United States Copyright Office
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Re: Second Request for Reconsideration for Refusal to Register Barrio Build Your Tacos Menu & Barrio Build Your Tacos Menu II; Correspondence IDs: 1-3JLN2P8, 1-38NWDAR; SR #s 1-7044247491, 1-7044248007

Dear Mr. Orille:

The Review Board of the United States Copyright Office ("Board") has considered Barrio Bros., LLC's ("Barrio's") second requests for reconsideration of the Registration Program's refusal to register copyright claims in the works titled "Barrio Build Your Tacos Menu" ("Menu I") and "Barrio Build Your Tacos Menu II" ("Menu II") (collectively, the "Works"). After reviewing the applications, deposit copies, and relevant correspondence, along with the arguments in each of the second requests for reconsideration, the Board affirms the Registration Program's denials of registration.

I. DESCRIPTION OF THE WORK

The Works are menu cards that consist of a listing of ingredients organized by food category. To the right of each ingredient is a circle for customers to indicate if they want that particular ingredient. The bottom of each menu card features another table listing possible side dish options. The menu cards are cast in white, gray, and black. Menu I and Menu II are almost identical, except that Menu II also has five icons to indicate whether an ingredient is spicy (pepper), vegan (skull), vegetarian (bottle), gluten free (letters "gf" within circle), or contains dairy (letter "D"). Reproductions of the Work are included as Appendix A.[1]

II. ADMINISTRATIVE RECORD

On October 15, 2018, Barrio filed two applications to register copyright claims in the Works, which were submitted as claims in "text, artwork, Design and Layout." In two separate letters, Copyright Office registration specialists refused to register the claims, finding that they

[1] The Works also feature a skull and BARRIO flower logo graphic design on Menu I and Menu II, respectively. Barrio's claims, however, do not include those designs. *See* Email from Scott J. Orille to Jalyce Mangum, Attorney-Advisor, U.S. Copyright Office (July 14, 2020); Email from Scott J. Orille to Jalyce Mangum, Attorney-Advisor, U.S. Copyright Office (Sept. 10, 2020).

did not contain "the authorship necessary to support a copyright claim." Initial Letter Refusing Registration from U.S. Copyright Office to Scott Orille (Oct. 26, 2018); Initial Letter Refusing Registration from U.S. Copyright Office to Scott Orille (Oct. 19, 2018).

Barrio then requested that the Office reconsider its initial refusals to register the Works. Letters from Randy L. Taylor to U.S. Copyright Office (Jan. 15, 2019) ("First Requests"). After reviewing the Works in light of the points raised in the First Requests, the Office affirmed the refusal to register the claims. The Office found "the combination and arrangement of the component elements to be insufficiently creative to support a claim in copyright." Refusals of First Requests for Reconsideration from U.S. Copyright Office to Randy Taylor, at 1 (May 21, 2019) ("Second Refusals").

Barrio subsequently requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Works. Letters from Scott J. Orille to U.S. Copyright Office (Aug. 19, 2019) ("Second Requests"). Barrio asserted that the Works "easily clear[] the hurdle of 'mechanical or routine,' 'little more than a prohibition of actual copying,' or something more than a 'merely trivial' variation." Second Requests at 7. Barrio contended that the Works are "a creative way of leading the user to choose ingredients from several different categories to create a desirable end product—a great build your own taco." *Id.* at 4.

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 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." U.S. COPYRIGHT OFFICE, 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.

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) Distinction Between Ideas and Expression

Section 102(b) of the Copyright Act expressly excludes copyright protection for "any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work." 17 U.S.C. § 102(b). As such, section 102(b) codifies the longstanding principle, first originated by the Supreme Court in *Baker v. Selden*, 101 U.S. 99 (1879), that copyright law protects the original expression of ideas, but not the underlying ideas themselves. In *Baker*, the Court held that Selden's copyright on a book describing a bookkeeping system that included blank forms with ruled lines and headings did not preclude another from publishing a book containing similar forms to achieve the same result. 101 U.S. at 102. The Court concluded that the copyright in Selden's book covered the way that Selden "explained and described a peculiar system of book-keeping," but did not, however, give Selden the right to prevent others from using the system described in this book; nor did it give Selden "the exclusive right to make, sell, and use account-books prepared upon the plan set forth in such book." *Id.* at 104.

A closely related principle, also stemming from *Baker*, is what is now referred to as the merger doctrine. In describing the limits of Selden's copyright, the Court explained that if the "art" that a book "teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public." *Id.* at 103. That is, where there is only one way or only a limited number of ways to convey the idea that the author seeks to express, the author's expression cannot be protected under copyright law, because that would give the author a monopoly over the idea itself and prevent others from using that same idea in other works. *See CCC Info. Servs., Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 68 (2d Cir. 1994) ("[W]hen the expression is essential to the statement of the idea, the expression also will be unprotected, so as to insure free public access to the discussion of the idea."); 1-2 MELVILLE & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.18[C][2] (2014). The fact, however, that one author has copyrighted one expression of an idea will not prevent other authors from creating and copyrighting their own expressions of the same idea. *See* PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2.3.2 (2015).

Applying these principles, the Copyright Office has a longstanding presumption against registering blank forms. The Office's regulations expressly preclude registration of "methods [or] systems" and further specify that "[b]lank forms, such as time cards, graph paper, account books, diaries, bank checks, scorecards, address books, report forms, order forms and the like, which are designed for recording information and do not in themselves convey information" are not copyrightable. 37 C.F.R. § 202.1(c); *see* COMPENDIUM (THIRD) § 313.4(G) ("The Office cannot register the empty fields or lined spaces in a blank form."); *Id.* at § 313.4(B) (explaining where there "may be only one way or only a limited number of ways to express a particular idea," the Office may refuse to register a claim to that expression). The Office will, however, examine a work to determine whether it contains "an appreciable amount of written or artistic expression" that can be separated from the work's underlying method of capturing information. *Id.* at § 313.4 (G).

B. Analysis of the Work

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

The Works are blank forms that permit a customer to enter information, *i.e.*, the customer's taco order. Applying the legal standards set forth in section 102(b) and the merger doctrine, as described above, blank forms are typically not subject to copyright protection. *See* 37 CFR § 202.1(c) (citing as "examples of works not subject to copyright . . . [b]lank forms, such as . . . graph paper . . . which are designed for recording information and do not in themselves convey information."); COMPENDIUM (THIRD) § 313.4(G) (the Office "cannot register the empty fields or lined spaces in a blank form.").

The Board does, however, consider whether the work contains "an appreciable amount of written or artistic expression" that is distinct from the underlying method for recording information reflected on the form. COMPENDIUM (THIRD) § 313.4(G). The Works' constituent elements—the words, short phrases, listing of ingredients, and menu icons—are not individually entitled to copyright protection. *See* 37 C.F.R. § 202.1(a) ("Words and short phrases []; familiar symbols or designs; [and a] mere listing of ingredients or contents" are "not subject to copyright"); *see also* COMPENDIUM (THIRD) § 313.4(C) (noting that business and product names, catchwords, catchphrases, mottoes, slogans, and other short phrases are not copyrightable). Further, Menu II's icons fall under *scènes à faire* as common, stock features of restaurant menus and human skull iconography, which are not sufficiently creative to support a claim for copyright. *See Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 709 (2d Cir. 1992) (quoting *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980)) ("[W]here 'it is virtually impossible to write about a particular historical era or fictional theme without employing certain "stock" or standard literary devices,' such expression is not copyrightable."). To depict a pepper, bottle, and skull, it is virtually impossible to avoid the basic shapes depicted in Menu II. *See, e.g.*, *Zalewski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 106 (2d Cir. 2014) (denying copyright protection for elements that are "features of all colonial homes, or houses generally"); *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc*., 843 F.2d 600, 606 (1st Cir. 1988) (noting that "as idea and expression merge, fewer and fewer aspects of a work embody a unique and creative expression of the idea; a copyright holder must then prove substantial similarity to those few aspects of the work that are expression not *required* by the idea"). The remaining icons consist of letters and a geometric shape—"v" and "gf" within a circle—which are not entitled to copyright protection.

Viewed as a whole, the Board finds that the Works are not sufficiently creative to support registration. In this respect, the Copyright Office follows the principle that works should be judged in their entirety and not based solely on the protectability of individual elements within the work. *See Atari Games Corp. v. Oman*, 979 F.2d 242, 244-45 (D.C. Cir. 1992). Works composed of public domain elements may be copyrightable but only if the selection, arrangement, and modification of the elements reflects choice and authorial discretion that is not so obvious or minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Feist*, 499 U.S. at 359. Here, however, the Works consist of very few elements—lists of ingredients organized by food type, familiar icons, and short phrases (*e.g.*, "BUILD YOUR

TACOS," and "PLEASE SIT BACK & RELAX")—most of which are necessary elements and not protectable by copyright.

Further, the arrangement of the ingredients, phrases, and icons within the Works are "routine" and "entirely typical." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 345, 362 (1991). The ingredients are divided into obvious categories, such as "PROTEIN," "CHEESE," and "SALSA." The placement of the vegan, veggie, gluten free, dairy, and spicy icons in Menu II are wholly dictated by the listing of ingredients. The placement of the ingredients into a table with circles and rectangles is an obvious layout, typical of "build your own" menu cards. *See* COMPENDIUM (THIRD) § 313.3(E) ("The general layout or format of . . . a form, or the like, is not copyrightable because it is a template of expression."). Thus, the Works' aggregation of words, phrases, and artwork lack sufficient creativity to warrant registration.

Barrio relies on *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542 (S.D.N.Y. 2001), to support its proposition that the arrangement of elements contained in the Works represent a sufficient amount of creative authorship. Second Requests at 6. While the Review Board agrees that combinations of unprotectable elements may be selected, coordinated, or arranged in a manner that is sufficiently creative for copyright protection, reasonable observation does not support Barrio's assertion that the Works here meet this threshold. Furthermore, the Works are distinguishable from the work at issue in *Goldstar Printing*, which concerned a Chinese restaurant menu that contained an arrangement of photographs of Chinese food dishes in addition to text. The court found that "the overall design . . . contain[ed] the requisite originality to render it a copyrightable work." *Id.* at 548. The Works do not contain an arrangement of photographs or similar visually creative material, and overall do not appear to be created in a manner that injects a sufficient amount of creativity into the otherwise standard design.

Barrio also argues that the Works contain at least the same amount of creativity as previously registered menus consisting of copyrightable combinations of pictorial and textual elements. Second Requests at 7. The Office, however, does not compare works that have been previously registered or refused registration. *See* COMPENDIUM (THIRD) § 309.3. The Office examines each claim on its own merits, applying uniform standards of copyrightability at each stage of registration. Because copyrightability involves a mixed question of law and fact, differences between any two works can lead to different results. *See Homer Laughlin China Co. v. Oman*, 2 U.S.P.Q.2d (BNA) 1074, 1076 (D.D.C. 1991) (stating that it was not aware of "any authority which provides that the Register must compare works when determining whether a submission is copyrightable"); *accord Coach, Inc.*, 386 F. Supp. at 499 (indicating the Office "does not compare works that have gone through the registration process"). Nonetheless, even if a comparison were required, the Board determined that the works referenced contain creative elements not present in the designs here. Here, the claimed arrangements merely consist of unprotectable words, short phrases, and artwork, arranged in a predictable and expected manner. The cited registrations, therefore, are not useful comparisons for the Works here.

Finally, Barrio contends that the "organization of ingredients [] creates a unique effect on the observer" by "leading the user to choose ingredients from several different categories to create a desirable end product—a great build your own taco." Second Requests at 4. When examining a work for copyrightable authorship, the Copyright Office uses objective criteria to

determine whether a work is sufficiently creative for copyright protection. 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. COMPENDIUM (THIRD) § 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.").

In the matter before the Board, the Works lack the modicum of creativity required by the Supreme Court in *Feist*.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claims 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
Regan A. Smith, General Counsel and
Associate Register of Copyrights
Catherine Zaller Rowland, Associate Register of
Copyrights and Director, Public Information and
Education
Kimberley Isbell, Deputy Director of Policy and
International Affairs

Appendix A

Barrio Build Your Tacos Menu	Barrio Build Your Tacos Menu II

build your tacos

Please sit back & relax

Your custom-designed tacos are being made by hand with care (all good things take time)

your name

$3 ea

quantity quantity

TORTILLA: (choose one)
- Corn | hard
- Flour | soft
- White Widow | soft+guac+sour cream w/a crunch | $1
- Stoner | soft+hard+queso+chorizo | $1
- Green Goddess | soft+hard+queso+guac | $1
- Bowl | add $1

PROTEIN: (choose one or add $2 for double meat)
- House Made Chorizo
- Braised Beef
- Grilled Pollo
- Pulled Pork
- Pescado del Dia
- Tofu | vegetarian
- Black Beans | vegetarian
- –Add Rice to Taco | add $1
- –Add Black Beans to Taco | add $1

TOPPINGS
- Lettuce
- Red Cabbage
- Jicama Slaw
- Cilantro/Onions
- Tomatoes

CHEESE:
- Queso Fresco | soft, moist, & mild in flavor
- Middlefield Smoked Cheddar
- Chihuahua | mild white cheese

SALSA:
- Pineapple Salsa | sweet & mild
- Corn Salsa with Tomatoes & Peppers | mild
- Salsa Verde | medium
- Salsa Roja | salsa de la casa | caliente

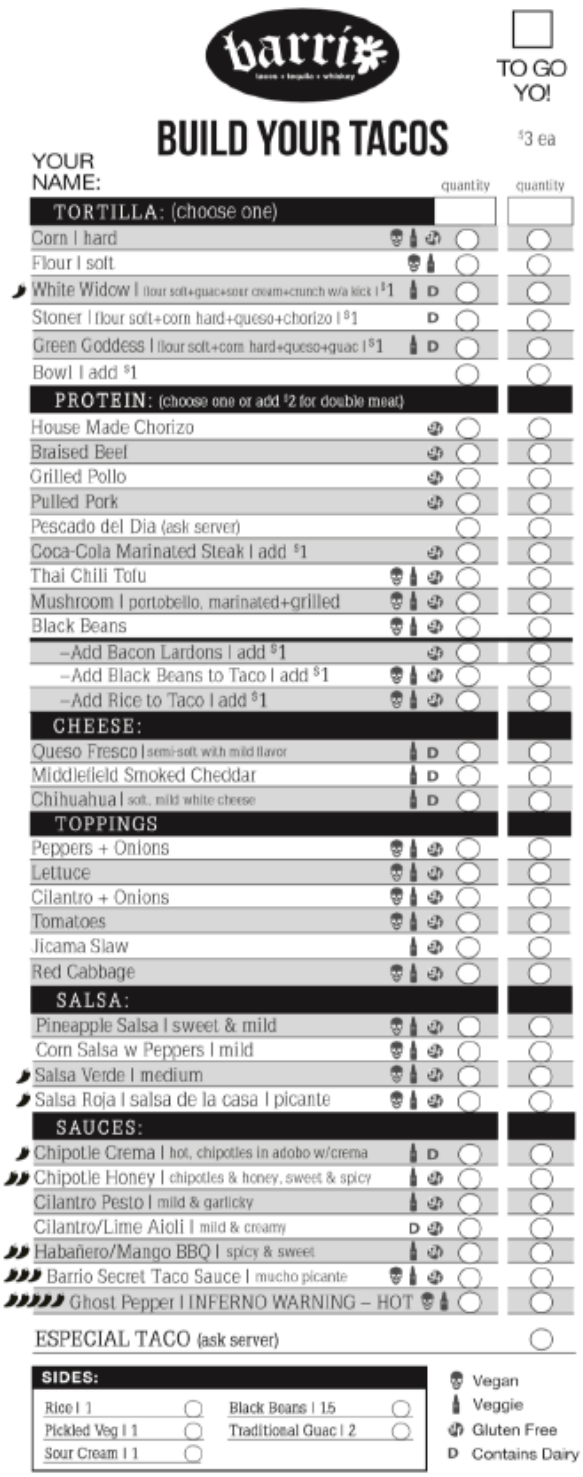
SAUCES:
- Chipotle Crema | hot, chipotles in adobo w/crema
- Guajillo Sauce | sun & dried guajillo peppers, hot
- Chipotle Honey | chipotles & honey, sweet & spicy
- Cilantro Pesto | mild & garlicky
- Cilantro/Lime Aioli | mild & creamy
- Habañero/Mango BBQ | mucho caliente & sweet
- Barrio Secret Taco Sauce | mucho caliente
- Ghost Pepper | INFERNO WARNING – HOT

SIDES:
- Rice | 1
- Black Beans | 1.5
- Pickled Veg | 1
- Traditional Guac | 2
- Sour Cream | 1

TODAY'S SPECIAL TACO | please ask your server

quantity:

Parties of 8 or more: Only one check please. 20% gratuity will be added.



barrio

TO GO YO!

BUILD YOUR TACOS

$3 ea

YOUR NAME:

quantity quantity

TORTILLA: (choose one)
- Corn | hard
- Flour | soft
- White Widow | flour soft+guac+sour cream+crunch w/a kick | $1 D
- Stoner | flour soft+corn hard+queso+chorizo | $1 D
- Green Goddess | flour soft+corn hard+queso+guac | $1 D
- Bowl | add $1

PROTEIN: (choose one or add $2 for double meat)
- House Made Chorizo
- Braised Beef
- Grilled Pollo
- Pulled Pork
- Pescado del Dia (ask server)
- Coca-Cola Marinated Steak | add $1
- Thai Chili Tofu
- Mushroom | portobello, marinated+grilled
- Black Beans
- –Add Bacon Lardons | add $1
- –Add Black Beans to Taco | add $1
- –Add Rice to Taco | add $1

CHEESE:
- Queso Fresco | semi-soft with mild flavor D
- Middlefield Smoked Cheddar D
- Chihuahua | soft, mild white cheese D

TOPPINGS
- Peppers + Onions
- Lettuce
- Cilantro + Onions
- Tomatoes
- Jicama Slaw
- Red Cabbage

SALSA:
- Pineapple Salsa | sweet & mild
- Corn Salsa w Peppers | mild
- Salsa Verde | medium
- Salsa Roja | salsa de la casa | picante

SAUCES:
- Chipotle Crema | hot, chipotles in adobo w/crema D
- Chipotle Honey | chipotles & honey, sweet & spicy
- Cilantro Pesto | mild & garlicky
- Cilantro/Lime Aioli | mild & creamy D
- Habañero/Mango BBQ | spicy & sweet
- Barrio Secret Taco Sauce | mucho picante
- Ghost Pepper | INFERNO WARNING – HOT

ESPECIAL TACO (ask server)

SIDES:
- Rice | 1
- Black Beans | 1.5
- Pickled Veg | 1
- Traditional Guac | 2
- Sour Cream | 1

Vegan
Veggie
Gluten Free
D Contains Dairy