



United States Copyright Office

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July 06, 2016

Susan Damron, Esq.
Brinks Gilson & Lione
1775 Pennsylvania Ave., NW
Suite 900
Washington, DC 20006

**RE: Second Request for Reconsideration for Refusal to Register Sysmex Logo;
Correspondence ID: 1-WIFQCK**

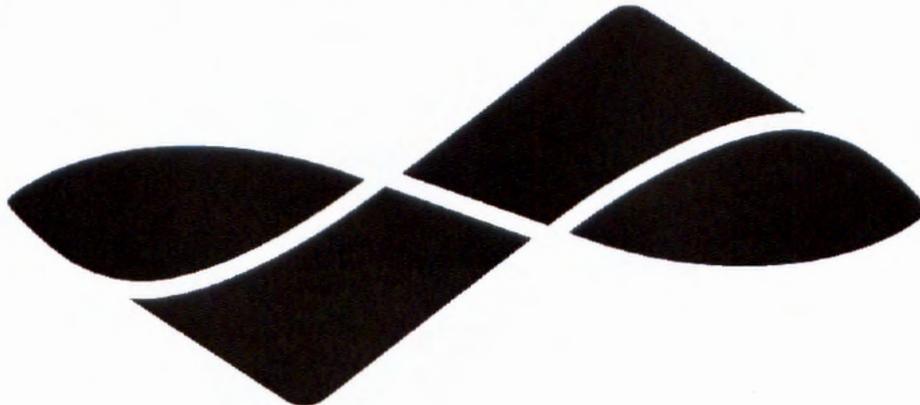
Dear Ms. Damron:

The Review Board of the United States Copyright Office (“Board”) has examined Sysmex Corporation’s (“Sysmex’s”) second request for reconsideration of the Registration Program’s refusal to register a two-dimensional artwork copyright claim in the work titled “Sysmex Logo” (“Work”). After reviewing the application, deposit copies, and relevant correspondence in the case, along with the arguments set forth 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, black and white graphic logo design. The design consists of two black elliptical shapes and two black rectangular shapes, separated by what appear as curved white lines. The shapes and linear elements mirror each other in the design.

A reproduction of the Work is set forth below:



II. ADMINISTRATIVE RECORD

On January 23, 2014, Sysmex filed an application to register a copyright claim in the Work. In an April 28, 2014 letter, a Copyright Office registration specialist refused to register the Work, finding that it “lacks the authorship necessary to support a copyright claim.” Letter from Kathryn Sukites, Registration Specialist, to Tiffany Shimada, Brinks Gilson & Lione (Apr. 28, 2014).

In a July 24, 2014 letter, Sysmex requested that the Office reconsider its initial refusal to register the Work. Letter from Philip A. Jones, Brinks Gilson & Lione, to U.S. Copyright Office (July 31, 2014) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office reevaluated the claims and again concluded that the Work lacked a sufficient amount of original and creative artistic authorship to support copyright registration. Letter from Stephanie Mason, Attorney-Advisor, to Philip A. Jones, Brinks Gilson & Lione (Dec. 9, 2014).

In a March 9, 2015 letter, Sysmex 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 Susan Damron, Brinks Gilson & Lione, to U.S. Copyright Office (Mar. 9, 2014) (“Second Request”). In that letter, Sysmex disagreed with the Office’s conclusion that the Work, as a whole, did not include the minimum amount of creativity required to support registration under the Copyright Act. Specifically, Sysmex claimed that the Work “is an original work of visual art that creatively combines several artistic elements, and thus is entitled to copyright protection.” *Id.* at 2. In support of its claim, Sysmex claimed the Work is the result of the following creative choices:

the inclusion of two misshaped ellipses and two misshaped rectangles; the misshaping of the ellipses and rectangles to form an overall butterfly design; the separation of the images with a white line that acts to link the shapes; the width of the design; the length of the design; the depiction of the two shapes on the right to form a reverse mirror image of the shapes on the left; the slanting of the design up and to the right; and the rounded corners on the bottom left and top right of the design.

Id. at 3. Sysmex further argued that the Work is not a familiar symbol or design, because the results of a trademark search of a U.S. Patent and Trademark Office database using the same design codes as the Work did not result in similar logos. *Id.* at 3, ex. A. Finally, Sysmex suggested that the Work was improperly refused because it also functions as a trademark. *Id.* at 4-5.

III. DECISION

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).

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 appearance, 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 Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). Thus, the fact that a work required effort to create, or has commercial or aesthetic appeal, does not necessarily mean that the work constitutes a copyrightable work of art.

B. Analysis of the Work

After careful examination, the Board finds that the Work fails to satisfy the requirement of creative authorship and thus is not copyrightable.

Here, it is indisputable that the Works' constituent elements—two misshapen ovals and two misshapen rectangles—are not individually subject to copyright protection. As explained in the *Compendium of U.S. Copyright Office Practices*, “common geometric shapes, including . . . curved lines, . . . ovals, [and] rectangles” do not satisfy the requirements for registration. COMPENDIUM (THIRD) § 906.1.

The question then is whether the combination of those elements is protectable, based on the legal standards set forth above. The Board finds that, viewed as a whole, the selection, coordination, and arrangement of the two misshapen ovals and rectangles, separated by curved lines, that comprise the Work are not sufficient to render the Work original. The Office will not register a work consisting of “a simple combination of a few familiar symbols or designs with minor linear or spatial variations.” *Id.* § 313.4(J). Accordingly, the Work lacks the requisite amount of creativity in selection, coordination, and/or arrangement to warrant copyright protection. *See Feist*, 499 U.S. at 359.

Systemx argues that because the Work is not the same as any trademarks registered with the U.S. Patent and Trademark Office, the Work is unique and therefore registerable by the Copyright Office. *See* Second Request at 3, ex. A. But this argument is unavailing. The standard for trademark registration is whether a mark distinguishes goods or services, which is different from copyright's originality standard. *See* 15 U.S.C. § 1052; *see also* COMPENDIUM (THIRD) § 301.1 (the fact that a work is unique does not necessarily mean it is copyrightable).

Systemx's suggestion that the Office did not register the Work because it also functions as a trademark is erroneous. As identified by Systemx, the Office will register “a properly filed copyright claim in a print or label that contains the requisite qualifications for copyright even though there is a trademark on it.” 37 C.F.R. § 202.10(b); *cf.* COMPENDIUM (THIRD) § 913.1 (explaining the types of logo designs that the Office typically refuses to register). As noted, the Board finds that, viewed as a whole, the Work is not sufficiently

original to render the Work copyrightable. The Board is not refusing registration because the Work may also function as a trademark.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the U.S. Copyright Office affirms the refusal to register the copyright claims in the Work. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action on this matter.

BY:



Catherine Rowland

Copyright Office Review Board