United States Copyright Office
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March 21, 2019

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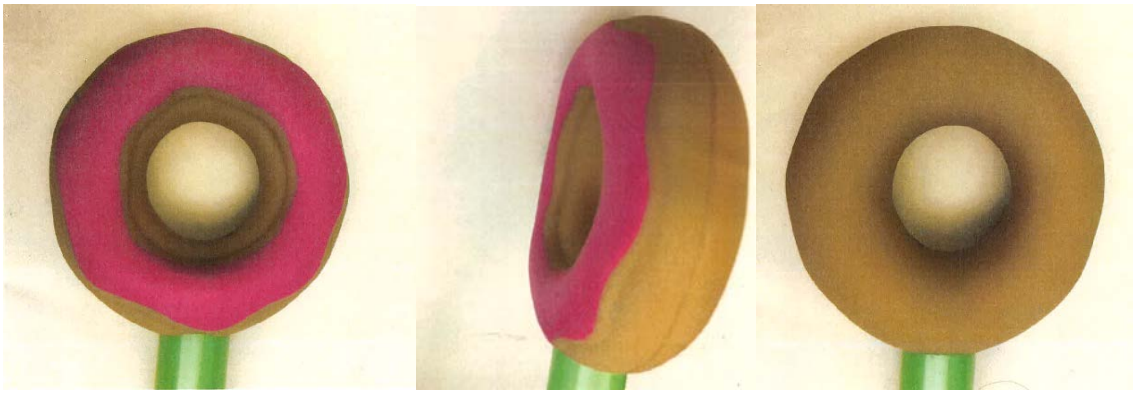
Re: Second Request for Reconsideration for Refusal to Register TOY DONUT POINTER; Correspondence ID: 1-35Z2D06; SR 1-4271512803

Dear Ms. Arnott:

The Review Board of the United States Copyright Office ("Board") has considered Learning Resources, Inc.'s ("Learning Resources'") second request for reconsideration of the Registration Program's refusal to register a three-dimensional art claim in the work titled "TOY DONUT POINTER" ("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 three-dimensional sculpture of a pink-frosted donut, mounted on a stick. The Work is depicted as follows:



II. ADMINISTRATIVE RECORD

On November 4, 2016, Learning Resources filed an application to register a copyright claim in the Work. In a January 18, 2018, letter, a Copyright Office registration specialist refused to register the claim, finding that it "lacks the authorship necessary to support a copyright claim." Letter from Examiner Proctor, Registration Specialist, to Larry L. Saret (Jan. 18, 2018).

Learning Resources then requested that the Office reconsider its initial refusal to register the Work. Letter from Louise Arnott to U.S. Copyright Office (Apr. 13, 2018) ("First Request"). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and again concluded that the Work lacked sufficient creativity because "[c]reating a three-dimensional 'donut' in the shape of a torus—which is the shape most actual cake donuts take—and accenting it with an irregular circular band of color to approximate frosting is an obvious and expected configuration." Letter from Stephanie Mason, Attorney-Advisor, to Louise Arnott at 3 (Aug. 24, 2018) ("First Request Refusal").

In response, Learning Resources 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 Louise Arnott, to U.S. Copyright Office (Nov. 13, 2018) ("Second Request"). In that letter, Learning Resources asserted that the Work "is not a common shape or design or dictated by expected or inevitable combinations of geometric forms." *Id.* at 2. To support this conclusion, Learning Resources makes two arguments that the Work as whole merits copyright protection. First, that the dimpling and uneven application of magenta frosting, the uneven nature of the overall shape, and the addition of the green stick at bottom result in modifications to standard shapes "in a creative way that rises to the level necessary to warrant protection." *Id.* at 6. Second, that there is no "standard" donut, donuts come in a variety of appearances, and the Work should not be penalized for referring to a real-life object. *Id.* at 5.

III. DISCUSSION

A. The Legal Framework

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 "[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 (THIRD EDITION) § 906.1 ("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 the requisite authorship necessary to sustain a claim to copyright.

The individual elements of the Work—brown torus and an irregular pink ring—are uncopyrightable as common geometric shapes, regardless of whether it is or is not atop a green stick. 37 C.F.R. § 202.1(a) (stating that "familiar symbols or designs" are not registerable); COMPENDIUM (THIRD) § 906.1. Learning Resources proposes that the modifications made to these standard shapes are sufficiently creative. It points to the raised surface following the outline of the irregular shape of the pink ring, the imperfect sides of the torus shape, and the addition of the stick to the bottom of the sculpture as "stylized sculptural elements and details that are arranged in a creative way." Second Request at 3. These contributions are *de minimis*, and do not rise to the level of protectable expression. COMPENDIUM (THIRD) § 313.4(B). Moreover, setting the donut on a green stick does not elevate the Work to the threshold required for originality. The green stick is simply that—a single green common geometric shape. Pairing

the donut with the stick element does not bridge the gap in creativity needed to warrant copyright protection.[1]

As Learning Resources correctly states, "works that combine geometric shapes into a larger design may be registered if the overall design is sufficiently creative." Second Request at 6. It then draws from the *Compendium* examples from Section 906.1 that the Office would register or decline to register. Learning Resources attempts to place the Work in the same category as a sufficiently creative wrapping paper design rather than a "perfectly smooth sphere." Learning Resource's argument, however, is unavailing. Instead, the Work is merely a "display of a few geometric shapes in a preordained or obvious arrangement." COMPENDIUM (THIRD) § 906.1. The minimal variations of two shapes result in a strikingly usual representation of a donut.

Learning Resources asserts that the Office erroneously concluded that "[c]reating a three-dimensional 'donut' in the shape of a torus—which is the shape most actual cake donuts take—and accenting it with an irregular circular band of color to approximate frosting is an obvious and expected configuration." First Request Refusal at 3. It argues that there is no such thing as a "standard" donut, having a variety of appearances and iterations as imperfect tori covered in imperfect frosting.[2] Second Request at 5. The Office agrees that there is no one standard donut, in terms of uniformity, consistency, or deliciousness. There are, however, "standard" expressions of donuts, in that their creative elements are combined in a well-established and very familiar way, such that there is not sufficient creativity for copyright protection.

When certain depictions are as a practical matter indispensable, or at least standard, in the treatment of a given topic, these choices are known as *scènes à faire*. *Atari Games Corp.*, 888 F.2d at 886. *Scènes à faire* are standard expressions that are virtually impossible to avoid when engaging with a particular topic. *See Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 709 (2d Cir. 1992). Copyright law does not protect these choices because they are "commonplace and lack originality." COMPENDIUM (THIRD) § 313.4(I). While *scènes à faire*

[1] The green stick is included in the Work so that Learned Resources can offer it for sale as an educational pointer. Learned Resources asserts that, because a donut shaped pointer is not common among educational pointers, the Work is "exceptional, original, and unique," thus warranting copyright protection. Second Request at 6. Novelty, however, is not relevant to the inquiry of copyright protection. COMPENDIUM (THIRD) § 310.1.

[2] Learning Resources also claimed that, "even if [the Work] looks like a 'real' donut, the creation and design of [the Work] required at least some degree of creativity" and asserted that "realism is not fatal to copyright." Second Request at 5-6. The Board agrees that realistic objects often are protected by copyright, but the ultimate question is whether the Work contains sufficient creative expression in depicting a realistic object. *See Coquico, Inc. v. Rodriguez-Miranda*, 562 F.3d 62, (1st Cir. 2009) (distinguishing protected original expression owed to the author from expression "ineluctably and inextricably intertwined with the idea of producing a realistic depiction of a coqui"); *Satava*, 323 F.3d at 812 (stating that an artist may protect the expression contributed to ideas found in nature).

cannot be registered by themselves, a work containing *scènes à faire* may be registered provided the work as a whole contains a sufficient amount of expression. *Id.*

The depiction of a brown donut with pink frosting falls under *scènes à faire*. A donut is a "small usually ring-shaped piece of sweet fried dough." Merriam-Webster, "Donut," https://www.merriam-webster.com/dictionary/donut (last visited Jan. 14, 2019). To depict a donut, it is virtually impossible to avoid a two or three-dimensional ring shape in some shade of brown, unless depicting a filled donut or a bear claw. Further, although not all donuts are frosted, strawberry pink is an exceedingly common and popular choice for frosting, and as a result has become a standard choice for depicting a donut.[3] Accordingly, the combination of a brown ring shape with an irregularly round pink shape is *scènes à faire* within the topic of donuts. To be sure, there are expressions of pink-frosted donuts that are sufficiently creative for copyright protection, in that they contain creative expression beyond *scènes à faire*. The Work at hand, however, does not.

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.

[3] *See, e.g.*, Dunkin Donuts, "Donuts," https://www.dunkindonuts.com/en/food-drinks/donuts/donuts (last visited Jan. 14, 2019) (displaying a photograph of a strawberry frosted donut as header image); Donut Bar, "Homepage," https://donutbar.com (last visited February 12, 2019) (displaying Chef Santiago Campa holding a pink frosted donut); Ruidoso News, "Customers flock to shop for a doughnut high," https://www.ruidosonews.com/story/news/local/2017/03/21/customersflock-shop-dooughnut-high/99457328/ (Mar. 21, 2017) (depicting the two dimensional pink-frosted donut in Apache Donuts and Kolaches); WLWT5, "OTR doughnut shop reopens after fire," https://www.wlwt.com/article/otr-doughnut-shop-reopens-after-fire/3560660 (Dec. 11, 2015) (depicting three dimensional pink-frosted donut sign for Holtman's Donut Shop); The Simpsons, "Treehouse of Horror XIII," Seas. 14, Ep. 1 (Nov. 3, 2002) (depicting multiple Homer Simpsons, the Homer Horde, chasing a giant pink-frosted donut).

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