



United States Copyright Office

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Sarah Robertson, Esq.
Dorsey & Whitney LLP
51 West 52nd Street, 8th Floor
New York, NY 10019

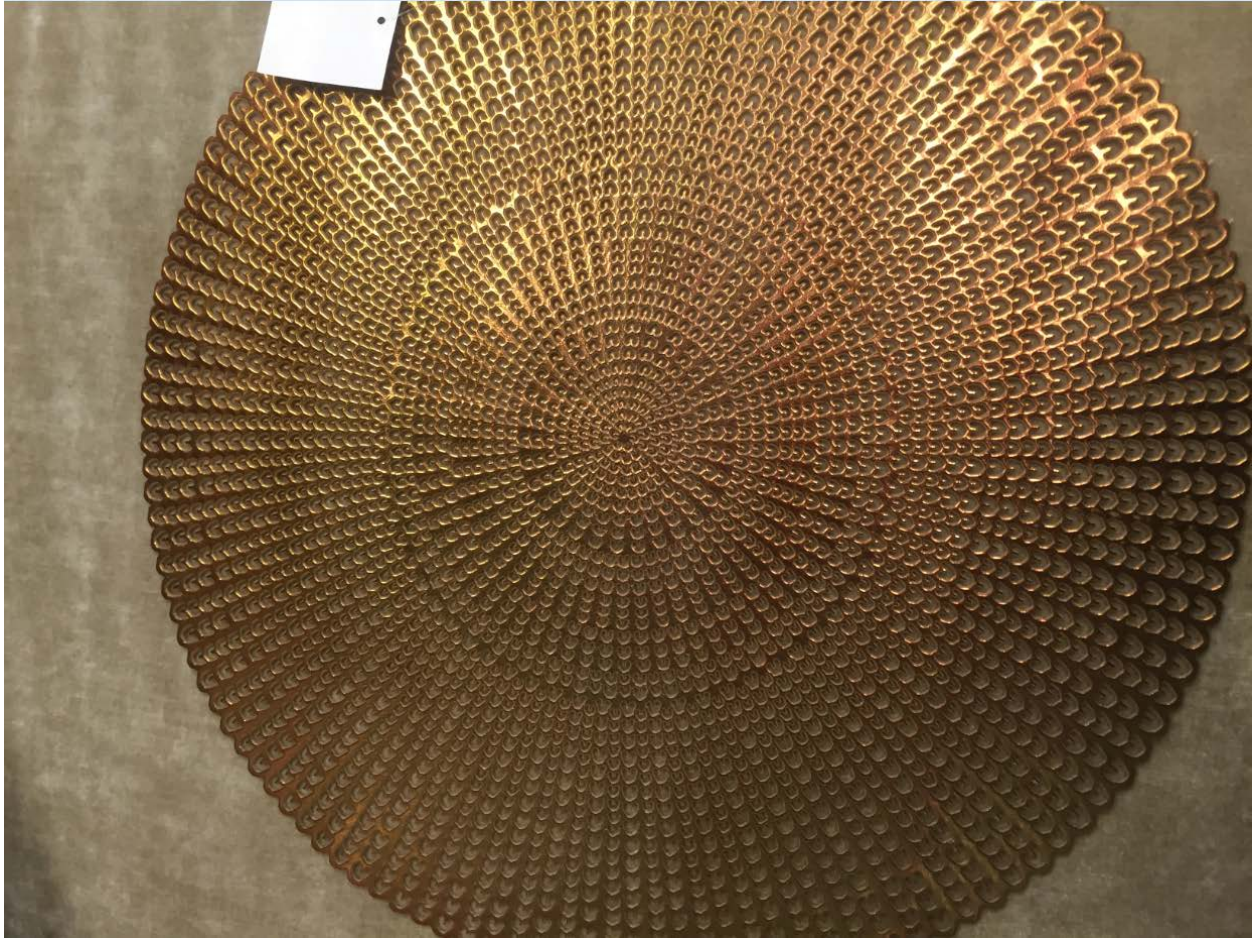
Re: Second Request for Reconsideration of Refusal to Register “Bellagio Pressed Vinyl Placemat”; Correspondence ID: 1-2S415K5; SR 1-5296636621

Dear Ms. Robertson:

The Review Board of the United States Copyright Office (“Board”) has considered Benson Mills, Inc.’s (“Benson’s”) second request for reconsideration of the Registration Program’s refusal to register a two-dimensional artwork claim in the work titled “Bellagio Pressed Vinyl Placemat” (“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 pattern, which is stamped out of a gold round vinyl placemat, that covers the entire surface of the placemat and consists of concentric rows of “U”-shaped holes. The size of the “U” shapes decreases as the concentric rows approach the center of the mat. A photographic reproduction of the Work is depicted below.



II. ADMINISTRATIVE RECORD

On June 2, 2017, Benson filed an application to register a copyright claim in two-dimensional art for the Work. In a June 5, 2017, letter, a Copyright Office registration specialist refused to register the claim, finding that the Work lacked “the authorship necessary to support a copyright claim.” Letter from Examiner Brown, Registration Specialist, U.S. Copyright Office, to Sarah Robertson, Dorsey & Whitney LLP (Jun. 5, 2017). The registration specialist also concluded that the work is a useful article and “does not contain any non-useful design element that could be copyrighted and registered.” *Id.* at 1.

In a letter dated July 6, 2017, Benson requested that the Office reconsider its initial refusal to register the Work, arguing that the work contains “more than the very minimal level of creativity required to meet the threshold requirement of originality under the Copyright Act.” Letter from Sarah Robertson, Dorsey & Whitney LLP, to U.S. Copyright Office (Jul. 6, 2017) (“First Request”). Benson challenged the Office’s assertion that the Work is a useful article, but contended that even if the Office were to conclude that the Work is a useful article, “the non-functional original components of the [W]ork are still entitled to registration.” After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claims and concluded that the Work “does not contain a sufficient amount of original and creative artistic or

graphic authorship to support a copyright registration.” Letter from Stephanie Mason, Attorney-Advisor, U.S. Copyright Office, to Sarah Robertson, Dorsey & Whitney LLP (Nov. 30, 2017). Without revisiting its assertion that the Work is a useful article, the Office stated that the “[U] shapes that make up this design are a common and familiar shape.” *Id.* at 2. The Office concluded that “the element that makes up the [W]ork is not combined in any way that differentiates it from the basic shape and design components,” and thus, “does not rise to the level of creativity necessary for copyright registration.” *Id.*

In a letter dated February 28, 2018, Benson 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 Sarah Robertson, Dorsey & Whitney LLP, to U.S. Copyright Office (Feb. 28, 2018) (“Second Request”). Benson reiterated its argument that the Work is not a useful article because “the work does not function as a placemat.” *Id.* at 13. However, Benson maintained that the non-functional elements are registrable even if the Board concluded that the Work is a useful article. Chiefly, Benson argued that the Work contains “at least eight different irregular sizes of tribal markings in the [W]ork creating original and visually pleasing bands of design.” *Id.* at 9. Benson contended that the “arrangement of [these] shapes is entitled to registration.” Second Request at 7. Moreover, Benson argued that the Work closely parallels the wrapping paper design that the Office identifies as copyrightable in the *Compendium of U.S. Copyright Office Practices, Third Edition*. Second Request at 7; see COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 906.1 (3d ed. 2017) (“COMPENDIUM (THIRD)”). Benson finally contended that “past decisions of the [Board] further illustrate that [the Work] contains a sufficient amount of creativity.” *Id.* at 11.

III. DISCUSSION

A. *The Legal Framework*

1) *Useful Articles and Separability*

Copyright does not protect useful articles as such, which are defined in the Copyright Act 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. Importantly, however, artistic features applied on or incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works under sections 101 and 102(a)(5) of the Copyright Act. This protection is limited to the “‘pictorial, graphic, or sculptural features’ [that] ‘can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.’” *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017) (quoting 17 U.S.C. § 101).

To assess whether an artistic feature incorporated into the design of a useful article is protected by copyright, the Office examines whether the feature “(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.” *Id.* at 1007; see also COMPENDIUM (THIRD) § 924. This analysis focuses on “the extracted feature and not on any aspects of the useful article that remain after the imaginary

extraction [because the] statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature.” *Star Athletica*, 137 S. Ct. at 1013. Put another way, while useful articles as such are not copyrightable, if an artistic feature “would have been copyrightable as a standalone pictorial, graphic, or sculptural work, it is copyrightable if created first as part of a useful article.” *Star Athletica*, 137 S. Ct. at 1011; 17 U.S.C. § 113(a) (“[T]he exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.”); *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”).

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, and slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring”); *id.* § 202.10(a) (stating “to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form”). Some combinations of common or standard design elements may contain sufficient creativity with respect to how they are juxtaposed or arranged to support a copyright. Nevertheless, not every combination or arrangement will be sufficient to meet this test. *See Feist*, 499 U.S. at 358 (finding the Copyright Act “implies that some ‘ways’ [of selecting, coordinating, or arranging uncopyrightable material] will trigger copyright, but that others will not”). A determination of copyrightability in the combination of standard design elements depends on whether the selection, coordination, or arrangement is done in such a way as to result in copyrightable authorship. *Id.*; *see also Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989).

A mere simplistic arrangement of non-protectable elements does not demonstrate the level of creativity necessary to warrant protection. For example, the United States District Court for the Southern District of New York upheld the Copyright Office’s refusal to register simple designs consisting of two linked letter “C” shapes “facing each other in a mirrored relationship” and two unlinked letter “C” shapes “in a mirrored relationship and positioned perpendicular to the linked elements.” *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 496 (S.D.N.Y. 2005).

Likewise, the Ninth Circuit has held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, vertical orientation, and the stereotypical jellyfish form did not merit copyright protection. *See Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003). The language in *Satava* is particularly instructive:

It is true, of course, that a *combination* of unprotectable elements may qualify for copyright protection. But it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.

Id. (internal citations omitted).

Similarly, while the Office may register a work that consists 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.

Finally, Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design’s uniqueness, its visual effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace. *See* 17 U.S.C. § 102(b); *Bleistein v. Donaldson*, 188 U.S. 239 (1903). The fact that a work consists of a unique or distinctive shape or style for purposes of aesthetic appeal does not necessarily mean that the work, as a whole, constitutes a copyrightable work of art.

B. Analysis of the Work

After careful examination, the Board finds that the Work fails to satisfy the requirement of creative authorship and thus is not copyrightable.

As a threshold matter, the Board considers the overall placemat to be a useful article. Benson argues that the Work “does not function as a placemat” because “the sole function of a placemat is to protect a surface” and “the punched out markings take away from that protective function.” Second Request at 13. That position is at odds with the title of the work, “Bellagio Pressed Vinyl *Placemat*” (emphasis added). While the holes in the placemat undoubtedly affect the utility of the placemat to protect a surface from food or beverage, the placemat retains its intrinsic utilitarian function to provide a protective barrier between a table surface and dinnerware. Nevertheless, Benson correctly states that the Work contains separable artistic

features from the overall useful article. Specifically, Benson argues that the Work’s decorative cutout pattern can be identified as a two-dimensional work of art separate from the placemat. The Board agrees.

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. The Board finds that neither the Work’s constituent elements nor the aggregate of those elements, taken as a whole, meet this low threshold.

It is uncontested that the Work’s constituent elements—the various “U”-shaped holes—are not individually subject to copyright protection. *See* Second Request at 9 (arguing for originality based on the “unique placement of the [varying sizes and shapes of] tribal markings”); *see also* 37 C.F.R. § 202.1(a) (prohibiting registration of “familiar symbols or designs; . . . lettering”); COMPENDIUM (THIRD) § 313.4(J) (3d ed. 2017) (providing that “[l]etters” and “[w]ell-known and commonly used symbols that contain a *de minimis* amount of expression” are not copyrightable.); *id.* § 906.2 (noting that mere variations on a familiar symbol or design are not copyrightable).

The question then is whether the combination of repeated “U” shapes in this manner is protectable when viewed as a whole. The Board finds that, viewed as a whole, the Work simply is not sufficiently creative to support a claim to copyright. *See Feist*, 499 U.S. at 359. Here, the standard symmetrical arrangement of “U”-shaped holes in a concentric pattern does not rise to the level of creativity necessary for copyright protection. There is simply not enough creative authorship in the design of the Work to warrant copyright protection.

Benson argues that the Work more than meets the minimal threshold of originality because the Work contains at least eight different sizes of “U” shapes. Second Request at 9. In support of its claim, Benson cites an example from the *Compendium* of a wrapping paper design eligible for registration, noting comparatively that its Work also “consists of common geometric shapes in a variety of sizes.” Second Request at 7 (citing COMPENDIUM (THIRD) § 906.1). The wrapping paper design follows:

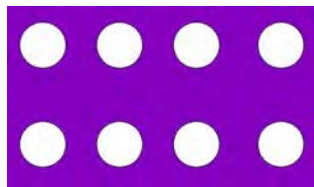


The Board finds the analogy unhelpful to Benson. The wrapping paper design includes stars of five or six different sizes and in at least eight different colors; circles of four or five different sizes; and triangles of four or five different sizes. Some of the shapes are stretched horizontally, others vertically; one triangle sits at an angle that parallels no edge, while the others all have a side that parallels an edge. And the various shapes are all arranged in an asymmetrical pattern that appears random. In short, the wrapping paper design exhibits creative authorship.

The Board similarly finds unpersuasive the cases Benson cites where a court found a combination of common elements to exhibit sufficient creativity. *See* Second Request at 7-9 (citing *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 764-65 (floral textile pattern); *Olem Shoe Corp. v. Wash. Shoe Co.*, No. 09-23494-CIV, 2011 U.S. Dist. LEXIS 138285 (S.D. Fl. Dec. 1, 2011), *aff'd*, 591 F. App'x 873 (11th Cir. 2015) (“particular arrangement of different sized dots at varying distances along vertical and horizontal planes . . . it is not merely a uniform change in dimension, size, or proximity from some specifically identifiable polka-dot pattern that separately exists”); *Prince Group, Inc. v. MTS Prods.*, 967 F. Supp. 121 (S.D.N.Y. 1997) (irregularly shaped and shaded polka dots in several different colors); *Klauber Bros., Inc. v. Target Group*, No. 14 Civ. 2125 (S.D.N.Y. Jul. 16, 2015) (lace textile design)). Each of the works at issue in the cited cases exhibits more creativity than the Work before the Board.

By comparison, the Work consists of only “U” shapes, repeated to appear smaller as the concentric rows of “U” shapes approach the center of the placemat. The “U” shape is arranged in a standard symmetrical, concentric pattern. Notably, the size difference between the “U” shapes appears to be dictated by the constraints of the concentric arrangement. *See* COMPENDIUM (THIRD) § 312.2 (noting that “[a] selection, coordination, and/or arrangement that is mechanical or routine, such as . . . arranging geometric shapes in a standard or symmetrical manner” will not trigger copyright). Finally, the Work’s color scheme is simple: the entire Work is rendered in gold vinyl. Thus, the Office finds that the Work does not evince enough creativity for protection under the Copyright Act. The selection and placement of the Work’s elements are the product of only *de minimis* creative choices. *Cf.* COMPENDIUM (THIRD) § 313.4(J) (“a work consisting of a simple combination of a few familiar symbols or designs with minor linear or spatial variations” is not copyrightable).

Indeed, the better analogy for the Work from section 906.1 of the *Compendium* is the painting with a purple background and evenly spaced white circles, the combination of which “does not contain a sufficient amount of creative expression to warrant registration.” COMPENDIUM (THIRD) § 906.1. A depiction of the painting follows:



The Board also finds Benson’s argument that the Board has allegedly reversed refusals of works similar to the one in contention unpersuasive. In its review process, the Office does not compare works that have been previously registered or refused registration. *See* COMPENDIUM (THIRD) § 602.4(C) (“When examining a claim to copyright, the U.S. Copyright Office generally does not compare deposit[s] to determine whether the work for which registration is sought is substantially similar to another work.”). The Board reviews each claim of copyright on its own merits. Thus, a prior registration does not require the Board to reverse the denial of a work that it finds lacks sufficient creative authorship. *See Homer Laughlin China Co. v. Oman*, No. 90 Civ. 3160, 1991 WL 154540, at *2 (D.D.C. July 30, 1991) (stating that court was not aware of “any authority which provides that the Register must compare works when determining whether a submission is copyrightable”); *accord Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 499

(indicating the Office “does not compare works that have gone through the registration process”).

Therefore, in the matter before the Board, the Work—a minimal combination of “U” shapes in a standard symmetrical, concentric arrangement—lacks the modicum of creativity required by *Feist*.

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:



U.S. Copyright Office Review Board

Karyn A. Temple, Acting Register of Copyrights and
Director, U.S. Copyright Office

Regan A. Smith, General Counsel and
Associate Register of Copyrights

Catherine Zaller Rowland, Associate Register of
Copyrights and Director of Public Information and
Education