When the Copyright Office Hides the Ball

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Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991), holds that, for a valid copyright, "the requisite level of creativity is extremely low….. Originality does not signify novelty; a work may be original even though it closely resembles other works…." Although the court also says in passing, *id.,* that copies could not be original, the issue was not before it. Given the rest, it presumably meant slavish copies, not derivatives.

In most cases, unlike patent grants and trademark registrations, copyright registration under 17 U.S.C. § 410(a), is pro forma. One cause is lack of ability to determine whether a work is original. *See, e.g.,* The Bridgeman Art Library, Ltd. v. Corel Corp., 36 F.Supp.2d 191, 200 (S.D. N.Y. 1999): "No one disputes that most photographs are copyrightable. In consequence, the issuance of a certificate of registration for a photograph proves nothing. …. Here, the facts pertinent to the issue of originality are undisputed. The Court has held as a matter of law, and reiterates, that plaintiff's works are not original…." (Notes omitted.)

Occasionally the Copyright Office nevertheless cites lack of originality as a basis for rejection. Even when its concern seems to lie elsewhere, courts generally go along. In a notable exception, however, now-Justice Ginsburg writing for the court concludes: "The rational basis for finding the elements as combined and arranged… 'commonplace…' eludes us. It is the Register's duty, as it is ours, to heed… *Feist.* Therefore, we… remand… with instructions to again return the matter… to the Register for renewed consideration…." Atari Games Corp. v. Oman, 979 F.2d 242, 247 (D.C. Cir. 1992).

The Office probably had good instincts in *Atari,* but its rejection was not entitled to be upheld without well-articulated reasons. Oddzon Products, Inc. v. Oman, 924 F.2d 346 (D.C. Cir. 1991), stands in contrast. The work is described as "a patented, trademarked product formed of hundreds of floppy, wiggly, elastomeric filaments radiating from a core." *Id.* at 347. When the filaments are discounted as functional, without effective rebuttal, nothing distinguishes the ball in question from any other sphere, so rejection was properly sustained. Although the Office may have been concerned about overlapping types of IP of protection, lack of originality could stand alone.

That seems less true of other rejections. For example, in Coach, Inc. v. Peters, 386 F.Supp.2d 495, 496 (S.D. N.Y. 2005), the Board of Appeals affirmed rejection of applications to register two variations on what Coach called the "Signature CC Fabric Design." Yet "two linked Cs facing each other, alternating with two unlinked Cs facing in the same direction… were simply not sufficient to establish the necessary amount of creativity required for copyright protection." *Id.* (Internal punctuation omitted.) Given doubts about whether a free-standing painting containing essentially the same thing would be rejected (*see* Bridgeman, above), it is difficult not to conclude that the Office was otherwise motivated. If it was reluctant to register copyright for a graphic intended, and subsequently registered, as a trademark, it should have said as much. It did not, but the rejection was upheld on the reasons provided.

More recently, Darden v. Peters, 488 F.3d 277 (4th Cir. 2007), reviewed refusal to register a map and a web page, both derived from digital U.S. Census maps. Despite the inclusion of other elements, an examiner had said, "copyright does not protect familiar shapes, symbols, and designs… or mere variations of typographic ornamentation, lettering, fonts, or coloring." 488 F.3d at 281 (Internal quotation marks

omitted). The Board affirmed with regard to the map and found the application "for text, maps, and formatting of an Internet web page… simply *too broad* to warrant protection." 488 F.3d at 282 (Emphasis added, internal quotation marks omitted). At least with regard to Darden's web page, the Office probably discerned utility beyond its appearance or the information conveyed; *see* § 101("useful article"). But, again, that is not what it said.

More like trademarks than patents, copyrights exist under 17 U.S.C. § 102(a) without administrative action. Yet owners of copyright in works created in the United States are denied access to the courts without at least attempting to register; § 411(a). With prompt registration, copyright is presumed valid under § 410(c) and important remedial advantages are conferred under § 412(a). Without registration, neither is true, so it is not a trivial matter.

When registration is refused, § 701(e) provides that decisions may be reviewed under the Administrative Procedure Act (APA), 5 U.S.C. §§ 701-706. Of these, APA § 706, setting out the standards of review, is most relevant here. APA § 706(2)(B) ("contrary to constitutional right, power, privilege, or immunity") was urged in *Darden.* The court rejects it, however saying: "Darden cites no authority even remotely suggesting that any court has ever regarded the agency's routine decision to deny registration as having constitutional ramifications for the claimant." 488 F.3d at 284.

Rather, as in other cases reviewing under the APA, *Darden* applies APA § 706(2)(A) ("arbitrary, capricious, an abuse of discretion or otherwise not in accordance with law"). At least when testimony would be unnecessary to air key issues adequately, that seems appropriate. Yet, when the standards of *Feist* are facially met, something else is presumably afoot. Until courts press harder, the Office will continue to hide the ball, and issues concerning overlapping protection are less likely to be aired in the

courts.

Unsophisticated applicants should sometimes be advised that copyright registration may offer less than they expect, a copyright being neither a trademark nor a patent. That aside, the Register might heed Judge Nies' suggestion that trademark examiners attend to matters within their jurisdiction, and leave resolution of overlapping protection for another day — and probably another forum; In re DC Comics, Inc., 689 F.2d 1042, 1052 (CCPA 1982) (concurring opinion).