



Copyright Review Board
United States Copyright Office · 101 Independence Avenue SE · Washington, DC 20559-6000

June 16, 2021

Bret J. Danow, Esq.
Katten
575 Madison Avenue
New York, NY 10022-2585

Re: Second Request for Reconsideration for Refusal to Register StaceFace Full Glasses Design (Correspondence ID 1-47IYMNX; SR # 1-8605057371)

Dear Mr. Danow:

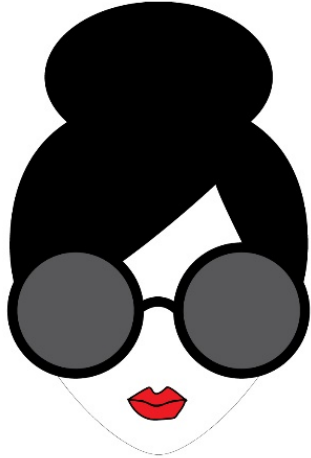
The Review Board of the United States Copyright Office (“Board”) has considered Staceypants, Inc.’s (“Staceypants’s”) second request for reconsideration of the Registration Program’s refusal to register a two-dimensional art claim in the work titled “StaceFace Full Glasses Design (“Work”). After reviewing 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 consisting of a pair of oversized round sunglasses above a set of red lips. The Work is reproduced below.



In addition to the Work at issue here, Staceypants previously registered the two-dimensional artworks “StaceFace Hairbun Design” (“Hairbun”) and “StaceFace,” depicted below, which the Board will discuss in connection with the creativity requirement for this Work.



StaceFace Hairbun Design
U.S. Reg. No. VA 1-999-385



StaceFace
U.S. Reg. No. VA 2-023-251

II. ADMINISTRATIVE RECORD

On March 3, 2020, Staceypants filed an application to register a copyright claim in the Work. In a March 4, 2020, letter, a Copyright Office registration specialist refused to register the claim, finding that it did not contain “sufficient creative authorship.” Initial Letter Refusing Registration from U.S. Copyright Office to Bret J. Danow (Mar. 4, 2020).

In response, Staceypants requested that the Office reconsider its initial refusal to register the Work. Letter from Bret J. Danow to U.S. Copyright Office (Mar. 12, 2020) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and concluded that “the creative authorship contained in [the Work] already has been registered,” pointing to the StaceFace and Hairbun registrations. Refusal of First Request for Reconsideration from U.S. Copyright Office to Bret J. Danow, at 1 (Aug. 25, 2020).

Staceypants subsequently 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 Bret J. Danow to U.S. Copyright Office (Oct. 16, 2020) (“Second Request”). In that letter, Staceypants asserts that the Work “contains a sufficient amount of appreciable differences representing separately registerable creative authorship.” *Id.* at 2. Specifically, the sufficient authorship consists of “a

chic face, complete with an eye-catching closed-lip smile, fashionable oversized sunglasses, and a meticulously crafted straight-edged nose.”¹ *Id.* at 3.

III. DISCUSSION

A. *The Legal Framework*

1) *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

¹ The Board notes that in no version of StaceFace is there a nose. Staceypants asserts that “the nose’s apex protrudes over the middle-upper lip and its narrow bridge is sculpted by a curved black line—a line perched atop the bridge of the nose, connecting two large black circles.” Second Request at 3. The black line between the sunglass lenses establishes only the bridge of the glasses and suggesting that the curve of the top lips establishes the tip of the nose ignores the existence of the philtrum. Even if these elements could be seen as a nose instead of the other parts of the face as described, it does not alter the Board’s determination because the Board is reviewing the Work as a whole, regardless of whether the portions Staceypants deems a “nose” are a nose or other part of the face.

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 stereotypical elements in a glass sculpture of a jellyfish including clear glass, an oblong shroud, bright colors, vertical orientation, and the 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.” U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 906.1 (3d ed. 2021) (“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* 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).

2) *Derivative Works*

The Copyright Office will register a claim in a derivative work where the deposit material contains new authorship with a sufficient amount of original expression. 17 U.S.C. § 103(a) (“The subject matter of copyright . . . includes . . . derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.”); *see also* COMPENDIUM (THIRD) § 311.1 (citing H.R. REP. NO. 94-1476, at 57 (1976)). The registration for a derivative work, however, “does not cover any previously published material, previously registered material, or public domain material that appears in the derivative work. Nor does it cover any material that is not owned by the copyright claimant.” *Id.*; *see also* 17 U.S.C. § 103(b) (copyright in a derivative

work is “independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.”).

In the case of derivative works, the “new authorship that the author contributed to the derivative work may be registered, provided that it contains a sufficient amount of original expression, meaning that the derivative work must be independently created and it must possess more than a modicum of creativity.” COMPENDIUM (THIRD) § 311.2 (citing *Waldman Publ’g Corp. v. Landoll, Inc.*, 43 F.3d 775, 782 (2d Cir. 1994)). The amount of creativity required for a derivative work is the same as that required for a copyright in any other work: “[a]ll that is needed to satisfy both the Constitution and the statute is that the ‘author’ contributed something more than a ‘merely trivial’ variation, something recognizably ‘his own.’” *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102–03 (2d Cir. 1951) (citing *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir. 1945)). Thus, “the key inquiry is whether there is sufficient nontrivial expressive variation in the derivative work to make it distinguishable from the [preexisting] work in some meaningful way.” *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 521 (7th Cir. 2009).

Although the amount of originality required is low, courts have recognized that derivative works “[l]acking even a modest degree of originality. . . are not copyrightable.” *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 911 (2d Cir. 1980); *see also L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976). Indeed, “[s]pecial caution is appropriate when analyzing originality in derivative works, ‘since too low a threshold will give the first derivative work creator a considerable power to interfere with the creation of subsequent derivative works from the same underlying work.’” *We Shall Overcome Found. v. The Richmond Org., Inc.*, No. 16-cv-2725, 2017 WL 3981311, at *13 (S.D.N.Y. Sept. 8, 2017). Very minor variations do not satisfy this requirement, such as merely changing the size of the preexisting work or recasting a work from one medium to another. *See L. Batlin & Son*, 536 F.2d at 491. Further, a claim to register a derivative work that adds only non-copyrightable elements to a prior product is not entitled to copyright registration. *Boyds Collection, Ltd. v. Bearington Collection, Inc.*, 360 F. Supp. 2d 655, 661 (M.D. Pa. 2005). Ultimately, whatever the addition is, it must be independently protectable for the derivative work to be registered.

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 the requisite authorship necessary to sustain a claim to copyright.

Initially, the Board notes that the Work is very similar to the works in StaceyPants’ Hairbun and StaceFace registrations and finds that it is, in fact, derivative of these earlier works. *See* Second Request at 2 (conceding that the Work is similar to the registered works, but arguing that it contains a sufficient amount of appreciable differences and comparing it to a different edition of a book). As noted above, when analyzing a derivative work like this, the Board must determine whether “[t]he new authorship . . . contains a sufficient amount of original expression, meaning that the derivative work must be independently created and it must possess more than a modicum of creativity.” COMPENDIUM (THIRD) § 311.2 (citing *Waldman Publ’g Corp.*, 43 F.3d at 782 and *Alfred Bell & Co.*, 191 F.2d at 102–03). The Board must therefore assess whether

there is enough nontrivial variation between the Work and Staceypants' earlier designs to make the Work distinguishable in a meaningful way.

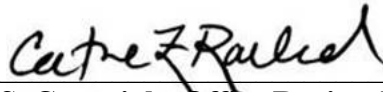
After careful review, it is clear that the variations between the Work and the Hairbun and StaceFace designs are insufficient to render the Work registrable. All of these designs include a white face with large, round sunglasses combined with the same mouth bearing the same expression. The only differences between the Work and Hairbun are that the latter has black hair set in a bun, an outline of a face, and the sunglasses have a thinner bridge and grey lenses instead of black. The Work differs from StaceFace only in that sunglasses in StaceFace are cropped on the sides, have a wider bridge, and grey lenses. The differences are only minor variations on each element, and the Work does not display even a modest degree of originality when the existing elements are discounted. *See Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d at 909 (“[T]o support a copyright the original aspects of a derivative work must be more than trivial.”) Thus, the Work is not independently copyrightable. *See, e.g., Gracen v. Bradford Exchange*, 698 F.2d 300, 304–305 (7th Cir. 1983) (finding that, although there were perceptible differences between a painting of Dorothy from *Wizard of Oz* and the publicity photo of Judy Garland as Dorothy on which it was based, those differences were too trivial for copyright protection); *Boyd's Collection*, 360 F. Supp. at 661; COMPENDIUM (THIRD) § 311.2;.

Staceypants's remaining argument is unavailing. It asserts that “marketplace realities” require it to make different designs to be used for different types of products, like clothing and accessories. Whether a work is shaped or altered due to the constraints of a useful article² or other medium in which it is rendered, however, is not a consideration for copyright protection. *C.f.* COMPENDIUM (THIRD) § 924.3(D) (noting that a two-dimensional pattern contained on a useful article is eligible for copyright protection regardless of whether it conforms to the article's overall shape). Further, the subjective intent of the creator is not a factor that the Board considers when evaluating a work for copyright protection. *Id.* § 310.5. Ultimately, the Board considers only the Work before it, and finds that it lacks “copyrightable material that does not appear in other versions of the same work.” *Id.* § 512.2(C).

² In its correspondence, Staceypants provides shirts, a pair of shoes, and a pocketbook as examples of applications of the various StaceFace works. Second Request at 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 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

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