



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

June 17, 2022

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Re: Second Request for Reconsideration for Refusal to Register Tomo the Tiger & Pimm the Puppy (SRs # 1-9239427049, 1-9239426851; Correspondence ID: 1-4PNQ7RZ)

Dear Mr. Matkov:

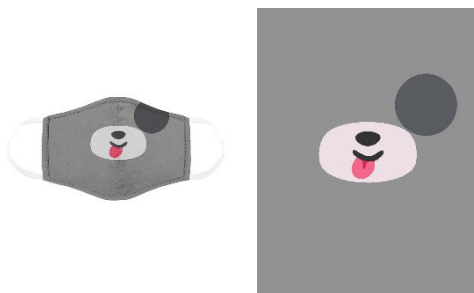
The Review Board of the United States Copyright Office (“Board”) has considered Peak Theory, Inc. d/b/a Cubcoats’ (“Cubcoats”) second request for reconsideration of the Registration Program’s refusal to register two-dimensional artwork claims in the works titled Tomo the Tiger and Pimm the Puppy (collectively, the “Works”). After reviewing the applications, deposit copies, 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 WORKS

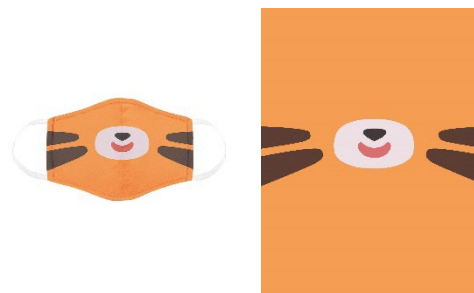
The Works consist of animal facial pictorials cropped from previously registered works. Pimm the Puppy has a gray background with a muzzle, nose, mouth, tongue, and dark gray circle above the muzzle. Tomo the Tiger has an orange background with a muzzle, nose, mouth, and set of stripes on each side of the muzzle. The registration applications included deposits showing the Works in rectangular designs, as well as samples depicting the Works applied to face masks. The Works and preexisting works are as follows:

The Works

Pimm the Puppy



Tomo the Tiger



Preexisting Works



II. ADMINISTRATIVE RECORD

On September 10, 2020, Cubcoats filed two applications to register copyright claims in the Works. On September 15, 2020, a Copyright Office registration specialist refused to register the claims, finding that the Works “are useful articles that do not contain any copyrightable authorship.” Initial Letter Refusing Registration from U.S. Copyright Office to Matthew Matkov at 1 (Sept. 15, 2020).

In a letter dated October 19, 2020, Cubcoats requested that the Office reconsider its initial refusal to register the Works. Letter from Matthew D. Matkov to U.S. Copyright Office (Oct. 19, 2020) (“First Request”). Cubcoats also requested that the Office review the Works based solely on the rectangular images because “the actual Deposit Copies of the artistic Works in question are contained within the [rectangular] images.” *Id.* at 4. After reviewing the Works in light of the points raised in the First Request, the Office re-evaluated the claims and again concluded that the Works cannot be registered because the “slight differences between the artwork of the previous registrations and the instant works . . . consist merely of non-copyrightable change of format.” Refusal of First Request for Reconsideration from U.S. Copyright Office to Matthew Matkov at 2 (Mar. 12, 2021).

In a letter dated June 10, 2021, Cubcoats requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Works. Letter from Matthew Matkov to U.S. Copyright Office (June 10, 2021) (“Second Request”). In that letter, Cubcoats argued that the Works “consist of deconstructed facial pictorials which were adapted, modified, and revised from the Original Registrations.” *Id.* at 3. Cubcoats further asserted “[t]he creativity in design, and therefore originality, stems from adapting the Prior Registrations to a child sized image to be applied to a mask so that the child has the face of the animal.” *Id.* at 8.

III. DISCUSSION

After carefully examining the Works and applying the legal standards discussed within, the Board finds that the Works do not contain the requisite authorship necessary to sustain a claim to copyright.

As an initial matter, regardless of whether the face masks are considered deposit copies, the analysis of the copyrightability of the Works is ultimately the same. Cubcoats requested that the Office reconsider the refusal based solely on an evaluation of the rectangular images and not based on the Works as applied to masks. First Request at 4. Cubcoats states that it included deposit copies of the Works as applied to face masks in its registration applications “to fully disclose [the] relevant underlying fact[],” First Request at 4, and that the Works are intended to be applied to child-sized face masks. Second Request at 8. If the Board considers the face masks to be deposit copies, the Board finds that the masks are useful articles. Cubcoats suggests that the masks are not useful articles because they are “character masks” that are generally registerable as part of costume designs. First Request at 4–5 (citing *Registrability of Costume Designs*, 56 Fed. Reg. 56,530 (1991)). The Board disagrees. The depicted masks are face coverings like those intended to cover the nose and mouth to slow the spread of airborne viruses.¹ Such masks are distinct from decorative masks that “generally portray their own appearance.” *Registrability of Costume Designs*, 56 Fed. Reg. at 56,531 (discussing masks “configured to resemble the nose of a pig, elephant, and parrot”); compare 17 U.S.C. 101 (a useful article “is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information”) with COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 925.1 (3d ed. 2021) (“COMPENDIUM (THIRD)”) (listing “decorative masks” as Works of Artistic Craftsmanship because they are “*intrinsically aesthetic* in nature”) (emphasis in original) and *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 666, 670–71 (3rd Cir. 1990) (holding animal masks configured to resemble the noses of a pig, elephant, and parrot, that only serve “*to simulate the nose of the respective animal [s]*” are not useful articles because such “nose masks have no utility that does not derive from their appearance”) (emphasis in original).

Artistic features applied on 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. 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.” *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017); see COMPENDIUM (THIRD) § 924.3. The Works, as affixed to the face masks, easily meet the first prong of the separability test. Not only can the two-dimensional artwork be perceived separately from the masks, Cubcoats actually submitted the two-dimensional artwork separately as deposit copies. See First Request at 4. Thus, even if the face masks are considered deposit copies, the

¹ See e.g., *Types of Masks and Respirators*, CENTERS FOR DISEASE CONTROL AND PREVENTION (Jan. 28, 2022), <https://www.cdc.gov/coronavirus/2019-ncov/prevent-getting-sick/types-of-masks.html>.

Board would focus on whether the separate two-dimensional artworks, which are the same works shown in the rectangular images, contain sufficient creativity for copyright protection.

The Board must consider the Works as derivative works when assessing their originality. There is no question that the Works are derivative versions of the preexisting works. *See* Second Request at 2 (stating that the Works “are derivative of the Prior Registrations”). The Board thus must focus solely on the new authorship added to the Works to determine whether it is sufficiently creative to warrant copyright protection. *See* 17 U.S.C. § 103(b) (“The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material”); *see also* COMPENDIUM (THIRD) § 311.1 (stating that “the author of the derivative work must recast, transform, or adapt some of the copyrightable portions of a preexisting work” for the derivative work to be protectable) (citing H.R. REP. NO. 94-1476, at 57 (1976)). 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 extending copyright protection to 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). A claim to register a derivative work that adds only non-copyrightable elements to a prior product is not entitled to copyright registration. COMPENDIUM (THIRD) § 311.1. Ultimately, whatever the addition is, it must be independently protectable for the derivative work to be registered.

Here, the new expression contained in the Works consists of “merely trivial” revisions to the preexisting works and therefore does not possess the “modicum of creativity” required to merit registration as a derivative work. *Alfred Bell & Co.*, 191 F.2d at 102–03. The new expression in Pimm the Puppy consists of a cropped and deconstructed facial pictorial with slight modifications to the color of the tongue and to the shapes of the muzzle, nose, and tongue. The new expression in Tomo the Tiger consists of a cropped and deconstructed facial pictorial with slight modifications to the color of the mouth and to the shape of the muzzle, nose, mouth, and

set of stripes on each side of the muzzle. The combination of trivial alterations to the preexisting shapes does not meaningfully distinguish the Works from the preexisting works. While the Office and an observer may be able to identify differences, these few differences are not sufficient to satisfy the creativity requirement for protection of the Works as derivative works. *See, e.g., Waldman Publ'g Corp.*, 43 F.3d at 782 (requiring sufficient creativity in the new authorship contained in a derivative work); *Schrock*, 586 F.3d at 521 (noting that “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”). Moreover, cropping the muzzle features of Pimm the Puppy and Tomo the Tiger from the preexisting works results in only minor, *de minimis* changes to the original designs and does not make the Works distinctive from the preexisting works in a meaningful way. *See, e.g., L. Batlin & Son, Inc.*, 536 F.2d at 491 (holding the differences between the plaintiff’s Uncle Sam toy savings bank and public domain Uncle Sam toy savings bank—shortening the figure, shortening and narrowing the base, changing the shape of the carpetbag, and adding an umbrella—were insufficient to constitute protectable originality); *Axxiom Mfg., Inc. v. McCoy Invs. Inc.*, 846 F. Supp. 2d 732, 752 (S.D. Tex. 2012) (holding minor differences in shapes, angles, and spacing were insufficient to constitute protectable originality).

Cubcoats invites the Board to compare the new authorship in the Works to changes made to the derivative work in *Eden Toys, Inc. v. Florelle Undergarment Co., Inc.*, 697 F. 2d 27 (2d Cir. 1982). In *Eden Toys*, the Second Circuit held that the “numerous changes” made to the Paddington drawing—changes to the proportions of the hat, elimination of fingers and toes, and overall smoother lines—created a sufficiently original derivative work from the original. *Id.* at 34–35. Here, the cropped facial features contain minimal variations in color and thickness from the preexisting works. Because the Paddington derivative work includes a greater number and variety of expressive alterations not present in the Works under review, the decision here is not inconsistent with the court’s analysis in *Eden Toys*.²

Cubcoats also suggests “the creativity in design, and therefore originality, stems from adapting the Prior Registrations to a child sized image to be applied to a mask so that the child has the face of the animal.” Second Request at 8. The Board, however, focuses on the actual appearance of the fixed Works and does not consider the author’s choices “involving the size . . . orientation, proportion, [or] configuration” when examining a work. COMPENDIUM (THIRD) § 310.8.

Lastly, the Board notes that while the Works cannot be registered as derivative works, because the Works depict only minor, uncopyrightable differences to the preexisting works, the copyrights in the preexisting works extend to the Works at issue here.

² The Board further notes that registration decisions are made “on a case-by-case basis.” COMPENDIUM (THIRD) § 309.3; *see also Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q. 2d 1074, 1076 (D.C. Cir. 1991) (stating that the court was not aware of “any authority which provides that the Register must compare works when determining whether a submission is copyrightable”).

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 Works. 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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