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Thomas A. Smart
Kaye, Scholer, Fierman, Hays & Handler, LLP
425 Park Avenue
New York, New York 10022-3598

COPYRIGHT
OFFICE

RE: STARS AND STRIPES DESIGN FOR CELLULAR TELEPHONE I
Control No. 60-708-0420(A)

Dear Mr. Smart:

101 Independence Avenue, S.E.

The Copyright Office Board of Appeals has reviewed your request for reconsideration of the Office's refusal to register a copyright claim in the above entitled work on behalf of your client, AT&T Corp. The Board has reviewed the claim and all correspondence from your office, regarding this claim, but has determined that the work cannot be registered because it lacks sufficient originality.

Washington, D.C.
20559-6000

Administrative Record

On October 5, 1999, the Copyright Office received an application for registration of the work entitled, Stars and Stripes Design for Cellular Telephone I. The nature of the work was identified as a 3-dimensional sculpture. The design is comprised of a series of horizontal red and white alternating stripes and a field of blue with white stars. The blue field with stars is affixed above the stripes at the top of the portable telephone.

By letter dated May 18, 2000, Visual Arts Examiner Geoffrey R. Henderson refused registration of the work because the design did not possess the minimal amount of original authorship needed to sustain a copyright registration. In support of his conclusion, he referenced the regulation that specifically states that a familiar symbol or design, typographic ornamentation, coloring and mere variations thereof are not copyrightable. 37 CFR § 202.1.

By letter dated July 28, 2000, Frank Politano, on behalf of AT&T, appealed the refusal to register the work and argued two basic points. First, he asserted that the Stars and Stripes design is a separable feature apart from the telephone, which admittedly is a useful article and as such not subject to copyright protection. Next, he argued that the Stars and Stripes design "is not a copy of any flag but rather a fanciful representation of a flag design that is evocative of the United States flag" and, consequently, contains a sufficient amount of creative authorship to merit copyright protection. In support of his second argument, he cites Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340 (1991), in which the court held that a

work need contain only "more than a *de minimis* quantum of" creativity to meet the threshold of originality required to support a copyright claim.

The Examining Division considered the first appeal and, in a letter dated October 27, 2000 from Attorney Advisor Virginia Giroux, determined that the design was conceptually separable from the utilitarian aspects of the telephone, but that the design elements, either alone or in combination, lacked sufficient original or artistic authorship to support registration of the work. Ms. Giroux's letter reiterated Mr. Henderson's conclusion that the Stars and Stripes design, including the color motif, is only a minor variation on the design of the American flag. Accordingly, the Examining Division upheld the initial refusal to register the works.

On February 21, 2001, you submitted a second appeal, requesting that the Office register the work. The premise for this appeal is simply that the work contains sufficient originality and that the examining attorney failed to correctly apply the legal principles set forth in Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951). To support your position, you note that a federal district court in California held that the depiction of the U.S. flag on a utilitarian object is copyrightable. See Int-Elect Engineering, Inc. v. Clinton Harley Corp., 27 U.S.P.Q. 2D (N.D. Cal. 1993). Furthermore, you argue that the Copyright Office has registered numerous works bearing designs that are variations of the American flag and imply that the AT&T work contains at least as much creative authorship as the earlier registered works.

Copyright Office registration decisions made on the merits of each work

When the Copyright Office Board of Appeals considers a work, it makes its decision upon a *de novo* review of the work at issue. It does not generally compare works in making its determination. Compendium of Copyright Office Practices, Compendium II ("Compendium II") § 108.03 (1984). Each decision of the Office to register a work is based solely on a determination whether sufficient creative authorship exists in the work and that work alone. The fact that on one or more previous occasions, individual examiners may have registered works that a disappointed claimant believes are similar to – or contain no more copyrightable authorship than – the claimant's work provides no basis for the Board to register the claim, especially when the propriety of the examiners' decisions to register the previous works was never reviewed by the Board. If the Board were to take up your invitation to review each of the 25 works described in the Declaration of John N. Jennison, it might well determine that most or all of the registrations for those works should not have been granted. An appeal from a refusal to register may not be transformed into a review of the propriety of past decisions to register other works.

De Minimis Authorship

The Board agrees that a work need contain only a "modicum of creativity" to sustain a claim for copyright protection, under the Feist standard. Moreover, the Board agrees that the Star and Stripes design is conceptually separable from the utilitarian aspects of the telephone.

See Compendium II, § 503.03. Nevertheless, the Board has determined that the elements in the Stars and Stripes design, whether considered as a whole or viewed as discrete elements, do not exhibit copyrightable authorship.

No registration is possible where the work consists solely of elements that either alone or in combination are incapable of supporting a copyright claim. Uncopyrightable elements include geometric figures or symbols, such as a rectangle, an arrow, and a five-pointed star. Compendium II, § 503.02(b) (1984); Bailie v. Fisher, 258 F2d 425 (D.C. Cir. 1958) (cardboard star with two folding flaps allowing star to stand for display not copyrightable 'work of art').

A simple, repetitive pattern of common shapes lacks the requisite minimal level of creativity needed to meet the decidedly low level of creativity needed to support your claim. In order to sustain a copyright, the creative expression must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations. Compendium II, § 503.03(b) (1984). See also, John Muller & Co. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986) (upholding Register's refusal to register a simple logo consisting of four angled lines which form an arrow and the word "Arrows" in cursive script below the arrow); Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988) (upholding Register's decision that fabric design consisting of striped cloth over which is superimposed a grid of 3/16" squares, even though "distinctly arranged or printed," did not contain a minimal amount of original artistic material to merit copyright protection); Homer Laughlin China Co. v. Oman, 22 U.S.P.Q. 2d 1074 (D.D.C. 1991) (upholding Register's determination that there was insufficient creative authorship in "Gothic" chinaware design pattern to merit copyright).

However, in your second letter of appeal, you argue that these cases are distinguishable because they deal only with two-dimensional designs and the designs "involved little if any creative expressions in the arrangement of the elements of the design." Nevertheless, the principles underlying the decisions in those cases would apply with equal force to an analysis of three-dimensional sculptural works, if that were the situation here. See, e.g., Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958) ; DBC of New York, Inc. v. Merit Diamond Corp., 768 F. Supp. 414 (S.D.N.Y. 1991) (upholding decision of Register of Copyrights denying registration for ring designs featuring triangular indentations on the ring band).

As an initial matter, we disagree with your characterization of the work as a three-dimensional sculpture and find that the design is merely a two-dimensional pattern applied to the surface of the telephone. The mere fact that the object to which the design is affixed is three-dimensional is not dispositive of the nature of the work at issue. In this case, the stars and stripes have no three dimensional aspects apart from the telephone. They merely have been affixed to the surface of the useful object and, as such, constitute a two-dimensional graphic design. In other words, the only possible authorship that is separable from the utilitarian aspects of the useful article is the two-dimensional graphic design that appears on the surface of the article.

Moreover, the Office disagrees with your conclusion that the Stars and Stripes design has more creative authorship than the works described in these cases. In making this determination, the Board applies the standard set forth in Feist Publications, Inc. v. Rural Tel. Serv. Co. Inc., 499 U.S. 340 (1991), in which the Supreme Court held that only a modicum of creativity is necessary to support a copyright. However, the Court also ruled in that case that some works fail to meet the standard. The Court observed that "as 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, and that there can be no copyright in work in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." Id. at 359.

For this reason, the Office has identified certain works, including words and short phrases, common shapes or designs, or simple arrangements of common elements such as letters, colors, or numbers, that do not embody copyrightable elements. See 37 CFR § 202.1(a). With respect to pictorial, graphic and sculptural works such as the work involved in this appeal, the Compendium states in § 501.02(a) that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." Common shapes, whether represented in a two-dimensional image or as part of a three-dimensional object, standard symbols, or mere coloration are not copyrightable, even with minor linear or spatial variations.

The Stars and Stripes design consists of eleven alternating red and white stripes with a slight curve in the lines on one side and a field of blue with eighteen stars. You assert that the blue field is not a rectangular but a curvilinear, irregular shape and that it includes the antenna as part of the design. Because of this geometric variation in the shape of the field of stars, you assert that it illustrates a "distinguishable variation" of the standard blue rectangle which is sufficient to support a copyright registration. Other variations cited in your reconsideration letter include the number of stars, the orientation of the stripes to the blue field of stars and the purported three-dimensional quality of the design, which taken together do invoke the American flag.

Nevertheless, these variations do not constitute sufficient original authorship to sustain a copyright registration. It appears that the field of stars on a blue background has its particular shape merely because the design is fitted to the contours of the telephone. There is also no discernable originality in placing a field of stars above alternating red and white stripes, since it merely follows the pattern of the American flag, a design already in the public domain, necessarily adapted to meet the constraints imposed by the shape of the telephone. The fact that the function keys fall within the field of blue is the result of the orientation of the pattern and does not appear to be a factor in the design itself. Likewise, the orientation of the stripes in relationship to the blue field is at best a trivial variation of the design of the American flag, and the Board finds the slight dip in the stripes to be merely a minor variation that fails to rise to the level of creativity required under the law.

To register this work based simply on the placement of the stars and stripes pattern on the surface of the cellular telephone, with the field of stars placed above the field of stripes, would be in effect to recognize that the claimant has the exclusive right to place a single image of the American flag over the entire surface of a cellular telephone. The constraints imposed by the shape of the telephone virtually dictate that the field of stars be placed above the field of stripes (or, at most, leave the designer with very little choice in the matter), and to recognize copyrightable authorship in the decision to have eleven fields of stripes below the field of stars, or to place the dividing line between the field of stars and the field of stripes at the top of the telephone's display screen, would be to recognize copyright in authorship that is *de minimis* at best. While a colorable argument for copyrightability might possibly be made for a depiction of the stars and stripes in a similar configuration divorced from the surface of a cellular telephone, the limitations necessarily imposed by the shape of the cellular telephone restrict the authorial choices so drastically in this case that the Board can discern no copyrightable authorship. See Morrissey v. Procter & Gamble Co., 379 F.2d 675 (1st Cir. 1967) (recognizing that where the subject matter can be expressed in only one or a limited number of ways, recognizing copyright in its expression would impermissibly appropriate the subject matter).

You also argue that recent case law supports your claim to registration, citing Int-Elect Engineering, Inc. v. Clinton Harley Corp., 27 U.S.P.Q.2d 1631 (N.D. Cal. 1993). In that case, the court found that a painting of a billowing American flag placed on a Yamaha motorcycle was a unique artistic creation and "more different than similar" to a similar depiction of the American flag on a particular helmet. However, the fact that the court in that case found that a particular rendering of the flag was "a unique artistic creation" does not mean that any star and stripe design will be copyrightable.

Similarly, the Appeals Board finds the other cases cited in support of your position unhelpful to a resolution of this appeal. In each case, the work at issue appears to have contained more creative authorship than that displayed in the Stars and Stripes design. See, e.g., Readers Digest Ass'n., Inc. v. Conservative Digest, Inc., 821 F.2d 800 (D.C. Cir. 1987) (a pre-Feist case in which the court, interpreting the originality requirement as meaning only that "the work is independently created, rather than copied from other works," found that the "distinctive arrangement and layout of" individually unprotectible elements was "entitled to protection as a graphic work ... a unique graphic design and layout"); Amplex Mf. Co. v. ABC Plastic Fabricators, Inc., 184 F. Supp. 285 (E.D. Pa. 1960) (finding a distinguishable arrangement and presentation of a pen-and-ink drawing of Egyptian lettering sufficiently original to support a copyright); Pantone, Inc. v. A.I. Friedman, Inc., 294 F. Supp. 545 (S.D.N.Y.1968) (a pre-Feist case finding more than a trivial variation in the selection and arrangement of bands of color presented in gradations moving from one basic hue to another). You also cited Hamil America, Inc. v. GFI, 193 F.3d 92 (2d Cir. 1999), but in that case the court never addressed the copyrightability of the fabric design, noting that the parties had stipulated in the lower court proceeding that a valid registration existed in the name of the appellee.

For the reasons stated above, the Appeals Board concludes that the design elements in the Stars and Stripes design, either alone or in combination, do not rise to the minimal level of creativity needed to support a copyright. The Board therefore affirms the Examining Division's decision to refuse to register this claim.

This letter constitutes final agency action.

Sincerely,

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