright Office (June 15, 2016) (“First Request”). Fendi argued that the Work “possesses more than a sufficient degree of creativity to justify copyright registration.” First Request at 3. In support of this claim, Fendi stated that “the constituent elements of the Work are not ‘familiar symbols and designs’, but original expression of the fictional idea of intense, menacing eyes of a fictional monster.” First Request at 4. Fendi also stated that “the selection and arrangement of the various constituent elements plainly satisfies the ‘minimal creativity’ requirement [in] *Feist*” and the “resultant ‘expression’ is an original, high fashion, internationally acclaimed design, regardless of the ‘originality’ of the individual elements comprising the design.” First Request at 5. As additional support, Fendi noted that “the originality of the Work has not gone unnoticed by the public, as demonstrated by its popularity and sales.” First Request at 3.

After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and concluded that “the work as a whole consists of two symmetrically positioned obtuse triangles arranged on an elongated rectangle, each triangle accented with a half-oval on the hypotenuse. This very simple arrangement of three common shapes into a basic configuration demonstrates insufficient creativity to support a claim of copyright.” Letter from Stephanie Mason, Attorney-Advisor, to Ralph H. Cathcart (Dec. 13, 2016) (“Second Refusal”).

In a letter dated March 10, 2017, Fendi 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 Ralph H. Cathcart to U.S. Copyright Office (March 10, 2017) (“Second Request”). In that letter, Fendi reasserted that “the [W]ork does not consist merely of common shapes . . . , but rather involve[s] creative elements, exaggerated lines, shapes and fictional, non-factual graphical representations that when taken together, are plainly original.” Second Request at 5. Additionally, Fendi stated that “[e]ven if, *arguendo*, the Copyright Office considers the constituent elements of [the Work] to be common shapes . . . , which Fendi vigorously denies, . . . the selection and arrangement of such elements are protectable.” Second Request at 4. In this second request, Fendi clarified that it did “not argue that the aesthetic appeal of [the Work] to consumers ma[de] the work original or sufficiently creative.” Second Request at 4. Moreover, Fendi explained that it did “not seek the exclusive right to the idea of fictional MONSTER EYES, but rather, only the protectable expression . . . or at a minimum, the ‘thin’ protection that a compilation obtains when the author infuses sufficient originality in the selection, arrangement, spatial differentiation, etc. of various elements that comprise the Work.” Second Request at 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 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. 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.

In addition, Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. *See* COMPENDIUM (THIRD) § 310.2. The attractiveness of a design, the espoused intentions of the author, the design’s visual effect or its symbolism, the time and effort it took to create, or the design’s commercial success in the marketplace are not factors in determining whether a design is copyrightable. *See, e.g., Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

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 sufficient original authorship necessary to sustain a claim to copyright.

The Work is comprised of a few solid-colored geometric shapes. As explained above, colors and common geometric shapes are not eligible for copyright protection as such. *See* 37 C.F.R. § 202.1(a); COMPENDIUM (THIRD) § 906.1. Rather, shapes and colors are the building blocks of creative authorship that are in the public domain. *See Hayuk v. Starbucks Corp.*, 157 F.Supp.3d 285, 290 (S.D.N.Y. 2016) (“Raw materials” such as colors, letters, descriptive facts and “the catalogue of geometric forms” are a part of the public domain and are not protectable.). Accordingly, the Board affirms that each of the constituent solid-colored geometric shapes used to create the Work as a whole—the rectangle, obtuse triangles, and half-ovals—cannot be protected by copyright.

The Board also concludes that, viewed as a whole, the combination of these standard elements is insufficient to render the Work original. *See* Second Request at 4 (“[e]ven if, *arguendo*, the Copyright Office considers the constituent elements of [the Work] to be common shapes, . . . the selection and arrangement of such elements are protectable.”). As explained above, works that combine geometric shapes and/or other non-protectable elements into a larger

design may be registered if the overall design is sufficiently creative. Here, however, the overall Work consists solely of one rectangle, two identical, rounded, obtuse triangles, and two identical half-ovals; each shape is a different color (blue for the rectangle, tan for the triangles, and black for the half-ovals). These five components are combined in a symmetrical, mirror-image arrangement. As noted above, mere simplistic arrangement of non-protectable elements, such as “C” shapes “in a mirrored relationship,” *Coach*, 386 F. Supp. 2d at 496–99, or evenly spaced white circles on a purple rectangle, does not demonstrate the level of creativity necessary to warrant copyright protection. COMPENDIUM (THIRD) § 906.1; *see id.* § 905 (“Merely bringing together only a few standard forms or shapes with minor linear or spatial variations does not satisfy [the minimum creativity] requirement.”); *see also Satava*, 323 F.3d at 811–12 (explaining that the combination of unprotectable elements must still be “numerous enough and their selection and arrangements original enough that their combination constitutes an original work of authorship”).

This mirror-image arrangement of a few shapes in the Work stands in contrast to the more original works in the cases cited by Fendi. Unlike the “irregularly shaped . . . [and] shaded” polka dot pattern placed in “conflicting diagonal lines at varying distances from each other” deemed copyrightable in *The Prime Group v. MTS Products*, 967 F. Supp. 121 (S.D.N.Y. 1997), the Work positions identical-colored shapes in a common, mirror-image arrangement on top of a standard rectangle. The other cases cited by Fendi are similarly unpersuasive. *See* First Request at 2-3; Second Request at 3-4. For instance, Fendi cites *Delta Galil USA* to assert the copyrightability of a “design consisting of simple smiley face with the word ‘Hi,’” Second Request at 4 (citing *I.C. ex rel. Solovsky v. Delta Galil USA*, 135 F.Supp.3d 196 (S.D.N.Y. 2015)). But the Copyright Office refused to register the work and has intervened to contest the sufficiency of its creativity. *See* Statement of Interest on Behalf of the U.S. Copyright Office at 11–16, *I.C. ex rel. Solovsky v. Delta Galil USA*, No. 14-cv-07289, ECF No. 101. Moreover, the work in that case consists of a hand-drawn “positive smiley face and the word ‘hi’ on the front of the shirt . . . [and a hand-drawn] frowning face and the word ‘bye’ on the back of the shirt”—meager as it is, seemingly involves more components than the Work’s symmetrical arrangement of three geometric shapes. *Delta Galil USA*, 135 F.Supp.3d at 214–15 (S.D.N.Y. 2015).

Fendi also understates the creativity of the works at issue in the two other cases on which it relies. In *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 764 (2d Cir. 1991), the court did not conclude that a mere arrangement of roses in a “straight row” is sufficiently creative. *See* First Request at 2. Rather, the court first determined that the design of the rose depicted in the work was itself sufficiently creative to warrant copyright protection, and found *additional* creativity in the overall arrangement of the roses “placed in straight lines and turned so that the roses faced in various directions.” *Folio Impressions*, 937 F.2d at 754. Similarly, the fabric pattern at issue in *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1316 (2d Cir. 1969), was not simply a “circle within a square within a circle.” *See* Second Request at 3. Rather, the design also consisted of different colors as well as “designs within the circles, between the squares, and around the outer square” and “figures around the outer part of the circle.” *Concord Fabrics*, 409 F.2d at 1316.

This Work here is more akin to those that courts have regularly held to be uncopyrightable. *See, e.g., Satava*, 323 F.3d at 811-12; *OddzOn Products, Inc. v. Oman*, 924 F.2d 346, 349 (D.C. Cir. 1991) (upholding Register’s decision to refuse copyright for KOOSH ball—“formed of hundreds of floppy, wiggly, elastomeric filaments radiating from a core”—because it did not contain “enough additional creative [expression] beyond the object’s basic shape to warrant a copyright”) (internal citations omitted); *John Muller & Co. Inc. v. N.Y. Arrows Soccer Team*, 802 F.2d 989, 990 (8th Cir. 1986) (upholding Register’s decision to refuse copyright for “logo consist[ing] of four angled lines which form an arrow and the word “Arrows” in cursive script below the arrow”); *Jon Woods Fashions, Inc. v. Curran*, 1988 WL 38585, at *2 (S.D.N.Y. 1988) (upholding Register’s decision to refuse registration of fabric pattern consisting of stripes overlaid with grid of 3/16” squares because works exhibiting a “simple combination of two or three standard symbols such as a circle, a star, and a triangle” lack the minimal amount of creative authorship necessary for copyright protection) (citing COMPENDIUM OF COPYRIGHT OFFICE PRACTICES §2.8.3.1.a (1st ed. 1973)). Like these cases, the creative authorship in Fendi’s symmetrical stacking of a few solid-colored geometric shapes is too trivial; the combination of elements in the Work as a whole do not go “beyond the mere display of a few geometric shapes in a preordained or obvious arrangement.” COMPENDIUM (THIRD) § 906.1.

Moreover, in evaluating the creativity of a work as a whole, the Office “will focus only on the actual appearance . . . of the work that has been submitted for registration, but will not consider any meaning or significance that the work may evoke.” COMPENDIUM (THIRD) § 310.3 (“symbolic meaning or impression of a work is irrelevant”); *see also id.* § 310.4 (general “look and feel” is also irrelevant). No creative authorship, therefore, is derived from the Work’s potential to evoke the impression of monster eyes. *See* First Request at 3 (The Work’s “eyes, which are . . . marked by dramatic sharp slanted lines, with pupils that “drip” from the top of the eye . . . when viewed as a whole, [create] an original rendition of a fictional monster’s eyes” with a ‘look and feel’ [that is] at once menacing, creative.”).¹ Furthermore, to the extent Fendi associates creativity with the Work’s deviation from the shape of a human eye, this analysis is also unpersuasive. Second Request at 2. The Office “will not consider possible design alternatives” as a basis for originality because “[i]t is not the variety of choices available to the author that must be evaluated, but the actual work that the author created.” COMPENDIUM (THIRD) § 310.8 (noting that “the creative process often requires many choices involving the size, coloring, orientation, proportion, configuration” etc. of constituent elements, but that these are present in every work).

Similarly, in determining whether a work contains sufficient original authorship, the Office does not consider the time and effort used in creating a design, its novelty, aesthetic appeal, popularity, or commercial value. *See* COMPENDIUM (THIRD) §§ 310.1, 310.2, 310.7, 310.10. To the extent Fendi asserts these arguments, First Request at 3; Second Request at 3-4, they are also irrelevant to assessing originality under settled case law and registration practices. *See generally Feist*, 499 U.S. at 359-60 (rejecting “sweat of the brow” doctrine); *Bleistein*, 188

¹ The Board also notes that this general depiction of monster eyes appears somewhat commonplace, based on a image search for “evil monster eyes.” *See* https://www.google.com/search?q=evil+monster+eyes&source=lnms&tbm=isch&sa=X&ved=0ahUKEwiU9YCu3KzVAhUq7IMKHReVDe0Q_AUIBigB&biw=.1536&bih=760.

U.S. at 251-52; *see also* COMPENDIUM (THIRD) § 310.10 (The Office will not consider commercial success because “[w]orks may experience commercial success even without originality and works with originality may enjoy none whatsoever.”) (*quoting Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp. 2d 482, 488 (E.D. Pa. 2002)).

Fendi’s request to protect the Work as a compilation is also irrelevant to the Board’s evaluation because the application only claimed the Work as a whole as two- and three-dimensional art, not a compilation. *Compare* First Request at 5, with Application (“Author Created” field); *see also* COMPENDIUM (THIRD) § 618.6 (describing proper steps for filing a claim in compilation authorship). For this reason, Fendi’s reliance (First Request at 5) on *Urantia Found. v. Maaherra*, 114 F.3d 955 (9th Cir. 1997), is misplaced as that case concerns only compilation authorship, *i.e.*, the selection and arrangement into a book of underlying textual material that was allegedly uncopyrightable because it was “authored by celestial beings.” *Id.* at 956.. Moreover, even if the compilation rubric applied,² the Board would not have been able to find sufficient creative compilation authorship to support registration. As detailed above, the Board has reviewed the overall combination of the Work’s constituent elements and has found that the Work as a whole lacks sufficient creative authorship.

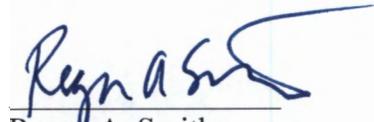
Lastly, Fendi asserts that “refusal . . . to register the Work is contrary to the intent of Article 1, Section 8, Clause 8” of the Constitution because the Work “has advanced the art of fashion design and made a significant impact on the fashion world generally.” First Request at 6. On the contrary, for the reasons stated above, registering the Work would run afoul of its longstanding regulation prohibiting registration of basic building blocks of creative expression, *see* 37 C.F.R. § 202.1(a), and would “cheat the public domain” of these essential elements, *Satava*, 323 F.3d at 813.

² The Board doubts that a “compilation” claim would ever be appropriate for this kind of visual art work. *See* Dennis S. Karjala, *Copyright and Creativity*, 15 UCLA ENT. L. REV. 169, 194-195 (2008) (noting that, if taken too far, “there is likely no work of authorship that is not a compilation under the statutory definition,” since “[a] novel, for example, is a selection and arrangement of words (or letters), a musical work is a selection and arrangement of notes, and a painting is a selection and arrangement of forms and colors.”). In any event, here the analysis of the claim in the “compilation” of visual elements is practically equivalent to the analysis of the claim in the visual artwork—both, in effect, require the Board to assess the combination of pictorial and graphic elements as a whole. *See* COMPENDIUM (THIRD) § 905 (explaining that, for visual art works, “original authorship may be present in the selection, coordination, and/or arrangement of images, words, or other elements, provided that there is a sufficient amount of creative expression in the work as a whole”).

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:



Regan A. Smith
Copyright Office Review Board