



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

June 23, 2023

Hillary Schroeder, Esq.
JUUL Labs, Inc.
560 20th Street
San Francisco, CA 94107

Re: Second Request for Reconsideration for Refusal to Register CA Refill Kit 1-5% Golden Tobacco 4 Pack and 8 Other Unpublished Works (SR # 1-8968744517; Correspondence ID: 1-4QM6XFO)

Dear Ms. Schroeder:

The Review Board of the United States Copyright Office (“Board”) has considered JUUL Labs, Inc.’s (“JUUL”) second request for reconsideration of the Registration Program’s refusal to register two-dimensional artwork claims in the works titled “CA Refill Kit 1-5% Golden Tobacco 4 Pack and 8 Other Unpublished Works” (“Works”). After reviewing the application, 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 are nine rectangular-shaped packaging designs. Each design is the same in all respects except for the specifics of the product itself. An example of one Work is below. Deposit images for the remaining Works are included in the Appendix.



The front of the design contains the company name, “JUUL,” a product flavor, drug content, a required warning box containing text in English and French, and a graphic accent. The graphic accent consists of four elongated centrally-positioned rectangles, each with a small hexagon in the center directly between two contrasting colors. One color matches the opaque color behind the text on the front of the package that provides the product’s drug strength. The back of the design features additional required information for the product, including a list of ingredients, a poison warning, and manufacturer contact information, all in English and French, along with an accompanying poison graphic, a universal product code (“UPC”), and a recycle graphic.

II. ADMINISTRATIVE RECORD

On June 26, 2020, JUUL filed an application to register copyright claims in the Works as a group of unpublished works. In an August 18, 2020 letter, a Copyright Office registration specialist refused to register the claim, determining that the Works lacked originality. Initial Letter Refusing Registration from U.S. Copyright Office to Linda Lim at 1 (Aug. 18, 2020).

On November 18, 2020, JUUL requested that the Office reconsider its initial refusal to register the Works, arguing that the individual design elements, including the “horizontal design comprising repeated design elements in uniform color” depicted in a photorealistic style and the JUUL name “created as a palindrome—deliberately rendering the L and J as mirror images of each other,” support the Works’ sufficient creativity. Letter from Hillary Schroeder to U.S. Copyright Office at 5–6 (Nov. 18, 2020) (“First Request”). Further, JUUL explains that “the order and arrangement of the images and text are sufficiently creative, as it is not necessitated by a particular sequence.” *Id.* at 7. After reviewing the Works in light of the points raised in the First Request, the Office reevaluated the claims and again concluded that the Works could not be registered. Refusal of First Request for Reconsideration from U.S. Copyright Office to Hillary Schroeder (Mar. 30, 2021) (“Refusal of First Request for Reconsideration”). The Office explained that the Works did not demonstrate sufficient creativity in their individual elements or in the combination and arrangement of their component elements. *Id.* at 3–4.

In a letter received on June 30, 2021, JUUL 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 Hillary Schroeder to U.S. Copyright Office (June 30, 2021) (“Second Request”). JUUL disagreed with the Office’s characterization of the individual design elements as mere common shapes. *Id.* at 2. Although JUUL admitted that it “presents its product with a flattened 2D appearance using simple shapes and colors[,]” it argued that the “resulting illustration of its pods create a ‘pop-art’ sensibility for the viewer.” *Id.* JUUL elaborated that “[t]he overall look-and-feel of the pod illustration” and “[t]he arrangement and placement of these illustrations within the larger work” are sufficiently creative to warrant copyright protection. *Id.* In the Second Request, JUUL also noted that the Office has registered similar works submitted by JUUL and that the United States Patent and Trademark Office had withdrawn its initial trademark refusal for the “JUULpods icon” after receiving clarification that the “2D illustration of the product” was “a purposefully simplified design of the product to create a distinctive image.” *Id.* at 2–3.

III. DISCUSSION

After carefully examining the Works and considering the arguments made in the First and Second Requests, the Board finds that the Works do not contain the requisite creativity necessary to sustain a claim to copyright.

A work may be registered for copyright if it is an “original work[] of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102(a). In the copyright context, the term “original” consists of two components: independent creation and sufficient creativity. *See Feist Publ’ns 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.* at 358–9. 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, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; [and] mere listing of ingredients or contents”); *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 claim. 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, 883 (D.C. Cir. 1989); *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 498–99 (S.D.N.Y. 2005).

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*, 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; *see Coach*, 386 F. Supp. 2d at 496 (refusing 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”).

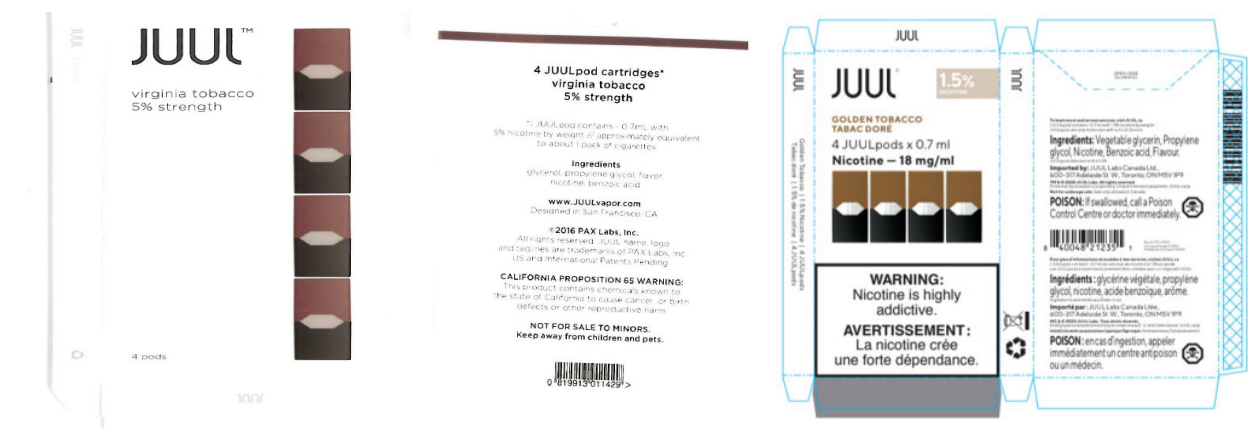
Applying these legal standards, the Board finds that the Works do not contain the requisite creativity necessary to sustain a claim to copyright. The individual elements of each Work and the Works as a whole fail to demonstrate sufficient creativity.

JUUL argues that the Works are similar to other packaging designs the Office has previously registered. See Second Request at 1 (stating that the Office provided “no explanation differentiating the work at hand from prior-registered works[,]” specifically TX0008639853, TX0008680456, and VA0002143723). The deposits of the works registered on TX0008639853 and VA0002143723 are as follows, each featured alongside a Work now before the Board:



TX0008639853

SR # 1-8968744517



VA0002143723

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While the Office does not compare works when making registration decisions,¹ the situation here presents a derivative works issue that JUUL has failed to address. The existence of previous registrations covering elements appearing in the Works actually narrows the authorship in the Works the Board can consider here.² The Copyright Act defines a “derivative work” as a work that is “based upon one or more preexisting works.” 17 U.S.C. § 101. The Office will only register a derivative work if it contains “a sufficient amount of original authorship.” COMPENDIUM (THIRD) § 507.1. Because many of the elements in the Works are present in JUUL’s previous registrations, the Works are derivative works. To be registrable, they must contain new authorship that is sufficiently original to meet the statutory requirements for copyright. *Id.* § 311.2. When conducting that analysis, “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.” *See Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 521 (7th Cir. 2009).

Comparing the works, the previously registered designs include the name “JUUL” in identical typeface on the packaging’s front side, so that element cannot be considered when reviewing the creativity of the Works.³ Additionally, the previous registrations include a back side with words and short phrases, including drug content, warnings, and manufacturing information, positioned above a UPC. The current Works differ only in that they contain a slightly different graphic accent, product flavors, lists of ingredients, familiar designs, and different UPCs. These elements are discussed in detail below.

Turning first to the individual elements of the Works, short phrases (including product flavors, drug contents, warnings, manufacturing information), a list of ingredients, UPC, geometric shapes, and familiar designs are insufficiently creative to warrant copyright protection. Words and short phrases are not copyrightable. COMPENDIUM (THIRD) § 313.4(C) (using examples of a business name or product name as not being copyrightable). The UPC, warnings, and contact information are also not copyrightable, as they are dictated by functional considerations—for tracking items, warning consumers of potentially hazardous chemicals, and contacting the manufacturer, respectively. *See* 17 U.S.C. § 102(b); *see also Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1146 (9th Cir. 2003) (“when determining whether a sculpture contains sufficient originality to qualify for copyright protection[,] ‘it makes no sense to include the utilitarian aspects’ of the object in the analysis.”)⁴ The drug content information

¹ Determinations of copyrightability are made on a “case-by-case basis” and “[a] decision to register a particular work has no precedential value.” COMPENDIUM (THIRD) § 309.3. Thus, the Office’s decision to register these other packaging designs is not determinative here.

² JUUL acknowledges the similarity between its prior registrations and the Works here. *See* Second Request at 2 (each Work “represents stylistic choices that differ from past illustrations of the same product”).

³ The name “JUUL” and typeface are also not subject to copyright protection. 37 C.F.R. §§ 202.1(a), (e). This is true regardless of how creative the shape or form of the typeface characters may be, for example if they create a palindrome that deliberately render the letters “L” and “J” as mirror images of each other. *See* First Request at 6; *see also* COMPENDIUM (THIRD) § 906.4.

⁴ The Board agrees with the general statement on independent creation made in the Office’s Refusal of First Request for Reconsideration: “The Office does not question that the *CA Refill Kit 1-5% Golden Tobacco 4 Pack and 8 Other Unpublished Works* design was created independently and not copied from any existing work; consequently, this component is not at issue.” Refusal of First Request for Reconsideration at 3. However, the Board also notes that the UPC was not independently created by JUUL, providing additional support for its lack of originality. With

and list of ingredients are mandated by law and are not products of creativity. 37 C.F.R. § 202.1(a); *see also* COMPENDIUM (THIRD) § 313.4(F) (prohibiting registration of “[a] product label that merely lists the ingredients for the product” or its contents); 21 C.F.R. § 201 (general drug label requirements). Similarly, the poison warning and recycle graphics, both standard industry designs on food and drug labels, are not copyrightable. *See* COMPENDIUM (THIRD) § 313.4(J) (“Standard industry designs, such as . . . food labeling symbols [and] hazard warning symbols” are not copyrightable.).

The graphic accent is nearly identical to the graphic accent found on JUUL’s previous registrations, aside from coloring and orientation. Whether the graphic accent is viewed as pictorial content or graphic content presented in a photorealistic style,⁵ merely adding or changing one or relatively few colors in a work, or combining expected or familiar pairs or sets of colors, is not copyrightable as a separate work. COMPENDIUM (THIRD) § 906.3. The *Compendium* states that “[m]aking a few minor changes in a preexisting work of authorship, such as simple tone-overs or color overlays” is an unprotectable variation. *Id.* § 313.4(K). Additionally, the change in the orientation of the graphic accent from vertical to horizontal is an uncopyrightable change in the spatial placement of an element. *See id.* § 914.1 (stating that the Office will typically refuse to register trademarks, logos, or labels that consist only of “mere spatial placement or format of trademark, logo, or label elements”). Thus, the individual elements of the Work are not sufficiently creative to achieve copyrightability.

Likewise, the combination of the unprotected individual elements is insufficiently creative to support a copyright claim. JUUL argues that the “overall look-and-feel of the pod illustration is, in itself, sufficiently creative to warrant copyright protection. The arrangement and placement of these illustrations within the larger work certainly warrants protection.” Second Request at 2. However, where a design combines uncopyrightable elements, it is protected only when the “elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.” *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003). Further, the Office “will not consider the so-called ‘look and feel’ of a work. Invoking a work’s ‘feel’ is not a viable substitute for an objective analysis of the work’s fixed and creative elements.” COMPENDIUM (THIRD) § 310.4. Here, the front sides of all Works consist of uncopyrightable words and short phrases placed directly on top of a centrally-positioned graphic accent consisting of side-by-side geometric shapes of differing colors, all positioned above a warning box. The back sides of all Works contain unprotected English text positioned above a UPC positioned above identical unprotected text in French. The central positioning of the graphic accent and the overall commonplace arrangement of the *de minimis* text are expected on a commercial product label, and neither supports a claim in copyright.

respect to copyright, the term “original” consists of two components: independent creation and sufficient creativity. *See Feist*, 499 U.S. at 345.

⁵ The authorship claims on JUUL’s previous registrations describe those works as “compilation of text and photographs” (TX0008639853), “photograph” (TX0008680456), and “photograph(s), compilation of text” (VA0002143723)—and JUUL described the graphic accent in the Works as consisting of “repeated elements . . . depicted in the style of photorealism.” Second Request at 5.

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

Suzanne V. Wilson, General Counsel and
Associate Register of Copyrights

Maria Strong, Associate Register of Copyrights and
Director of Policy and International Affairs

Jordana Rubel, Assistant General Counsel

APPENDIX



