United States Copyright Office
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November 28, 2017

Julianna M. Simon
Knobbe, Martens, Olson & Bear, LLP
2040 Main St., 14th Floor
Irvine, CA 92614

Re: Second Request for Reconsideration for Refusal to Register "Wanderer"; Service Request #: 1-3051870942; Correspondence ID: 1-20QMRMW

Dear Ms. Simon:

The Review Board of the United States Copyright Office ("Board") has considered Sisco Textiles N.V.; La Jolla Sport USA, Inc.'s ("Sisco") second request for reconsideration of the Registration Program's refusal to register the two-dimensional artwork present in a garment, titled "Wanderer" ("Work"). After reviewing the application, deposit materials, relevant correspondence, and the arguments in the second request for reconsideration in light of the Supreme Court's recent decision in *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017), the Board reverses the Registration Program's denial of registration.

The Work, a kimono, includes a combination of preexisting lace patterns incorporated into the bottom half of the kimono as well as beige lace trim decorating its back and sleeves. The particular two-dimensional artistic features identified by Sisco for registration include the placement of vertical strips of lace, "the use of three different flower designs," "the arrangement of one row of one flower design, followed by six rows of another flower design, all interspersed with a third, smaller flower design," and "the inconsistency in the shape of the bottom trim of the kimono." Letter from Andrew Simpson, Knobbe, Martens, Olson & Bear, LLP, to U.S. Copyright Office at 3 (July 25, 2016) ("First Request"); *accord* Letter from Julianna M. Simon, Knobbe, Martens, Olson & Bear, LLP, to U.S. Copyright Office at 2-3 (May 2, 2017) ("Second Request").

Sisco does not seek copyright protection for the overall kimono, which it concedes is a useful article that cannot be protected under the Copyright Act. First Request at 2 (Sisco "does not dispute that the 'Wanderer' work is on an item of clothing" . . . and that the "appropriate inquiry here is whether the [Work] contains some element that . . . can be identified as separable from the utilitarian aspects of [the] article" of clothing.); *see* 17 U.S.C. § 101. Rather, Sisco "seek[s] copyright registration for the original expression/two-dimensional work of art fixed in the tangible medium of the kimono fabrics." Second Request at 2.

As noted, copyright law does not protect useful articles, which are defined as "article[s] having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. It is well-established that "items of clothing are, as a general rule, uncopyrightable 'useful articles.'" *Morris v. Buffalo Chips Bootery, Inc.*, 160

F.Supp.2d 701, 720 (S.D.N.Y. 2001). However, an artistic feature applied on or incorporated into a useful article may be eligible for copyright protection if it: "(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated." *Star Athletica*, 137 S. Ct. at 1007, 1016 (holding that two-dimensional graphic designs on the surface of cheerleading uniforms satisfied this test and were, therefore, separable features).

Here, the Board finds that the Work contains separable artistic features from the overall useful article. Specifically, the Work's relatively complex placement of lace patternwork can be identified as a two-dimensional work of art separate from the kimono; it is thus separable. *See Star Athletica*, 137 S. Ct. at 1012-14; *see also Express, LLC v. Fetish Group., Inc.*, 424 F. Supp. 2d 1211, 1225 (C.D. Cal. 2006) ("[T]he placement, arrangement, and look of [] lace trim… are copyrightable."). Such features would qualify as a protectable pictorial, graphic, or sculptural work if imagined separately from the useful article; moreover, they do not recreate the kimono when so imaginatively removed. *Star Athletica,* 137 S.Ct. at 1012-14. The Court was clear, however, that application of its "test does not render the shape, cut, and physical dimensions of [] cheerleading uniforms [or other garments] eligible for copyright protection," and the shape or cut of the Work is similarly ineligible. *Id.* at 1016.

Moreover, the Board finds that the overall presence and placement of several distinct, albeit preexisting design elements (namely, lace flower patterns placed in combination with circle and honeycomb lace patterns and vertical lace trim), taken as a whole, contains sufficient creative expression to be copyrightable under the threshold articulated in *Feist Publications, Inc. v. Rural Telephone Services Co.*, 499 U.S. 340, 363 (1991). *See also* COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 906.1 (3d ed. 2014) ("COMPENDIUM (THIRD)") ("Generally, the U.S. Copyright Office will not register a work that merely consists of common geometric shapes unless the author's use of those shapes results in a work that, as a whole, is sufficiently creative."). At the same time, the Board notes that the individual lace elements, namely, the band of beige lace trim, and three types of flower designs, are preexisting elements not individually protectable under copyright law. *See* Application (noting that lace elements were preexisting). Moreover, they appear to be standard elements. *See Express, LLC v. Fetish Group, Inc.*, 424 F.Supp.2d 1211, 1223-25). Accordingly, the Board concludes that the Work possesses a small but sufficient amount of creativity beyond the combination of standard elements to establish thin copyright protection, but not enough creativity to qualify for broad protection. *See, e.g., id.* at 1223-27 (similar, evaluating three-flower lace embroidery pattern); *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) (describing level of creativity required when the expressive aspect of a work consists of the combination of standard elements). "Thin" copyright protection affords the holder only protection against virtually identical copying. *Satava,* 323 F.3d at 811.

For the reasons stated herein, the Review Board of the United States Copyright Office reverses the refusal to register the copyright claim in the Work. The Board now refers this matter to the Registration Policy and Practice division for registration of the Work, provided that all other application requirements are satisfied.

BY: Regan A. Smith
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