



United States Copyright Office

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Re: Second Request for Reconsideration for Refusal to Register Garmin Switzerland GmbH – Watch Bands; Correspondence IDs: 1-32PXY25, 1-32QDQNC; SR 1-6171893851, SR 1-6077016811

Dear Ms. Bailey:

The Review Board of the United States Copyright Office (“Board”) has considered Garmin Switzerland GmbH’s (“Garmin’s”) second request for reconsideration of the Registration Program’s refusal to register jewelry design and two-dimensional artwork claims in two watch bands titled “Watch Band with Crosshatch Pattern and Delta” (“Crosshatch Band”) and “Watch Band with Stippling and Delta” (“Stippling Band”) (collectively, the “Works”). After reviewing the applications, deposit copies, and relevant correspondence, along with the arguments in the second requests for reconsideration, the Board affirms the Registration Program’s denials of registration.

I. DESCRIPTION OF THE WORKS

The Works are designs on two watch bands. The Crosshatch Band is red and features a diamond crosshatch pattern surrounded on each lateral side by a flat edge and also bordered at one end by a flat edge featuring a triangle in one corner. The Stippling Band is white and features stippling and a triangle embossed on the band. Garmin does not claim the color or shape of either watch band. The Works are depicted below:



II. ADMINISTRATIVE RECORD

On January 5, 2018, Garmin filed an application to register a copyright claim in the Crosshatch Band. In a January 5, 2018, letter, a Copyright Office registration specialist refused to register the claim, finding that the Crosshatch Band was a useful article without any copyrightable elements. Letter from Kristen Sosinski, Registration Examiner, to Jennifer C. Bailey, at 1 (Jan. 5, 2018). In a letter dated March 12, 2018, Garmin requested that the Office reconsider its initial refusal to register the Crosshatch Band. Garmin acknowledged that the “watch band itself is a useful object.” Letter from Jennifer C. Bailey to U.S. Copyright Office, at 2 (Mar. 12, 2018) (“Crosshatch First Request”). It contended that the “design features

incorporated onto the watch band are separable from the functional aspects of the watch band itself” and that “[i]ts creative selection and arrangement of the crosshatch pattern coupled with the location of the delta in relief on the watch band satisfy the sufficient amount of original authorship.” *Id.* at 4. Additionally, Garmin clarified that it “limit[ed] its claim for copyright to the diamond crosshatch pattern surrounded on each lateral side by a flat, non-patterned trim edge and further edged at one end by a flat, non-patterned section having a delta.” *Id.* at 1. And that it did not claim “the color or shape of the watch band.” *Id.* After reviewing the Crosshatch Band in light of the points raised in the Crosshatch First Request, the Office re-evaluated the claims and concluded that while the design elements of the Crosshatch Band are separable, the “embossed triangles and basic diamond crosshatch pattern” do not “contain a sufficient amount of creative authorship to support a copyright registration.” Letter from Stephanie Mason, Attorney-Advisor, to Jennifer C. Bailey, at 4 (June 20, 2018).

On January 5, 2018, Garmin also filed an application to register a copyright claim regarding another watch band, the Stippling Band. In a January 9, 2018 letter, a Copyright Office registration specialist refused to register the claim, finding that the Stippling Band was a useful article without any copyrightable elements. Letter from Christopher Stoner, Registration Specialist, to Jennifer C. Bailey, at 1 (Jan. 9, 2018). In a letter dated March 12, 2018, Garmin requested that the Office reconsider its initial refusal to register the Stippling Band. As with the Crosshatch Band, Garmin acknowledged that the “watch band itself is a useful object.” Letter from Jennifer C. Bailey to U.S. Copyright Office, at 2 (Mar. 12, 2018) (“Stippling First Request”). It similarly contended that the design features on the band are separable and registrable, due to the “stippling pattern coupled with the location of the delta in relief relative to the stippling patter[n].” *Id.* at 4. Additionally, Garmin clarified that it “limit[ed] its claim for copyright to the combination of the stippling pattern and delta.” *Id.* at 1. And that it did not claim “the color or shape of the watch band.” *Id.* After reviewing the Stippling Band in light of the points raised in the Stippling First Request, the Office re-evaluated the claims and concluded that while the design elements of the Crosshatch Band are separable, the “embossed triangles and basic circular stippling pattern” do not “contain a sufficient amount of creative authorship to support a copyright registration.” Letter from Stephanie Mason, Attorney-Advisor, to Jennifer C. Bailey, at 3 (June 20, 2018).

In two letters dated September 13, 2018, Garmin requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Works. Letters from Jennifer C. Bailey to U.S. Copyright Office (Sept. 13, 2018) (“Crosshatch Second Request” and “Stippling Second Request”). Regarding both bands, Garmin argued that the Office improperly “focus[ed] on the individual components or elements of the [bands] as opposed to analyzing the [bands] as a whole.” Crosshatch Second Request at 8; Stippling Second Request at 8. Instead, Garmin asserted that the Office must “look[] at the creative ways [Garmin] has selected and

arranged the elements as a whole, which compel a finding of originality.” Crosshatch Second Request at 8; Stippling Second Request at 8.

III. DISCUSSION

A. *The Legal Framework*

1) *Useful Articles and Separability*

Copyright does not protect useful articles as such, which are defined in the Copyright Act as “article[s] having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” 17 U.S.C. § 101. Importantly, however, artistic features applied on or incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works under sections 101 and 102(a)(5) of the Copyright Act. This protection is limited to the “‘pictorial, graphic, or sculptural features’ [that] ‘can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.’” *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017) (quoting 17 U.S.C. § 101).

To assess whether an artistic feature incorporated into the design of a useful article is protected by copyright, the Office examines whether the feature “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.” *Id.* at 1007; *see also* COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 924 (3d ed. 2017) (“COMPENDIUM (THIRD)”). This analysis focuses on “the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction [because the] statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature.” *Star Athletica*, 137 S. Ct. at 1013. Put another way, while useful articles as such are not copyrightable, if an artistic feature “would have been copyrightable as a standalone pictorial, graphic, or sculptural work, it is copyrightable if created first as part of a useful article.” *Star Athletica*, 137 S. Ct. at 1011; 17 U.S.C. § 113(a) (“[T]he exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.”); *see also Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978) (holding that copyright protection is not available for the “overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape . . . may be”).

2) *Originality*

A work may be registered if it qualifies as an “original work[] of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102(a). In this context, the term “original” consists of two components: independent creation and sufficient creativity. *See Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). First, the work must have been independently created by the author, *i.e.*, not copied from another work. *Id.* Second, the work must possess sufficient creativity. *Id.* Only a modicum of creativity is necessary, but the Supreme Court has ruled that some works (such as the alphabetized telephone directory at issue in *Feist*) fail to meet even this low threshold. *Id.* The Court observed that “[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.” *Id.* at 363. It further found that there can be no copyright in a work in which “the creative spark is utterly lacking or so trivial as to be virtually nonexistent.” *Id.* at 359.

The Office’s regulations implement the longstanding requirement of originality set forth in the Copyright Act and described in the *Feist* decision. *See, e.g.*, 37 C.F.R. § 202.1(a) (prohibiting registration of “[w]ords and short phrases such as names, titles, slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring”); *id.* § 202.10(a) (stating “to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form”). Some combinations of common or standard design elements may contain sufficient creativity with respect to how they are juxtaposed or arranged to support a copyright. Nevertheless, not every combination or arrangement will be sufficient to meet this test. *See Feist*, 499 U.S. at 358 (finding the Copyright Act “implies that some ‘ways’ [of selecting, coordinating, or arranging uncopyrightable material] will trigger copyright, but that others will not”). A determination of copyrightability in the combination of standard design elements depends on whether the selection, coordination, or arrangement is done in such a way as to result in copyrightable authorship. *Id.*; *see also Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989).

A mere simplistic arrangement of non-protectable elements does not demonstrate the level of creativity necessary to warrant protection. For example, the United States District Court for the Southern District of New York upheld the Copyright Office’s refusal to register simple designs consisting of two linked letter “C” shapes “facing each other in a mirrored relationship” and two unlinked letter “C” shapes “in a mirrored relationship and positioned perpendicular to the linked elements.” *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 496 (S.D.N.Y. 2005). Likewise, the Ninth Circuit has held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, vertical orientation, and the stereotypical jellyfish form did not

merit copyright protection. *See Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003). The language in *Satava* is particularly instructive:

It is true, of course, that a *combination* of unprotectable elements may qualify for copyright protection. But it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that 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.

Id. (internal citations omitted).

Similarly, while the Office may register a work that consists merely of geometric shapes, for such a work to be registrable, the “author’s use of those shapes [must] result[] in a work that, as a whole, is sufficiently creative.” COMPENDIUM (THIRD) § 906.1; *see also Atari Games Corp.*, 888 F.2d at 883 (“[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.”). Thus, the Office would register, for example, a wrapping paper design that consists of circles, triangles, and stars arranged in an unusual pattern with each element portrayed in a different color, but would not register a picture consisting merely of a purple background and evenly-spaced white circles. COMPENDIUM (THIRD) § 906.1.

B. Analysis of the Work

After carefully examining the Works and applying the legal standards discussed above, the Board finds that the Works do not contain the requisite separable authorship necessary to sustain a claim to copyright.

The Board finds that the watch bands are useful articles, a fact that Garmin does not dispute. Crosshatch First Request at 2; Stippling First Request at 2. Instead, Garmin focuses on the distinct patterns on each band as the basis for registration: the diamond crosshatch and triangle of the Crosshatch Band and the stippling and triangle of the Stippling Band. Under *Star Athletica*, these patterns are conceptually separable, as they can be perceived apart from the watch bands themselves, and can be identified as freestanding three-dimensional works of art.

The designs on the watch bands, however, must still meet the standard for originality under *Feist*, which they do not. *See Feist*, 499 U.S. at 358–59. The question of independent creation is not at issue. The Office’s analysis, therefore, focuses on the question of sufficient creativity. The individual elements of the Crosshatch Band—straight lines, diamonds,

rectangular edging, and a triangle—are uncopyrightable as common geometric shapes. 37 C.F.R. § 202.1(a) (stating that “familiar symbols or designs” are not registrable); COMPENDIUM (THIRD) § 906.1 (including straight lines, diamonds, circles, rectangles, and triangles in the list of non-protectable common geometric shapes). The fact that the design is three-dimensional does not alter the Office’s analysis. COMPENDIUM (THIRD) § 906.1 (“The Copyright Act does not protect common geometric shapes, either in two-dimensional or three-dimensional form.”). The individual elements of the Stippling Band – circles and a triangle – are similarly not registrable as common geometric shapes.

More importantly, the combinations of the components in each watch band are not sufficient to make the designs original. The *Compendium* instructs that a painting of a solidly colored rectangle decorated with many evenly spaced circles would be denied registration. *Id.* § 906.1. In contrast, it also instructs that a wrapping paper design featuring a multitude of common geometric shapes in different sizes and arranged in an unusual pattern would be registered. *Id.* Here, the Crosshatch Band features intersecting straight lines that create diamonds, trimmed on three sides by flat edges, with a triangle on one edge. This is a minimal combination of simple shapes. As in the first example from the *Compendium*, the crosshatch design and diamonds are comprised of repeated and identical common shapes arranged in a familiar and unremarkable pattern. The inclusion of flat edging and a single triangle are *de minimis* additions that do little to enhance the creativity of the overall design. Indeed, it is a predictable arrangement to add a plain border to a visual work. In contrast to the wrapping paper example from the *Compendium*, the watch band features a limited number of geometric shapes arranged in a basic manner without distinctive colorization. Similarly, the Stippling Band merely features a dot pattern with one triangle. The design on the Stippling Band is nearly identical to the first example provided in the *Compendium*; the band, however, does not even feature multiple colors. As demonstrated by the *Compendium*, regularly spaced dots placed on a rectangle lack the requisite originality required by *Feist*. As with the Crosshatch Band, the addition of a single triangle is insufficient to generate creative authorship.

In support of its argument, Garmin cites to *North Coast Industries v. Jason Maxwell, Inc.*, 972 F.2d 1031 (9th Cir. 1992), a case that the Board does not find persuasive in terms of registering the Works. In *North Coast Industries*, a women’s clothing manufacturer brought a copyright infringement claim against a competitor. Plaintiff North Coast Industries argued that tops produced by Jason Maxwell featured a geometric design that infringed on North Coast’s geometric color block design, which had been registered with the Copyright Office. *Id.* at 1032. The district court held that North Coast did not own a valid copyright in that design, because it had been copied from the work of Piet Mondrian and Yves St. Laurent. *Id.* at 1033. On appeal, the Ninth Circuit’s inquiry focused on the copyrightability of North Coast’s design. *Id.* The Ninth Circuit held that the district court erred in “determin[ing], as a matter of law, that [North

Coast’s design] was substantially similar to the preexisting work . . . and that the question is one of fact for the jury.” *Id.* at 1034. The Ninth Circuit, therefore, did not find “the arrangement of geometric shapes to satisfy the originality requirement,” as argued by Garmin, Crosshatch First Request at 5; Stippling First Request at 5, but instead merely found that this was a question better suited for a jury. Moreover, North Coast’s design featured rectangles of different widths and length bounded together by thick lines. 972 F.2d at 1037. The rectangles were arranged in an unpredictable and uneven grid-like format. *Id.* In contrast, the Crosshatch and Stippling Bands contain repeating and evenly spaced geometric shapes with *de minimis* additions. Without opining on its ultimate registrability, it is clear to the Board that North Coast’s design exhibits more creativity than the Crosshatch and Stippling Bands, because of the stylized borders used to create the rectangles and the irregularity with which the rectangles were partitioned.

Thus, after analyzing both the individual elements of the Works and the combinations of those elements, the Office concludes that the designs on the watch bands do not meet the standard for originality under *Feist*, and hence fail to demonstrate registrability.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claims in the Works. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.



U.S. Copyright Office Review Board

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