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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

STARBUZZ TOBACCO, INC.,

Plaintiff,

vs.

GOLD STAR TOBACCO, INC. ET

AL.,

Defendants

CASE NO.: SACV 19-408 JVS (DFMx)

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

On July 3, 2019, pursuant to 17 U.S.C. § 411(b)(2), the Court requested advice from the Register of Copyrights (the “Register”) by August 5, 2019, on the following questions (the “Request”):

- 1) Would the Register of Copyrights have refused Starbuzz’s Copyright Registration No. VAu 1-313-168 for two-dimensional artwork, registered on April 4, 2018, if the Register of Copyrights had known that:

- 1 a) although Starbuzz did not identify the work as being a
2 derivative work, Starbuzz knew that (i) GOLD STAR®
3 word trademark(s), and (ii) GOLD STAR® logo
4 trademark(s), which are owned by a third party,
5 preexisted it?
6 b) although Starbuzz did not identify the work as being a
7 derivative work, Starbuzz had received authorization
8 from the third party who owned the GOLD STAR® word
9 and logo trademarks to create the Design incorporating
10 those trademarks?

11 2) If the Register of Copyrights opines that it would have refused
12 Starbuzz’s Copyright Registration No. VAu 1-313-168, would
13 the Register of Copyrights accept a supplementary registration
14 by Starbuzz pursuant to §§ 1802.2; 1802.6(J) of the
15 Compendium despite:

- 16 a) Starbuzz failing to disclose the preexisting GOLD
17 STAR® word trademark(s) and GOLD STAR® logo
18 trademarks?
19 b) Starbuzz failing to disclose the preexisting Canadian
20 trademark?¹

21 The Register hereby submits her response.

22 **BACKGROUND**

23 A review of the Copyright Office’s records shows the following:

24 On April 4, 2018, the U.S. Copyright Office (“Copyright Office” or
25 “Office”) received an application to register a two-dimensional artwork, titled
26 “Goldstar Tobacco Since 2012” (the “Starbuzz Work”). The application identified
Starbuzz Tobacco, Inc. (“Starbuzz”) as the work made for hire author of and
copyright claimant for the two-dimensional artwork. The application stated that

¹ Request at 3–4 (July 3, 2019).

1 the work was created in 2015, and that it was unpublished. The application did not
2 identify the work as a derivative work or disclose that the work incorporated
3 preexisting material. The Office registered the work with an effective date of
4 registration² of April 4, 2018, and assigned registration number VAu 1-313-168.
5 Based on the information provided in the application, the Office had no reason to
6 question the representations in the application and accepted them as true and
7 accurate.³

8 In the Order accompanying the Request, the Court found “that Defendants
9 had plausibly alleged that Starbuzz knowingly submitted inaccurate information in
10 connection with his application for Copyright Registration No. VAu 1-313-168
11 because [Defendant Samer] Abdelmaseh had sent” images of his GOLD STAR
12 word and logo trademarks⁴ “to Starbuzz’s graphic designer before the [Starbuzz
13 Work] was finalized.”⁵ The Court has requested that the Register consider
14 whether, given this information, the Office would have refused to register the claim
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16 ² The effective date of registration is the date that the Office received a completed
17 application, the correct deposit copy, and the proper filing fee.

18 ³ The principles that govern how the Office examines registration applications are
19 found in the *Compendium of U.S. Copyright Office Practices, Third Edition*. One
20 such principle is that the Office generally “accepts the facts stated in the
21 registration materials, unless they are contradicted by information provided
22 elsewhere in the registration materials or in the Office’s records.” U.S. COPYRIGHT
23 OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 602.4(C) (3d ed.
24 2017) (“COMPENDIUM (THIRD)”). Additionally, “the Office does not conduct
25 investigations or make findings of fact to confirm the truth of any statement made
26 in an application.” *Id.*

⁴ The U.S. Patent and Trademark Office eventually registered the GOLD STAR
logos as Reg. No. 5,031,249 on August 30, 2016, and Reg. No. 5,053,328 on
October 4, 2016.

⁵ Request at 2; *see* Order Regarding Mot. for Issuance of Request to the Register of
Copyrights 15, ECF No. 55.

1 or a supplementary claim based on accurate information regarding the origin of the
2 work.

3 ANALYSIS

4 An application for copyright registration must comply with the requirements
5 of the Copyright Act set forth in 17 U.S.C. §§ 408(a), 409, and 410. Regulations
6 governing applications for registration are codified in title 37 of the Code of
7 Federal Regulations at 37 C.F.R. §§ 202.1 to 202.24. The principles that govern
8 how the Office examines registration applications are found in the *Compendium of*
9 *U.S. Copyright Office Practices* (“*Compendium*”).

10 In pertinent part, the statutory requirements for copyright registration dictate
11 that an application for registration shall “in the case of a compilation or derivative
12 work,” include “an identification of any preexisting work or works that it is based
13 on or incorporates, and a brief, general statement of the additional material covered
14 by the copyright claim being registered.”⁶ The *Compendium* explains that “[a]
15 claim should be limited if the work contains an appreciable amount of material that
16 was previously published, material that was previously registered, material that is
17 in the public domain, and/or material that is owned by an individual or legal entity
18 other than the claimant who is named in the application,”⁷ and that “[i]f the work .
19 . . contains an appreciable amount of unclaimable material,⁸ the applicant should
20 identify the unclaimable material that appears in that work and should exclude that
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23 ⁶ 17 U.S.C. § 409(9).

24 ⁷ COMPENDIUM (THIRD) § 621.

25 ⁸ Unclaimable means “(i) previously published material; (ii) previously registered
26 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.”
COMPENDIUM (THIRD) Glossary.

1 material from the claim [by providing] a brief, accurate description of the
2 unclaimable material in the appropriate field/space of the application.”⁹

3 The Copyright Office will register a claim in a derivative work where the
4 deposit material contains new authorship with a sufficient amount of original
5 expression.¹⁰ In the case of derivative works, the “new authorship that the author
6 contributed to the derivative work may be registered, provided that it contains a
7 sufficient amount of original expression, meaning that the derivative work must be
8 independently created and it must possess more than a modicum of creativity.”¹¹

9 The amount of creativity required for a derivative work is the same as that required
10 for a copyright in any other work. The author must have “contributed something
11 more than a ‘merely trivial’ variation.”¹² Thus, “the key inquiry is whether there is
12 sufficient nontrivial expressive variation in the derivative work to make it
13 distinguishable from the [preexisting] work in some meaningful way.”¹³ A claim
14 to register a derivative work that adds only non-copyrightable elements, such as
15 mere coloring to a preexisting work is not entitled to copyright registration.¹⁴

16 Ultimately, whatever the addition is, it must be independently protectable in order
17 for the derivative work to be registered. A registration for a derivative work covers

18 ⁹ COMPENDIUM (THIRD) § 621.1.

19 ¹⁰ COMPENDIUM (THIRD) § 311.1 (citing H.R. REP. NO. 94-1476, at 57 (1976)).

20 ¹¹ COMPENDIUM (THIRD) § 311.2 (citing *Waldman Publishing Corp. v. Landoll,*
21 *Inc.*, 43 F.3d 775, 782 (2d Cir. 1994)).

22 ¹² *Id.* (citing *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d
23 Cir. 1951)).

24 ¹³ *Schrock v. Learning Curve International, Inc.*, 586 F.3d 513, 521 (7th Cir.
25 2009).

26 ¹⁴ *See* 37 C.F.R. § 202.1(a) (stating that “mere variations of . . . coloring” are “not
subject to copyright” and “applications for registration of such works cannot be
entertained”); *see also* *Boyd's Collection, Ltd. v. Bearington Collection, Inc.*, 360 F.
Supp. 2d 655, 661 (M.D. Pa. 2005).

1 only the new creative expression added by the author, not the expression in the
2 preexisting work.¹⁵

3 The Copyright Office’s regulations require applicants to make “[a]
4 declaration . . . that the information provided within the application is correct to the
5 best of [the applicant’s] knowledge.”¹⁶ Generally, the Office “accepts the facts
6 stated in the registration materials, unless they are contradicted by information
7 provided elsewhere in the registration materials or in the Office’s records.”¹⁷ The
8 Office “generally does not compare deposit copy(ies) to determine whether the
9 work for which registration is sought is substantially similar to another work.”¹⁸

10 In responding to the Court’s questions, the Office applies the foregoing
11 governing statutory and regulatory standards and examining principles. The Office
12 notes that it is not unusual for an examiner to correspond with an applicant about
13 factual assertions if the assertions appear to conflict with other information
14 provided in the application materials.¹⁹ Accordingly, if the Office becomes aware
15 of an error at the time of application, such as the omission of the statement
16 regarding preexisting material or a date of creation that is inconsistent with a
17 deposit, or has questions about facts asserted in the application, it provides the
18 applicant an opportunity to correct the error or verify the facts within a specified
19 period of time.²⁰ If the applicant responds in a timely fashion to the satisfaction of
20

21 _____
22 ¹⁵ COMPENDIUM (THIRD) § 311.2.

23 ¹⁶ 37 C.F.R. § 202.3(c)(3)(iii).

24 ¹⁷ COMPENDIUM (THIRD) § 602.4(C).

25 ¹⁸ COMPENDIUM (THIRD) § 604.2(D).

26 ¹⁹ COMPENDIUM (THIRD) § 602.4(C).

²⁰ Generally, when a registration specialist corresponds with an applicant, the applicant will be given forty-five days to respond to the specialist’s questions

1 the Office, the Office can proceed with the registration. The Register's response
2 herein is thus premised on the fact that any errors identified were not timely
3 corrected through such a process.

4 **REGISTER'S RESPONSE TO THE COURT**

5 Based on the foregoing statutory and regulatory standards, and its examining
6 practices, the Register responds to the Court's questions as follows:

7 1) Had the Office been aware that the Starbuzz Work registered under VAu
8 1-313-168 was based on preexisting artwork owned by a third party, the Office
9 would have refused to register the claim because the application failed to identify
10 that preexisting artwork. The Office would have refused registration even if the
11 work made for hire author received authorization from the third party to
12 incorporate the preexisting artwork.

13 As noted above, however, it is not unusual for an examiner to correspond
14 with an applicant about factual assertions in an application. If the Office had
15 become aware of the preexisting artwork at the time of application, or had
16 questions about facts asserted in the application, it would have provided the
17 applicant an opportunity to identify and disclaim the preexisting work or verify the
18 facts. The Office would typically correspond with the applicant to resolve each of
19 the questions for which the Court seeks advice, and it might be typical for this
20 process to resolve such errors. The Register's responses herein are based on the
21 assumption that any errors identified in the applications would not have been
22 timely corrected through such a process.

23 2) The Court asks "[i]f the Register of Copyrights opines that it would have
24 refused Starbuzz's Copyright Registration No. VAu 1-313-168, would the Register
25

26 concerning issues in the application materials. COMPENDIUM (THIRD) § 605.6 (B),
(D).

1 of Copyrights accept a supplementary registration by Starbuzz pursuant to
2 §§ 1802.2; 1802.6(J) of the Compendium.” The Register understands the court to
3 be asking whether the Office would grant a registration to Starbuzz if it filed an
4 application for a supplementary registration in which it identified and disclaimed
5 the GOLD STAR® word trademark(s), the GOLD STAR® logo trademark and the
6 Canadian trademark.

7 As the court recognized, defective applications may be corrected post-
8 registration using the supplementary registration option.²¹ The Office may decline
9 to issue a supplementary registration when it is aware that there is actual or
10 prospective litigation involving a basic registration if the proposed change would
11 be directly at issue in the litigation and if the proposed amendment may confuse or
12 complicate the pending dispute.²² In such cases, the Office typically stays its
13 consideration of the application for a supplementary registration until the applicant
14 confirms in writing that the dispute has been resolved. Here, the Office would
15 review and act upon an application for supplementary registration while this
16 litigation is pending. Any preexisting material upon which the Starbuzz Work may
17 be based is not directly at issue in this litigation. Given that the Court has been
18 briefed on the issues, the Court would not be confused or misled if the Office
19 issued a supplementary registration. Instead, a supplementary registration would
20 correct any error in the current registration, focus the registration on the additional

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22 ²¹ COMPENDIUM (THIRD) § 1802.6(J) (“A supplementary registration may be
23 used to correct or amend the information that appears on the certificate of
24 registration in the fields/spaces marked Author Created, Limitation of Copyright
25 Claim, Nature of Authorship, and/or Material Added to This Work.”)

26 ²² COMPENDIUM (THIRD) § 1802.9(G). For example, if the identity of the author of
a work was the main issue in a litigation, the Office would not want to issue a
supplementary registration that that proposed to change the author identified in the
basic registration.

1 copyrightable material in dispute, and allow the parties to litigate their dispute
2 before the court.

3 Based on the Office’s practices, if an application to correct or amplify the
4 information set forth in VAu 1-313-168 excluded the preexisting GOLD STAR
5 logos and Canadian trademark as previously existing artwork on which the
6 Starbuzz Work is based or incorporates, and if the application identified derivative
7 authorship that represented a sufficient amount of creative expression to warrant
8 registration, the Office would issue a supplementary registration provided that the
9 other legal and formal requirements have been met.²³ Here, the Office believes
10 that the additional graphic elements contained in the Starbuzz Work constitute a
11 sufficient amount of original authorship to warrant registration. Thus, the Office
12 would issue a supplementary registration if it received an application and filing fee
13 in proper form. Under the Office’s practices, the effective date of the
14 supplementary registration would be the date on which the Office received an
15 acceptable application and filing fee.²⁴

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19 ²³ Generally, the Office may issue a supplementary registration to limit a claim to
20 copyright in a derivative work if, upon examination, the Office determines that the
21 derivative authorship claimed in the application for supplementary registration is
22 registrable. *See* COMPENDIUM (THIRD) § 311.2 (“The new authorship that the
23 author contributed to the derivative work may be registered, provided that it
24 contains a sufficient amount of original expression, meaning that the derivative
25 work must be independently created and it must possess more than a modicum of
26 creativity.”); *Id.* § 1802.6(J) (“If the specialist determines that the authorship
described in the application for supplementary registration is not registrable, he or
she may communicate with the applicant and may refuse to issue a supplementary
registration.”).

²⁴ COMPENDIUM (THIRD) § 1802.12.

1 Dated: August 5, 2019


Karyn A. Temple
Register of Copyrights

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