



United States Copyright Office

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

September 3, 2020

David E. Crawford, Esq.
CRAWFORD IP LAW
P.O. Box 31097
St. Louis, MO 63131

**Re: Second Request for Reconsideration for Refusal to Register The Sidestroke;
Correspondence ID: 1-3OJARHK; SR # 1-7589450101**

Dear Mr. Crawford:

The Review Board of the United States Copyright Office (“Board”) has considered Summersalt, Inc.’s (“Summersalt’s”) second request for reconsideration of the Registration Program’s refusal to register a two-dimensional artwork claim in the work titled “The Sidestroke” (“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 graphic design embodied in a swimsuit. The design consists of eight diagonal color fields—white at top, green in the middle, and teal at base—that correspond with the ruching of the swimsuit. The Work is reproduced below.



II. ADMINISTRATIVE RECORD

On April 10, 2019, Summersalt filed an application to register a copyright claim in the Work. In an April 11, 2019, letter, a Copyright Office registration specialist refused to register the claim, finding that it lacked “the minimum amount of creative pictorial, graphic, or sculptural authorship” to support a claim to copyright. Initial Letter Refusing Registration from U.S. Copyright Office to David Crawford, Crawford IP Law (Apr. 11, 2019).

In a letter dated May 7, 2019, Summersalt requested that the Office reconsider its initial refusal to register the Work. Letter from David Crawford to U.S. Copyright Office (May 7, 2019) (“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’s graphic elements “do not satisfy the originality requirement, regardless of whether they are considered individually or as part of the overall design.” Refusal of First Request for Reconsideration from U.S. Copyright Office to David Crawford, at 3 (Aug. 27, 2019) (“First Request Refusal”).

In response, Summersalt 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 David Crawford, to U.S. Copyright Office (Nov. 27, 2019) (“Second Request”). In that letter, Summersalt contends that “[t]he geometries of the elements [in the Work] are unique, the uneven arrangement of the elements is nonobvious, and the collection of elements are not commonplace. Traits such as uncommon, unique, unusual, and nonobvious are indicia of creativity in the copyright context.” *Id.* at 5. Examples of the “nonobvious” creativity cited by Summersalt include elements that are “evocative of a pectoral fin found in a fish” and “distributions of angles, tapers, lengths, and widths [that] are irregular.” *Id.* at 2, 4.

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”).

3) *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).

B. Analysis of the Work

After careful examination and analysis, the Board finds that the Work is a useful article that does not contain the requisite separable original authorship necessary to sustain a claim to copyright.

As an initial matter, both the Copyright Office and Summersalt agree that the Work is a useful article and that the configuration of the eight diagonal color fields is a separable design element applied to the surface of the Work, satisfying the separability portion of the *Star Athletica* test for copyrightability. First Request Refusal at 2; Second Request at 4. The elements consist of eight polygons, which, individually, are not in and of themselves copyrightable as they are common geometric shapes. See 37 C.F.R. § 202.1(a) (prohibiting registration of "familiar symbols or designs . . . or colors); COMPENDIUM (THIRD) § 906.1 ("the Copyright Act does not protect common geometric shapes, either in two dimensional or three-dimensional form . . . including . . . squares, cubes, rectangles . . . parallelograms"). The simple color combination of white, green, and teal is also excluded from copyright protection. See 37 C.F.R. § 202.1(a); COMPENDIUM (THIRD) § 906.3 ("Merely . . . combining expected or familiar pairs or sets of colors is not copyrightable . . .").

Additionally, viewed as a whole, the Board finds that the selection, coordination, and arrangement of these shapes are insufficient to render the Work eligible for copyright protection. Summersalt argues that the combination of color fields has a “nonobvious” quality that establishes the Work’s creativity. *See* Second Request at 5. But the fact “that a work is new, innovative, or even unique does not necessarily mean that it contains a sufficient amount of creative expression to satisfy the originality requirement.” COMPENDIUM (THIRD) § 310.1 (citing H.R. REP. NO., 94-1476, at 51 (1976)). The question is whether a work is sufficiently creative. *See Feist*, 499 U.S. at 346.

The Work is an arrangement of eight diagonal polygons in three color fields, oriented light to dark, top to bottom. The arrangement of colors vertically according to shade is a garden variety orientation. In addition, the direction of the polygons corresponds with the cross-body ruching of the swimsuit. Draping or ruching of fabric across the body from the shoulder to the opposite waist is long-standing in clothing construction and fashion design.¹ Draping and ruching are also often tied to the intrinsic utilitarian function of the article of clothing. *See Jovani Fashion Ltd. v. Fiesta Fashions*, 500 F. App’x 42, 44 (2d Cir. 2012) (unreported) (noting that removing the “horizontal satin ruching at the dress waist” would “adversely affect the garment’s ability to function as a prom dress”). The Office finds that the Work does not deviate from this well-established functional clothing construction. Further, orienting a few color blocks to follow this standard design does not demonstrate sufficient creativity for copyright protection.

Similarly unavailing is Summersalt’s assertion that the combination of elements in the Work resembles a dorsal fin. Second Request at 2. In its review, the Board focuses on the actual appearance of the fixed Work and does not consider any meaning or significance that the Work may evoke. The fact that an allusion to nature may take place in the mind of the person who encounters the work has no bearing on originality. *See* COMPENDIUM (THIRD) § 310.3.

¹ *See, e.g.*, “Augustus (Emperor from 27 BC to AD 14),” c. 20 BC (head), first third of 2nd century BC (body), Louvre Museum, Paris, France (<https://www.louvre.fr/en/oeuvre-notices/augustus-emperor-27-bc-ad-14>); “Evening Dress,” Madeleine Vionnet, ca. 1936, The Metropolitan Museum of Art, New York, New York (<https://www.metmuseum.org/art/collection/search/84819?searchField=All&sortBy=Relevance&deptids=8&ft=one+shoulder+dress&offset=160&rpp=80&pos=204>); “United States, March 1 – Geena Davis,” Time and Life Pictures (1991) (<https://www.gettyimages.com/detail/news-photo/geena-davis-news-photo/110537939?adppopup=true>).

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.



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