



United States Copyright Office

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

March 15, 2019

Edward E. Vassallo, Esq.
Venable LLP
1290 Avenue of the Americas
New York, NY 10104
evassallo@Venable.com

Re: Second Request for Reconsideration for Refusal to Register “Tommy Hilfiger Flag”; Correspondence ID: 1-33DWZTC; SR 1-4413364221

Dear Mr. Vassallo:

The Review Board of the United States Copyright Office (“Board”) has considered Tommy Hilfiger Licensing LLC’s (“Tommy Hilfiger’s”) second request for reconsideration of the Registration Program’s refusal to register a two-dimensional artwork claim in the work titled “Tommy Hilfiger Flag” (“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 of a rectangle. Within the rectangle are four smaller rectangles; two identically sized navy rectangles and two identically sized red and white rectangles. The red and white rectangles are sandwiched between the navy rectangles. A reproduction of the Work is set forth below.



II. ADMINISTRATIVE RECORD

On February 14, 2017, Tommy Hilfiger filed an application to register a copyright claim in the Work.¹ In a November 30, 2017, letter, a Copyright Office registration specialist refused to register the claim, finding that it “lacks the requisite authorship necessary to support a copyright claim.” Letter from R. Baker, Copyright Examiner, U.S. Copyright Office, to Lisa Mottes (Nov. 30, 2017).

In a letter dated February 28, 2018, Tommy Hilfiger requested that the Office reconsider its initial refusal to register the Work. Letter from Edward E. Vassallo, Fitzpatrick, Cella, Harper & Scinto, to U.S. Copyright Office (Feb. 28, 2018) (“First Request”). Tommy Hilfiger argued that the work “is more than just geometric shapes, and a significant amount of creativity, thought, ingenuity, and authorship was involved in selecting, combining, and arranging the elements of the Flag Logo Design to form an original and unique design.” First Request at 2. Tommy Hilfiger contended that the work “consists of four different rectangles arranged in a unique

¹ In the application, Tommy Hilfiger asserted a claim to copyright in “photograph,” indicating that the work contains a photograph. However, the deposit copy submitted contains a two-dimensional image of a flag. In later correspondence, Tommy Hilfiger amended the application to assert a claim in “two-dimensional artwork.” Email from Edward E. Vassallo, Venable LLP, to Jalyce Mangum, Attorney-Advisor, U.S. Copyright Office (January 9, 2019).

manner so as to collectively comprise one larger rectangle and includes a combination of different colors, different shapes, and different size elements.” *Id.* Finally, Tommy Hilfiger explained that the “location and arrangement of the[] shapes is unique in that it is a creative combination of the letters ‘T,’ ‘J,’ and ‘H’ of the nautical flag alphabet [] to create a unique flag, which represents the initials of Thomas J. Hilfiger.” *Id.* After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claim and again concluded that the Work “does not contain a sufficient amount of original and creative graphic or artistic authorship to support a copyright registration.” Letter from Stephanie Mason, Attorney-Advisor, U.S. Copyright Office, to Edward E. Vassallo (July 3, 2018). The Office explained that there are no elements or features embodied in the Work, alone or combined, that are eligible for copyright protection. *Id.* at 4.

In a letter dated October 3, 2018, Tommy Hilfiger 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 Edward E. Vassallo, Fitzpatrick, Cella, Harper & Scinto, to U.S. Copyright Office (Oct. 3, 2018) (“Second Request”). In that letter, Tommy Hilfiger argued that the originality present in the work exceeds the standard set forth in *Feist Publications, Inc., v. Rural Telephone Service Co.* *Id.* at 2-5. Specifically, Tommy Hilfiger explained, “four rectangles of two different shapes are arranged in a unique way to form one larger rectangle, transforming four rectangles into five.” Second Request at 3. Tommy Hilfiger highlighted that the rectangles are sized so that the long and short rectangles form the top and bottom to the “nearly square” rectangles within, and to this “unique” arrangement of shapes are added three colors. *Id.* Tommy Hilfiger also contended that the arrangement has meaning—mimicking the letter “H” when turned 90 degrees and displaying the letters “T,” “J,” and “H” in the nautical flag alphabet for Thomas J. Hilfiger. Finally, Tommy Hilfiger noted that the flag means “going home” in the yachting world because the red on the right side of the Work denotes returning from one’s voyage. *Id.*

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. 2017) (“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.

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.

To begin, the Work is a combination of four rectangles and three colors: two equally sized blue rectangles and two equally sized red and white rectangles. The Office cannot register common geometric shapes or coloring. *See* 37 C.F.R. § 202.1(a) (“examples of works not subject to copyright and applications for registration [include] familiar symbols or designs [and] coloring”); COMPENDIUM (THIRD) § 906.1 (listing some of the geometric shapes not eligible for copyright protection, including rectangles); *id.* at § 313.4(J) (noting that familiar symbols and designs cannot be registered). Thus, the individual elements of the overall Work are not independently copyrightable. Indeed, Tommy Hilfiger acknowledges that “color alone and a standard shape alone are not registrable.” Second Request at 7.

Tommy Hilfiger correctly states that “the Office should consider . . . the work at issue in its entirety.” Second Request at 7. However, as the Ninth Circuit explained in *Satava*, “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.” 323 F.3d 805 at 811. Indeed, some combinations of common or standard design elements may contain sufficient creativity to support a copyright, but not every combination will meet this threshold. *See Feist*, 499 U.S. at 358. Based on this standard, examination of the Work as a whole still reveals a lack of copyrightable authorship. The Work falls squarely into the Copyright Office’s regulations barring registration of a simple combination of basic geometric shapes and mere variations of coloration. *See* 37 C.F.R. § 202.1(a); COMPENDIUM (THIRD) § 906.1 (“The Copyright Act does not protect common geometric shapes . . .”). Essentially, the Work is one large rectangle divided into two equally sized blue rectangles and two equally sized red and white rectangles. The arrangement of four rectangles to create a larger rectangle, even if one among many possibilities, is not sufficiently creative to warrant copyright protection. Additionally, the red, white, and blue colors added to the arrangement of shapes do not raise the Work into copyrightability; they are exceedingly common for flag designs. COMPENDIUM (THIRD) § 906.1 (“Merely . . . combining expected or familiar pairs or sets of colors is not copyrightable”).

Tommy Hilfiger argues that the “location and arrangement” of the rectangle shapes and colors “is a creative combination of the letters T, J, and H of the nautical flag alphabet [] representing the initials of Thomas J. Hilfiger (the founder of the Tommy Hilfiger brand).” *See* Second Request at 3. The Board does not find this explanation persuasive. First, to the extent that Tommy Hilfiger asks the Board to consider the symbolic meaning of the Work, *id.*, the symbolic meaning or impression that a work conveys is irrelevant to whether a Work contains a sufficient amount of creativity. COMPENDIUM (THIRD) § 310.3. Equally irrelevant is the intent

of the author. *Id.* § 310.5 (“The fact that a creative thought may take place in the mind of the person who created a work . . . has no bearing on the issue of originality unless the work objectively demonstrates original authorship.”).

Second, the combination of preexisting flags from the Nautical Flag Alphabet does not exhibit sufficient original authorship. Compiled by the British government in 1857, the Nautical Flag Alphabet, also known as the International Code of Signals, consists of internationally agreed upon flag signals that are used to prevent incidents at sea.² A reproduction of the International Code of Signals is set forth below:³

INTERNATIONAL FLAGS AND PENNANTS							
ALPHABET FLAGS			NUMERAL PENNANTS				
Alfa		Kilo		Uniform		1	
Bravo		Lima		Victor		2	
Charlie		Mike		Whiskey		3	
Delta		November		X-ray		4	
Echo		Oscar		Yankee		5	
Foxtrot		Papa		Zulu		6	
Golf		Quebec		SUBSTITUTES		7	
Hotel		Romeo		2nd Substitute		8	
India		Sierra		3rd Substitute		9	
Juliett		Tango		CODE (Answering Pennant or Decimal Point)		0	

² See generally Agreement between the Government of the United States of America and the Government of the Union of Soviet Socialist Republics on the Prevention of Incidents on and over the High Seas, U.S.-U.S.S.R., May 25, 1972, 23 U.S.T. 1168.

³ NATIONAL IMAGERY AND MAPPING AGENCY (NATIONAL GEOSPATIAL-INTELLIGENCE AGENCY), INTERNATIONAL CODE OF SIGNALS: FOR VISUAL, SOUND, AND RADIO COMMUNICATIONS, PUB. 102 (2003), https://msi.nga.mil/MSISiteContent/StaticFiles/NAV_PUBS/ICOS/Covers.pdf.

As discussed above, works composed of preexisting elements may be copyrightable, but only if the selection, coordination, and/or arrangement of those elements reflect authorial discretion that is not so obvious or minor that the “creative spark is utterly lacking or so trivial as to be virtually nonexistent.” *Feist*, 499 U.S. at 359. Here, it appears that the author principally employed the “J” and “H” flags to compose the Work, replacing the white rectangle in the “J” flag with the white and red rectangles from the “H” flag. The combination of the two preexisting flags is too trivial to support a claim to copyright. *See, e.g., Homer Laughlin China Co. v. Oman*, No. 90 Civ. 3160, 1991 WL 154540 (D.D.C. 1991) (upholding refusal to register chinaware design pattern composed of simple variations of geometric designs due to insufficient creative authorship to support copyright registration). The Work is simply too basic in form. *See COMPENDIUM (THIRD) § 905 (“Merely bringing together only a few standard forms or shapes with minor linear or spatial variations does not satisfy this requirement.”).*

In support of its argument that the Work’s arrangement of shapes and colors constitutes sufficient creativity, Tommy Hilfiger cites two district court decisions involving other works. The Office, however, considers each work submitted for copyright registration on its own merits in accordance with the statute and relevant legal principles as cited above. Differences between any two works thus can lead to different results. *See COMPENDIUM (THIRD) 602.4(C)* (“When examining a claim to copyright, the U.S. Copyright Office generally does not compare deposit[s] to determine whether the work for which registration is sought is substantially similar to another work.”); *see also Homer Laughlin China Co. v. Oman*, No. 90 Civ. 3160, 1991 WL 154540, at *2 (D.D.C. July 30, 1991) (stating that court 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 (indicating the Office “does not compare works that have gone through the registration process”).

In any event, each of the works at issue in the cases cited by Tommy Hilfiger is distinguishable from the Work here. *Runstadler Studios, Inc. v. MCM Ltd. P’ship*, 768 F. Supp. 1292 (N.D. Ill. 1991), concerned a three-dimensional sculpture composed of 39 clear glass rectangles, overlying each other to form a spiral with approximately 405 degrees of arc. The *Runstadler Studios* court applied a presumption of validity because the Office had registered a copyright registration for the work. *Id.* at 1295. The court held that the sculpture possessed sufficient creativity due to the “choice of location, orientation and dimensions of the glass panes, and the degree of arc of the spiral,” which were evidence of “more than a trivial amount of intellectual labor and artistic expression.” *Id.* at 1295–96. In other words, the arrangement of the geometric elements in *Runstadler Studios* was original and creative based on elements, such as three-dimensional arrangement and degree of arc, not present in the Work.

Similarly, in *Prince Group., Inc. v. MTS Products.*, 967 F. Supp. 121 (S.D.N.Y. 1997), the arrangement of unprotectable elements was far more original and creative than that of the arrangement in the Work. There, the work at issue was a polka dot design. But the dots in the design were (1) “irregularly shaped, and not the perfect circles of a standard polka dot,” (2) shaded, meaning there was “a crescent of white around half of the perimeter of each of the dots which is different from the standard uniformly colored polka dot, and they consist of several different colors,” and (3) arranged in “imperfect and conflicting diagonal lines at varying

distances from each other giving the appearance of randomness.” *Id.* at 125. The presence of the shading and colors, and irregular placement of the dots rendered the pattern sufficiently original, even though the individual elements were not copyrightable. The Office cannot reach the same conclusion here: the elements in the Work here are not arranged in an original way.

Overall, the Board finds that the Work is not copyrightable. The level of creative authorship involved in its configuration of elements is, at best, *de minimis*, and too trivial to support copyright registration. *See COMPENDIUM (THIRD) § 313.4(B).*

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
Karyn A. Temple, Acting Register of Copyrights
and Director, U.S. Copyright Office
Regan A. Smith, General Counsel and
Associate Register of Copyrights
Catherine Zaller Rowland, Associate Register of
Copyrights and Director, Public Information and
Education