



United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

December 27, 2019

Shawn B. Hussain, Esq.
Avyno Law
6345 Balboa Boulevard
Suite 208, Building 1
Encino, CA 91316

**Re: Second Request for Reconsideration for Refusal to Register
Tire Tread (2 Separate Works); Correspondence ID: 1-3CZWZLN; SR 1-
6455960012, 1-6455960194**

Dear Mr. Hussain:

The Review Board of the United States Copyright Office (“Board”) has considered MerchSource LLC’s (“MerchSource’s”) second request for reconsideration of the Registration Program’s refusal to register three-dimensional sculpture claims in two works, both titled *Tire Tread* (“Works”). 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 WORKS

The Works consist of two three-dimensional sculptures in the shape of tires. The treads of the tires consist of two rows of angled rectangles, arranged so that every other rectangle is raised. In one claim, on top of each rectangles are two small, hollow protruding circles, the other claim instead has smaller circular nubs, three on each rectangle. An image of each work is below, with the full deposit images provided in the Appendix.

SR 1-6455960012 (“Tread 1”):¹

SR 1-6455960194 (“Tread 2”):



II. ADMINISTRATIVE RECORD

On April 3, 2018, MerchSource filed an application to register a copyright claim in the Works. In an April 4, 2018 letter, a Copyright Office registration specialist refused to register the claims, finding that the Works lacked sufficient creative authorship. Letter from R. Barker, Registration Specialist, to Jennifer Hamilton, Avyno Law P.C. (Apr. 4, 2018).

In two substantially identical letters dated July 3, 2018, MerchSource requested that the Office reconsider its initial refusal to register the Works. Letters from Jennifer Hamilton to U.S. Copyright Office (July 3, 2018) (“First Requests”). After reviewing the Works in light of the points raised in the First Request, the Office re-evaluated the claims and again concluded that the Works merely combined “common and familiar shapes” that are not themselves copyrightable, and that the combination and arrangement of these unprotectable shapes is “insufficiently creative.” Letter from Stephanie Mason, Attorney-Advisor, to Jennifer Hamilton, Avyno Law P.C. (Jan. 11, 2019).

In letters dated April 11, 2019, MerchSource requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Works. Letters from Shawn B. Hussain, to U.S. Copyright Office (Apr. 11, 2019) (“Second Request”). MerchSource made largely identical arguments with respect to both Works,² emphasizing the “extremely low”

¹ To avoid ambiguity, the Board uses “Tread 1” and “Tread 2” to denote the individual claims where applicable.

² Because MerchSource sent individual letters for the two claims, references to “Tread 1 Second Request” and “Tread 2 Second Request” refer to the letters for SR 1-6455960012 and SR 1-6455960194 respectively.

requirement for creativity articulated in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), and citing Third Circuit law that the combination of copyrightable elements may be registrable as long as the artist has added a “spark” of creativity. Tread 1 Second Request at 1–2. MerchSource urged that the Works included “optional design decision[s]” that “create an original 3-dimensional shape,” such as diagonal stripes placed in a “chevron-like pattern,” indentation to “create a sunken effect,” and circular protrusions on the non-indented stripes. Tread 1 Second Request at 2 (referencing raised circles with “an inner raised button and outer raised button”); Tread 2 Second Request at 2 (referencing “three raised circles or buttons”). Finally, MerchSource points to a prior registration it received for the bottom sole of a shoe, which MerchSource suggests has a similar level of creative authorship as the Works. Tread 1 Second Request at 3 (claiming Tread 1 “possesses at least the same amount, if not more creativity and complexity than that possessed in the registered bottom sole design”); Tread 2 Second Request at 3 (same).

III. DISCUSSION

A. *The Legal Framework — 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*, 499 U.S. at 345. 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).

Similarly, 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.” U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 906.1 (3D ED. 2014) (“COMPENDIUM (THIRD)”); *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.

Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. *See id.* § 310.2. The attractiveness of a design, the espoused intentions of the author, the design’s visual effect or its symbolism, the time and effort it took to create, or the design’s commercial success in the marketplace are not factors in determining whether a design is copyrightable. *See, e.g., Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

B. Analysis of the Works

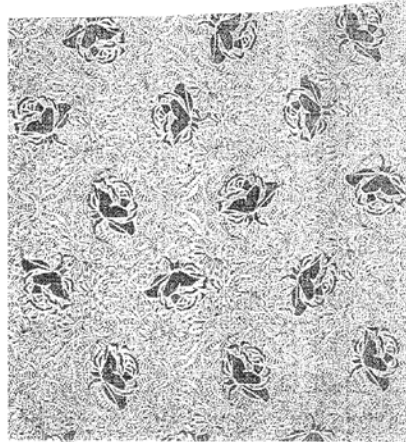
After carefully examining the Works and applying the legal standards discussed above, the Board finds that they do not contain the requisite separable authorship necessary to sustain a claim to copyright.

As MerchSource acknowledges, the Works themselves consist of common spheres and rectangles that are not registrable absent additional creative choices. Tread 1 Second Request at 2 (“the tire tread design in the present case comprises of common geometric shapes such as circles, chevrons, stripes, and diagonal lines”); Tread 2 Second Request at 2 (same). “The

Copyright Act does not protect common geometric shapes” including spheres and rectangles, and the 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.” COMPENDIUM (THIRD) § 906; *see also* 37 C.F.R. § 202.1(a). Because Tread 1 and Tread 2 consist only of minor variations on common shapes, registration can only issue if the creative choices made by MerchSource in the combination or arrangement of those unprotectable shapes are sufficiently creative to show copyrightable authorship.

Viewing the Works as a whole, the Board finds the combination of unprotectable elements in Tread 1 and Tread 2 insufficiently creative to support a registration. Both Works employ a symmetrical, evenly spaced arrangement of common shapes. Tread 1 consists of rectangles, using the center of the tire as a line of symmetry, each side alternating between indentation or a raised rectangle containing two further raised hollow circles. Tread 2 uses the same approach, except that the rectangles have a sharper angle from the center and the raised rectangles include three evenly-spaced round nubs. As a whole, these are not particularly creative designs that go beyond a “garden-variety” arrangement, *Feist*, 499 U.S. at 362, and the Works lack any variation in their sizing, orientation, or coloration. Each rectangular tread is the same size and orientation within the design, and there is no variety in the spacing or sizing of the protruding circular aspects of the treads. In both cases, the slanted chevron-like placement of treads predictably mimics the standard grooves of common tire treads. Moreover, the Works’ unprotectable elements are not “numerous enough [or] their selection and arrangement original enough that their combination constitutes an original work of authorship.” *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) (noting “it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection”) (emphasis in original); *see also* COMPENDIUM (THIRD) § 906.1 (protectable arrangement of uncopyrightable elements must combine them in a sufficiently creative way, such as one resulting in an “unusual pattern”).

The Works’ use of a small number of simple shapes stops short of instances in which courts have found copyright protection. For example, MerchSource points to *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759 (2d Cir. 1991), in which the Copyright Office issued a registration for a fabric design containing both original artwork (the roses) and an original arrangement of the roses, and suggests that *Tire Treads* contains similar creative authorship because it employs “at least some creative input.” Tread 1 Second Request at 2–3. But the fabric pattern in *Folio Impressions* did not rely on the symmetrical and even spacing of a small number of shapes; the pattern in that case was copyrightable because it used a creative depiction of a rose, placed over a public domain pattern, with the roses rotated to face “various directions” and angles. *Id.* at 763–65. Specifically, the design in that case was as follows:



Nor do the other cases cited by MerchSource compel a different conclusion. In *Boisson v. Banian, Ltd.*, 273 F.3d 262 (2d Cir. 2001), the quilt designs at issue included creative choices in “the arrangement and shapes of the letters, the colors chosen to represent the letters and other parts of the quilts, the quilting patterns, the particular icons chosen and their placement.” *Id.* at 273. And the work in *Nicholls v. Tufenkian Import/Export Ventures, Inc.*, 2004 WL 1399187 (S.D.N.Y. 2004), consisted of a graphic design of rectangles and circles employing various colors in a design where the circles are partially “shaded a color different from the rest of the circle” and some circles are “partially obscured by semi-transparent rectangles.” *Id.* at *3. Those works are depicted here:



School Days I (*Boisson*)




Prado (*Nicholls*)

MerchSource urges the Board to compare the Works with previously issued registrations, which it believes evince similar amounts of creative authorship. As the Compendium notes, the Copyright Office, however, makes copyrightability decisions “on a case-by-case basis” and “[t]he 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.” COMPENDIUM (THIRD) § 309.3; *see also Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q. 2d 1074, 1076 (D.C. Cir. 1991) (court not aware of “any authority which provides that the Register must compare works when determining whether a submission is copyrightable”). Even if the Board turned to consider the examples cited by MerchSource, both Works are unprotectable because they simply combine too few elements in a common and predictable manner.

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.



U.S. Copyright Office Review Board

Karyn A. Temple, 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, Public Information &
Education

Appendix: Deposit Images

Tread 1:





Tread 2:



