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Judicial Review, Copyrightability And the Register's Discretion: A New Direction

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JUDICIAL REVIEW, COPYRIGHTABILITY AND THE REGISTER'S DISCRETION: A NEW DIRECTION?

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I. INTRODUCTION

In this country, the right to copyright has its foundation in article I, section 8, clause 8 of the Constitution.¹ In utilizing its power over the years, Congress has enacted various copyright acts beginning in 1790.² While delineating in very general terms the au-

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1. This provision states that Congress shall have the power to "promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." U.S. CONST. art. I, § 8, cl.8.

2. See Act of May 31, 1790, ch. 15, 1 Stat. 124 (granted copyright protection to "au-

thority of the Register of Copyrights,³ these statutes⁴ and regulations⁵ also outline the conditions that must be met to acquire copyright registration.⁶ The current Copyright Act affords protection to "original works of authorship."⁷ Further, the copyrighted work does not have to be novel; it need only be original with the author.⁸ It is the expression of an idea that is entitled to copyright, not the idea itself.⁹

Parts II through IV of this Article discuss the scope of the Register of Copyrights' authority in determining a work's copyright status, given the implications, dicta and holdings of the re-

thors of any map, chart, book or books already printed"); Act of April 29, 1802, ch. 36, 2 Stat. 171 (designs); Act of February 3, 1831, ch. 16, 4 Stat. 436 (music); Act of August 18, 1856, ch. 169, 11 Stat. 138 (dramatic compositions); Act of March 3, 1865, ch. 126, 13 Stat. 540 (photographs and negatives); Act of July 8, 1870, ch. 230, 16 Stat. 198 (statues and models); Act of March 4, 1909, ch. 320, 35 Stat. 1075, *repealed by Copyright Act of 1976*, Pub. L. No. 94-553, 90 Stat. 2541 (substantial revision of the 1909 Act) (codified at 17 U.S.C. § 101 (1982)); Act of August 12, 1912, ch. 356, 37 Stat. 488 (motion pictures); Act of October 15, 1971, Pub. L. No. 92-140, 85 Stat. 391 (sound recordings); Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2541 (substantial revision of the 1909 Act) (codified at 17 U.S.C. § 101 (1982)); Act of December 12, 1980, Pub. L. No. 96-517, § 10(a), 94 Stat. 3028 (computer programs). *See also* Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988). When this Article refers to the 1976 Copyright Act, it includes the 1988 Berne Convention Implementation Act amendments, which took effect March 1, 1989. Where prior versions of the Act are cited, they will be so indicated.

3. The Register of Copyrights and the subordinate officers and employees of the Copyright Office are appointed by the Librarian of Congress, and act under his or her general direction and supervision. *See* 17 U.S.C. § 701 (1988). The Register is authorized to "establish regulations not inconsistent with law for the administration of the functions and duties made the responsibility of the Register under this title. All regulations established by the Register under this title are subject to the approval of the Librarian of Congress." 17 U.S.C. § 702 (1988).

4. The text of 17 U.S.C. § 408(a) (1988) reads as follows:

At any time during the subsistence of copyright in any published or unpublished work, the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 [describing application for copyright] and 708 [setting out copyright office fees]. . . . Such registration is not a condition of copyright protection.

17 U.S.C. § 408(a) (1988).

5. The registration of copyright is governed by 37 C.F.R. § 202.3: "This section prescribes conditions for the registration of copyright, and the application to be made for registration under sections 408 and 409 of Title 17 of the United States Code, amended by Pub. L. 94-553." 37 C.F.R. § 202.3 (1989).

6. The Copyright Office at times has had difficulty in deciding which types of works should be afforded registration. Recently, the Register was dealing with this dilemma on a daily basis. *See* Samuelson, *CONTU Revisited: The Case Against Copyright Protection for Computer Programs in Machine-readable Form*, 1984 DUKE L.J. 663, 692 n.109.

7. 17 U.S.C. § 102(a) (1988).

8. *Reader's Digest Ass'n, Inc. v. Conservative Digest, Inc.*, 821 F.2d 800, 806 (D.C. Cir. 1987).

9. *Baker v. Selden*, 101 U.S. 99, 103 (1879).

viewing federal courts. This analysis will focus mainly on the law as it exists today; however, the opinions decided under prior copyright acts are still valuable from a legal standpoint because the criteria for registration were as nebulous under the prior law as they are today. Parts V, VI and VII place in perspective the emergence of a partial or possibly total usurpation of the Register's discretion in the area of copyright registration, and evaluate the significant ramifications and practical effects of a recent decision by the District of Columbia Court of Appeals.

II. REGISTRATION

Why register a work? As to works created on or after January 1, 1978, registration is not a prerequisite to the existence of a copyright.¹⁰ The moment the work is created—that is, the first time the work is fixed in a copy or phonorecord—copyright is automatic to that work.¹¹ Therefore, as to works published from January 1978 through February 1989, registration is needed only to cure a prior publication without a copyright notice.¹² The Berne Convention Implementation Act¹³ has made registration less significant for copyright protection¹⁴—for works first published on or after March 1, 1989, failure to register the work will never introduce that work into the public domain.¹⁵

As to some works created from January 1, 1978, until March 1, 1989,¹⁶ registration may be a condition to the continued existence of a copyright.¹⁷ Registration becomes necessary for these works after a relatively small number of copies or phonorecords of the work have been published without a copyright notice.¹⁸ Unless re-

10. 2 M. NIMMER & D. NIMMER, *NIMMER ON COPYRIGHT* § 7.16 [A] (1989) [hereinafter NIMMER].

11. *Id.* See 17 U.S.C. § 101 (1988). See also H.R. REP. No. 1476, 94th Cong., 2d Sess. 146, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5762 ("the outright omission of a copyright notice does not automatically forfeit protection and throw the work into the public domain").

12. NIMMER, *supra* note 10, at § 7.16 [A].

13. Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988).

14. The Berne Convention amendments of 1988 attempt to shift American copyright law toward a more European perspective—that is, to rid the law of its fixation with formalities. For example, copyright notice was prospectively eliminated as a condition to copyright protection. NIMMER, *supra* note 10, at § 7.01.

15. *Id.* at § 7.16[A].

16. The effective date of the Berne Convention Implementation Act was March 1, 1989.

17. NIMMER, *supra* note 10, at § 7.16 [A].

18. *Id.* See *Valve & Primer Corp. v. Valve-Matic & Mfg. Corp.*, 730 F. Supp. 141 (N.D. Ill. 1990). But see *Donald Frederick Evans and Assoc. v. Continental Homes, Inc.*, 785 F.2d

gistration has occurred prior to publication, or within five years thereafter, the copyright is in the public domain.¹⁹

For works created before January 1, 1978, registration was not a condition to copyright because these works were first protected by common law copyright rules and received automatic statutory copyright on January 1, 1978.²⁰ Under the 1909 Act, works obtained statutory copyright status, without registration, when copies of the work were published and displayed a proper copyright notice.²¹ Thus, registration was not needed to create the copyright, but only to record it.²² Once the copyright had been obtained by publication with notice, the author then had to comply with the requirements of section 13 of the 1909 Act.²³ Where the work for which copyright protection was sought was unpublished, the 1909 Act required registration and deposit as a condition precedent to statutory copyright.²⁴ If the work was not registered and deposited as required by the 1909 Act, only common law copyright protection remained.²⁵ As is true of works created from January 1, 1978 until March 1, 1989, registration of works created prior to 1978 is necessary in order for the existence of the copyright to continue.²⁶ Although registration²⁷ may not be a prerequisite for the existence of a copyright, registration is clearly a condition precedent to the filing of an infringement action under both the 1909 Act²⁸ and the 1976 Act (excluding the Berne Convention Implementation Act amendments).²⁹

897 (11th Cir. 1986).

19. NIMMER, *supra* note 10, at § 7.16 [A].

20. *Id.*

21. *Id.*

22. *Id.*

23. Section 13 of the 1909 Copyright Act required that once copyright had been obtained by publication with notice, a requisite number of copies and the registration claim had to be deposited. *Id.*

24. *Id.*

25. *Id.*

26. *Id.*

27. For purposes of an infringement action, the effective date of copyright registration is the day on which the application, deposit, and fee, subsequently determined by either the court or Copyright Office to be acceptable, have been received by the Copyright Office. 17 U.S.C. § 410(d) (1988).

28. NIMMER, *supra* note 10, at § 7.16 [B]. See *Vacheron & Constantin-Le Coultre Watches Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958). See also *infra* notes 53-59 and accompanying text.

29. NIMMER, *supra* note 10, at § 7.16 [B]. The 1976 Act provision, codified at 17 U.S.C. § 411(a) (1982), merely reiterated the 1909 Act's provision. Before the Berne Convention Implementation Act amendments, attempted registration sufficed under the 1976 Act. See *Gemveto Jewelry Co., Inc. v. Jeff Cooper Inc.*, 568 F. Supp. 319, 329 (S.D.N.Y. 1983). See generally R.J. FRACKMAN, *LITIGATION COPYRIGHT CASES* (1988).

There are two exceptions to the requirement of registration prior to the institution of an infringement action. First, for infringements occurring after March 1, 1989, where the claimant's country of origin is not the United States, registration is not a prerequisite to filing suit.³⁰ Second, when the work consists of sounds, images, or both, and the work is first fixed simultaneously with its transmission, an action for infringement may be filed prior to registration.³¹

In addition to being a condition precedent to the filing of an infringement action, registration of copyright is required in order for a copyright owner to be entitled to recover statutory damages and attorney's fees arising from an infringement action.³² Although loss of copyright protection may not be the result of failure to register, in order to be financially compensated for an infringement, registration is essential.

Other incentives for registration also exist. First, the copyright registration certificate constitutes prima facie evidence of the validity of the copyright and the facts stated in the certificate.³³ This is true under the current Act, however, only if registration is made before or within five years after first publication of the work.³⁴ Second, the registration documents act as constructive notice of copyright and of all facts stated in those documents.³⁵ Third, as indicated above, registration may be a condition to the continued existence of copyright in a work. Fourth, a special certificate of registration obtained from the Office of Copyright is needed for the United States Customs Service to bar the importation of piratical copies or phonorecords of a registered work.³⁶ Finally, registration is useful for actual notice of copyright to those who search the records of the Office of Copyright.

III. STANDARD OF REVIEW

Although the Register of Copyrights is appointed by the Librarian of Congress, the Register's discretionary acts are not sub-

30. NIMMER, *supra* note 10, at § 7.16 [B]. See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988).

31. NIMMER, *supra* note 10, at § 7.16 [B]. See 17 U.S.C. § 411(b) (1988).

32. 17 U.S.C. § 412 (1988).

33. NIMMER, *supra* note 10, at 7.16 [D]. See 17 U.S.C. § 410(c) (1988); *M. Kramer Mfg. Co., Inc. v. Andrews*, 783 F.2d 421, 434 (4th Cir. 1986); *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 780 (S.D.N.Y. 1968).

34. NIMMER, *supra* note 10, at § 7.16 [D].

35. *Id.* at § 7.16 [E]. See 17 U.S.C. § 205(c)(2) (1988).

36. 19 C.F.R. § 133.33(a)(1) (1990).

ject to review by the Librarian.³⁷ However, the decisions of the Register are subject to judicial review.³⁸ The standard of review a court must use in evaluating the Register's decisions is governed by the Administrative Procedure Act (APA).³⁹ Courts have interpreted the APA to mandate that the decisions of the Register must stand unless an abuse of discretion is found.⁴⁰

IV. REGISTER'S DISCRETION

A. *Bouve v. Twentieth Century-Fox*

In *Bouve v. Twentieth Century-Fox Film Corp.*,⁴¹ the District of Columbia Circuit Court held that the Register of Copyrights was incorrect in refusing registration to a collection of twenty articles that a party attempted to register as a book.⁴² The Register's position was that the articles had to be registered separately, thus requiring a two dollar fee for each.⁴³ In upholding the district court, the court of appeals commented: "[W]e are persuaded . . . that the Register . . . acted upon a clearly erroneous conclusion of law; that he . . . refused to perform a ministerial duty imposed upon him by the law; and that the order of the District Court was correct."⁴⁴ *Bouve*, decided under the Copyright Act of 1909,⁴⁵ signaled

37. See 40 Op. Att'y Gen. 263 (1941).

38. NIMMER, *supra* note 10, at § 7.21 [A].

39. *Id.* 5 U.S.C. § 701(d) (1988) specifies that most actions (with some exceptions not applicable here) of the Register of Copyrights are subject to the provisions of the Administrative Procedure Act. The Act mandates that a reviewing court shall "hold unlawful and set aside agency action, findings, and conclusions found to be arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law." 5 U.S.C. § 706(2)(A) (1988).

40. See, e.g., *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986) ("[t]he Register's decisions are subject to judicial review, but only on an abuse of discretion standard"); *Norris Indus., Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir.) ("[b]ut our view of the uncontradicted evidence . . . reveals no abuse of administrative discretion by the Register"), *cert. denied*, 464 U.S. 818 (1983); *Esquire, Inc. v. Ringer*, 591 F.2d 796, 806 (D.C. Cir. 1978) ("the application of the regulation to the facts presented by [the applicant's] copyright applications unquestionably involved the exercise of administrative discretion"), *cert. denied*, 440 U.S. 908, *reh'g denied*, 441 U.S. 917 (1979); *Gemveto Jewelry Co. v. Jeff Cooper Inc.*, 568 F. Supp. 319, 330 (S.D.N.Y. 1983) ("the scope of judicial review is limited to whether the decision was 'arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law'").

41. 122 F.2d 51 (D.C. Cir. 1941)

42. *Id.* at 56.

43. *Id.* at 52.

44. *Id.* at 56.

45. The *Bouve* court wrote: "Section 10 of the [1909] Act provides that a person entitled to secure a copyright may obtain registration of his claim by complying with the provisions of the Act, and upon compliance the Register shall issue the certificate. . . ." *Id.* at 52 (emphasis added) (footnote omitted). The statutory equivalent of this section in the Act of 1976 now reads:

a gradual decline in the discretion of the Register.⁴⁶

Interestingly, several years later, the District of Columbia Circuit Court relied on *Bouve* to uphold the discretion of the Register.⁴⁷ In *Bailie v. Fisher*,⁴⁸ the court held that a cardboard star, which had two folded flaps that enabled it to stand, was not a "work of art" under the Copyright Act,⁴⁹ and therefore was not proper subject-matter for copyright protection.⁵⁰ The *Bailie* court, interpreting the identical language as the *Bouve* court, found that the Register was entitled to exercise some degree of discretion: "The Register's discretion is not uncontrolled, but is subject to judicial review and correction."⁵¹ In *Bouve*, the court did not allow the Register to decide whether the articles had to be registered separately. It is important to note that the Register was not refusing registration per se, but was merely selecting the label put on it.⁵²

B. *Vacheron v. Benrus*

In the same year that the District of Columbia Circuit Court decided *Bailie*, the Second Circuit handed down its opinion in *Vacheron & Constantin-Le Coultre Watches Inc. v. Benrus Watch Co.*⁵³ Judge Learned Hand, writing for a majority of the court, found that the Register's decision not to issue a copyright registra-

When, after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application, together with the number and effective date of the registration.

17 U.S.C. § 410(a) (1988) (emphasis added).

46. See *infra* text accompanying notes 75-78.

47. The D. C. Circuit Court commented: "It seems obvious, also, that the [Copyright] Act establishes a wide range of selection within which discretion must be exercised by the Register in determining what he has no power to accept." *Bailie v. Fisher*, 258 F.2d 425, 426 (D.C. Cir. 1958) (quoting *Bouve v. Twentieth Century-Fox Film Corp.*, 122 F.2d 51, 53 (D.C. Cir. 1941)). See *infra* notes 163-69 and accompanying text for further commentary on the *Bailie* decision.

48. 258 F.2d 425 (D.C. Cir. 1958).

49. *Id.* at 426.

50. *Id.*

51. *Id.* (quoting *Bouve*, 122 F.2d at 53).

52. "The Register of Copyrights refused registration upon the ground that the material was not a book but, instead, was page proof of twenty contributions to periodicals. . . ." *Bouve*, 122 F.2d at 52 (emphasis in original).

53. 260 F.2d 637 (2d Cir. 1958).

tion certificate for an artistic watchface design⁵⁴ under the statutory provision allowing the copyrighting of works of art foreclosed an infringement action.⁵⁵ In dissent, Chief Judge Clark countered that the court had no business ignoring the copyright issue because the Register's refusal to issue a certificate of copyright was an erroneous ruling, and beyond the authority of the official making it.⁵⁶ Further, he doubted if the ministerial grant of a certificate was a condition precedent to a suit for copyright,⁵⁷ noting that "the opinion herewith, while assuming copyrightability for the purposes of decision, finds a technical barrier against all relief under the Copyright Act because the Register of Copyrights had refused a certificate."⁵⁸ What is ironic about this dissent is that the majority opinion also concluded that the Register had no discretion.⁵⁹ It was the court's reluctance to act on the Register's refusal to issue a certificate that placed the two sides at odds.

C. *Esquire, Inc. v. Ringer*

The lack of uniformity in this area has become greater and more poignant as courts have reviewed the Register's decisions. In *Esquire, Inc. v. Ringer*,⁶⁰ copyright was sought for artistic lighting fixtures. The Register refused to register the copyright because

54. Judge Hand wrote: "It is true that 'works of art' is a loose phrase whose perimeter is hard to define; nevertheless, the decision here did not demand the exercise of a discretion that was conclusive with the Register[]" in light of the fact that mandamus was available. *Id.* at 640. For a thorough discussion on the protection of ornamental designs under intellectual property law, see generally J.H. Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Convention Revision of 1948 to the Copyright Act of 1976*, 1983 DUKE L.J. 1143. For a discussion of registration under the current Act, as well as the 1909 Act, see *supra* notes 10-36 and accompanying text.

55. Judge Hand concluded in somewhat inconsistent terms:

We do not think it necessary to decide whether the plaintiff's watch was copyrightable . . . arguendo, we will assume that it was. We think however, that even so, § 13 of Title 17 [Copyright Act of 1909's infringement section] forbade any action for infringement of the copyright when the Register . . . had refused, as he did, to accept the watch. . . .

Vacheron, 260 F.2d at 639.

56. *Id.* at 644 (Clark, C.J., dissenting).

57. *Id.* This was the first opinion to establish that registration was a prerequisite to an infringement action under the 1909 Act.

58. *Id.* Another factor that troubled Chief Judge Clark was that the court reached this conclusion despite the fact that the Supreme Court had recently held that an ornamental design did not cease to be artistic when embodied in a useful article and therefore could be entitled to copyright protection. See *Mazer v. Stein*, 347 U.S. 201, *reh'g denied*, 347 U.S. 949 (1954).

59. See *infra* notes 138-46 and accompanying text.

60. 591 F.2d 796, 806 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908, *reh'g denied*, 441 U.S. 917 (1979).

federal regulations prohibited copyright of the design of a utilitarian article, like the objects in question, when all the design elements were directly related to the useful functions of the article.⁶¹ The district court issued a writ of mandamus directing the Register to issue a certificate of registration for the lighting fixture designs.⁶² The District of Columbia Circuit Court reversed, explaining that the Register had adopted a "reasonable and well supported interpretation" of the federal regulation.⁶³ The court emphasized that "[c]onsiderable weight [was] to be given to an agency's interpretation of its regulations. . . . This [was] particularly so if an administrative interpretation relate[d] to a matter within the field of administrative expertise and ha[d] been consistently followed for a significant period of time."⁶⁴ The court acknowledged that in this subject matter area, the Copyright Office's decisions had been consistently followed for a significant period of time.⁶⁵ The district court, however, had reviewed the same opinions and had arrived at the opposite conclusion.⁶⁶

D. *Cablevision v. Motion Picture Association*

In *Cablevision Sys. Dev. Co. v. Motion Picture Ass'n of America, Inc.*,⁶⁷ a trade association representing the cable television industry, and Cablevision, an individual cable company, brought an action against several copyright owners for a declaration as to the interpretation of a statute⁶⁸ that allowed copyright owners of distant non-network programs to receive a portion of fees paid to cable systems by subscribers. The owners brought a counterclaim for infringement. The district court invalidated the regulations promulgated under the statute by the Copyright Office and dismissed the counterclaim.⁶⁹

61. *Esquire*, 591 F.2d at 798.

62. *Id.* at 799.

63. *Id.* at 800. See also 37 C.F.R. § 202.10(c) (1976).

64. *Esquire*, 591 F.2d at 801 (citing *Southern Mutual Help Ass'n v. Califano*, 574 F.2d 518, 526 (D.C. Cir. 1977)).

65. *Id.* at 802.

66. *Id.*

67. 836 F.2d 599 (D.C. Cir.), *cert. denied*, 487 U.S. 1235 (1988).

68. The Copyright Act of 1976 granted television systems a license to retransmit copyrighted broadcast programming to subscribers and requires in return that the system deposit with the Copyright Office a fee equal to a specified percentage of gross receipts from subscribers to the cable service for the basic service of providing secondary transmissions of primary broadcast transmitters. See 17 U.S.C. §§ 111(c)(1), (d)(1)(B) (1982 & Supp. IV 1986).

69. *Cablevision*, 836 F.2d at 607.

The District of Columbia Circuit Court reversed. Judge Silberman, delivering the majority opinion, expressed the view that the reasonable interpretations of the statute and the regulations by the Copyright Office were due judicial deference.⁷⁰ The court specifically mentioned that “[i]f we agreed that the Copyright Office had no power to interpret the statute, every dispute over the meaning of the statute could give rise to an infringement action. . . .”⁷¹ The court found this to be especially true in an area such as the cable industry, where the Copyright Office had greater expertise than the federal courts.⁷²

The language in the case indicating that deference be given to the Register should be construed in a limited fashion for two reasons. First, the opinion concerns an infringement action and not one dealing directly with the issue of registration. Second, the opinion is narrowly tailored and limited to the statute in question because the legislative history indicated that Congress gave the Copyright Office great discretion in this area.⁷³ Nevertheless, Judge Silberman realized that the erosion of the Copyright Office’s discretion could lead to burdensome results for the federal courts.⁷⁴

Courts have interpreted the provisions analyzed in the *Cablevision* and *Esquire* decisions to stand for the proposition that the determination to register a work rests within the sound discretion of the Register,⁷⁵ and that decisions of the Copyright Office should be given considerable weight.⁷⁶ Thus, some courts are inclined to give strong deference to the Register’s decisions,⁷⁷ despite

70. *Id.* at 608.

71. *Id.*

72. *Id.*

73. *Id.* at 607-10.

74. In reaching its result, the court distinguished *Bartok v. Boosey & Hawkes, Inc.*, 523 F.2d 941 (2d Cir. 1975). In *Bartok*, the Copyright Office defined the term “posthumous” on a form. The Second Circuit held that “the Copyright Office has no authority to give opinions or define legal terms and its interpretation on an issue never before decided should not be given controlling weight.” *Id.* at 946-47. The court in *Cablevision* found *Bartok* inapplicable, interpreting the above quoted language as dictum. In *Bartok*, the Copyright Office’s interpretation of a statute was found to be inconsistent with legislative intent, as opposed to the situation involved in *Cablevision*. See *Cablevision*, 836 F.2d at 609-10.

75. See also *Public Affairs Ass’n, Inc. v. Rickover*, 268 F. Supp. 444, 448 (D.D.C. 1967); NIMMER, *supra* note 10, at § 7.21[A].

76. See generally *DeSylva v. Ballentine*, 351 U.S. 570, 577-78, *reh’g denied*, 352 U.S. 859 (1956); *Mazer v. Stein*, 347 U.S. 201, 212-13, *reh’g denied*, 347 U.S. 949 (1954); *Eltra Corp. v. Ringer*, 579 F.2d 294 (4th Cir. 1978); *Hoffenberg v. Kaminstein*, 396 F.2d 684 (D.C. Cir.), *cert. denied*, 393 U.S. 913 (1968).

77. In *Xerox Corp. v. Apple Computer, Inc.*, 734 F. Supp. 1542, 1549 (N.D. Ca. 1990), the court demonstrated its reluctance to review cases involving the Register’s discretion, writing: “A number of considerations militate against the conclusion that Congress intended

an occasional attempt to curb its discretion.⁷⁸

V. A CRITICAL CHALLENGE TO THE REGISTER'S DISCRETION: *Atari v. Oman*

A decisive step has been taken by the District of Columbia Circuit Court to the extent that the Copyright Office's discretion over initial copyright registration is now in doubt. The remainder of this Article focuses on what justifies this conclusion, and discusses its implications.

A. Background

The District of Columbia Circuit Court in *Atari Games Corp. v. Oman*⁷⁹ found that the Register of Copyrights abused its discretion when it failed to account for its ruling to deny initial copyright registration for the video game BREAKOUT.⁸⁰ With this decision, the District of Columbia Circuit embarked on a high level of judicial scrutiny of the Register's decisions, ending a history of fairly unfettered discretion on the Register's part.⁸¹ The District of Columbia Circuit took this rare step because of the Register's clear abuse of settled copyright law.⁸²

courts to be in the business of cancelling copyrights."

78. See, e.g., *Bouve*, *supra* notes 41-52 and accompanying text.

79. 888 F.2d 878 (D.C. Cir. 1989).

80. *Id.* at 879. BREAKOUT was an audiovisual computer video game created in 1975 by Atari, Inc. the predecessor of the present plaintiff-appellant Atari Games Corporation. *Id.* For a description of BREAKOUT as a video game see *infra* notes 88, 187.

81. See *Atari*, 888 F.2d at 890 (Silberman, J., concurring). Aside from *Bouve* and *Atari*, these authors have found no other instances since 1941 where an appellate court has reversed the Register's denial of initial copyright registration. There are four instances of the Register's copyright denials being upheld by appellate courts. See *Brandir Int'l, Inc. v. Cascade Pacific Lumber*, 834 F.2d 1142 (2d Cir. 1987) (district court had also upheld the Register's copyright denial); *Norris Indus., Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir.) (district court had upheld four copyright denials by the Register of Copyrights and one grant of copyright registration; appellate court upheld same four denials but invalidated the one copyright registration granted by the Register), *cert. denied*, 464 U.S. 818 (1983); *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978) (district court reversed the Register's copyright denial), *cert. denied*, 440 U.S. 908, *reh'g denied*, 441 U.S. 917 (1979); *Bailie v. Fisher*, 258 F.2d 425 (D.C. Cir. 1958) (district court upheld the Register's copyright denial).

There have been two instances where the Register's copyright denials have been upheld by district courts with no appeals. See *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q. 2d 1870 (S.D.N.Y. 1988); *Gemveto Jewelry Co., Inc. v. Jeff Cooper Inc.*, 568 F. Supp. 319 (S.D.N.Y. 1983).

82. The *Atari* court was unable to determine whether "the Register's action comport[ed] with the demand of reasoned decisionmaking," or ascertain the Register's application of the "relevant statutory prescriptions." *Atari*, 888 F.2d at 879, 881. The court was likewise adamant in guarding against "rudderless administrative pronouncements," de-

B. Implications

The strict approach taken by the *Atari* court⁸³ regarding initial copyright denials has significant implications, and profoundly impacts both the Copyright Office's discretion in deciding initial copyright status and its reconsideration of such denials of copyrightability on remand. The D.C. Circuit justified its mandate because of the Register's failure to adequately explain the legal and statutory bases for denying copyright registration to Atari's video game.⁸⁴ This failure likewise prompted the court to specifically set out the prevailing case law parameters within which the Copyright Office should reevaluate its determination to be "consistent with the rulings of courts and the analysis of scholars."⁸⁵

These implications are by no means limited to copyright decisions involving video games. The *Atari* approach encompasses all initial denials of copyright registration, regardless of the type of material, subject matter, or work submitted. It further includes both the reversal of any questionable denial and the encouragement to register any copyright application not definitively uncopyrightable.⁸⁶

Justifications for these implications exist, and are illustrated by analyzing (1) the District of Columbia Circuit Court's specific evaluation and rejection of the Register's denial of Atari's copyright application, and (2) the current settled state of copyright law concerning computer programs, video games and their audiovisual screen displays.

C. Register's Determination

In early 1987, Atari sought expedited registration of a copyright claim in the audiovisual display of its video game⁸⁷

mandating that "executive agencies hew to principled 'legal theory' and . . . not indulge in 'ad hocery.'" *Id.* at 881 (emphasis added) (quoting *Pacific Northwest Newspaper Guild v. NLRB*, 877 F.2d 998, 1003 (D.C. Cir. 1989) and *Kamargo Corp. v. FERC*, 852 F.2d 1392, 1398 (D.C. Cir. 1988)).

83. See *supra* notes 81-82. For further discussion of this approach, see Sunstein, *Deregulation and the Hard Look Doctrine*, 1983 SUP. CT. REV. 177; Leventhal, *Environmental Decisionmaking and the Role of the Courts*, 122 U. PA. L. REV. 509 (1974); Shapiro & Levy, *Heightened Scrutiny of the Fourth Branch: Separation of Powers and the Requirement of Adequate Reasons for Agency Decisions*, 1987 DUKE L.J. 387.

84. *Atari*, 888 F.2d at 882.

85. *Id.* at 890 (Silberman, J., concurring).

86. *Id.*

87. The acceptance of video games as copyrightable audiovisual works was conclusively established after the 1980 Copyright Act (for computer programs). See 17 U.S.C. §§ 101, 117 (1982). The Act brought computer programs within the embrace of copyright pro-

BREAKOUT, a computer video game in the form of a "ball and paddle" game similar to a solitary ping-pong or tennis game.⁸⁸ Notably, both the audiovisual screen display of a video game and its underlying computer program (i.e., the computer program that generates the audiovisual aspects of the video game) can receive separate copyright status.⁸⁹

The audiovisual display of a video game can be copyrighted as long as the screen display has some expression that is original and fixed in a tangible medium of expression.⁹⁰ Video screen displays have been held to contain the requisite fixation for copyrightability because the displays are contained in the computer program and can be generated from the program.⁹¹

Obtaining a copyright of the audiovisual screen display protects the underlying computer program under 17 U.S.C. section 106(1).⁹² If copyright for the audiovisual screen display is denied, it may still be obtained for the underlying computer program.⁹³ Procuring copyright in the underlying computer program, however, may not securely protect the audiovisual screen display of that program because many different computer programs can produce the same audiovisual display.⁹⁴

tection by including the definition of a computer program (which was recommended by the Commission On New Technological Uses (CONTU)) in 17 U.S.C. § 101: "A 'computer program' is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result." 17 U.S.C. § 101 (1982). See also *Apple Computer v. Franklin Computer Corp.*, 714 F.2d 1240 (3d Cir. 1983) (the 1980 Act extends copyright protection to the computer's operating system), *cert. dismissed*, 464 U.S. 1033 (1984).

88. In the words of the circuit court:

BREAKOUT'S audiovisual display features a wall formed by red, amber, green, and blue layers of rectangles representing bricks. A player maneuvers a control knob that causes a rectangular-shaped representation of a paddle to hit a square-shaped representation of a ball against the brick wall. When the ball hits a brick, that brick disappears from its row, the player scores points, and a brick on a higher row becomes exposed. . . . Various tones sound as the ball touches different objects or places on the screen. The size of the paddle diminishes and the motion of the ball accelerates as the game is played.

Atari, 888 F.2d at 879. See *infra* note 187 for the Copyright Office's description of **BREAKOUT**.

89. See, e.g., *Midway Mfg. v. Strohon*, 564 F. Supp. 741, 749 (N.D. Ill. 1983); *Stern Elecs., Inc. v. Kaufman*, 669 F.2d 852, 856 (2d Cir. 1982).

90. *Atari*, 888 F.2d at 882, 884.

91. See, e.g., *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 433-42 (4th Cir. 1986).

92. See *id.* at 441-42; *Sterns Elecs., Inc.*, 669 F.2d at 856.

93. In fact, in the Register's final denial of the registration of Atari's video game screen display, the Copyright Office specifically noted that Atari was not precluded "from registering a claim in [**BREAKOUT'S**] computer program." *Atari*, 888 F.2d at 880. See also *Atari Games Corp. v. Oman*, 693 F. Supp. 1204, 1206 n.6 (D.D.C. 1988), *rev'd*, 888 F.2d 878 (D.C. Cir. 1989).

94. There could be three different programs all individually copyrighted but none

Atari sought copyright registration in anticipation of infringement litigation in which it would be plaintiff, and wanted its video game to be copyrighted before the commencement of that suit.⁹⁵ In February, May, and December of 1987, the Register denied Atari's application to copyright BREAKOUT.⁹⁶

The Register's bases for the denials were three-fold. First, the common geometric shapes used in the audiovisual display (*i.e.*, the use of a square for a ball, a rectangle for a paddle, four colored layers of rectangles to represent bricks), their coloring, and the accompanying sounds (*i.e.*, three tones before the ball is released and a string of double tones afterwards) did not constitute copyrightable subject matter.⁹⁷ These features, neither independently nor in their arrangement as a whole, qualified for copyright protection because they were too ordinary and were merely "familiar symbols or designs."⁹⁸ The Register's second justification centered on the lack of creative authorship.⁹⁹ The Register found that the "images . . . created by playing the video game . . . [were] also not registrable since they [were] created randomly by the player and not by the author of the video game."¹⁰⁰ Finally, the Register determined that "the arrangement of the 'stationary screen display' contain[ed] no copyrightable authorship because 'so few items' appear[ed] on the screen and 'the arrangement [was] basically dictated by the functional requirements of this or similar backboard type games.'"¹⁰¹ In other words, BREAKOUT represented no more than a video game idea—that is, a generic video game.

Even though the Register acknowledged BREAKOUT as an audiovisual work, it nevertheless rejected Atari's application.¹⁰² Af-

would protect the audiovisual screen display itself. *Atari*, 888 F.2d at 886.

95. *Atari*, 888 F.2d at 886 (Silberman, J., concurring). See also *Atari Games Corp. v. Romstar, Inc.*, 87 Civ. 9504 (N.D. Ill.). For the strategic advantages of having a work copyrighted before the commencement of an infringement suit, see *supra* notes 10-36.

96. *Atari Games Corp. v. Oman*, 693 F. Supp. 1204 (D.C.C. 1988), *rev'd*, 888 F.2d 878 (D.C. Cir. 1989). The three separate denials, totalling some seven single-spaced pages, consisted of a first denial letter of February 1987, a reconfirmed denial on reconsideration in a May 1987 letter, and a final denial letter of December 1987. *Id.* at 1206.

97. *Id.*

98. *Id.*

99. *Id.*

100. *Atari*, 888 F.2d at 880.

101. *Id.*

102. *Atari*, 888 F.2d at 879-80. The Copyright Act defines "audiovisual works" as: works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.

ter the final denial in December 1987, Atari filed suit with the District of Columbia District Court, seeking judicial review of the Register's decision through the appropriate remedy of sections 701-706 of the Administrative Procedure Act (APA).¹⁰³

D. District Court's Decision

Applying a traditional standard of judicial review, the District of Columbia District Court held that "[t]he Register's analysis and conclusion were well within the bounds of [its] discretion, and reflected a reasonable application of controlling law and copyright regulations to the facts before [it]."¹⁰⁴ Furthermore, "[i]t was not unreasonable for the Register to conclude that . . . there [was] nothing 'distinctive' in the arrangement or layout of BREAK-OUT."¹⁰⁵ The district court found the Register's three separate denials of copyright status to cumulatively represent a "thoughtful and well-orchestrated effort to set forth the applicable statutory and regulatory framework, examine the relevant case law, and assess plaintiff's application in light of these pertinent considerations."¹⁰⁶

The district court reached these findings because video games are not per se copyrightable,¹⁰⁷ and the Copyright Office "reasonably concluded that BREAKOUT lacked the 'minimal artistic expression' necessary to render copyrightable the design and configuration of a video game display."¹⁰⁸ Moreover, the district court agreed with the Register's determination that BREAKOUT contained no expression separable from its generic video game because Atari's game was "little more than a stock description of a paddle-and-ball game, inseparable in any principled manner from the idea which it embodie[d]."¹⁰⁹ Therefore, the district court granted the

17 U.S.C. § 101 (1988). As the *Atari* case demonstrates, however, the classification of a work as an audiovisual work does not mean it achieves copyright status.

103. The APA mandates that the reviewing court shall "hold unlawful and set aside agency action, findings, and conclusions found to be *arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.*" 5 U.S.C. § 706(2)(A) (1988) (emphasis added). See *supra* note 39 and accompanying text.

104. *Atari*, 693 F. Supp. at 1206.

105. *Id.* at 1206 n.5. The district court noted that the Register "apparently concluded that BREAKOUT [was] one of those uncommon instances in which any expressive value contained therein [was] *de minimis*, and thus not sufficient for copyright purposes." *Id.* at 1207 (emphasis in original).

106. *Id.* at 1206.

107. *Id.* at 1207.

108. *Id.*

109. *Id.* The district court discussed the distinction between a "generic" video game (e.g., a maze-and-chase game, a hero-rescues-heroine-from-villain game, or a space-attack

Register's motion for summary judgment in May 1988.¹¹⁰

E. Circuit Court's Decision

Atari successfully challenged the district court's decision in the District of Columbia Circuit Court of Appeals with a unanimous decision reversing the district court's judgment.¹¹¹ The circuit court did, however, agree with the district court on two essential issues.¹¹² Both courts found that prevailing case law held that video games are audiovisual works¹¹³ entitled to copyright status if they meet the two basic prerequisites for copyrightability—originality and creativity.¹¹⁴ Originality requires a work to

game) and an "expressive rendition" (i.e., one "worthy" of copyrightability) of a "generic" video game. *Id.* Neither the district court nor the Copyright Office used the term "generic"; the authors have coined this term to clearly represent the distinction drawn by the district court. In the district court's view, such a distinction went to the heart of the "idea-expression" dichotomy in determining the existence of copyrightability. The district court contended that to be copyrightable, the "expressive rendition" had to be "clearly distinct and separable from the idea of the [generic] game itself." *Id.* at 1207 n.7. The district court therefore supported the Register's rejection of Atari's video game as copyrightable because "the Register was understandably at a loss to separate Atari's expression of a ball-and-paddle game from the game itself." *Id.*

The District of Columbia Circuit Court, however, rejected this analysis for three reasons. *See infra* notes 132-34 and accompanying text. Notably, the Copyright Office seemed to have confused the distinction between the idea-expression dichotomy and the *scènes à faire* doctrine. *See infra* notes 129-30, 135, and 200.

110. *Atari*, 693 F. Supp. at 1208. In 1983, copyrights had been granted to Atari for both its home version of BREAKOUT and for its arcade game SUPER BREAKOUT. The existence of such copyrights was not timely brought to the attention of the district court, and thus never entered into the district court's analysis or formed any part of the record before the D.C. Circuit Court. *Atari*, 888 F.2d at 879 n.2.

111. *Id.* at 879. Judge Silberman joined in the judgment, but filed a concurring opinion. *See infra* notes 137-48 and accompanying text.

112. *Atari*, 888 F.2d at 879, 882.

113. *See supra* notes 87-91 and accompanying text.

114. The court of appeals considered the copyrightability of video games settled law. *Atari*, 888 F.2d at 884 n.6. The Copyright Office presumably agreed that video games as audiovisual works were entitled to copyright protection, provided they satisfied the prerequisites for copyrightability under the Copyright Act. *Id.* at 879-80. The Copyright Office did, however, make a questionable statement in its first denial letter of February 1987. The Copyright Office stated that the "images . . . created by playing the video game . . . [were] also not registrable since they [were] created randomly by the player and not by the author of the video game." *Id.* at 880. If that proposition were meant to suggest that player interaction with the video game prevented the author from meeting the creative authorship requirement for copyrightability because the video screen display was too much a product of the player's interactive input to be original to the copyright holder, then the Copyright Office would be deviating from prevailing case law concerning video games and their copyrightability. *See, e.g., Stern Elecs., Inc. v. Kaufman*, 669 F.2d 852, 856 (2d Cir. 1982); *Williams Elecs., Inc. v. Artic Int'l, Inc.*, 685 F.2d 870 (3d Cir. 1982); *Midway Mfg. Co. v. Artic Int'l, Inc.*, 704 F.2d 1009 (7th Cir.), *cert. denied*, 464 U.S. 823 (1983).

be of independent creation, with its origin from the author.¹¹⁵ Put another way, the work must be independently created by the author and not copied from any other work.¹¹⁶ This independent, original effort that can be distinguished from any other author's work cannot solely qualify a work for copyright protection.¹¹⁷ There must also be a minimal amount of creativity, which requires the work to be a product of a modest amount of aesthetic or artistic expression or intellectual labor.¹¹⁸ Both courts further agreed that the Copyright Office expressly recognized that Atari's video game met the originality requirement, because the game had originated with or was independently created by Atari.¹¹⁹

That, however, was the extent to which the district and circuit courts were in agreement. First, the courts disagreed on whether *BREAKOUT* met the creativity requirement. The district court supported the Register's rejection of Atari's copyright application because *BREAKOUT* lacked sufficient creativity,¹²⁰ emphasizing that "[t]he question of whether a particular work reflect[ed] a sufficient quantum of creativity to satisfy the copyright laws [was] not susceptible to bright line rules or broad principles."¹²¹ The district court further concluded that "[s]uch a decision [to deny initial copyright registration] necessarily require[d] the exercise of informed discretion, and the Register, in . . . mak[ing] such

115. *Atari*, 888 F.2d at 882. It should be emphasized that the Copyright Act provides copyright protection only to "original works of authorship." 17 U.S.C. § 102(a) (1988). However, there is no definition of originality in the Copyright Act itself; rather, case law has established the standards for originality. Under this case law, a work need not be artistic or novel to obtain copyright protection. See *Mazer v. Stein*, 347 U.S. 201 (copyright protects statuettes of a lamp but not the utilitarian aspects of the lamp itself), *reh'g denied*, 347 U.S. 949 (1954). Originality denotes only enough definite expression so that one may distinguish authorship. *Id.* at 214. The Eighth Circuit in *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985), considered whether a white pages telephone directory was original enough for copyright protection. The *Hutchinson* court held that, because the directory's author had "solicited, gathered, filed, sorted, and maintained the information" used in the directory, the directory was "derived from information compiled and generated by [the author's] efforts." *Id.* at 132. The directory was therefore found to be original and copyrightable. *Id.* See *Reader's Digest Ass'n, Inc. v. Conservative Digest, Inc.*, 821 F.2d 800, 806 (D.C. Cir. 1987); *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 433-39 (4th Cir. 1986); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951).

116. *Atari*, 888 F.2d at 882.

117. *Id.*

118. *Id.* See also *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 668 (7th Cir. 1986), *cert. denied* 480 U.S. 941 (1987).

119. *Atari*, 888 F.2d at 882.

120. *Atari*, 693 F. Supp. at 1205. The Copyright Office's basis for denying copyright was that Atari's video game did not constitute a "work of authorship"—that is, it was not the result of the minimally required (non-trivial) amount of creative expression. *Id.*

121. *Id.*

determinations on a daily basis, [was] generally recognized to possess considerable expertise over such matters."¹²²

In contrast, the District of Columbia Circuit Court emphasized that the creative authorship requirement demanded only a very slight, minimal, or modest level of creativity to achieve copyrightability.¹²³ The circuit court did not merely reject both the Copyright Office's and the district court's interpretation of what constituted the minimum amount of original creative expression necessary to achieve copyright status. Rather, the court of appeals found unacceptable all of the Copyright Office's bases for denying copyright status to Atari's video game, determining that all of the Register's bases for denial were both conclusive and decisively inadequate to justify evaluating Atari's video game "as one of the 'rare' instances of expressive value so slight as to be insufficient for copyright purposes."¹²⁴

The *Atari* court listed three areas in which the Copyright Office lacked the principled legal theory and the acceptable legal support to uphold its denial determination. First, the evaluation of an audiovisual work must be done by looking at the work in its entirety.¹²⁵ Second, the standard of creativity employed to determine

122. *Id.* (citing *Norris Indus., Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir.), *cert. denied*, 464 U.S. 818 (1983)).

123. *Id.* at 882-83. See also *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 668 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987). The Copyright Office contended that BREAKOUT did not meet this modest creativity threshold, basing its position on the Copyright Office's regulation that "'familiar symbols or designs' and 'mere variations of typographic ornamentation, lettering or coloring' [were] not subject to copyright." *Atari*, 888 F.2d at 883 (citing 37 C.F.R. § 202.1 (1989)).

124. *Id.* at 880. It is enigmatic that only after the court of appeals' inquiry after oral argument did the Copyright Office identify three other instances, in addition to BREAKOUT, in which copyright registration of an audiovisual work was denied to a video game. See *infra* note 196. No information was given by the Copyright Office for the court to determine whether those video games were comparable to BREAKOUT, whether they were original or derivative works, or whether they lacked sufficient creative authorship as alleged against Atari's video game. *Atari*, 888 F.2d at 884 n.5.

125. *Id.* at 881-82. The court of appeals was "at a loss to understand why the Register did not more solidly link the final decision to the [Copyright] Act's apparent recognition that the whole—the 'series of related images'—may be greater than the sum of its several or stationary parts." *Id.* Further, "the case law correspondingly indicate[d] that the Register's focus . . . ultimately should be on the audiovisual work as a whole, *i.e.*, the total sequence of images displayed as the game is played." *Id.* at 883 (emphasis in original). The court observed that its recent opinion in *Reader's Digest Ass'n, Inc. v. Conservative Digest, Inc.*, 821 F.2d 800, 806 (D.C. Cir. 1987), held that even the ordinary lines, typefaces, and colors of a magazine cover could qualify for copyright status as a graphic work if those common elements formed a distinctive arrangement and layout that created a unique graphic design. *Atari*, 888 F.2d at 883. Likewise, in *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109 (9th Cir. 1970), greeting cards were held to be copyrightable, although textual matter standing alone was not.

copyrightability should have been the "normal" one—that is, one of "a very modest degree of intellectual labor."¹²⁶ Lastly, the determination of the copyrightability of a work solely concerned the issue of whether the work qualified as "copyrightable subject matter."¹²⁷ The scope—the extent or amount of copyright protection a work merits—was irrelevant. The *Atari* court found that the Copyright Office failed to concern itself exclusively with the copyrightability issue.¹²⁸

In addition, the court of appeals wrote that Atari's video game could not be denied copyrightability because of the idea-expression dichotomy,¹²⁹ or because of the *scènes à faire* doctrine, which de-

126. *Atari*, 888 F.2d at 882. The court of appeals did "not grasp the standard of creativity the Copyright office employed. . . ." *Id.* The majority opinion classified the standard applied by the Copyright Office as an unacceptable heightened standard resembling the "substantial creativity" measuring rod sometimes used to judge derivative works[.]" *Id.* The court further indicated that the Copyright Office's comparison of Atari's claim for protection of its work as a whole to the protection afforded to compilations and other derivative works was misdirected. *Id.* at 884.

The *Atari* court was firm in not accepting any standard other than the normal creativity standard, as even "simple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and in court." *Id.* at 883. The court noted four examples of fabric designs, all with very simple patterns, that had received copyright status. *Id.* The court likewise cited *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 388 (5th Cir. 1984), to stand for the proposition that component parts, "neither original to the plaintiff nor copyrightable" may, in combination, create a "separate entity [that] is both original and copyrightable." *Atari*, 888 F.2d at 883.

The court further indicated that the Copyright Office's counsel intimated at oral argument that the Copyright Office treated "games" categorically different. The court refused to address that issue since there was no claim that games as a category were any different than other copyrightable subject matter. *Id.* at 886 n.6.

127. See 17 U.S.C. § 410 (a) (1988).

128. The court of appeals found the "cryptic character" of the Copyright Office's decision to be inconsistent with earlier and later pronouncements of the Copyright Office and courts. *Atari*, 888 F.2d at 882. The court was concerned that the Register confused or blended the separate issues of the existence of copyright with the scope of copyright protection. *Id.*

129. *Id.* at 884-86. As the Eighth Circuit Court of Appeals pointed out in *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1211 (8th Cir. 1986), § 102(b) of the 1976 Copyright Act, which provided that copyright protection extended only to expression and not to ideas, was "nothing more than a codification of the idea/expression dichotomy as it developed in the case law prior to passage of the 1976 Act." For a discussion of *Toro* see *infra* notes 175-86 and accompanying text.

The case law embodying the idea-expression dichotomy has its roots in *Baker v. Selden*, 101 U.S. 99, 102-03 (1879), which held that copyright protection extended only to the expression of a particular idea, not to the idea itself. The doctrine is based on both a presumed legislative intent to grant an author a monopoly only in his expressions—not his ideas—and in the First Amendment interest in the free exchange of ideas. *Toro*, 787 F.2d at 1212 (citing *Harper & Row, Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 555-61 (1985)). See also *Mazer v. Stein*, 347 U.S. 201, 217 (copyright protection given only to the expression

nies copyright to "stereotyped expressions, 'incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.'"¹³⁰ The court of appeals thereby rejected the Register's and the district court's conclusion that a computer video game can be denied copyrightability based on the distinction between a "generic" video game and an "expressive rendition" of a generic video game.¹³¹

The *Atari* court advanced three reasons for rejecting the copyright denial of computer video games based on the idea-expression dichotomy. First, the court classified as "untenable" the "lump categorization of video games as 'idea' rather than 'expression,'" and found that "the variety of ways to perform the same [video game] function sustain[ed] the classification of such works as 'expression.'"¹³² Second, "even the simplest game may have variations of sizes, shapes, sequences, colors and sounds."¹³³ Third, the audiovisual aspects of a video game were "conceptually separable from [their] utilitarian aspects."¹³⁴

of the idea—not to the idea itself), *reh'g denied*, 347 U.S. 949 (1954).

The idea-expression dichotomy should not be confused with the copyright law doctrine of merger, under which copyright protection is denied to even some expressions of ideas if the idea behind the expression is such that it can be expressed only in a very limited number of ways. *Toro*, 787 F.2d at 1212. The merger doctrine was designed to prevent an author from monopolizing an idea merely by copyrighting a few expressions of it. *Id.* (citing *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967)). See also *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) (merger doctrine applied when court refused to find copyright infringement of a jewel-encrusted bee-shaped pin because the idea of the bee pin was inseparable from its expression).

130. *Atari*, 888 F.2d at 886 (quoting *Alexander v. Haley*, 460 F. Supp. 40, 45 (S.D.N.Y. 1978)). The Register argued that even if Atari's video game did contain expression, the symbols displayed were so ordinary and commonplace as to fail the *scènes à faire* analysis. *Id.* The court of appeals rejected the Copyright Office's application of the *scènes à faire* analysis to the copyrightability of Atari's video game. *Id.* For further discussion of the *scènes à faire* doctrine and video games, see *Atari, Inc. v. North Am. Phillips Consumer Elecs. Corp.*, 672 F.2d 607 (7th Cir.) (distinguishing the unprotected generic idea of a video game from the protected copyrightable expression and depiction of just such an unprotected video game idea), *cert. denied*, 459 U.S. 880 (1982); *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 436-37 (4th Cir. 1986) (distinguishing subject matter that allowed for only a very limited manner of expression, so much so that an idea and its expression virtually remained a unit and therefore there was no copyrightable subject matter or material, from audiovisual computer video games whose subject matter involved a variety of ways to perform the same function and therefore were different expressions and were copyrightable); Note, *Copyright Protection for Computer Screen Displays*, 72 MINN. L. REV. 1123, 1128-31 (1988).

131. See *supra* note 109 and accompanying text.

132. *Atari*, 888 F.2d at 885 (quoting *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 436-37 (4th Cir. 1986)).

133. *Id.* (quoting Patry, *Electronic Audiovisual Games: Navigating the Maze of Copyright*, 31 J. COPYRIGHT SOC'Y 1, 46 (1983)).

134. *Id.* (quoting *Williams Elecs., Inc. v. Bally Mfg. Corp.*, 568 F. Supp. 1274, 1281 (N.D. Ill. 1983)).

Based on the foregoing analysis, the District of Columbia Circuit Court found that the Copyright Office's erroneous component-by-component analysis, its application of an elevated creativity standard, and the lack of a discernable standard to differentiate between copyrightability and the scope of copyright protection,¹³⁵ more than justified labelling the Register's denial of copyright to BREAKOUT an abuse of discretion. The court remanded the case to the Register of Copyrights for further consideration consistent with the court's opinion.¹³⁶

F. Concurring Opinion

Judge Silberman, in his concurring opinion, agreed with the majority that the standard the Copyright Office used to deny registration was not discernable.¹³⁷ He emphasized, however, that the court's review of the Register's rejection of initial copyright status was not "a final decision on the copyrightability of the item [seeking copyright registration]."¹³⁸ Furthermore, Judge Silberman was

135. The *Atari* court faulted the Register of Copyrights for failing to distinguish between copyrightability and the scope of copyright protection. See *supra* note 128 and accompanying text. The court further criticized the Register for failing to articulate a standard to differentiate between uncopyrightable subject matter and material that was copyrightable, but merited only slight protection in an infringement suit. *Atari*, 888 F.2d at 886. For example, in *Atari, Inc. v. North Am. Phillips Consumer Elecs. Corp.*, 672 F.2d 607 (7th Cir.), *cert. denied*, 459 U.S. 880 (1982), the Seventh Circuit distinguished ordinary, commonplace symbols that did qualify as copyrightable but obtained only extremely limited copyright protection, from uncopyrightable *scènes à faire* expressions or symbols employed in other types of subject matter.

136. *Atari*, 888 F.2d at 886.

137. *Id.* at 887 (Silberman, J., concurring).

138. *Id.* One reason for Judge Silberman's conclusion that the court's reversal of the Register's denial of initial copyright protection was not the final determination of the submitted work's copyrightability was that the issue of copyrightability could again be decided in a later infringement suit. For example, after reversing the Copyright Office's denial, even if the Copyright Office then decided to grant copyright to the work submitted, the copyrightability issue could nevertheless reappear, because "the Copyright Office's imprimatur is worth only a rebuttable presumption as to copyrightability in an infringement action." *Id.* Thus, in an infringement suit, a certificate of copyright registration only constitutes prima facie evidence of copyrightability. See *supra* note 33 and accompanying text. The burden is on the non-holder of the copyright registration (usually the defendant) to demonstrate why the copyright is not valid. If the non-holder does meet her burden, then copyright protection is denied to the work even though it had received initial copyright registration from the Copyright Office. See, e.g., *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1019 (9th Cir. 1985), *cert. denied*, 474 U.S. 1059 (1986). Moreover, because an infringement suit is not a direct review of agency action governed by the Administrative Procedure Act, a court is not obliged to afford any abuse of discretion deference to the Copyright Office's determination. Accordingly, a court reviews the copyrightability of the work at issue in the infringement suit *de novo*. *Atari*, 888 F.2d at 887 (Silberman, J., concurring).

concerned that “[e]very time the Register denies registration for too little creativity . . . [it will have] to issue an opinion that compares with the learned offerings of my colleagues.”¹³⁹

What most disturbed Judge Silberman was the majority’s expansion of the scope of review of the Copyright Office’s registration decisions.¹⁴⁰ The majority opinion implied that “the Register’s position is vulnerable if it departs from some judicial interpretations—which sounds like at least a tentative view on the merits.”¹⁴¹ Moreover, “even a suggestion that the Register is barred from adopting an interpretation of the Copyright Act regarding video games that is inconsistent with the view expressed by certain courts . . . would be at odds with the abuse of discretion standard of review; it would more nearly resemble *de novo* scrutiny.”¹⁴²

Judge Silberman also criticized the majority for its thorough discussion of copyright law which did not relate directly to the narrow issue before the court.¹⁴³ He advised against any preemptive rejection of the Register’s denial determinations: “[T]he proper course in the review of a registration decision is to allow the Register to present [its] interpretation of [copyright law]—which he has not done clearly here, even in counsel’s *post hoc* suggestions—before the court offers its own guidance.”¹⁴⁴ Furthermore, he did not think that “the Register should be bound on remand to accept the creativity standard found to be ‘normal’ or appropriate by certain courts of appeals and by Professor Nimmer.”¹⁴⁵

Judge Silberman reiterated his agreement that the case be remanded because “the Register ha[d] not explained if or why it [was] employing a categorical distinction between the registrability thresholds for video game displays and other works.”¹⁴⁶ He warned about making remand “a device to induce an agency to provide the

139. *Id.* Because the Copyright Office receives over 100,000 applications every year, the Copyright Act only requires the Copyright Office to give an explanation whenever it denies registration. *Id.* See 17 U.S.C. § 410(b) (1988). As a practical matter, this makes only denials vulnerable to legal challenge. *Atari*, 888 F.2d at 890 n.6. (Silberman, J., concurring). Nevertheless, the *Atari* concurrence emphasized that *Chevron U.S.A. Inc. v. Natural Resources Defense Counsel, Inc.*, 467 U.S. 837, *reh’g denied*, 468 U.S. 1227 (1984), required courts “to leave undisturbed a permissible or reasonable agency interpretation of a statute if Congress ha[d] not directly addressed the issue presented.” *Atari*, 888 F.2d at 887 (Silberman, J., concurring).

140. *Id.* at 888.

141. *Id.* at 889.

142. *Id.* (emphasis in original).

143. *Id.*

144. *Id.* (emphasis in original).

145. *Id.* at 890.

146. *Id.*

explanation and the result [the court] think[s] correct."¹⁴⁷ Moreover, "[i]f improperly read, the majority opinion might have the effect of causing the Copyright Office to register *virtually any offering*."¹⁴⁸

VI. THE REGISTER'S RECONSIDERATION ON REMAND

The Copyright Office filed its reconsideration decision on remand¹⁴⁹ on May 1, 1990, in the District of Columbia District Court. The Copyright Office, for the fourth time, found that " 'BREAKOUT' [was] not an original work of authorship within the meaning of section 102 of the Copyright Act. . . . [Moreover], 'BREAKOUT' lack[ed] even the modest degree of creative authorship required by the statute to qualify for copyright registration."¹⁵⁰ The Register of Copyrights acknowledged, as it previously had done, that the screen display of BREAKOUT was an audiovisual work.¹⁵¹ Yet it again denied BREAKOUT copyright protection

147. *Id.* Administrative judicial review has the potential of inducing an agency to act in certain ways, which is in fact a fundamental policy underlying judicial review. As to matters of law, the purposes of administrative judicial review are to have an agency follow the law as set out in the agency's enabling statute and as developed through judicial interpretation and *stare decisis*. See generally Shapiro & Glicksman, *The Supreme Court, and the Quiet Revolution in Administrative Law*, 1988 DUKE L.J. 819; Strauss, *One Hundred Fifty Cases per Year: Some Implications of the Supreme Court's Limited Resources for Judicial Review of Agency Action*, 87 COLUM. L. REV. 1093 (1987); Starr, *Judicial Review in the Post-Chevron Era*, 3 YALE J. ON REG. 283 (1986); Levin, *Administrative Discretion, Judicial Review, and the Gloomy World of Judge Smith*, 1986 DUKE L.J. 258; Shapiro, *APA: Past, Present, Future*, 72 VA. L. REV. 447 (1986).

5 U.S.C. § 706 (2)(A) (1988) mandates that a reviewing court shall "hold unlawful and set aside agency actions, findings, and conclusions found to be arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law." The final phrase "or otherwise not in accordance with the law" evidences the essential policy justifying the remand of agency action submitted to judicial review—to have the agency align its actions accordingly. See, e.g., Shapiro & Levy, *Heightened Scrutiny of the Fourth Branch: Separation of Powers and the Requirement of Adequate Reasons for Agency Decisions*, 1987 DUKE L.J. 387; Weaver, *Judicial Interpretation of Administrative Regulations: The Deference Rule*, 45 U. PRRT. L. REV. 587 (1984).

148. *Atari*, 888 F.2d at 890 (Silberman, J., concurring) (emphasis added).

149. Reconsideration on remand letter from Ralph Oman to A. Sidney Katz, April 30, 1990, Case No. 88-0021 JHP, *on remand from Atari Games Corp. v. Oman*, 693 F. Supp. 1204 (D.D.C. 1988), *rev'd*, 888 F.2d 878 (D.C. Cir. 1989) [hereinafter Letter on remand]. Copy on file with THE UNIVERSITY OF MIAMI ENTERTAINMENT & SPORTS LAW REVIEW. Given the wording of the circuit court's mandate and the fourth denial of registration for BREAKOUT, apparently the Copyright Office was convinced that it did have persuasive justifications for supporting its continual denial. Or was the Copyright Office insisting that it be given the discretion that was the very rationale for its existence?

150. Letter on remand, *supra* note 149, at 1.

151. *Id.*

because it was not an original work of authorship.¹⁵² The Copyright Office emphasized that it was “applying the same creativity standard to the videogame ‘BREAKOUT’ as it would to any other type of work, be it a pictorial, graphic, dramatic, musical, or literary work, etc.”¹⁵³

Accordingly, the Register of Copyrights summarily restated its rejection of BREAKOUT because of insufficient creativity,¹⁵⁴ despite the court of appeals’ initial uncertainty as to how the Register’s original decision could be sustained under prior Copyright Office actions and court pronouncements regarding the creativity threshold.¹⁵⁵ The only new issue dealing with insufficient creativity that the Register raised was its commentary concerning BREAKOUT’S “flat, unadorned geometric shapes carrying out the action of the game.”¹⁵⁶ The Register claimed that “the graphic, visual display elements [of BREAKOUT] [did] not evince authorship in the nature of perspective, shaping, depth or brushstroke which would significantly contribute to creative expression.”¹⁵⁷

The Copyright Office emphasized that it reconsidered BREAKOUT

as a whole, evaluating whether the screen displays of ‘BREAK-OUT’ contained any distinctive selection or arrangement and also considered the creativity of the component elements. The [Copyright] Office conclude[d] that neither the work as a whole in its series of related images nor the individual components qualif[ied] this work as a registrable audiovisual work because ‘BREAKOUT’ [was] too trivial, uncreative, and nondistinctive to constitute an original work of authorship.¹⁵⁸

The Copyright Office cited to *Bailie v. Fisher*,¹⁵⁹ *Toro Co. v. R*

152. *Id.* at 2.

153. *Id.* Yet two sentences later, the Copyright Office stated that BREAKOUT was not a painting, and therefore could not be examined as such. *Id.* The Copyright Office cited to no case law that would support its proposition that it applied the same creativity standard to any type of work. It is one thing to say that the same *general principles* of creativity for copyright protection are applied to all works. But it is quite another to assert that the *very same* creativity standard is applied to every single work submitted for initial copyright status, regardless of the type of work. If all works submitted for copyright application are to be subjected to the same creativity standard regardless of the type of work in question, why does the Copyright Act define and distinguish works into seven different categories? See 17 U.S.C. § 102 (1988).

154. Letter on remand, *supra* note 149, at 2-4.

155. *Atari*, 888 F.2d at 884.

156. Letter on remand, *supra* note 149, at 3.

157. *Id.*

158. *Id.* at 2-3.

159. 258 F.2d 425 (D.C. Cir. 1958). For further discussion of *Bailie*, which held that

& R Prod. Co.,¹⁶⁰ and *Bibbero Sys., Inc. v. Colwell Sys., Inc.*¹⁶¹, as well as to section 102 of the Copyright Act, for the conclusion that BREAKOUT failed to have the minimal creativity required to achieve copyright protection.¹⁶² However, of the three cases, only *Toro*, if read in the most liberal fashion, can be considered to address the issue of creativity.

Bailie involved a picture-record device¹⁶³ that was submitted for initial copyright status as a work of art.¹⁶⁴ The Copyright Office denied the device copyright status,¹⁶⁵ and the district court entered summary judgment in favor of the Register's rejection of copyright.¹⁶⁶ On appeal, the District of Columbia Circuit Court, noting that "[a] thing is a work of art if it appears to be within the historical and ordinary conception of the term art,"¹⁶⁷ held that the cardboard star, which stood because of folded flaps, did not fall within that definition.¹⁶⁸ The *Bailie* court, while upholding the Register's denial of initial copyright, never mentioned or discussed the issue of any standard of creativity. The only issue before the court was whether the work submitted for copyright registration qualified as a work of art.¹⁶⁹

*Bibbero Sys., Inc. v. Colwell Sys., Inc.*¹⁷⁰ considered the scope of the "blank forms rule" pursuant to a Copyright Office regulation which provided that blank forms were not copyrightable.¹⁷¹ The Copyright Office had granted copyright to a medical billing form,¹⁷² and in the ensuing infringement suit, the district court granted summary judgment for defendant, finding that the billing form was an uncopyrightable blank form designed to record infor-

the Register of Copyrights' discretion was subject to judicial review and correction, see *supra* notes 47-51 and accompanying text.

160. 787 F.2d 1208 (8th Cir. 1986).

161. 893 F.2d 1104 (9th Cir. 1990).

162. Letter on remand, *supra* note 149, at 3.

163. The picture-record device comprised a cardboard star with a circular center bearing the photograph of an entertainer, upon which was superimposed a transparent phonograph record from which the voice of the pictured celebrity could be heard. *Bailie*, 258 F.2d at 426.

164. *Id.* The actual shaping of the picture-record device, not the recording or the photograph, was submitted for copyright protection. *Id.*

165. *Id.*

166. *Id.*

167. *Id.* (quoting *Rosenthal v. Stein*, 205 F.2d 633, 635 (9th Cir. 1953)).

168. *Id.*

169. *Id.*

170. 893 F.2d 1104 (9th Cir. 1990).

171. *Id.* at 1105. The regulation at issue was 37 C.F.R. § 202.1(c) (1989).

172. These billing forms were used by doctors to record services performed and instructions on how to file insurance claims. *Bibbero*, 893 F.2d at 1105.

mation, not convey it.¹⁷³ The Ninth Circuit Court of Appeals upheld the district court's finding of uncopyrightability,¹⁷⁴ without discussing any standard of creativity.

*Toro Co. v. R & R Prod. Co.*¹⁷⁵ involved a lawn care machine manufacturer's parts numbering system.¹⁷⁶ In the infringement case, the district court found the parts-numbering system to be precluded from copyright protection pursuant to section 102(b) of the 1976 Copyright Act because it was a "system."¹⁷⁷ The Eighth Circuit affirmed the district court's holding, but for different reasons. The Eighth Circuit found that section 102(b) of the Copyright Act did not address the issue of whether the expression embodied in plaintiff's parts-numbering system was copyrightable.¹⁷⁸ The real issue was whether the parts-numbering system fell within the subject matter of copyright, that is, whether it was "an original work of authorship fixed in a tangible medium of expression."¹⁷⁹ The court found that the numbers were indiscriminately assigned to a part, and that "no effort or judgment went into the selection or composition of the numbers."¹⁸⁰ The system lacked the originality required to sustain copyright protection because the "random and arbitrary use of numbers in the public domain d[id] not evince enough originality to distinguish authorship."¹⁸¹ The Eighth Circuit emphasized that its holding should not be interpreted as meaning that all numbering systems were not copyrightable: "A system that uses symbols in some sort of meaningful pattern, something by which one could distinguish *effort or content*, would be an original work. Originality is a very low threshold, but still a threshold."¹⁸²

While the essential issue in *Toro* involved the application of the originality standard and its application to a "disputed work [that] [was] similar to a *pre-existing protected* work or one in the

173. *Id.* at 1106. The court relied on the long standing principles first enunciated in *Baker v. Selden*, 101 U.S. 99 (1897), and now codified at 37 C.F.R. § 202.1(c) (1989).

174. *Bibbero*, 893 F.2d at 1108.

175. 787 F.2d 1208 (8th Cir. 1986).

176. *Id.* at 1211.

177. *Id.* at 1212.

178. *Id.*

179. *Id.*

180. *Id.* at 1213.

181. *Id.* Because plaintiff's parts-numbering system was composed of random numbers arbitrarily assigned to the different parts, there was no particular series or configuration of numbering denoting a certain type or category of parts. Moreover, the numbers did not use any encoded information, thus establishing that the system fell short "of even the low threshold of originality." *Id.*

182. *Id.* (emphasis added).

public domain,"¹⁸³ this was not the case in *Atari*.¹⁸⁴ Moreover, the *Toro* court never used the word "creativity" in its entire decision.¹⁸⁵ Nevertheless, the Copyright Office cited *Toro* for justifying its conclusion that BREAKOUT did not constitute an original work of authorship.¹⁸⁶

Not only did the Copyright Office find that BREAKOUT lacked the minimum creativity needed for copyright status, it further found that BREAKOUT consisted of "nothing more than a large rectangle comprising different colored bars, pieces of which disappear in response to the manipulation of a small rectangle by the player of the game."¹⁸⁷ The Register concluded that "[t]he

183. *Id.* (emphasis added).

184. The Copyright Office never claimed that BREAKOUT was similar to a pre-existing protected work or one in the public domain. Notably, the Copyright Office offered no explanation or justification for equating an originality standard applied to works seeking copyrightability which were similar to works already in the public domain or already copyrighted to a creativity standard applied to a work that was original and in no way similar to any pre-existing protected work or one in the public domain.

185. The Eighth Circuit in *Toro* cited to its decision in *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985), as a prime example of what constituted originality and creativity. *Hutchinson* held that a white pages telephone directory was original enough for copyright protection, as the directory's author had "solicited, gathered, filed, sorted, and maintained the information" used in the directory. *Id.* at 132. The *Hutchinson* court found the directory to be original because it had been derived from the information compiled by the author, indicating that originality concerned independent creation, whereas creativity concerned artistic expression unique enough to warrant creative authorship. *Id.* See *supra* note 115 and accompanying text.

186. Letter on remand, *supra* note 149, at 2-3. Even if it can be assumed that the Eighth Circuit's originality discussion in *Toro* was actually referring to the creativity requirement, a serious doubt remains. It seems difficult to equate a lack of originality of a lawn care parts inventory system that used public domain numbers and was found to be lacking any distinguishing effort or content to possess enough definite expression to distinguish authorship, with a determination that a computer programmed audiovisual game like BREAKOUT was so nondistinctive and trivial as to lack minimal creativity. In the Copyright Office's first consideration of BREAKOUT, it conceded that the video game was original. See *supra* note 119 and accompanying text. Apparently, the Copyright Office confused the originality and the creativity standards. See *infra* note 184.

187. Letter on remand, *supra* note 149, at 3. The Copyright Office offered the following description of BREAKOUT:

Four long, colored rectangular broken bars appear[ing] across the upper portion of the screen . . . suggest[ing] the existence of a wall. Along the bottom of the screen appears a small rectangle, or dash, representing a paddle, and a small square is used to represent a ball which bounces off the paddle and hits the broken bars at the top of the screen. These figures are surrounded by thick lines depicting a rectangular box (or playing field). When one of the broken bars is struck by the 'ball,' it disappears. The object of 'BREAKOUT' is to cause the 'ball' to strike enough rectangles so as to make it 'break out' from below the line of rectangles and thereby score as many points as possible.

Id. See *supra* note 88 for the District of Columbia Circuit Court's description of BREAKOUT.

component elements of the 'BREAKOUT' visual display [were] quite simple. . . . Since the design elements of 'BREAKOUT' consist[ed] only of a few simple geometric shapes (rectangles and squares), the graphics [did] not render the work copyrightable."¹⁸⁸

The Register conceded that works made up of simple geometric shapes could be copyrightable if the arrangement was distinctive.¹⁸⁹ Insofar as BREAKOUT was concerned, it found "no original authorship in either the selection or arrangement of the images or their components. . . . [Nor did it find any] 'unique graphic design' in the visual display of something so simple and basic as 'BREAKOUT.'"¹⁹⁰ Moreover, "'BREAKOUT' [was] not a 'unique graphic design' merely because Atari chose to use four broken bars, a rectangle and a square encompassed by a large rectangle."¹⁹¹

The Copyright Office cited two Second Circuit cases which involved works that contained original and distinctive arrangements,¹⁹² again emphasizing all works were evaluated according to the same creativity standard.¹⁹³ The Copyright Office further stated that it did not

compare works when rendering a registration decision. Copyright arises on independent creation, and is not based on comparison of prior art. Each work is evaluated according to its own merits without regard to whether other works of a similar nature have or have not been registered, but the same standard, expressed in the Compendium [of Copyright Office Practices II, sections 202.01, 202.02], is applied.¹⁹⁴

Lastly, the Copyright Office claimed that its rejection of BREAKOUT was consistent with its previous determinations re-

188. Letter on remand, *supra* note 149, at 3.

189. *Id.*

190. *Id.* at 3-4.

191. *Id.* at 4 n.1.

192. *Id.* at 4-5. The cases cited were *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092 (2d Cir. 1974) (fabric design consisting of strip of crescents with ribbons and rows of semicircles), and *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315 (2d Cir. 1969) (fabric design consisting of a circle within a square within a circle).

193. Letter on remand, *supra* note 149, at 5.

194. *Id.* at 5 n.2. In theory, such an approach is legitimate. However, in practice, it can easily lead to untenable contradictions based on arbitrary determinations. For example, some works of a similar type (e.g., two fabric designs, one of crescents with ribbons and rows of semicircles, and another of a circle within a square within a circle) may receive copyright, whereas other works of a similar type (e.g., fabric designs, one of right triangles with bows and rows of parallelograms and another of a triangle within a circle within a triangle) may not receive copyright. If all of them were evaluated according to the same creativity standard, then such contradictory determinations are insupportable, and can be considered arbitrary and capricious.

garding audiovisual works.¹⁹⁵ The Copyright Office mentioned five video games that it rejected because of a lack of sufficient creativity,¹⁹⁶ and explained that there was a common justification for their rejection: "[T]he display screens both individually and as a whole simply lacked sufficient creativity to make them registerable [sic] as audiovisual works."¹⁹⁷

VII. CONCLUSION

Judge Silberman in his concurring opinion expressed concern that the majority opinion in *Atari* could be misinterpreted as improperly confining the Copyright Office's discretion on remand.¹⁹⁸ He was justified in his apprehension that a much stricter standard of judicial review of initial copyright denials is emerging because of the majority's conclusion that in the initial evaluation of any type of work where copyright law is fairly clear and settled, the Copyright Office must assume a presumption of initial copyrightability.¹⁹⁹

Atari supports a new approach to denials of initial copyright registration.²⁰⁰ It subjects any denial of copyright registration for a

195. *Id.* at 5.

196. DRAW POKER DOUBLE DOWN, which was denied copyright for lack of sufficient creativity in February 1990, consisted of "a series of essentially static images showing the placement and number of playing cards and very brief textual phrases. The motion in the game consisted of the cards turning over, the word 'win' blinking, and the word 'jackpot' rolling down the screen." *Id.* The other four video games, for which the Copyright Office provided no description, were also denied copyright on the ground that they lacked sufficient creativity: (1) TIC TAC TOE (denied copyright in August 1989); (2) OCTASY (denied copyright in October 1988); (3) WI—JTAT FULL DICE DISPLAY (denied copyright in December 1987); and (4) GONDOMANIA (derivative version) (denied copyright in December 1987). *Id.*

197. *Id.* Atari Games Corporation filed a Notice of Petition for Review by the D.C. District Court on July 2, 1990, requesting the court reverse the Copyright Office's "barren exercise of supplying reasons to support a pre-ordained result." Plaintiff's Memorandum in Support of Petition for Review at 6, *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989) (No. 88-0021). Moreover, Atari demanded review of the Copyright Office's fourth denial of BREAKOUT because it had not "'engaged in a genuine reconsideration' of the BREAKOUT application, and ha[d] not compiled with either the letter or the spirit of the Appellate Court's mandate." Plaintiff's Memorandum at 5. As of the time of publication of this Article, this Petition for Review remains pending before the United States District Court for the District of Columbia.

198. *Atari*, 888 F.2d at 887 (Silberman, J., concurring).

199. While the *Atari* court never used this phraseology, it conceptualizes the implications of this new approach to judicial review of the Register of Copyrights' decisions of initial copyright registration.

200. The circuit court's approach is critical only to *initial copyright denials*. Initial grants of copyright are rarely challenged and infrequently invalidated. See *supra* note 139. The District of Columbia Circuit's approach is not the only "encroachment" upon the Register's discretion in evaluating initial copyright status. See *NEC Corp. v. Intel Corp.*, 10

work in a clear area of copyright law to a low threshold abuse of discretion standard. These denials are reversible unless the Copyright Office gives persuasive justification to the contrary.²⁰¹ In this way, the majority opinion does not lend itself to misinterpretation.

The *Atari* decision does not, standing alone, represent the erosion of the Register's discretion. It is the culmination of a line of cases that have challenged the Register's discretion to determine which works should be afforded copyright status. Moreover, the Copyright Office's reaction to *Atari* is an overt demonstration of the Register of Copyrights' determination to retain its discretionary powers, for despite the mandate of the *Atari* court, the Copyright Office again rejected the idea that BREAKOUT was copyrightable. Even though the legal position of the Copyright Office in this regard can be described as tenuous, the Office has not hesitated to continue asserting the very discretion that Congress granted it.

As Judge Silberman pointed out, the thrust of the majority opinion in *Atari* severely limits the Copyright Office's discretion. The presumption of copyrightability imposed by the court means that there is only one reasonable alternative for the Copyright Office to pursue. *Atari's* approach implicitly encourages the Copyright Office to automatically grant initial copyright status unless there is insufficient case law precedent on the copyrightability of the type of material submitted for registration. Such an approach would allow more plaintiffs to go into an infringement suit with at the very least, the evidentiary weight of copyright status in their favor.²⁰² Moreover, if the registration was obtained before or within five years after first publication of the work, the plaintiff would have prima facie evidence of a valid copyright.

Is this result harmful to current copyright litigation? This Article contends that no serious harm would result. The stricter scrutiny mandated by the majority in *Atari* dictates that both the issue of copyrightability and the issue of the scope of copyright protection be decided in an infringement suit, thereby formalizing what for all practical purposes currently occurs in infringement actions. There may be some increased infringement litigation because more

U.S.P.Q. 2d 1177, 1179, (N.D. Cal. 1989), where the court suggested that issues such as those involving the idea-expression dichotomy, merger, and the *scènes à faire* doctrine should not be the basis for denying initial copyright; rather, such issues should be left to an infringement suit. See also *Atari*, 888 F.2d at 885 n.7.

201. In essence, there is a burden of persuasion on the Register to overcome the presumption of initial copyrightability.

202. *Atari*, 888 F.2d at 881.

plaintiffs will be armed with their "prima facie" copyright protection. However, despite the possibility of some multiplicity of litigation, plaintiffs seeking copyright protection will be able to forego the present expensive and time consuming two-tiered system. More significantly, the *Atari* court's heightened scrutiny approach poignantly demonstrates that it is the federal courts, not the Copyright Office, that decides copyright law.