



United States Copyright Office

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January 13, 2017

David J. Stewart
Alston & Bird LLP
2101 West Peachtree Street
Atlanta, GA 30309-3424

**Re: Second Request for Reconsideration for Refusal to Register Experia Sock Design;
Correspondence ID: 1-18TE4KP**

Dear Mr. Stewart:

The Review Board of the United States Copyright Office (“Board”) has considered James L. Throneburg’s (“Mr. Throneburg’s”) second request for reconsideration of the Registration Program’s refusal to register a two-dimensional artwork claim in the work titled “Experia Sock Design” (“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 two-dimensional design imprinted on a white ankle-length sock. There is a grey oval encompassing the heel of the sock; a black rectangle with a small thin slope is positioned above the grey oval by the Achilles. The same grey color as the heel encompasses the ball and toe of the sock in a triangular shape that extends over the top of the sock at the toe. The top band of the sock, which surrounds the ankle, is a thick circular band with the word “Experia” written across it. The top portion of the sock, running along the top of the foot, is a colored rectangular shape that extends from the circular ankle band to the grey toe. This top portion also has rectangular wings that extend around and under the arch of the foot. If the sock is cut open from the bottom and laid flat, then this top portion looks like a plus (“+”) sign. The “+” portion has a logo positioned by the sock’s toe as well as eight small, thin horizontal white chevron lines applied symmetrically at a slight angle on both sides of the top ridge of the foot. It is bordered on all sides by a darker version of the same color.

While the design is the same on each sock, the deposited copy of the Work contains many color variations. Some are black, white, and grey variations with the top band around the ankle and the eight small, thin horizontal lines as an accent color. Others have the grey heel/ball with the “+” a solid color. The deposited copy contains green, blue, orange, yellow, pink, bright pink, and purple color variations.

Reproductions of the Work are set forth in Appendix A.

II. ADMINISTRATIVE RECORD

On March 12, 2015, Mr. Throneburg filed an application to register a copyright claim in the Work. In a March 12, 2015 letter, a Copyright Office registration specialist refused to register the claim, finding that it was a useful article that did not meet the originality standards laid out in the copyright statute, regulations, and case law. Letter from Sandra Ware, Registration Specialist, to Laura Kees, Alston & Bird LLP (March 12, 2015).

In a letter dated June 9, 2015, Mr. Throneburg requested that the Office reconsider its initial refusal to register the Work. Letter from Laura Kees, Alston & Bird LLP, to U.S. Copyright Office (June 9, 2015) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and concluded that although the design on the sock is conceptually separable from the sock itself, the Work still “does not contain a sufficient amount of original and creative authorship to support a copyright registration” because it is a “combination of various common shapes in a simple pattern.” Letter from Stephanie Mason, Attorney-Advisor, to Laura Kees, Alston & Bird LLP (Sept. 16, 2015).

In a letter dated December 14, 2015, Mr. Throneburg 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 David J. Stewart, Alston & Bird, LLP, to U.S. Copyright Office (Dec. 14, 2015) (“Second Request”). In that letter, Mr. Throneburg asserted “that not a single element of the sock design, with the possible exception of the circular band at the cuff of the sock . . . is a common geographic [sic] shape” *Id.* at 4. Mr. Throneburg further argued that the Work’s individual elements “including the strikingly unique center section . . . with its border, chevrons and unique mesh-design background, are independently copyrightable . . . the combination of all the elements as a whole [also] results in a unique and original work.” *Id.* at 5.

III. DISCUSSION

A. *The Legal Framework*

1) *Useful Articles and Separability*

The 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. Works of artistic craftsmanship that have been incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works pursuant to 17 U.S.C. § 102(a)(5). The protection for such works is limited, however, in that it extends only “insofar as [the works’] form but not their mechanical or utilitarian aspects are concerned.” *Id.* at 101. In other words, a design incorporated into a useful article is only eligible for copyright protection to the extent that the design includes artistic “features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” *Id.*; see also *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978) (holding that copyright protection is not available for the “overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape . . . may be”).

The Office employs two tests to assess separability: (1) a test for physical separability; and (2) a test for conceptual separability. See COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924.2 (3d ed. 2014) (“COMPENDIUM (THIRD)”); see also *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041 n.2 (9th Cir. 2014) (finding that the Office’s interpretation of conceptual separability is entitled to deference); *Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. 1995) (finding that the Office’s tests for physical and conceptual separability are “a reasonable construction of the copyright statute[]” consistent with the words of the statute,” existing law, and the legislature’s declared intent in enacting the statute).

To satisfy the test for physical separability, a useful article must contain pictorial, graphic, or sculptural features that can be physically separated from the article by ordinary means. See COMPENDIUM (THIRD) § 924.2(A). To satisfy the test for conceptual separability, a useful article must contain pictorial, graphic, or sculptural features that can be visualized—either on paper or as a freestanding sculpture—as a work of authorship that is separate and independent from the utilitarian aspects of the article and the overall shape of the article. In other words,

. . . the feature must be [able to be] imagined separately and independently from the useful article without destroying the basic shape of that article. A pictorial, graphic, or sculptural feature satisfies this requirement only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article.

COMPENDIUM (THIRD) § 924.2(B); cf. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668 (citing a carving on the back of a chair or a floral relief design on silver flatware as examples of conceptually separable design features).

If the useful article does not contain any features that can be physically or conceptually separated from its utilitarian function, the Office will refuse to register the claim because Congress has made it clear that copyright protection does not extend to any aspect of a useful article that cannot be separated from its utilitarian elements. If the Office determines that the work contains one or more features that can be separated from its functional elements, the Office will examine those features to determine if they contain a sufficient amount of original authorship to warrant registration.

2) *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 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).

Finally, 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 (THIRD) § 906.1; *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 creative authorship necessary to sustain a claim to copyright.

Here, it is undisputed that the Work, a sock, is a useful article. Thus, for there to be any consideration of the Work's design features, these features must be either physically or conceptually separable from the Work's utilitarian function as a piece of clothing. *See Esquire, Inc.*, 591 F.2d at 800. While the design printed on the sock clearly lacks physical separable design elements, it is clear that the imprinted design is conceptually separable. *See* Second Request at 2 (agreeing with the Office's identification of the design as conceptually separable from the utilitarian aspect of the Work). The geometric elements in the imprinted design are able to be visualized separately and independently from the clothing without destroying the basic shape of the sock or impairing its utilitarian features. *See* COMPENDIUM (THIRD) § 924.2(B). Accordingly, although copyright law does not protect the shape or design of clothing, designs imprinted on fabric may be registered if the design contains a sufficient amount of creative expression. *See Blue Fish Clothing, Inc. v. Kat Prints*, No. 91-1511, 1991 U.S. Dist. LEXIS 5720, at *4 (E.D. Pa. Apr. 29, 1991) (noting that copyright "[p]rotection has, however, been extended to the designs affixed or applied to a dress or other clothing").

Still, for a work to be eligible for copyright protection, it must "possess more than a *de minimis* quantum of creativity." *Feist*, 499 U.S. 340, 363. Neither the Work's constituent elements nor the compilation of those elements meet this low threshold. The individual elements – grey ball and heel pads, the black tab above the heel pad, a colored ring around the ankle, the colored "+" design that runs up the top of the foot and wraps around under the arch, the two rows of 8 chevron lines, and the white accents – are all minor variations of common and familiar uncopyrightable shapes. Mr. Throneburg asserts that "important elements of is [sic] sock design, including the strikingly unique center section . . . , with its border, chevrons and unique mesh-design background, are independently copyrightable." Second Request at 5. We disagree. The Copyright Act does not protect common geometric shapes, such as the straight and curved lines, ovals, and rectangles that are represented in the Work. *See* 37 C.F.R. 202.1(a); COMPENDIUM (THIRD) § 906.1. Nor does it protect common patterns, such as the standard chevron pattern. COMPENDIUM (THIRD) § 313.4(J) ("Examples of familiar symbols and designs include, without limitation: []Common patterns, such as standard chevron."); *see Star Fabrics, Inc. v. DKJY, Inc.*, No. 2:13-cv-07293-ODW(VBKx), 2014 U.S. Dist. LEXIS 2775, at *15 (C.D. Cal. Jan. 9, 2014) (noting that the copyright owner did not own a copyright in the chevron design itself, just in the way the pattern was uniquely represented with "purple, violet, and black undulating lines in a distorted chevron pattern. White, purple, and salmon dots are nestled within the waves."). The design element Mr. Throneburg focuses on—the colored "+" design—is merely a rectangular shape that runs up the front of the foot, includes basic chevron lines, and has rectangular wings that wrap around the foot's arch.

The Board recognizes that although the individual components of a given work may not be copyrightable, these components may be protectable if selected or combined “in a distinctive manner indicating some ingenuity.” *Atari Games Corp.*, 888 F.2d at 883. Here, though, the Board finds that the selection, combination, and arrangement of the Work’s design elements, noted above, is not sufficient to render the Work original. These few and unprotectable elements are combined in an entirely standard and commonplace manner, and much of the placement is dictated by the shape of the sock and foot. *See* COMPENDIUM (THIRD) § 313.4(J) (“[T]he Office cannot register a work consisting of a simple combination of a few familiar symbols or designs with minor linear or spatial variations.”) The grey pads at the heel and ball of the sock, as well as the cuff around the ankle, are common features found on many socks. The center section that also wraps under the foot appears to be dictated the by the foot’s curvature rather than by creative design. Furthermore, mere coloration or mere variations in coloring alone are not eligible for copyright protection. 37 C.F.R. § 202.1(a). Simply adding or changing one or relatively few colors in a work, such as the color variations in the deposited copy of the Work, is not copyrightable. COMPENDIUM (THIRD) § 960.3. Overall, the Board finds that the level of creative authorship involved in this configuration of elements is, at best, *de minimis*, and too trivial to enable copyright registration. *See id.* § 313.4(B).

Mr. Throneburg further argues that the Work is similar to works previously registered by the Office, which are at issue in *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468 (6th Cir. 2015), *cert. granted*, 136 S. Ct. 1823 (U.S. 2016). Second Request at 6-7. The Office has a policy of not comparing works that have been previously registered or refused registration. COMPENDIUM (THIRD) § 309.3 (“The fact that the U.S. Copyright Office registered a particular work does not necessarily mean that the Office will register similar types of works or works that fall within the same category. A decision to register a particular work has no precedential value and is not binding upon the Office when it examines any other application.”); *see also Homer Laughlin China Co. v. Oman*, No. 90-3160, 1991 WL 154540, at *2 (D.D.C. July 30, 1991) (court not aware of “any authority which provides that the Register must compare works when determining whether a submission is copyrightable.”); *accord, Coach*, 386 F. Supp.2d at 499 (indicating that the Office “does not compare works that have gone through the registration process”).

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.

BY:


Chris Weston
Copyright Office Review Board

APPENDIX A











































WATER

















Expedia

