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## A QUANTUM OF ORIGINALITY IN COPYRIGHT

Katherine L. McDaniel and James Juo\*

### Introduction

To be eligible for copyright protection, a work must be “original.”<sup>1</sup> “Simply stated, original means not copied, and exhibiting a minimal amount of creativity.”<sup>2</sup> But can a work consisting of the selection and arrangement of simple public domain elements be sufficiently creative to be entitled to copyright protection? Certainly. “The requisite originality for copyright protection can also be found in the combination of unoriginal (and therefore uncopyrightable) elements.”<sup>3</sup>

There has been, however, some reluctance by the Copyright Office to register works that could be characterized as simple combinations of standard design elements. This may reflect an institutional concern about the creation of improper monopolies on commonplace expressions that would curtail other creative works. Nevertheless, relatively simple works are entitled to copyright protection so long as the necessary quantum of originality is present.<sup>4</sup>

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<sup>1</sup> Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 547-49 (1985); *see also* 1 MELVIN B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01 (Matthew Bender ed., LexisNexis 2007).

<sup>2</sup> Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters., Inc., 945 F.2d 509, 512 (2d Cir. 1991).

<sup>3</sup> Express, LLC v. Fetish Group, Inc., 424 F. Supp. 2d 1211, 1225 (C.D. Cal. 2006); *cf.* Zidell v. Dexter, 262 F. 145, 146 (9th Cir. 1920) (“The fact that the elements were old, however, does not prove want of invention in assembling them into a single design” for a patent.).

<sup>4</sup> Runstadler Studios, Inc. v. MCM Ltd. P'ship, 768 F. Supp. 1292, 1298 (N.D. Ill. 1991).

This article will review the level of creativity required for copyright protection, and examine cases that applied the requisite creativity threshold to different combinations of public domain shapes and text. In addition, this article will discuss the judicial doctrine of “thin” copyrights that prevents only virtually identical copying for original works where the amount of originality is slight.

### **I. The Amount Of “Creativity” Required To Qualify For Copyright Protection Is Extremely Low**

The Supreme Court in *Feist Publications v. Rural Telephone Service Co.*, held that the degree of creativity necessary in order to be entitled to copyright protection is “extremely low,” such that “[t]he vast majority of works make the grade quite easily.”<sup>5</sup> Even a slight amount of original authorship will suffice.<sup>6</sup>

*Feist* involved the compilation of names and telephone numbers into an alphabetical listing for a telephone book. The Court held that “there is nothing remotely creative about arranging names alphabetically in a white pages directory.”<sup>7</sup> This alphabetical directory was not protected by copyright because “[i]t is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course.”<sup>8</sup>

Thus, the level of creativity necessary to qualify for copyright protection is based on whether the work presents a configuration embodying more than an “age-old practice” so

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<sup>5</sup> *Feist Publ’ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991); *see also Key Publ’ns*, 945 F.2d at 513 (“In practice, the requirement of originality has become ‘little more than a prohibition of actual copying.’” (citation omitted)).

<sup>6</sup> *Feist*, 499 U.S. at 345.

<sup>7</sup> *Id.* at 363. *But cf.*, *Key Publ’ns*, 945 F.2d at 514 (the arrangement of a telephone directory designed for use by the New York Chinese-American community “entailed the de minimis thought needed to withstand the originality requirement”).

<sup>8</sup> *Feist*, 499 U.S. at 363; *see also Savata v. Lowry*, 323 F.3d 805, 810 (9th Cir. 2003) (“expressions that are standard, stock, or common to a particular subject matter or medium are not protectable under copyright law”).

familiar and “commonplace” that it would be “expected as a matter of course.” Indeed, a simple work that shows some creative spark meets the threshold level of creativity, “no matter how crude, humble or obvious” it might be.<sup>9</sup> Inasmuch as “an artist is a man who says a difficult thing in a simple way,”<sup>10</sup> a creative spark may be found in a simple design.

## II. Creative Combinations of Public Domain Elements

In evaluating a work for copyright protection under *Feist*, the focus of inquiry is not on the individual elements of the work, but on the combination of those elements in the work as a whole.<sup>11</sup> Indeed, the arrangement of the elements, in and of itself, may be indicative of original authorship.<sup>12</sup>

Lest “every song [be] merely a collection of basic notes, every painting a derivative work of color and stroke, and every novel merely an unprotected jumble of words,” a court cannot assess the originality of a work solely from the originality of the individual component parts. As *Feist* makes clear, *a work that is entirely a collection of unoriginal material nevertheless may be copyrighted if the material is selected, coordinated or arranged in an original fashion*. While component parts are not entitled to copyright protection simply by virtue of their combination into a larger whole, copyright may protect the particular way in which the underlying elements are combined—if the particular method of combination is itself original.<sup>13</sup>

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<sup>9</sup> *Feist*, 499 U.S. at 345 (citation omitted).

<sup>10</sup> CHARLES BUKOWSKI, NOTES OF A DIRTY OLD MAN (City Lights Books 1981) (1969).

<sup>11</sup> *Feist*, 499 U.S. at 358 (“to merit protection, the facts must be selected, coordinated, or arranged ‘in such a way’ as to render the work as a whole original”); *accord* Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1109 (9th Cir. 1970) (“all elements of each card, including text, arrangement of text, art work, and association between art work and text, [must] be considered as a whole”); Atari Games Corp. v. Oman, 888 F.2d 878, 883 (D.C. Cir. 1989) (“*Atari I*”) (“the Register’s focus, even if initially concentrated on discrete parts, ultimately should be on the audiovisual work as a whole”).

<sup>12</sup> Atari Games Corp. v. Oman, 979 F.2d 242, 243 n.1 (D.C. Cir. 1992) (“*Atari II*”) (“Recalling the creativity of the work of Mondrian and Malevich, for example, we note that arrangement itself may be indicative of authorship.”).

<sup>13</sup> Diamond Direct, LLC v. Star Diamond Group, Inc., 116 F. Supp. 2d 525, 528 (S.D.N.Y. 2000) (citations omitted) (emphasis added); *see also* Savata, 323 F.3d at 811 (“[A] combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.”).

Regardless of whether a design element in the public domain is categorized as ornate or simple, it would be considered unoriginal material and, hence, unprotectable on its own. To be entitled to copyright protection, such unoriginal design elements must be combined or arranged in an “original” manner, rather than in the mechanical application of a commonplace idea.<sup>14</sup>

A. *Combination of Shapes*

There is no per se prohibition against affording copyright protection to a design that is a combination of so-called simple shapes. As recognized by the D.C. Circuit in *Atari Games Corp. v. Oman* (“*Atari I*”), which involves a video game using simple geometric shapes, such as rectangles and squares, to represent a wall, a ball, and a paddle:

[S]imple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and in court. *See, e.g., Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir. 1974) (concluding that fabric design consisting of strip of crescents with scalloping or ribbons and rows of semicircles “constitutes modest but sufficient originality so as to support the copyright”); *Tennessee Fabricating Co. v. Moultrie Mfg. Co.*, 421 F.2d 279, 282 (5th Cir.) (holding that filigree pattern of intercepting straight and arc lines “possessed at least the minimal degree of creativity required for a copyright”), *cert. denied*, 398 U.S. 928, 90 S. Ct. 1819, 26 L. Ed. 2d 91 (1970); *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1316 (2d Cir. 1969) (treating as subject to copyright protection fabric design consisting of a circle within a square within a circle); *In Design v. Lynch Knitting Mills, Inc.*, 689 F. Supp. 176, 178-79 (S.D.N.Y.) (upholding copyright of rhomboid pattern on a sweater), *aff’d*, 863 F.2d 45 (2d Cir. 1988).<sup>15</sup>

Shortly after the Supreme Court’s decision in *Feist*, the Northern District of Illinois in *Runstadler Studios, Inc. v. MCM Ltd. Partnership* acknowledged that “combinations of standard

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<sup>14</sup> *See Feist*, 499 U.S. at 363 (copyright protection denied for a work that was the product of “an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course”).

<sup>15</sup> *Atari I*, 888 F.2d at 883-84. *See infra* Part II.D, for a detailed discussion of the *Atari* cases.

shapes may possess the requisite creativity for copyright protection.”<sup>16</sup> The defendant had argued that the Copyright Office’s failure to register its spiral sculpture of glass rectangles “proves that the combination of glass rectangles cannot be a proper subject of copyright,” and that the plaintiff’s registered spiral sculpture of glass rectangles likewise should be denied copyright protection.<sup>17</sup> This tit-for-tat argument was unsuccessful. The court noted that “[w]hatever the Copyright Office’s actions with respect to [defendant’s] application, the case law is contrary.”<sup>18</sup>

In *Prince Group, Inc. v. MTS Products*, the Southern District of New York noted that “a work may be copyrightable even though it is entirely a compilation of unprotectable elements.”<sup>19</sup> The defendant had argued that the plaintiff’s registered Mega Dot pattern was simply a slight variation of the common polka dot design, which is a collection of circles – “a basic geometric shape that falls within the public domain, and is thus, uncopyrightable.”<sup>20</sup> The court held that “the decision to place the polka dots in imperfect and conflicting diagonal lines at varying distances from each other giving the appearance of randomness, distinguishes this arrangement from the regularity of the generic polka dot design; thus, establishing a sufficient level of creativity for copyright validity.”<sup>21</sup>

These cases illustrate that copyright protection may be available for a combination of simple geometric shapes, such as rectangles or circles, where their arrangement establishes some modicum of ingenuity and creativity.

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<sup>16</sup> *Runstadler Studios, Inc. v. MCM Ltd. P’ship*, 768 F. Supp. 1292, 1296 (N.D. Ill. 1991).

<sup>17</sup> *Id.* at 1296 n.5.

<sup>18</sup> *Id.*

<sup>19</sup> *Prince Group, Inc. v. MTS Prod.*, 967 F. Supp. 121, 125 (S.D.N.Y. 1997).

<sup>20</sup> *Id.* at 124.

<sup>21</sup> *Id.* at 125; *see also* *Thimbleberries, Inc. v. C&F Enterprises, Inc.*, 142 F. Supp. 2d 1132 (D. Minn. 2001) (repeating quilt pattern was sufficiently creative for copyright protection).

B. *Shapes Combined With Text*

The question of whether the combination of public domain shapes and text is entitled to copyright protection was presented in *Dahlen v. Michigan Licensed Beverage Association*, which concerned the layout of a poster containing paraphrased public domain material.<sup>22</sup> The Eastern District of Michigan noted that the poster's arrangement included font-related features such as "the use of bold or capitalized letters . . . to emphasize certain words," and simple shapes such as "a box of text" and "a border around the outer edges of the poster."<sup>23</sup> The arrangement represented specific creative choices by the author.<sup>24</sup> Quoting *Feist*, the court found that:

None of these features is essential to an informational poster. This arrangement does not conform to an "age-old practice," nor is it "so commonplace that it has come to be expected as a matter of course."<sup>25</sup>

The *Dahlen* court upheld the validity of the copyright registration of the poster comprising standard fonts and box shapes.<sup>26</sup> Even though boldfaced text and box shapes may not be individually copyrightable, the combination of these public domain features possessed sufficient creativity to qualify for copyright protection.<sup>27</sup>

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<sup>22</sup> *Dahlen v. Mich. Licensed Beverage Ass'n*, 132 F. Supp. 2d 574 (E.D. Mich. 2001).

<sup>23</sup> *Id.* at 582.

<sup>24</sup> In another case concerning the presentation of public domain text, a garden rock cast with a public domain poem was entitled to copyright protection. *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199 (3d Cir. 2005). The court found that the fact that the plaintiff "selected an inspirational poem from the public domain, adapted that poem to make it visually and rhythmically appealing, and then cast it on its own sculptural work" showed the "quantum of creativity" sufficient to qualify for copyright protection. *Id.* at 207. The work reflected choices made with some creative thought. *Id.*

<sup>25</sup> *Dahlen*, 132 F. Supp. 2d at 582 (quoting *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 343 (1991)).

<sup>26</sup> *Id.*

<sup>27</sup> Providing copyright protection for a distinctive combination of public domain features is also consistent with pre-*Feist* precedent. For example, in *Reader's Digest Ass'n v. Conservative Digest, Inc.*, 821 F.2d 800 (D.C. Cir. 1987), the Reader's Digest magazine cover was found to be entitled to copyright protection even though none of the individual elements of the magazine cover (e.g., ordinary lines, typefaces, and colors) was entitled to copyright protection. *Id.* at 806. Reader's Digest had "combined and arranged common forms to create a unique graphic design and layout" that was entitled to protection as a graphic work. *Id.*; see also *Amplex Mfg. Co. v. A.B.C. Plastic Fabricators, Inc.*, 184 F. Supp. 285, 288 (E.D. Pa. 1960) ("the distinguishable variation in the arrangement and

Similarly, the question of whether the combination of public domain shapes within text is entitled to copyright protection was addressed in *Willard v. Estern*.<sup>28</sup> The dispute in *Willard* centered on the use of a known “Caneel” petroglyph<sup>29</sup> as the middle two zeros in the calendar year “2000,” which is reproduced below:<sup>30</sup>



There was no dispute that the “2” and the “0” used typical fonts and spacing, and that the “Caneel” petroglyph was a public domain shape. The *Willard* court held that this simple combination of public domain elements was a copyrightable work.<sup>31</sup> This is consistent with the *Feist* precedent because the combination of a calendar year with a petroglyph does not represent an “age-old practice” so commonplace that it would be “expected as a matter of course.” A petroglyph (a rock carving which connotes the stone age) is not commonly associated with a calendar year (specifically, the “2000” millennium which connotes the most modern age).

In a case pre-dating *Feist*, the Eighth Circuit in *John Muller & Co., Inc. v. New York Arrows Soccer Team, Inc.*, upheld a refusal to register a logo consisting of four angled lines forming an arrow, with the word “arrow” in cursive script underneath, because it was not an abuse of discretion to find that the design lacked sufficient creativity to support a copyright.<sup>32</sup> The reported decision, however, provides little context that would help indicate whether there

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manner of presentation —the dark background, the particular size of the letters, their spacing, their arrangement into three rows—all combined to give the product authorship worthy of protection”).

<sup>28</sup> *Willard v. Estern*, 206 F. Supp. 2d 723 (D. V.I. 2002).

<sup>29</sup> A petroglyph is a carving or line drawing on rock, especially one made by prehistoric people. THE AMERICAN HERITAGE COLLEGE DICTIONARY 1022 (3d ed. 1997).

<sup>30</sup> The authors wish to thank Deborah Willard for graciously providing a sample of her copyrighted artwork. The original artwork that was registered also included an illustration of fireworks in the background.

<sup>31</sup> *Willard*, 206 F. Supp. 2d at 725.

<sup>32</sup> *John Muller & Co., Inc. v. N. Y. Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986).



was some ingenuity in using an arrow shape with the word “arrow.” The *John Muller* decision can be harmonized with *Feist* to the extent that the combination of an arrow (→) with the word “arrow” represented an “age-old practice” that is so commonplace that it would be “expected as a matter of course.”<sup>33</sup>

The choices made in selecting and combining the elements of a work in a distinctive manner can point to whether the originality requirement for copyright protection has been met. In *Willard*, the juxtaposition of an old petroglyph within the year 2000 indicated some ingenuity and creativity; whereas, without further context, the placement of the word “arrow” underneath an arrow shape in *John Muller* could be considered so commonplace as to be unoriginal.

C. *Modifications in the Shape and Color of Lettering in a Logo*

Recently, the Eastern District of New York in *Sadhu Singh Hamdad Trust v. Ajit Newspaper Advertising, Marketing And Communications, Inc.*, addressed the issue of whether the stylized rendering of text in a logo was entitled to copyright protection.<sup>34</sup> In this case, the plaintiff published a daily newspaper, the *Ajit Daily*, in the Punjab region of India.<sup>35</sup> The defendant published a weekly newspaper called the *Ajit Weekly*, which is distributed in the United States, Canada, the United Kingdom and Europe.<sup>36</sup> The plaintiff alleged that defendants deliberately copied the *Ajit Daily's* logo in order to reap the benefits of a false association with

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<sup>33</sup> See *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991); see also *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 546 (S.D.N.Y. 2001) (a Chinese restaurant menu consisting of photographs of common Chinese dishes was not entitled to copyright protection).

<sup>34</sup> *Sadhu Singh Hamdad Trust v. Ajit Newspaper Adver., Mktg and Comm'ns, Inc.*, 503 F. Supp. 2d 577 (E.D.N.Y. 2007).

<sup>35</sup> *Id.* at 581.

<sup>36</sup> *Id.*

the *Ajit Daily*.<sup>37</sup> The plaintiff had duly registered its masthead logo in India, and asserted copyright infringement in the United States based on the Berne Convention.<sup>38</sup>

The logo in question consisted of the word “Ajit” (which means “unconquerable” and was the name of a famous Sikh warrior) using a modified Punjabi font.<sup>39</sup> The top hook of the word in the Ajit logo was flattened and extended, and the bottom hook at the right-hand corner was cut off to form a flatter, lower hook than in standard Punjabi fonts, which is illustrated in the drawings from the defendant’s brief dated March 15, 2006, reproduced below:



The *Sadhu* court noted that “courts have also found in some cases that while the use of a particular form of extensively used lettering is not copyrightable, the arrangement of that lettering, and the manner of presentation, including background, letter size, and spacing, combined to give the product sufficient independent authorship to warrant copyright protection.”<sup>40</sup> Here, “whether the Ajit logo, with its modification in color and shape from standard Punjabi font, possesses the requisite originality and creativity to warrant United States copyright protection is a close question.”<sup>41</sup> Drawing all inferences in favor of the plaintiff who opposed a motion for summary judgment, the court concluded that “[a] reasonable juror could

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<sup>37</sup> *Id.*

<sup>38</sup> *Id.* at 583-84 (citing 17 U.S.C. § 104).

<sup>39</sup> *Id.* at 588.

<sup>40</sup> *Id.* at 589 (citing *Amplex Mfg. Co. v. A.B.C. Plastic Fabricators, Inc.*, 184 F. Supp. 285, 286-87 (D.C. Pa. 1960)).

<sup>41</sup> *Id.*

find that the combination of bright red coloring with the modification of some of the lettering is sufficient to establish such creativity.”<sup>42</sup>

D. *A “Simple” Video Game*

The Copyright Office’s practice guidelines assert that “the simplicity of standard ornamentation” or “a simple combination of a few standard symbols” is not a basis of copyrightability.<sup>43</sup> These guidelines, however, would be contrary to the controlling legal authority if applied as an indiscriminate per se rule against simple shapes and coloring. The Court of Appeals for the District of Columbia criticized the Copyright Office’s per se approach in *Atari Games Corp. v. Oman* (“*Atari I*”),<sup>44</sup> and *Atari Games Corp. v. Oman* (“*Atari II*”).<sup>45</sup> The work at issue was a video game called BREAKOUT.

BREAKOUT is a relatively early video game of comparative simplicity. The sound accompaniment is four basic tones. The screen shows the two players’ scores at the top. The players move a “paddle” to hit a “ball” against a “wall.” The wall is built of eight rows of rectangles arranged in four monochromatic stripes (red, amber, green, yellow). When the square blue ball hits a rectangle, the rectangle vanishes. When the ball breaks through the wall of rectangles to the empty space beyond, it ricochets at greatly increased speed until it reemerges. Both the ball’s speed and the size of the rectangular paddle change during play. The ball’s movement does not follow the laws of physics; instead, the angle of the ball’s rebound depends solely on where it impacts the paddle.<sup>46</sup>

In *Atari I*, the court found that the Register of Copyrights’ refusal of registration lacked clarity in a number of areas, including the standard of creativity and the consideration of the

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<sup>42</sup> *Id.* at 590.

<sup>43</sup> U.S. COPYRIGHT OFFICE, COMPENDIUM II, COPYRIGHT OFFICE PRACTICES, Sec. § 503.02(a) (1984).

<sup>44</sup> *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989) (“*Atari I*”).

<sup>45</sup> *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992) (“*Atari II*”).

<sup>46</sup> *Id.* at 243.

work as a whole.<sup>47</sup> The Register argued that BREAKOUT lacked “modest” creativity and “pointed to the Copyright Office regulation providing that ‘familiar symbols or designs’ and ‘mere variations of typographic ornamentation, lettering or coloring’ are not subject to copyright.”<sup>48</sup> The appellate court, however, noted that copyright protection may be accorded to “simple shapes, when selected or combined in a distinctive manner indicating some ingenuity,”<sup>49</sup> and concluded that “[w]e are thus uncertain whether or how the Register’s decision on BREAKOUT harmonizes with prior Copyright Office actions and court rulings on the creativity threshold.”<sup>50</sup> The court also expressed concern “that the Register’s attention may have trained dominantly on components, not on the work as a whole.”<sup>51</sup> The *Atari I* case was remanded “with instructions to return the matter of Atari’s application to the Register for renewed consideration consistent with this opinion.”<sup>52</sup>

The dispute was later replayed in *Atari II* where, after remand, the Register of Copyrights again refused registration of BREAKOUT because it failed to meet the standard of creativity for a copyright.<sup>53</sup>

In his second refusal to register BREAKOUT, the Register characterized the representations of the wall, ball, and paddle as “simple geometric shapes and coloring” which “*per se* are not copyrightable.” Letter at 3 (citing 37 C.F.R. § 202.1 (1988)). Viewing BREAKOUT “as a whole,” the Register found “no

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<sup>47</sup> *Atari I*, 888 F.2d at 883-84.

<sup>48</sup> *Id.* at 883 (citing 37 C.F.R. § 202.1).

<sup>49</sup> *Id.*

<sup>50</sup> *Id.* at 884.

<sup>51</sup> *Id.* at 883.

<sup>52</sup> *Id.* at 886.

<sup>53</sup> *Atari Games Corp. v. Oman*, 979 F.2d 242, 243 (D.C. Cir. 1992) (“*Atari II*”).

original authorship in either the selection or arrangement of the images or their components.” *Id.* at 3-4.<sup>54</sup>

The “per se” prohibition against registering “simple geometric shapes” in the Register’s later refusal appears to be at odds with the *Atari I* court’s admonition that “simple shapes” may be accorded copyright protection. With regard to the *Atari I* court’s concern about how the prior refusal can be harmonized with prior court rulings on the creativity threshold, the Register apparently focused on the intervening *Feist* decision as supporting the decision to refuse registration.

The Register reported that he reconsidered BREAKOUT under the “generally accepted modest degree of creativity standard.” Letter at 1. On brief he contended that “*Feist* confirms the Copyright Office’s understanding of the statutory standard of original work of authorship.” Brief for Appellee at 21. We do not comprehend, however, how one reconciles *Feist*’s elucidation with the Register’s analysis in this case.<sup>55</sup>

As previously discussed, the quantum of creativity required under *Feist* is “extremely low.”<sup>56</sup> The work, however, must be something more than the commonplace or expected result of an age-old practice firmly rooted in tradition.<sup>57</sup>

The Register, on the other hand, had focused on whether the geometric shapes being used were “simple,” rather than on whether those geometric shapes were being used in a traditional manner so commonplace as to be expected. Moreover, during oral argument, counsel for the Register suggested that the use of “nonrepresentational images” in the BREAKOUT videogame

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<sup>54</sup> *Id.* (emphasis in original). The Register’s refusal also asserted that, “If the Copyright Office were to examine a painting consisting entirely of rectangles and find it copyrightable, it is important to understand that this decision would be based on creative elements such as depth, perspective, shading, texture of brushstroke, etc. and not on the geometric shapes per se.” *Id.* at 243 n.1.

<sup>55</sup> *Id.* at 246.

<sup>56</sup> *Feist Publ’ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

<sup>57</sup> *Id.* at 363.

shows a lack of creativity.<sup>58</sup> For example, counsel for the Register argued that a brick wall composed of rows of colored rectangles was not fanciful or expressive because “[i]t is simply common symbols that had been run together.”<sup>59</sup> The court rejected these arguments as being in “tension” with *Feist*.<sup>60</sup> “Abstract representation . . . is neither an ‘obvious’ nor an ‘inevitable’ choice.”<sup>61</sup>

The *Atari II* court found that “[t]he assemblage of elements in BREAKOUT does not appear to follow ‘a convention’ that is ‘purely functional,’ allowing ‘no opportunity for variation.’”<sup>62</sup> Applying the abuse of discretion standard, the court held that “the rejection of BREAKOUT was unreasonable when measured against the Supreme Court’s instruction that “the requisite level of creativity [for copyrightability] is extremely low.”<sup>63</sup> The case was remanded again with instructions for renewed consideration by the Register of Copyrights consistent with the *Atari II* opinion.<sup>64</sup>

### III. A “Thin” Scope Of Protection

While the minimum level of creativity for copyrightability is extremely low, if the quantum of originality just meets that bare minimum, it may only be entitled to “thin” copyright protection that prevents virtually identical copying.<sup>65</sup> The Ninth Circuit in *Satava v. Lowry*,

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<sup>58</sup> *Atari II*, 979 F.2d at 246.

<sup>59</sup> *Id.* at 246-47.

<sup>60</sup> *Id.* at 246.

<sup>61</sup> *Id.* at 247. While a simple geometric shape on its own would not be copyrightable, such simple shapes may warrant copyright protection when selected and combined in a distinctive manner indicating some ingenuity. Thus, a simple shape that is selected as an abstract representation of something else can help show the creative spark necessary for copyright protection.

<sup>62</sup> *Id.* at 246 (citing *Victor Lalli Enters. v. Big Red Apple, Inc.*, 936 F.2d 671, 673 (2d Cir. 1991)).

<sup>63</sup> *Id.* at 243 (quoting *Feist*, 499 U.S. at 345).

<sup>64</sup> *Id.* at 247.

<sup>65</sup> *See, e.g.*, *Beaudin v. Ben & Jerry's Homemade, Inc.*, 95 F.3d 1, 2 (2d Cir. 1996) (“Where the quantum of originality is slight and the resulting copyright is ‘thin,’ infringement will be established only by very close copying

indicated that a thin copyright may be appropriate where there is some creativity in the work, but not enough to qualify for broad protection.<sup>66</sup> However, “expressions that are standard, stock, or common to a particular subject matter or medium are not protectable under copyright law.”<sup>67</sup> “There must be something more than a ‘merely trivial’ variation, something recognizably the artist’s own.”<sup>68</sup>

The work at issue in *Satava* was a glass-in-glass<sup>69</sup> jellyfish sculpture that was described as a “vertically oriented, colorful, fanciful jellyfish with tendril-like tentacles, and a rounded bell encased in an outer layer of rounded clear glass that is bulbous at the top and tapering toward the bottom to form roughly a bullet shape, with the jellyfish portion of the sculpture filling almost the entire volume of the outer, clear glass shroud.”<sup>70</sup> In applying the originality requirement to these sculptures, the court was concerned over whether the expressions in the sculptural work varied from the standard manner of expression in that medium, namely, a glass-in-glass jellyfish sculpture.<sup>71</sup>

Satava may not prevent others from depicting jellyfish with tendril-like tentacles or rounded bells, because many jellyfish possess those body parts. He may not prevent others from

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. . .”). The requirement of originality, in practice, has become little more than a prohibition against actual copying. *Key Publ’ns, Inc. v. Chinatown Today Publ’g Enters., Inc.*, 945 F.2d 509, 513 (2d Cir. 1991) (citation omitted).

<sup>66</sup> *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003); *see also Express, LLC v. Fetish Group, Inc.*, 424 F. Supp. 2d 1211, 1227 (C.D. Cal. 2006).

<sup>67</sup> *Satava*, 323 F.3d at 810; *see also Feist Publ’ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991) (Copyright protection denied for a telephone directory that was the result of “an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course.”).

<sup>68</sup> *Satava*, 323 F.3d at 810; *see also Express*, 424 F. Supp. 2d at 1227 (Thin copyright protection was available for “creativity beyond the standard elements.”).

<sup>69</sup> “Glass-in-glass sculpture is a centuries-old art form that consists of a glass sculpture inside a second glass layer, commonly called the shroud. The artist creates an inner glass sculpture and then dips it into molten glass, encasing it in a solid outer glass shroud. The shroud is malleable before it cools, and the artist can manipulate it into any shape he or she desires.” *Satava*, 323 F.3d at 809.

<sup>70</sup> *Id.* at 807.

<sup>71</sup> *Id.* at 812.

depicting jellyfish swimming vertically, because jellyfish swim vertically in nature and often are depicted swimming vertically.

Satava may not prevent others from depicting jellyfish within a clear outer layer of glass, because clear glass is the most appropriate setting for an aquatic animal. He may not prevent others from depicting jellyfish “almost filling the entire volume” of the outer glass shroud, because such proportion is standard in glass-in-glass sculpture. And he may not prevent others from tapering the shape of their shrouds, because that shape is standard in glass-in-glass sculpture.<sup>72</sup> . . . These elements are *so commonplace* in glass-in-glass sculpture and *so typical* of jellyfish physiology that to recognize copyright protection in the combination effectively would give Satava a monopoly on lifelike glass-in-glass sculptures of single jellyfish with vertical tentacles.<sup>73</sup>

Satava could not prevent other artists from using such “standard and stereotyped elements,” but the court noted that Satava “has made some copyrightable contributions: the distinctive curls of particular tendrils; the arrangement of certain hues; the unique shape of jellyfishes’ bells.”<sup>74</sup> To the extent that these choices in shape and color were not governed by jellyfish physiology or the glass-in-glass medium, they may be entitled to “a thin copyright that protects against only virtually identical copying.”<sup>75</sup>

The Central District for California later applied the doctrine of “thin” copyright protection in *Express, LLC v. Fetish Group, Inc.*, noting that one reason for the narrow scope of protection for a “thin” copyright is “the threat of copyright protection expanding to the point of

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<sup>72</sup> *Id.* at 811.

<sup>73</sup> *Id.* at 812 (citation omitted) (emphasis added); *see also* *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987) (“No copyright protection may be afforded to the idea of producing stuffed dinosaur toys or to elements of expression that necessarily follow from the idea of such dolls.”).

<sup>74</sup> *Satava*, 323 F.3d at 812.

<sup>75</sup> *Id.*; *Ets-Hokin v. Skyy Spirits Inc.*, 323 F.3d 763, 766 (9th Cir. 2003) (“When we apply the limiting doctrines, subtracting the unoriginal elements, *Ets-Hokin* is left with only a ‘thin’ copyright, which protects against only virtually identical copying”); *Apple Computer v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994) (“When the range of protectable expression is narrow, the appropriate standard for illicit copying is virtual identity.”); *see also* *Sadhu Singh Hamdad Trust v. Ajit Newspaper Adver., Mktg and Comm’ns, Inc.*, 503 F. Supp. 2d 577, 591 (E.D.N.Y. 2007) (“Plaintiff’s Ajit logo, with its particular letter shapes and spacing, appears to be virtually identical to that of defendant’s Ajit logo.”).



providing a monopoly on commonplace expressions or expressions that are driven more by the limitations of the medium or the subject than by creativity.”<sup>76</sup> Here, Express was accused of violating Fetish’s copyright for a camisole having “scalloped lace edging along the hemline and around the top and a three-flower embroidery design below the right hip.”<sup>77</sup>

The court sought to identify the elements in which Fetish could claim a copyright.<sup>78</sup> Assessing the originality of the separate elements (such as the placement of lace trim and the use of cut-out lace flowers with the embroidery design) and of the combination of those elements, the court found that neither were entitled to broad protection.<sup>79</sup> In assessing the separate elements, the court found them to be “standard elements” of camisoles.<sup>80</sup> Although not all of these elements are used on every camisole, “they appear with enough frequency that it would be a disservice to creativity to allow Fetish to claim a monopoly in the use of them.”<sup>81</sup> In addition, most of these elements could be found in prior art garments, such that the combination of these elements in Fetish’s camisole should not, in general, be considered protected by copyright law.<sup>82</sup> The court, however, did find that the floral embroidery design established “some small amount of creativity beyond the standard combination of standard elements” because the design was

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<sup>76</sup> Express LLC v. Fetish Group Inc., 424 F. Supp. 2d 1211, 1226 (C.D. Cal. 2006) ; *cf.* Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp., 340 U.S. 147, 152-3 (1950) (“A patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.”).

<sup>77</sup> Express, 424 F. Supp. 2d at 1214.

<sup>78</sup> *Id.* at 1214-5. Fetish had filed a supplemental registration for its copyright which stated that the lace trim on the garment was preexisting material and Fetish claimed no copyright in the lace trim. *Id.* at 1216. Express argued that the amended copyright registration covered only the embroidery design, whereas Fetish argued that the copyright included the placement and arrangement of the lace. *Id.* at 1221. Because the court concluded that the embroidery design was the only aspect of the camisole entitled to copyright protection, the dispute about the scope of the copyright registration was, “in the end, irrelevant.” *Id.* at 1221-2.

<sup>79</sup> *Id.* at 1226.

<sup>80</sup> *Id.* at 1226-7.

<sup>81</sup> *Id.* at 1227.

<sup>82</sup> *Id.*

fairly intricate and did not represent the only way that stems and leaves can be depicted.<sup>83</sup> Thus, Fetish was entitled to thin copyright protection that guards only against virtually identical copying.

Fetish had filed a motion for summary judgment of copyright infringement which required that there be no genuine issue of fact that Fetish's and Express' camisoles were "substantially similar."<sup>84</sup> "The Ninth Circuit applies a two-part test in determining substantial similarity: the extrinsic test and the intrinsic test."<sup>85</sup>

The extrinsic test is based on several objective criteria:

First, the copyright holder must identify the concrete elements which are similar. Second, the court must determine whether the allegedly similar elements are protected by copyright. Third, the court must define the scope of the plaintiff's copyright—i.e., whether it is entitled to broad or thin protection.<sup>86</sup>

The intrinsic test asks "whether the ordinary, reasonable person would find the total concept and feel of the works to be substantially similar."<sup>87</sup> The court noted, however, that "while the intrinsic test is inherently subjective and therefore often inappropriate for summary judgment, 'where the works are so overwhelmingly identical that the possibility of independent

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<sup>83</sup> *Id.* at 1227.

<sup>84</sup> *Id.* Access by the alleged infringer is an additional requirement for copyright infringement, but Express had conceded that it had actual knowledge of Fetish's camisole, so this issue was not in dispute. *Id.* at 1227-8.

<sup>85</sup> *Id.* at 1228.

<sup>86</sup> *Id.* (citations omitted). *cf.* *Beaudin v. Ben & Jerry's Homemade, Inc.*, 95 F.3d 1, 2 (2d Cir. 1996) (The "ordinary observer" test for copyright infringement should be applied using a "more discerning" standard where the copyright is "thin").

<sup>87</sup> *Express*, 424 F. Supp. 2d at 1228 (*quoting* *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000)); *cf.* *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 111 (2d Cir. 2001) (The standard test for substantial similarity between two works is whether an "ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard [the] aesthetic appeal as the same." (citations omitted)).

creation is precluded,' it is not necessary for a jury to decide the questions raised by the intrinsic test."<sup>88</sup>

The court ruled that Fetish's and Express' camisoles, as a whole and with respect to the embroidery design, were "virtually identical."<sup>89</sup> Although not precisely identical, the court found that these slight discrepancies were eclipsed by the almost total likeness in the arrangement and placement of the two designs on the garments.<sup>90</sup> Summary judgment of copyright infringement was granted based on Express' "virtually identical" copying of Fetish's "thin" copyright notwithstanding the court's concerns about providing a monopoly on standard elements or standard combinations of such elements.<sup>91</sup>

Concern about providing a monopoly on commonplace expressions may have animated the Register's reluctance to allow registration of the "simple" videogame in the *Atari* cases. This concern, however, can be addressed by the doctrine of "thin" copyright protection, which was applied in *Satava* and *Express* to address the protectable elements of works that, on the surface, appeared less simple but which consisted largely of standard and stereotyped elements.

### Conclusion

While standard geometric shapes, or the coloration of such shapes, by themselves typically do not have the quantum of original creative authorship essential for copyright

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<sup>88</sup> *Express*, 424 F. Supp. 2d at 1228 (quoting *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1330 (9th Cir. 1983)); see also *Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.*, 295 F. Supp. 1366, 1369 (S.D.N.Y.), *aff'd*, 415 F.2d 1007 (2d Cir. 1969) (In view of the "remarkable likeness" of the designs, "the similarities are so obvious that there can be no genuine issue of fact that defendant's design was copied from plaintiffs'").

<sup>89</sup> *Express*, 424 F. Supp. 2d at 1228.

<sup>90</sup> *Id.* Thus, "virtually identical" copying does not require that the works be "precisely" identical. *Id.*

<sup>91</sup> *Id.* at 1229. For cases involving a "thin" copyright, *Express* suggests that such cases would likely be amenable to summary judgment since there may be little difference between the "virtually identical" standard for infringing a "thin" copyright and the "overwhelmingly identical" standard for granting summary judgment of copyright infringement in general. *Id.*

protection, a combination of such design elements could very well have the necessary creative spark to warrant copyright protection. The focus should be on whether the work is the expected result of a standard or commonplace practice.

The Copyright Office, on the other hand, seems more focused on whether the elements of a work can be categorized as being “simple,” rather than on whether the combination of those elements is the expected or mechanical result of a commonplace practice. This is reflected in its COMPENDIUM II, COPYRIGHT OFFICE PRACTICES, which asserts that “the simplicity of standard ornamentation” or “a simple combination of a few standard symbols” is not a basis of copyrightability.<sup>92</sup> The Copyright Office may be concerned that allowing the registration of a so-called simple work could provide an improper monopoly on standard design elements and unduly curtail other creative works.<sup>93</sup> However, this concern can be addressed by the judicial doctrine of “thin” copyright protection that prevents only virtually identical copying.<sup>94</sup> In addition, the Copyright Office could consider any express admission by the applicant that the work may only be entitled to a “thin” copyright.<sup>95</sup>

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<sup>92</sup> U.S. COPYRIGHT OFFICE, COMPENDIUM II, COPYRIGHT OFFICE PRACTICES, § 503.02(a) (1984).

<sup>93</sup> See *Express*, 424 F. Supp. 2d at 1226 (noting “the threat of copyright protection expanding to the point of providing a monopoly on commonplace expressions or expressions”). This tension between broad and narrow protection is also present in patent law. For example, a design patent may be entitled to only a “narrow” scope of protection where “a field is crowded with many references relating to the design of the same type of appliance.” *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984).

<sup>94</sup> See *Satava*, 323 F.3d at 812. The *Satava* court, however, also suggested that the unprotectable elements had to be “numerous enough” to constitute an original work of authorship. *Id.* at 811.

<sup>95</sup> See *Express*, 424 F. Supp. 2d at 1219 (The scope of a registered copyright is determined by the registration application, “even if the Copyright Office does not extensively examine the registration applications or apply rigorous standards.”). An analogy may be drawn with patent law where statements made during the prosecution of a patent application may estop the patent owner from taking an inconsistent position in later litigation. See *Cordis Corp. v. Medtronic AVE, Inc.*, 511 F.3d 1157, 1177 (Fed. Cir. 2008), *reh’g and reh’g en banc denied*, 2008 U.S. App. LEXIS 10499 (Apr. 9, 2008) (unpublished), *cert. denied*, 129 S. Ct. 201 (2008) (the doctrine of prosecution disclaimer in patent law limits claim scope where a “clear and unmistakable” statement is made by the patentee during prosecution); *cf. Express*, 424 F. Supp. 2d at 1219 (Although a presumption of validity attached to a registered copyright because the Copyright Office has passed judgment on the claimed copyright, “it does not create the same strong presumption of validity that attaches to patents.”).

The Copyright Office also should give consideration to an applicant's explanation of the context of a so-called simple work in order to establish that the work is creative and not merely the mechanical result of some age-old practice.<sup>96</sup> This may include the inspiration for the work, the choices available for combining the elements of the work, the reasons for making the choices, and whether those choices represent commonplace expressions or not. While the Copyright Office should not weigh the artistic merit of a work,<sup>97</sup> such explanations could help provide a basis for finding the quantum of originality needed for a copyright. Rather than an apparent per se approach that focuses on the alleged simplicity of the work, the Copyright Office should give such explanations due consideration in the registration process.

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<sup>96</sup> What is "creative," of course, often depends on context. *Compare* Kellerman v. Coca-Cola Co., 280 F. Supp. 2d 670 (E.D. Mich. 2003) (a novelty hat in the shape of a wing nut for fans of the Detroit Red Wings hockey team was sufficiently creative to warrant copyright protection) *with* Past Pluto Prods. Corp. v. Dana, 627 F. Supp. 1435 (S.D.N.Y. 1986) (a novelty hat in the shape of the Statue of Liberty crown lacked sufficient originality); *cf. In re Opendahl & Larson LLP*, 373 F.3d 1171, 1173 (Fed. Cir. 2004) (The hypothetical of "tennis.net" which "produces a witty double entendre relating to tennis nets" was used to illustrate the reasoning for rejecting a bright line rule that a top-level-domain component could not demonstrate distinctiveness for a trademark.).

<sup>97</sup> "It would be a dangerous undertaking for persons trained only to the law to constitute themselves judges of the worth of pictorial illustrations outside of the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).