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June 25, 1998

Dear Mr. Clarida:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated October 23, 1997, appealing a refusal to register claims to copyright in two 2-dimensional works. Upon a careful reexamination of the works and analysis of the statutory and case law you have advanced in support of registration, the Board has accepted for registration the work entitled HILTON PACKAGE DESIGN. With respect to the second work entitled HILTON CROWN DESIGN, we regret that we have no alternative but to again refuse registration.

Administrative Record

On February 9, 1996, you submitted, on behalf of the claimant, Brown and Williamson Tobacco Corporation, two GATT application forms for registration of claims to copyright in the two above mentioned restored works under the provisions of the Uruguay Round Agreements Act (URAA).

In a letter dated August 7, 1996, signed by David Levy, Attorney Advisor, the Visual Arts Section of the Copyright Office Examining Division refused to register the works because the elements of the works, either alone or in combination, lacked the minimum copyrightable authorship upon which registration could be made. The letter refusing registration stated that the "'three-pointed crown" was a familiar symbol and design and therefore not copyrightable, citing 37 C.F.R. § 202.1, and that simple variations of standard designs and their simple arrangement do not furnish a basis on which to support a copyright claim.

In a letter dated October 30, 1996, you requested reconsideration of the initial rejections. Relying on what you contend are basic standards of copyrightability articulated in Feist Publications v. Rural Telephone Services, 499 U.S. 340 (1991) and in Atari Games Corp. v. Oman, 979 F.2d 232 (D.C. Cir. 1992), you maintained that the works possess sufficient original authorship to warrant copyright protection.

On August 18, 1997, the Visual Arts Section, in a letter signed by Attorney Advisor Levy, again refused registration on the ground that "no elements either alone or in combination of the works rise to the level of copyrightability" upon which a registration could be made.

In a letter dated October 22, 1997, you have requested a second review before the Copyright Office Appeals Board. The letter states that "for purposes of the present appeal, applicant will focus solely on the decision regarding the copyrightability of the overall 'Hilton Package Design' (Exhibit C) consisting of a particular combination of common graphic elements," but states that the applicant "also disagrees with the Visual Arts Section's unsupported conclusion that the 'Hilton Crown Design' (Exhibit B) is a 'familiar symbol or design.'" Your letter appear to focus solely upon the "Hilton Package Design" and makes no arguments relating to the "Hilton Crown Design" apart from the statement in a footnote that "the Visual Arts Section has cited no prior art in support of that conclusion [i.e., that the crown design is a "familiar symbol or design"], nor has it articulated a standard by which to determine whether a particular symbol or design is 'familiar.'"

Discussion

Although the Board believes that the "Hilton Package Design" presents a close question, the Board has concluded that the package design contains sufficient copyrightable authorship to justify registration, and a certificate of registration will be issued.

However, the Board has concluded that the Visual Arts Section correctly found that the "Hilton Crown Design" contains no copyrightable authorship. Accordingly, registration of the crown design will be denied.

The crown design consists of a three-pointed, somewhat elongated (vertically) gold crown on a red rectangle, with a gold border near the edges of the rectangle.*

In your October 23, 1997 letter you have again maintained that under Feist and Atari, the minimum original creative authorship must be found in every instance where an author creates a distinguishable variation which is not commonplace or practically

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* This description is based upon the crown design as it appears on the Hilton cigarette package deposited with the application. Exhibit B to your October 23, 1997 letter is identical to the described design, but in black and white.

inevitable. The Register, in your view, must clearly articulate and explain a refusal to register in the context of the Feist and Atari precedents.

The Board has considered the discussions pertaining to copyrightability in Feist and Atari, but has concluded that the crown design does not cross the threshold of originality required for copyright protection. In contrast to the package design, which includes the crown design as well as (in the words of your October 23, 1997 letter) a "grid of equilateral triangles, the size, spacing and arrangement of the lettering, the color combination, and the relative proportions of all these elements to each other," neither the design of the crown itself nor the placement of the crown in a rectangle with a simple straight-lined border raise any serious issue of copyrightability.

Feist confirmed that, as you argue, there is a low standard for determining the copyrightability of a work. The ruling also explicitly recognized, however, that some works, such as white-page, alphabetical listings of phone books, fail to meet that low standard for copyrightability. 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," 499 U.S. at 363, and that there can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* At 359.

Even prior to Feist, Copyright Office registration practices recognized that works with only a *de minimis* amount of authorship are not copyrightable. See Compendium of Copyright Office Practices, Compendium II, § 202.02(a)(1984). With respect to pictorial, graphic & sculptural works, the class within which the crown design would fall, the Compendium states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." Compendium II, § 503.02(a)(1984). The Compendium recognizes that it is not aesthetic merit, but the presence of creative expression that is determinative of copyrightability, *id.*, and that "registration cannot be based upon the simplicity of standard ornamentation such as chevron stripes, the attractiveness of a conventional fleur-de-lys design, or the religious significance of a plain, ordinary cross. Similarly, it is not possible to copyright common geometric figures or shapes such as the hexagon or the ellipse, a standard symbol such as an arrow or a five-pointed star. ... The same is true of a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations." *Id.*

Whether or not the Visual Arts Section was correct in concluding that the crown design was a "familiar symbol and design," it is clear to the Board that the design does not, in the words of Feist, "possess more than a *de minimis* quantum of creativity." As

a simple line drawing of a three-pointed crown on an ordinary background, it does not exhibit even the minimal degree of authorship required to justify registration. Although the Board is not prepared to say that the crown design contains no creative spark whatsoever, at best what creativity may be found in the design appears to the Board to be, in the words of Feist, 499 U.S. at 359, so trivial as to be virtually nonexistent.

The Board finds support for this conclusion in other case law as well. In John Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986), the court upheld a refusal to register a logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below, noting that the design lacked the minimal creativity necessary to support a copyright and that a "work of art" or a "pictorial, graphic or sculptural work ... must embody some creative authorship in its delineation of form". *See also* Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958) (cardboard star with two folding flaps allowing star to stand for display not copyrightable 'work of art'); Magic Marketing, Inc. v. Mailing Services of Pittsburgh, Inc., 634 F. Supp. 769 (W.D. Pa. 1986) (envelopes with black lines and words "gift check" or "priority message" did not contain minimal degree of creativity necessary for copyright protection); Forstmann Woolen Co. v. J. W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y. 1950) (label with words "Forstmann 100 % Virgin Wool" interwoven with three fleurs de lis held not copyrightable); The Homer Laughlin China Co. v. Oman, 1991 Copyright Law Decisions (CCH) ¶ 26,772 (D.D.C. 1991) (upholding refusal to register chinaware design pattern composed of simple variations or combinations of geometric designs due to insufficient creative authorship to merit copyright protection); Jon Woods Fashions v. Curran, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988)(upholding refusal to register fabric design consisting of striped cloth with small grid squares superimposed on the stripes where Register concluded design did not meet minimal level of creative authorship necessary for copyright); Tompkins Graphics, Inc. v. Zipatone, Inc., 1984 Copyright Law Decisions (CCH) ¶ 25,698 (E.D. Pa. 1983) (collection of various geometric shapes not copyrightable).

As you observe, Atari states that a "'distinguishable variation in the arrangement and manner of presentation' of public domain elements" may be protectible. However, the cases in which this doctrine was developed make clear that the "distinguishable variation" contributed by an author must be "more than a 'merely trivial' variation, something recognizably 'his own.'" Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102-103 (2d Cir. 1951). The Board is unable to recognize in the crown design any contribution by the designer that is "recognizably his own" and "more than merely trivial."

Your letter also relies on Atari for the proposition that if a design is not "practically inevitable," it must be copyrightable. However, the "practically inevitable"

language in Atari is found in a discussion of Feist's description of the arrangement of a white pages telephone directory and does not purport to proclaim a standard of copyrightability. See 979 F.2d at 245; *see also* Feist, 499 U.S. at 363. Neither Atari or Feist purported to hold that unless a contribution is "practically ineveitable," it is necessarily copyrightable.

Atari concerned an audiovisual work, the video game "Breakout," that involved substantially more authorship than the logo or design here. In Atari, the game consisted of a rectangular-shaped representation of a "paddle," that was used to "hit" a "ball" against a colored rectangular wall of "bricks"; it also included audio sounds when the ball came in contact with the paddle or wall. The court considered the game as a whole, including its full "series of related images," the interrelationship of which the court considered "crucial." 979 F.2d at 244. The court expressly accepted the Register's assertion that the individual graphic elements of each screen were not copyrightable. *Id.* The crown design is more akin to an individual graphic element of a video game screen than to the interrelationship of successive video game screens that Atari held to be copyrightable.

For the foregoing reasons, the Copyright Office must again refuse registration for a claim to copyright in the work entitled HILTON CROWN DESIGN but will issue a registration for HILTON PACKAGE DESIGN. This constitutes final agency action with respect to this claim.

Sincerely,



David O. Carson
General Counsel
for the Appeals Board
U.S. Copyright Office

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June 11, 1998

GENERAL COUNSEL
OF COPYRIGHT

JUN 15 1998

RECEIVED

VIA EXPRESS MAIL

SECOND APPEAL
Board of Appeals
Copyright GC/I&R, Attention: David Carson
P.O. Box 70400
Southwest Station
Washington, DC 20024

Re: SECOND APPEAL - BOARD OF APPEALS
Request for Reconsideration
Control Number 6-050-6051(C)

Dear Mr. Carson:

Further to my letter of October 23, 1997, I write to inquire as to the status of the above-referenced Second Appeal, requesting reconsideration of the Visual Arts Section's refusal to register certain drawings entitled "Hilton Crown Design" and "Hilton Package Design." Despite several telephone calls, I have not yet received any official communication from the Copyright Office regarding the disposition of this appeal.

As I noted in my previous letter, a final decision as to the registrability of these works will have significant consequences for my client's international anti-counterfeiting efforts. My client is still involved in anti-counterfeiting proceedings in Indonesia, the outcome of which may depend on my client's ability to obtain a U.S. copyright registration for these works. Thus, the need for an expeditious resolution of this appeal remains pressing.

RWC/RWC/21078/00/269215.01

I would appreciate any information your office is able to provide regarding the status of this appeal. I look forward to your response.

Sincerely,

Robert W. Clarida

cc: Arthur J. Greenbaum, Esq.
Charles I. Sherman, Esq. (by fax: (502) 568-7297)

COPYRIGHT OFFICE APPEALS BOARD

HILTON CROWN DESIGN
and
HILTON PACKAGE DESIGN
Brown & Williamson Tobacco Corporation
Robert W. Clarida, Attorney,
Cowan, Liebowitz & Latman, P.C.
Control No. 6-050-6051(C)

Issue: Copyrightability of a design

Prior Activity

These VA submissions were submitted on February 9, 1996, designated as 2-dimensional graphic works on GATT application forms for registration of claims to copyright in two "restored works" pursuant to the Uruguay Round Agreements Act (URAA). The claimant, Brown & Williamson Tobacco, Corporation was represented by attorney, Robert W. Clarida of the law firm, Cowan, Liebowitz & Latman. The two submissions are two-dimensional designs devoid of any copyrightable authorship.

The Copyright Office first refused to register the works in a letter dated August 7, 1996, sent by David Levy, Attorney Advisor, Visual Arts Section. The registrations were refused because the "elements" of the works either alone or in combination lacked the minimum copyrightable authorship upon which registrations could be made.

In a letter dated October 30, 1996, the applicant, through its attorney, Robert W. Clarida, requested a reconsideration of the initial rejections.In the context of the basic standards -

originality and creativity- of copyrightability, as articulated in Feist Publications v. Rural Telephone Services, 449 U.S. 340 (1991) and in Atari Games Corp. v. Oman, 979 F.2d 242 (D.C. Cir. 1992),he maintained that the works posses sufficient original authorship to warrant copyright protection.

On August 18, 1997, the Copyright Office, represented by Attorney Advisor, David Levy, again refused registration on the ground that "no elements either alone or in combination" of the works-"the single symbol and single label- "rise to the level of copyrightability" upon which a registration could be made.

In a letter dated October 22, 1997, the claimant/applicant. through its attorney, requested reconsideration and appealed for the second time.

ARGUMENT FOR REGISTRATION

The precedents pronounced in Feist and Atari reflect the current status of the law on copyrightability. The High Court held that the threshold of creativity is extremely low; even a slight amount will suffice. This quantum can be met either from a particular element of the work or from a combination or arrangement of the elements in the work as a whole. And all that is necessary is to show that the selection or arrangement and the overall effect of the combination is not com

mon place or producing an inevitable result.

As for originality no considerable uniqueness is required; the mere "distinguishable variation" from another work or works is sufficient to show that the work owes its origin to the author/creator asserting copyright.

"It is not the Register's task to shape the protection threshold or ratched it up beyond the 'minimum creative spark required by the Copyright Act and the Constitution'" 979 F.2d ar 247 (citation omitted).

Under Feist and Atari that minimum creative spark must be found in every instance where an author creates a distinguishable variation which is not a common place or practically inevitable. You cannot merely say the Feist threshold was not met. The Register must clearly articulate and explain its refusal to register in the context of the foregoing standards. That the Attorney Advisor did not do.

In the works in question, neither the particular combination or arrangement or juxtaposition of elements in the crown design nor the combination of the crown design with the lettering and triangle grid elements in the overall package design are so commonplace that they have to be expected as a matter of course or inevitable practical result.

ARGUMENT AGAINST REGISTRATION

The Register accepts and follows the law articulated in Feist and Atari. And within the parameters of those basic standards, the designs in question are neither sufficiently distinguishable nor uncommon or nontraditional in nature to rise above the common place or customary result. The petitioner with some justification argues the paucity of the Attorney Advisor's elucidation of the refusal to register rather than the substantive reasons why it should not have been rejected in the first place. The individual elements are in the public domain, and their combination or arrangement is typical and conventionally acceptable.