

IN THE UNITED STATES COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

LONGHORN LOCKER COMPANY, LLC	§	
and AMERICAN INDEPENDENCE	§	
MANUFACTURING, LLC, collectively	§	
doing business as LONGHORN LOCKER,	§	
AMERICAN INDEPENDENCE	§	
MANUFACTURING and AIM,	§	
	§	
Plaintiff,	§	
v.	§	Civil Action No 3:19-CV-02872-K
	§	
HOLLMAN, INC., CRYSTAL CLEAR	§	
CREATIVE, LLC; KELLIE MATHAS; and	§	
TITAN OF LOUISIANA, INC.,	§	
	§	
Defendants.	§	

**RESPONSE OF THE REGISTER OF COPYRIGHTS  
TO REQUEST PURSUANT TO 17 U.S.C. § 411(b)(2)**

On March 31, 2021, pursuant to 17 U.S.C. § 411(b)(2), the Court requested advice from the Register of Copyrights (“Register”) on the following questions:

1. Would the Register of Copyrights have refused to register the ‘424 Registration for Longhorn’s unpublished two-dimensional artwork if the Register of Copyrights had known that, although Longhorn did not identify any preexisting work in its copyright application, Longhorn created and owns the preexisting, unpublished, and unregistered works depicted below? Why?
2. Would the Register of Copyrights have refused the ‘424 Registration for Longhorn’s unpublished two-dimensional artwork if the Register of Copyrights had known, although Longhorn did not identify any preexisting work in its copyright application, Longhorn created and owns a preexisting, unpublished, and unregistered version of its work as depicted below? Why?
3. Would the Register of Copyrights have refused the ‘424 Registration for Longhorn’s unpublished two-dimensional artwork if the Register of Copyrights had known that, although

Longhorn did not identify any preexisting work in its copyright application, Longhorn created and owns a preexisting, unpublished, and unregistered sculptural work as depicted below? Why?

4. Would the Register of Copyrights have refused the '424 Registration if the Register of Copyrights had known that, although Longhorn is named as the author on the '424 Registration, Longhorn created the works depicted in the '424 Registration based on the New Orleans Saints' request that Longhorn make minor variations to a preexisting work authored by Longhorn? Why?<sup>1</sup>

The Register hereby submits her response.

## **BACKGROUND**

### **I. Examination History**

A review of the records of the U.S. Copyright Office (“Copyright Office” or “Office”) shows the following:

On February 6, 2018, the Copyright Office received an application to register a group of two-dimensional graphic works titled “Images of Lockers.” The application identified Longhorn Locker Co LLC (“Longhorn”) as the work made for hire author and copyright claimant of the work. The application stated that “Images of Lockers” was completed in 2017 and first published on August 11, 2017. The Office initially refused registration, finding that the lockers were useful articles, which the Copyright Act defines as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>2</sup> The Office’s refusal letter explained that the Copyright Act provides that the design of a useful article is only protectable by copyright if it “incorporates pictorial, graphic, or

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<sup>1</sup> Request to the Register of Copyrights Pursuant to 17 U.S.C. § 411(b)(2) at 2–18, ECF No. 200 (“Request”) (images and illustrations referenced in questions appear in Request).

<sup>2</sup> 17 U.S.C. § 101.

sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article,” and that the Office had concluded that the works submitted did “not contain any non-useful design element that could be copyrighted and registered.”<sup>3</sup> The applicant submitted a Request for Reconsideration, in which it explained that it sought to register graphic images that represent the “design of a locker,” and was “not seeking protection for the locker itself.”<sup>4</sup> The Attorney-Advisory who reviewed the Request responded: “It is not clear from your letter if the applicant Longhorn Locker Co LLC is seeking registration for the image of the lockers, or for the lockers themselves. Please advise.”<sup>5</sup> The applicant clarified: “The Applicant is seeking copyright registration on the images of the lockers.”<sup>6</sup>

Based on these representations, the Office registered “Images of Lockers” on June 7, 2019, with an effective date of registration (“EDR”) of February 6, 2018, and assigned registration number VA0002153424 (the “424 Registration”). The registration certificate contains an annotation that states: “Registration based on deposited images, it does not extend to items depicted in the images.”<sup>7</sup>

On October 5, 2020, Longhorn submitted an application for supplementary registration to correct the year of completion and clarify that the images were actually unpublished at the time the registration was made. The application removed the date of publication and stated that the

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<sup>3</sup> Initial Letter Refusing Registration from Copyright Office to James E. Walton, Law Offices of James E. Walton, P.L.L.C. (Nov. 26, 2018).

<sup>4</sup> Letter from James E. Walton to Copyright Office (Jan. 29, 2019).

<sup>5</sup> Email from Stephanie Mason, Attorney-Advisor, Copyright Office, to James E. Walton (June 6, 2019).

<sup>6</sup> Email from James E. Walton to Stephanie Mason (June 7, 2019).

<sup>7</sup> Copies of the application, reproductions of the deposits, Office correspondence with Longhorn, and the registration certificate are attached hereto as Appendix A.

correct year of completion was 2016.<sup>8</sup> On January 12, 2021, the Office approved the supplementary registration application and assigned registration number VAu001416441.<sup>9</sup> The VAu001416441 certificate also clarified that the images were registered as an “unpublished collection.” Consistent with section 1802.7(A) of the COMPENDIUM (THIRD), the supplementary registration also contains an annotation that refers to the annotation on the basic registration.

The Office had no reason to question the representations in the initial and supplementary applications and accepted them as true and accurate.

## II. The Court’s Request

In this pending case, Defendants contend that “the ‘424 Registration is invalid or unenforceable under 17 U.S.C. § 411(b)(1) based on the existence of prior works, the possible use of prior works as a starting point for the images submitted as a deposit with the applications for a copyright registration, and the failure to disclose this information to the USCO in the application that led to the ‘424 Registration.”<sup>10</sup> Specifically, Defendants allege:

[B]efore Longhorn filed the application leading to the ‘424 Registration that Longhorn had created lockers and a locker mock up for the Dallas Cowboys (the “Cowboys locker”); that Longhorn had proposed lockers for the Saints to purchase from Longhorn; that in making this request, the Saints asked Longhorn to copy the Cowboys lockers with minor variations to the Cowboys lockers; that other similar lockers and drawings of lockers, other than the Cowboys lockers, existed at the time Longhorn filed the application leading to the ‘424 Registration, and that the images that are the subject of the ‘424 Registration are the product of the

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<sup>8</sup> See U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 1802.7(C) (3d ed. 2017) (“COMPENDIUM (THIRD)”) (noting that an error in the publication date may be corrected where an unpublished work was erroneously registered as a published work).

<sup>9</sup> See 17 U.S.C. § 408(d) (noting that an application for supplementary registration may be used “to correct an error in a copyright registration or to amplify the information given in a registration”).

<sup>10</sup> Request at 1.

Saint's [sic] request to make modified copies of existing lockers and drawings of lockers.<sup>11</sup>

Finding that Defendants' allegations satisfied the conditions of 17 U.S.C. § 411(b)(2), requiring the Court to seek the Register's opinion, the Court requested that the Register consider whether any of the identified inaccuracies described in the Request, if known, "would have caused the Register of Copyrights to refuse the '424 Registration."<sup>12</sup>

## ANALYSIS

### **I. Relevant Statutes, Regulations, and Agency Practice**

An application for copyright registration must comply with the requirements of the Copyright Act set forth in 17 U.S.C. §§ 408(a), 409, and 410. Regulations governing applications for registration are codified in the Code of Federal Regulations at 37 C.F.R. §§ 202.1 to 202.24. The principles that govern how the Office examines registration applications are found in the *Compendium of U.S. Copyright Office Practices*. Longhorn filed its applications in 2018. The governing principles the Office would have applied at that time are set forth in the version of the *Compendium of U.S. Copyright Office Practices, Third Edition* ("COMPENDIUM (THIRD)") that was released in September 2017.<sup>13</sup>

#### **A. Multiple Versions of Unpublished, Unregistered Works**

As an overarching principle, the Office generally requires that separate works be registered separately.<sup>14</sup> The Copyright Act states that "where a work is prepared over a period of

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<sup>11</sup> Order at 4, EFC No. 196.

<sup>12</sup> Request at 2.

<sup>13</sup> The Copyright Office released a new version of the COMPENDIUM (THIRD) in January 2021, but the 2017 version is the applicable version here as it was in effect at the time the application was submitted. *See* COMPENDIUM (THIRD), <https://www.copyright.gov/comp3/2017version/docs/compendium.pdf>.

<sup>14</sup> *See* COMPENDIUM (THIRD) § 511. There are limited exceptions to this rule, including for registration of collective works, published works using the "unit of publication" option, and group registration options for works such as serials, newspapers, newsletters, contributions to periodicals, unpublished photographs, published photographs, databases, and secure test items. Longhorn's graphic works were registered pursuant to the group

time, the portion of [the work] that has been fixed at any particular time constitutes the work as of that time.”<sup>15</sup> The Act also states that “where the work has been prepared in different versions, each version constitutes a separate work.”<sup>16</sup>

Although copyright law generally protects each version of a work, whether it is necessary to separately register a new version and exclude copyrightable material that appeared in previous versions of the same work depends on whether the previous versions have been previously published or registered, or otherwise contain material that is in the public domain or owned by a third party.

The statutory requirements for copyright registration dictate that an application for registration shall “in the case of a compilation or derivative work” include “an identification of any preexisting work or works that it is based on or incorporates, and a brief, general statement of the additional material covered by the copyright claim being registered.”<sup>17</sup> Under the Copyright Act, a “derivative work” is defined as “a work based upon one or more preexisting works, such as . . . [an] art reproduction, abridgment . . . or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a ‘derivative work.’”<sup>18</sup>

The COMPENDIUM (THIRD) explains that “[a] claim should be limited if the work contains an appreciable amount of material that was previously published, material that was previously

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registration option for unpublished collections. See 37 CFR §§ 202.3(b)(5), 202.4; COMPENDIUM (THIRD) §§ 511, 512.2 n.2.

<sup>15</sup> 17 U.S.C. § 101 (defining “created”).

<sup>16</sup> *Id.*

<sup>17</sup> *Id.* § 409(9).

<sup>18</sup> *Id.* § 101 (definition of “derivative work”).

registered, material that is in the public domain, and/or material that is owned by an individual or legal entity other than the claimant who is named in the application,”<sup>19</sup> and that “[i]f the work . . . contains an appreciable amount of unclaimable material,<sup>20</sup> the applicant should identify the unclaimable material that appears in that work and should exclude that material from the claim [by providing] . . . a brief, accurate description of the unclaimable material in the appropriate field/space of the application.”<sup>21</sup> The requirement to disclaim also applies if the work contains “an appreciable amount of material that was previously submitted for registration (but has not been registered yet).”<sup>22</sup> In such case, “the applicant should provide the case number/service request number for the previous application” or state “pending” and submit the date that the previous application was submitted.<sup>23</sup>

However, if all previous versions of the work are unpublished and unregistered, there is generally no need to identify any previous versions. If the work submitted for registration contains “copyrightable material that appeared in previous versions of the same work,” the COMPENDIUM (THIRD) states that there is “no need to exclude that preexisting material from the application unless that material has been previously published or previously registered or unless that material is in the public domain or is owned by a third party.”<sup>24</sup>

The COMPENDIUM (THIRD) illustrates these principles through two relevant examples. The first example involves an unpublished screenplay for which the author prepared multiple

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<sup>19</sup> COMPENDIUM (THIRD) § 621.

<sup>20</sup> Unclaimable material is “(i) previously published material; (ii) previously registered material; (iii) material that is in the public domain; and/or (iv) copyrightable material that is not owned by the claimant named in the application.” *Id.* Glossary.

<sup>21</sup> *Id.* § 621.1.

<sup>22</sup> *Id.* § 621.8(F).

<sup>23</sup> *Id.* § 621.8(F).

<sup>24</sup> *Id.* § 512.1.

drafts over time.<sup>25</sup> In such a case, “a registration for the most recent version will cover all of the copyrightable material that appears in the deposit copy, including any unpublished expression that has been incorporated from prior versions of the same work.”<sup>26</sup> The second example involves “an unpublished website that has been updated, modified, or revised from time to time.” The registration for the most recent version for an unpublished work “will cover all of the copyrightable material that is submitted for registration, including any unpublished text, photographs, or other content that has been incorporated from prior iterations of the same website.”<sup>27</sup>

## **B. Identifying the Author**

An application for registration must include “the name . . . of the author or authors,” unless the work is anonymous or pseudonymous.<sup>28</sup> The Supreme Court has explained that, other than in a work made for hire context, “the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.”<sup>29</sup> Simply providing an idea that is ultimately fixed by another into a tangible means of expression does not make one an author.

A work is considered a “joint work” if it is “prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”<sup>30</sup> A person must “contribute a sufficient amount of original authorship to the work” to

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<sup>25</sup> *Id.*

<sup>26</sup> *Id.*

<sup>27</sup> *Id.*

<sup>28</sup> 17 U.S.C. § 409(2).

<sup>29</sup> *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989); *see also* COMPENDIUM (THIRD) § 613.1.

<sup>30</sup> 17 U.S.C. § 101 (definition of “joint work”).



be considered a joint author.<sup>31</sup> An author may satisfy this requirement even if his contribution to the work is less significant than the contributions made by another author, but the author must contribute more than a *de minimis* amount of copyrightable expression.<sup>32</sup>

When completing the “author” field, “the applicant should only provide the name(s) of the author(s) [or work made for hire author] who created the copyrightable material that the applicant intends to register.”<sup>33</sup> “[T]here is no need to provide the name of any person(s) who created material that is *de minimis* or uncopyrightable.”<sup>34</sup>

### **C. Other Copyright Office Regulations and Practices**

Copyright Office regulations require applicants to make “[a] declaration [] that the information provided within the application is correct to the best of the [applicant’s] knowledge.”<sup>35</sup> Generally the Office “accepts the facts stated in the registration materials, unless they are contradicted by information provided elsewhere in the registration materials or in the Office’s records.”<sup>36</sup>

In responding to the Court’s questions, the Office applies the foregoing governing statutory and regulatory standards and examining principles. The Register notes that it is not unusual for an examiner to correspond with an applicant about factual assertions if the assertions appear to conflict with other information provided in the application materials.<sup>37</sup> Accordingly, if the Office becomes aware of an error at the time of application, such as the omission of the

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<sup>31</sup> COMPENDIUM (THIRD) § 505.2.

<sup>32</sup> *Id.*

<sup>33</sup> *Id.* § 613.3.

<sup>34</sup> *Id.*

<sup>35</sup> 37 C.F.R. § 202.3(e)(3)(iii).

<sup>36</sup> COMPENDIUM (THIRD) § 602.4(C).

<sup>37</sup> *Id.*

statement regarding preexisting material or a date of creation that is inconsistent with a deposit, or has questions about facts asserted in the application, it provides the applicant an opportunity to correct the error or verify the facts within a specified period of time.<sup>38</sup> If the applicant responds in a timely fashion to the satisfaction of the Office, the Office can proceed with the registration. The Register's response herein is thus premised on the fact that any errors identified were not timely corrected through such a process.

## **II. Register's Responses to Court's Questions**

The Court's questions suggest that there may be confusion as to the scope of the '424 Registration. The Office initially refused registration for "Images of Lockers" because it believed Longhorn sought to protect the lockers depicted in the graphic images, as opposed to the images themselves. If an article has an intrinsic utilitarian function, such as a locker's function providing storage for athletic gear and clothing, its design can only be protected by copyright if the design "incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."<sup>39</sup> To satisfy the separability test, 1) the article must include a feature that "can be perceived as a two- or three-dimensional work of art separate from the useful article;" and 2) that feature must "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

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<sup>38</sup> Generally, when a registration specialist corresponds with an applicant, the applicant will be given 45 days to respond to the specialist's questions concerning issues in the application materials. COMPENDIUM (THIRD) §§ 605.6 (B), (D).

<sup>39</sup> 17 U.S.C. § 101.

useful article into which it is incorporated.”<sup>40</sup> The Office determined that the lockers themselves were useful articles that did not meet the separability test.<sup>41</sup>

The registration certificate and the procedural history of the ‘424 Registration make it clear that the design, attributes, and configuration of the lockers themselves are not covered by the registration. Longhorn explicitly stated in correspondence with the Office that it was “not seeking protection for the locker itself.”<sup>42</sup> To minimize the risk of confusion on this issue, the Office included an annotation on the copyright registration certificate that explains that the registration “does not extend to items depicted in the images.” Section 113(b) of the Copyright Act provides that the owner of the copyright in a work that portrays a useful article as such does not obtain any rights with respect to the making, distribution, or display of the useful article its work portrays.<sup>43</sup> Thus, although the lockers are displayed in the two-dimensional graphic works that were submitted as deposits with the “Images of Lockers” application, the registration for “Images of Lockers” does not extend to the lockers themselves.<sup>44</sup> The scope of the ‘424 Registration is an important consideration in understanding the Register’s responses below and in evaluating Longhorn’s infringement claim.

Based on the foregoing statutory and regulatory standards, and the Office’s examining practices, the Register responds to the Court’s questions as follows:

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<sup>40</sup> *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S.Ct. 1002, 1007 (2017).

<sup>41</sup> Initial Letter Refusing Registration from Copyright Office to James E. Walton (Nov. 26, 2018).

<sup>42</sup> Email from James E. Walton to Stephanie Mason (June 7, 2019); Email from Stephanie Mason to James E. Walton (June 6, 2019); Letter from James E. Walton to Copyright Office (Jan. 29, 2019); Initial Letter Refusing Registration from Copyright Office to James E. Walton (Nov. 26, 2018).

<sup>43</sup> 17 U.S.C. § 113(b); *see also* COMPENDIUM (THIRD) § 922 (“When the Office registers a technical or scientific drawing, the registration covers only the drawing itself and does not . . . provide copyright protection for the design and manufacture of the item depicted in the drawing.”).

<sup>44</sup> *See* 17 U.S.C. § 412(a) (requiring registration prior to institution of a civil action for infringement).

Question 1:

The first three questions posed by the Court ask whether the Office would have granted the '424 Registration to Longhorn for "Images of Lockers" if it had known that, although Longhorn did not identify any preexisting works in its copyright application, Longhorn had created and owns several different unpublished and unregistered works that preexisted the two-dimensional graphic images that are included in the registration.

The first question states that Longhorn "created and owns the preexisting, unpublished, and unregistered works depicted below," below which are a series of two-dimensional graphic works showing Clemson University football team lockers with various features such as drawers, hanging clothes rods, cabinet doors, and name plates in different layouts. For the reasons stated earlier, the Register assumes that the Court's question refers to Longhorn's creation and ownership of the two-dimensional graphic works displayed in Question 1, not to the lockers depicted in those two-dimensional works. As useful articles that do not meet the separability test, the depicted lockers are not protectable by copyright.<sup>45</sup>

The two-dimensional graphic works shown in Question 1 are the same types of two-dimensional graphic works as those shown in the deposits Longhorn submitted with the application for "Images of Lockers," but the specific layout of the lockers within the individual graphic images that make up "Images of Lockers" differs from any of the layouts shown in the Clemson football locker graphic images.

As noted above, if a work contains copyrightable material that appeared in previous versions, the applicant does not need to identify any preexisting material in the application "unless that material has been previously published or previously registered or unless that

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<sup>45</sup> 17 U.S.C. § 101; *Star Athletica*, 137 S.Ct. at 1007.

material is in the public domain or is owned by a third party.”<sup>46</sup> Inherent in Question 1 is the fact that the preexisting images depicted are unpublished, unregistered, and were created and owned by Longhorn.<sup>47</sup> Therefore, even if the “Images of Lockers” graphic works contain an appreciable amount of material that also appears in the graphic works depicted in Question 1, Longhorn was not required to identify the preexisting graphic works depicted in Question 1 in its application for “Images of Lockers.”

Question 2:

The work in Question 2 is a technical drawing depicting one specific football locker that is described as the “Cowboys Player Locker.”<sup>48</sup> A technical drawing is a diagram “illustrating scientific or technical information in linear form, such as architectural blueprints or mechanical drawings.”<sup>49</sup> While the technical drawing appears to illustrate a football locker that is similar to the lockers depicted in the two-dimensional graphic works submitted as deposits with the application for “Images of Lockers,” none of the text or illustrations in the technical drawing are actually included in the “Images of Lockers” two-dimensional graphic works. The COMPENDIUM (THIRD) and the application itself specify that applicants are only required to disclaim preexisting material if “the work described in the application contains an appreciable amount of unclaimable

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<sup>46</sup> COMPENDIUM (THIRD) § 512.1.

<sup>47</sup> The Court does not specify whether Longhorn submitted an application to register the works depicted in Question 1 prior to the date it submitted its application to register the “Images of Lockers” graphic images. A search by the Office did not identify any such applications. If Longhorn had applied to register the works depicted in Question 1 at the time it submitted the “Images of Lockers” application, it should have identified that pending application in its application for “Images of Lockers.” *See id.* § 621.8(F).

<sup>48</sup> Again, the Register assumes that the Court’s question refers to Longhorn’s creation and ownership of the technical drawing shown in Question 2, not the locker depicted in the technical drawing, which is not protectable by copyright.

<sup>49</sup> COMPENDIUM (THIRD) § 618.4(C).

material.”<sup>50</sup> Because the text and illustrations from the technical drawings do not appear in any of the “Images of Lockers” two-dimensional graphic works, there was no need to disclaim those drawings. Additionally, like the images in Question 1, Longhorn would not have been required to disclaim the technical drawing in Question 2 if it was an unpublished and unregistered work owned by Longhorn.

Question 3:

Question 3 asks the Register whether she would have refused registration for the work if she had known that Longhorn created and owns a “preexisting, unpublished, and unregistered sculptural work,” and then depicts what appears to be a photograph of a locker. To the extent Longhorn created a physical locker prior to the date it submitted the application to register the “Images of Lockers” two-dimensional graphic works, it was not required to disclaim the physical locker in its application because it was clear from the application and subsequent correspondence that Longhorn intended to register only the two-dimensional graphic works depicting the lockers.<sup>51</sup>

Because the locker depicted in the photograph displayed with Question 3 does not appear to be a copyrightable sculptural work (at least based on features visible in the two-dimensional

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<sup>50</sup> *Id.* § 621.1; *Preview the Standard Application for a Visual Arts Work*, U.S. COPYRIGHT OFFICE 19, <https://copyright.gov/registration/docs/va-standard.pptx> (last visited May 7, 2021) (depicting portion of copyright application that states: “If your work does not contain any preexisting material,” you should leave this screen blank and “click ‘Continue’ to proceed to the “Rights & Permissions screen.”).

<sup>51</sup> *See* COMPENDIUM (THIRD) § 621.9(A)(2) (stating that a registration specialist may register a claim for a photograph depicting a sculpture without disclaiming the sculpture when it is clear that the application seeks protection only for the photograph).

image provided), it therefore does not constitute a preexisting work of original authorship that would need to be disclaimed.<sup>52</sup>

As the Office stated in its initial refusal of the application and as explained above, a locker is a useful article, which is copyrightable and registrable as a sculptural work “only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”<sup>53</sup> The Office determined that the lockers depicted in the “Images of Lockers” two-dimensional graphic works did “not contain any non-useful design element that could be copyrighted and registered.”<sup>54</sup> Similarly, as a useful article that does not meet the separability test, the locker shown in Question 3 is not protectable by copyright.

#### Question 4:

If the Office had known that, although Longhorn is named as the sole author on the ‘424 Registration, Longhorn created the works depicted in the ‘424 Registration based on the New Orleans Saints’ request that Longhorn make minor variations to a preexisting work authored by Longhorn, the Office would have granted the ‘424 Registration to Longhorn for “Images of Lockers.”

The Register assumes that Question 4’s reference to “the works depicted in the ‘424 Registration” is a reference to the two-dimensional graphic images shown in the deposit submitted with the “Images of Lockers” application, not the lockers themselves, which are not

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<sup>52</sup> The New Orleans Saints logo affixed to the locker in the photograph may be copyrightable as two-dimensional artwork, but the Office does not understand the Court to be asking for an opinion on the logo.

<sup>53</sup> 17 U.S.C. § 101 (defining “pictorial, graphic, and sculptural works”); *see also Star Athletica*, 137 S.Ct. at 1007 (laying out separability test based on statutory definition).

<sup>54</sup> Initial Letter Refusing Registration from Copyright Office to James E. Walton (Nov. 26, 2018).

copyrightable and are outside the scope of the ‘424 Registration. Question 4 also does not provide any information about the “preexisting work” referenced in the Question. As explained above, if the preexisting work was a physical locker, it may not contain separable copyrightable authorship; none of the locker images included in the Request appear to contain such protectable authorship. If the preexisting work was another two-dimensional graphic work (i.e., a photograph or drawing), that work may be protectable by copyright, but may be distinct from the claimed work.

In any event, the description of events in the Request does not make it clear whether the New Orleans Saints contributed any copyrightable authorship sufficient for the New Orleans Saints to be named as an author of the two-dimensional graphic works. If the New Orleans Saints suggested mere ideas for variations to a preexisting two-dimensional graphic image, but Longhorn alone fixed those ideas into the expression depicted in the graphic image, then the contribution of the New Orleans Saints would not appear to be copyrightable and the New Orleans Saints should not have been named as a joint author.<sup>55</sup> Even if the New Orleans Saints contributed to creating the expression depicted in the graphic image, the Request specifies that the variations to the preexisting work were “minor,” which could be a *de minimis* contribution that is insufficient to become a joint author.<sup>56</sup>

Based on the language in the Request specifying that “Longhorn created the works depicted in the ‘424 Registration based on the New Orleans Saints’ request that Longhorn make minor variations to a preexisting work,” the Register understands that Longhorn alone actually

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<sup>55</sup> See 17 U.S.C. § 102(b) (ideas are not copyrightable); COMPENDIUM (THIRD) § 313.3(A) (the “idea or concept for a work of authorship” is not copyrightable and is not registrable).

<sup>56</sup> COMPENDIUM (THIRD) § 505.2 (noting that each author must contribute a sufficient amount of original authorship to the work).



fixed the variations to the preexisting work into a tangible means of expression (*i.e.*, the two-dimensional graphic works). Therefore, applying the Office's examining practices, and statutory and regulatory standards, Longhorn is the sole author of the two-dimensional graphic works depicted in the '424 Registration and the Office would not have refused the '424 Registration based on the new information set out in Question 4.

Dated: May 18, 2021

/s/ Shira Perlmutter

Shira Perlmutter  
Register of Copyrights and Director  
of the U.S. Copyright Office

# APPENDIX A

REGISTRATION \*268-1 ATTORNEY  
Service Request #: 1-6270834821

## Mail Certificate

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Law Offices of James E. Walton, P.L.L.C.  
James E. Walton  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, TX 76028 United States

Priority: Routine

Application Date: February 06, 2018

## Correspondent

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Organization Name: Law Offices of James E. Walton, P.L.L.C.  
Name: James E. Walton  
Email: jim@waltonpllc.com  
Telephone: (817)447-9955  
Fax: (817)447-9954  
Address: 1169 N. Burleson Blvd., Suite 107-328  
Burleson, TX 76028 United States

Registration Number

\*-APPLICATION-\*

**Title** \_\_\_\_\_

Title of Work: Images of Lockers

**Completion/Publication** \_\_\_\_\_

Year of Completion: 2017  
Date of 1st Publication: August 11, 2017  
Nation of 1<sup>st</sup> Publication: United States

**Author** \_\_\_\_\_

- Author: Longhorn Locker Co LLC  
Author Created: 2-D artwork  
Work made for hire: Yes  
Citizen of: United States

**Copyright Claimant** \_\_\_\_\_

Copyright Claimant: Longhorn Locker Co LLC  
P.O. Box 375, Venus, TX, 76084, United States

**Rights and Permissions** \_\_\_\_\_

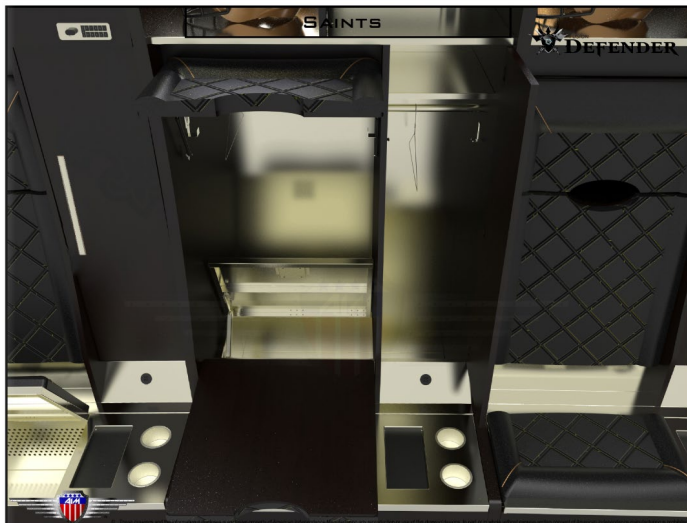
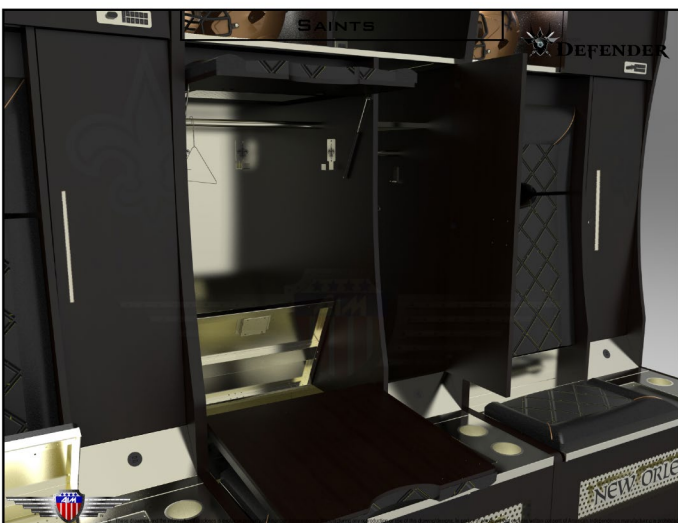
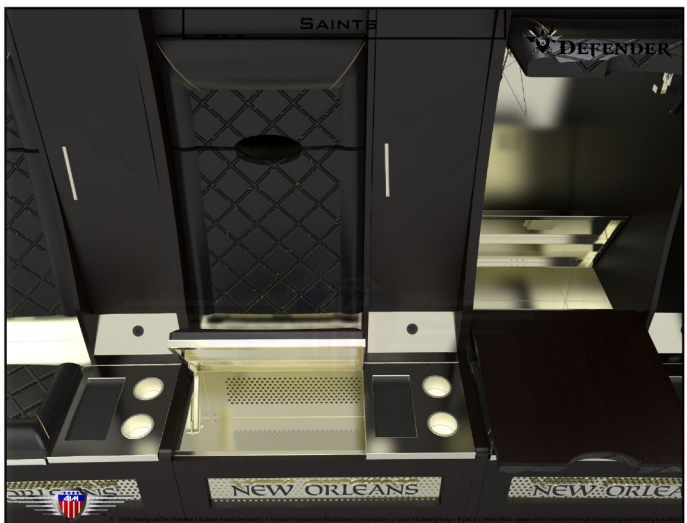
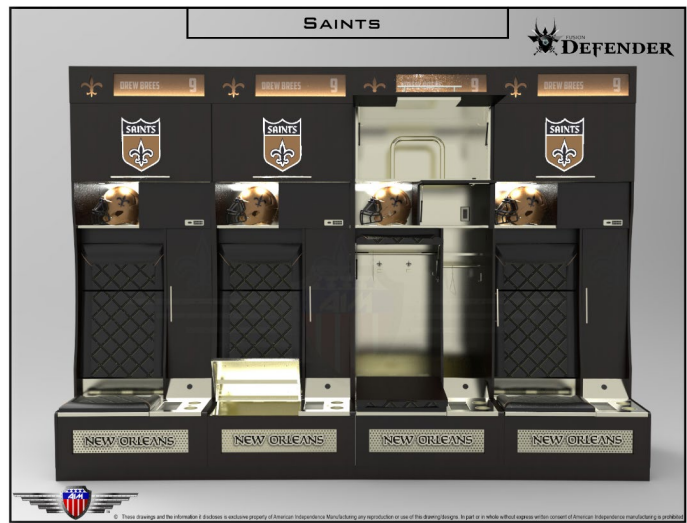
Organization Name: Law Offices of James E. Walton, P.L.L.C.  
Name: James E. Walton  
Email: jim@waltonpllc.com  
Telephone: (817)447-9955  
Address: 1169 N. Burleson Blvd., Suite 107-328  
Burleson, TX 76028 United States

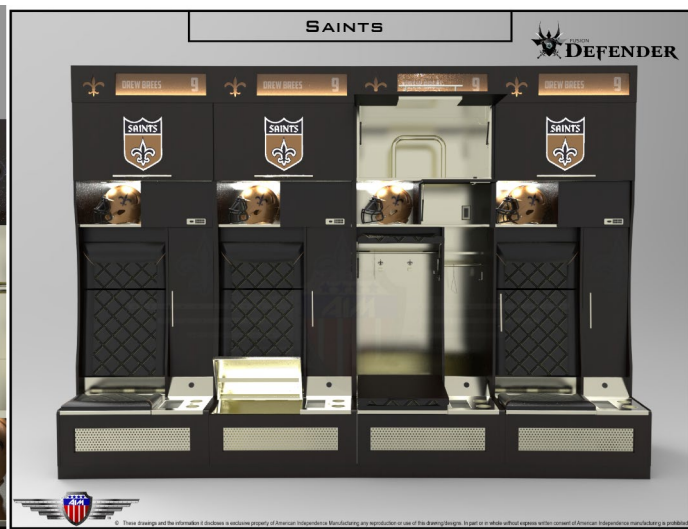
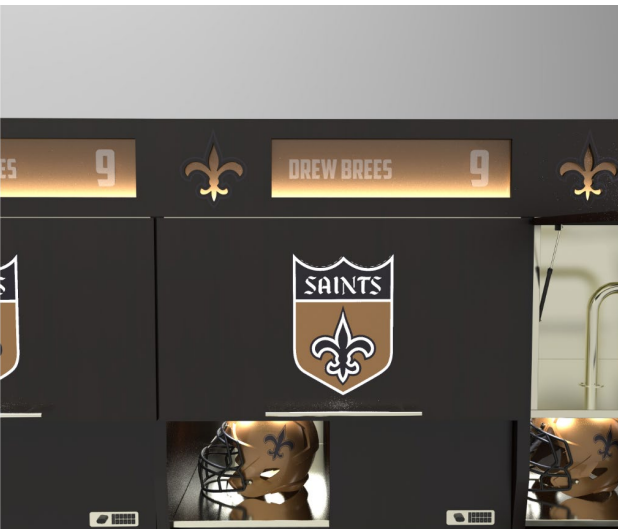
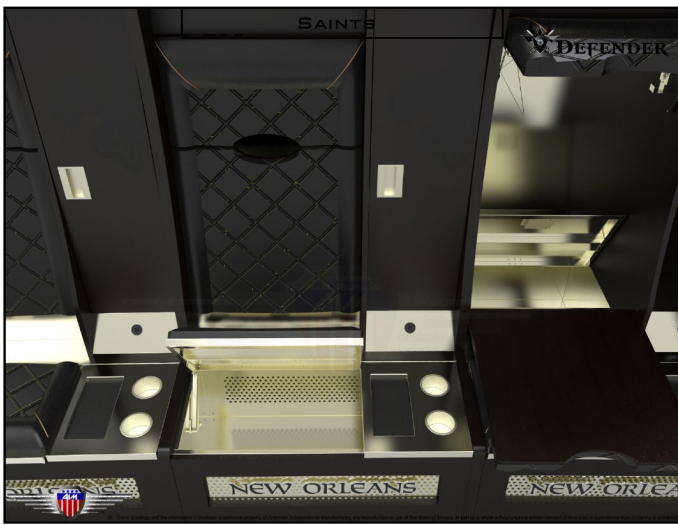
**Certification** \_\_\_\_\_

Name: James E. Walton

Date: February 06, 2018  
Applicant's Tracking Number: 1583JW-62292

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November 26, 2018

Law Offices of James E. Walton, P.L.L.C.  
Attn: James Walton  
1169 N. Burlison Blvd., Suite 107-328  
Burlison, TX 76028  
United States

Correspondence ID: 1-3ALAZ7P

RE: Images of Lockers

Dear James Walton:

Registration for the above work must be refused because it is a useful article that does not contain any copyrightable authorship needed to sustain a claim to copyright.

The Copyright law protects pictorial, graphic, or sculptural works. 17 U.S.C. 102(a)(5). Eligible works of art include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects. In addition, the design of a useful article is considered a pictorial, graphic, or sculptural work "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." The copyright statute defines "useful article" as "...an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. And article that is normally a part of a useful article is considered a useful article." 17 U.S.C. 101.

We examined your work, concluded that it is a useful article, and determined that it does not contain any non-useful design element that could be copyrighted and registered. Consequently, we cannot register your copyright claim.

Sincerely,  
B. Garner  
Registration Specialist  
Visual Arts Division  
Copyright Office

Enclosures:  
Reply Sheet





## United States Copyright Office

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\* 1 - 3 A L A Z 7 P \*

# Return this sheet if you request reconsideration.

## How to request reconsideration:

- Send your request in writing. **Please note that your request must be postmarked (via the U.S. Postal Service) or dispatched (via commercial carrier, courier, or messenger) no later than three months after a refusal is issued.**
- Explain why the claim should be registered or why it was improperly refused.
- Enclose the required fee – see below.
- Address your request to:

**RECONSIDERATION  
Copyright RAC Division  
P.O. Box 71380  
Washington, DC 20024-1380**

**Note:** Include the Correspondence ID Number (see above) on the first page. Indicate either “First Reconsideration” or “Second Reconsideration” as appropriate on the subject line.

**Notification of decision:** The Copyright Office will send a written notification of its decision, including an explanation of its reasoning.

**First Request for Reconsideration:** The Registration Program Office considers the first request. If it upholds the refusal, you may submit a second request.

**Second Request for Reconsideration:** The Copyright Office Board of Review considers the second request. The Board consists of the Register of Copyrights and the General Counsel (or their respective designees), and a third member appointed by the Register. The Board’s decision constitutes final agency action.

## FEES:

**First Request**                      \$250 per claim (i.e. the work(s) contained on one application)

**Second Request**                \$500 per claim (i.e. the work(s) contained on one application)



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FEB U 1 2019



\* 1 - 3 A L A Z 7 P \*

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**FEES:**

<b>First Request</b>	\$250 per claim (i.e. the work(s) contained on one application)
<b>Second Request</b>	\$500 per claim (i.e. the work(s) contained on one application)

**LAW OFFICES OF JAMES E. WALTON, P.L.L.C.**

1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955  
(817) 447-9954 (Facsimile)

29 January 2019

**Via First Class Mail**

FEB 01 2019

RECONSIDERATION  
Copyright RAC Division  
P.O. Box 71380  
Washington, D.C. 20024-1380

Re: United States Copyright Application – 1-6270834821  
**Locker Mock-Ups**  
**Correspondence ID No. 1-3ALAZ7P**  
**First Request for Reconsideration**  
Our File No. 1583JW-62292

Dear Sir:

The subject copyright application was filed on 6 February 2018. A Notice of Refusal was mailed on 26 November 2018. This letter serves as a First Request for Reconsideration in response to the Notice of Refusal.

17 U.S.C. § 102(a)(5) specifically provides protection for original works of authorship in the categories of pictorial, graphic, and sculptural works.

The subject copyright application is for an original work of authorship in the form of a graphic work. The graphics in the application represent unique and highly ornamental sports lockers. Each graphical image in the work was prepared with the aid of a computer after many hours of painstaking design work, including notes, sketches, and discussions among the designers and authors. The graphical works embodied in the application represent a unique, yet arbitrary, design for a locker. In the subject application, the Applicant is not seeking protection for the locker itself, but rather for the unique graphical images submitted with the application.

As is clearly illustrated, the design depicted in the graphical images includes many pictorial, graphic, and sculptural features that can be identified separately from and which are capable of existing independently of any utilitarian aspects a generic

RECONSIDERATION  
Copyright RAC Division  
29 January 2019

locker. For example, the rack and tabs in the upper part of the image have a sleek and contemporary feel to them, particularly because they have been shown to be formed of a shiny, metallic material. The images include dramatic representations of lighting and shadows, particularly around the helmet, that bring the images to life and add a warm look and feel to the image. This same dramatic use of lighting and shadows is used utilized in the storage areas and beneath the seat. The choice to depict some of the doors and panels in an open position adds a feeling of movement to the design. Many other design features are embodied in the subject images, including the angles at which the lockers are presented, the proportions of the components in the lockers, and the number of lockers presented in each image. The subject images are the culmination of many hours of research, design, and development.

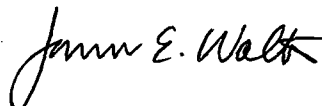
These types of unique graphical images are used by the Applicant to help prospective clients to envision how their locker rooms might look if they choose the Applicant to design their lockers. As is evident in the images, these lockers are for high-end clients, who want only the best that money can buy. The subject images go way beyond any intrinsic utilitarian aspects of sports lockers. None of the features depicted in the images are part of a "normal," "useful" locker. Normal lockers do not utilize stainless steel storage compartments; normal lockers do not include stainless steel racks for shoulder pads; normal lockers do not include custom lighting and ventilation; and normal lockers do not include plush, folding seat backs. Clearly, the subject application is not merely a useful article. The images that form the subject application are highly artistic, unique, one-of-a-kind representations of a high-end locker. These images are used to impress clients and entice them to buy products from the Applicant.

For at least the foregoing reasons, the Applicant submits that the application was improperly refused. Therefore, the Applicant hereby requests that the refusal be withdrawn and that the application be approved.

Enclosed herewith is a check in the amount of \$250.00 to cover the fee for this First Request for Reconsideration.

If you have any questions, please do not hesitate to contact us.

Very truly yours,



James E. Walton

Enclosures

Copy of Return Sheet  
Check in the amount of \$250.00

Created	Type	Comments	Activity Id
2/12/2019	To Do		1-3EKPIEG
2/13/2019	Notes	First appeal received 2/1/2019	1-3ENL7GC
6/6/2019	Email - Outbound	<p>Subject: Intent</p> <p>Body:</p> <p>Dear Mr. Walton:</p> <p>We are currently reviewing the reconsideration request you submitted for the work titled Images of Lockers. It is not clear from your letter if the applicant Longhorn Locker Co LLC is seeking registration for the image of the lockers, or for the lockers themselves. Please advise.</p> <p>Sincerely,                      Stephanie Mason, Attorney-Advisor                      Office of Registration Policy and Practice                      U.S. Copyright Office</p>	1-3KF5Q0H
6/7/2019	Email - Inbound	<p>Dear Ms.</p> <p>The Applicant is seeking copyright registration on the images of the lockers.</p> <p>Please let me know if you have any other questions.</p> <p>Thank you.</p> <p>Jim</p> <p>-----</p> <p>James E. Walton                      Law Offices of James E. Walton, P.L.L.C.                      1169 N. Burleson Blvd., Suite 107-328                      Burleson, Texas 76028                      Voice (817) 447-9955                      Fax (817) 447-9954                      Cell (817) 296-0535</p> <p>Notice: This email and any files transmitted with it are confidential and intended solely for the use of the individual or entity to whom they are addressed. If you are not the intended recipient or the person responsible</p>	1-3KFE5VQ

		for delivering this email to the intended recipient, be advised that you have received this email in error and that any use, dissemination, forwarding, printing, or copying of this email is strictly prohibited. If you have received this email in error, please notify James E. Walton immediately at (817) 447-9955.	
6/7/2019	Notes	Claim in image only registered on appeal following RP consultation. Registration does not extend to items depicted in image. Stephanie Mason, Attorney-Advisor Office of Registration Policy and Practice U.S. Copyright Office	1-3KFE5VT
6/7/2019	Letter - Outbound		1-3KFE5Y6



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June 07, 2019

Law Offices of James E. Walton, P.L.L.C.  
Attn: James Walton  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, TX 76028

Correspondence ID: 1-3KFE5W3  
Original Corresp. ID: 1-3ALAZ7P  
Re: Images of Lockers

Dear Mr. Walton:

This correspondence is in response to your letter of January 29, 2019, requesting reconsideration of the U.S. Copyright Office's refusal to register a copyright claim in the above-referenced work. You made this request on behalf of the applicant, Longhorn Locker Co LLC.

We have carefully reviewed *Images of Lockers* in light of the points raised in your letter as well as a further examination of the work. Upon reconsideration, we have decided to register a copyright claim in this work because we find that it contains a sufficient amount of original and creative pictorial that may be regarded as copyrightable and, therefore, support a copyright registration. Please note, the registration is for the images only, not the lockers depicted in the images.

The effective date of registration for this work is February 6, 2018, the date that we originally received the application, deposit material, and filing fee. The certificate of registration is being mailed separately and should arrive soon.

We hope that this resolves the matter satisfactorily for both you and your client.

Sincerely,

A handwritten signature in blue ink that reads "Stephanie Mason".

Stephanie Mason, Attorney-Advisor  
Office of Registration Policy and Practice  
U.S. Copyright Office



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\* 1 - 3 K F E 5 W 3 \*

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**Second Request**                \$500 per claim (i.e. the work(s) contained on one application)



Registration #: 7600215341  
Service Request #: 1-0270834821

Law Offices of James E. Walton, P.L.L.C.  
James E. Walton  
1169 N. Burlison Blvd., Suite 107-328  
Burlison, TX 76028 United States

Registration Number  
**VA 2-153-424**  
Effective Date of Registration:  
February 06, 2018

**Title** \_\_\_\_\_

Title of Work: Images of Lockers

**Completion/Publication** \_\_\_\_\_

Year of Completion: 2017  
Date of 1st Publication: August 11, 2017  
Nation of 1<sup>st</sup> Publication: United States

**Author** \_\_\_\_\_

• Author: Longhorn Locker Co LLC  
Author Created: 2-D artwork  
Work made for hire: Yes  
Citizen of: United States

**Copyright Claimant** \_\_\_\_\_

Copyright Claimant: Longhorn Locker Co LLC  
P.O. Box 375, Venus, TX, 76084, United States

**Rights and Permissions** \_\_\_\_\_

Organization Name: Law Offices of James E. Walton, P.L.L.C.  
Name: James E. Walton  
Email: jim@waltonpllc.com  
Telephone: (817)447-9955  
Address: 1169 N. Burleson Blvd., Suite 107-328  
Burleson, TX 76028 United States

**Certification** \_\_\_\_\_

Name: James E. Walton

**Date:** February 06, 2018  
**Applicant's Tracking Number:** 1583JW-62292

---

**Correspondence:** Yes  
**Copyright Office notes:** Basis for Registration: Registration based on deposited images, it does not extend to items depicted in the images.