



Copyright Review Board  
United States Copyright Office · 101 Independence Avenue SE · Washington, DC 20559-6000

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**Re: Second Request for Reconsideration for Refusal to Register Outsole  
(SR # 1-8409988481; Correspondence ID: 1-47JEY17)**

Dear Mr. Braunel:

The Review Board of the United States Copyright Office (“Board”) has considered Cole Haan LLC’s (“Cole Haan”) second request for reconsideration of the Registration Program’s refusal to register a sculpture claim in the work titled “Outsole” (“Work”). After reviewing the application, deposit copy, and relevant correspondence, along with the arguments in the second request for reconsideration, the Board affirms the Registration Program’s denial of registration for the Work.

## **I. DESCRIPTION OF THE WORK**

The Work is a shoe sole design consisting of seven white square blocks followed by a rectangular block, all with a textured surface, arranged in a line along the side of the sole. The height of each block gradually changes as it follows the curved arch of a foot. The middle of each square block has a vertical line indentation and the square blocks are separated from one another by narrow spaces, giving a tooth-like appearance. The rectangular block is separated from the tallest of the square blocks by a narrow space, and contains five vertical indentations on the outside sole and three on the inside sole. The indentations in the rectangular block are such that it appears as if square blocks are fused together with no spaces in between. On the inside sole there is a concave indentation with a smooth surface along four of the blocks. Brown ridged grips are attached to the bottom of the rectangular block, which is positioned on the heel of the sole, and at the front toe area of the sole. The Work is as follows:

### ***Outside sole***



### ***Inside sole***



## II. ADMINISTRATIVE RECORD

On January 2, 2020, Cole Haan filed an application to register a copyright claim in the Work. In a February 4, 2020 letter, a Copyright Office registration specialist refused to register the claim, finding that the Work is a useful article that does not contain any copyrightable authorship. Initial Letter Refusing Registration from U.S. Copyright Office to Matthew Braunel (Feb. 4, 2020).

In a May 1, 2020 letter, Cole Haan requested that the Office reconsider its initial refusal to register the Work. Letter from Matthew Braunel to U.S. Copyright Office (May 1, 2020) (“First Request”). After reviewing the Work in light of the points raised in the First Request, the Office re-evaluated the claim and again concluded that the Work lacked a sufficient amount of creative authorship. Refusal of First Request for Reconsideration from U.S. Copyright Office to Matthew Braunel (Aug. 25, 2020) (“Second Refusal”). The Office concluded that neither the separable features of the Work, “squares with minor linear indentations and small triangular-shaped teeth-like perforations . . . [which amount to] common and familiar shape[s]” nor the combination and arrangement of those shapes, “in a simple linear formation on the bottom of the sidewall of the shoe sole” are sufficiently creative to support a copyright registration. *Id.* at 4–5.

In a letter dated November 25, 2020, Cole Haan requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Work. Letter from Matthew Braunel to U.S. Copyright Office (Nov. 25, 2020) (“Second Request”). Cole Haan argues that the elements of the Work are not common and familiar shapes but “uniquely-designed ‘tooth’-like shapes,” each with its own dimensions, contours, and sizes. *Id.* at 5. Cole Haan further argued that the combination of elements in the Work as a whole contains a sufficient amount of creativity. To support this argument Cole Haan contends that “the combination of the differently-shaped ‘teeth’ elements and the spaces between them, all taken together . . . form the visual impression of the Work – not just a line of non-copyrightable shapes.” *Id.* at 6 (emphasis omitted). It also argues that the increasing height of the tooth shaped elements, indentations, and spaces adds to the Work’s creativity “forming an overall pattern of spaces and line indentations with increasing heights.” *Id.* at 7–8.

## III. DISCUSSION

After carefully examining the Work and considering the arguments made in the First and Second Requests, the Board finds that the Work is a useful article that does not contain the requisite separable authorship necessary to sustain a claim to copyright.

The Copyright Act defines useful articles as those “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 (definition of “useful article”). Useful articles may receive copyright protection “only if, and only to the extent that,” they incorporate pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article. *Id.* (definition of “pictorial, graphic, and sculptural works”). The Board therefore must apply the test articulated by the Supreme Court in *Star Athletica, LLC v. Varsity Brands, Inc.* to determine whether sculptural features “(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.” 137 S. Ct. 1002, 1007 (2017).

Applying this test to the Work, the Board finds that, under the first step of the *Star Athletica* test, there are three-dimensional sculptural elements that can be perceived separately when viewing the Work. Under the second step, the elements of the Work that can be imagined separately from the useful article do not contain sufficient authorship to be copyrightable.

Cole Haan and the Office agree that the white portion of the design applied to the sole is a separable sculptural element that can be imagined separately from the useful article into which it is incorporated. Second Refusal at 3; Second Request at 1. But the separable aspects of the design are limited to the block and rectangular shapes and line indentations.<sup>1</sup> The Office notes that the Work appears to be a version of an outsole featured in Cole Haan’s ZERØGRAND line of shoes.<sup>2</sup> According to Cole Haan’s website, the shoe is designed to “mimic the foot’s natural motion” and allow the wearer to “move smoothly from heel to toe with less fatigue.”<sup>3</sup> This statement accompanies images of the shoe that features the outsole, including the varying heights of the square block elements and spacing between the block-shaped elements depicted in the Work. The varying heights of the square blocks and the spacing between blocks, therefore, appear to be driven by the functional purpose of increased flexibility. Courts applying the *Star Athletica* test have carved out utilitarian features on similar grounds, supporting the Office’s conclusion here. For example, in a case involving a banana costume, the Third Circuit carved out from copyright protection the dimensions and locations of cutout holes for arms, legs, and hands because the cutouts were “intrinsically useful (perhaps even necessary) to make the costume wearable.” *Silvertop Assocs., Inc. v. Kangaroo Mfg., Inc.*, 931 F.3d 215, 221 n.5 (3d Cir. 2019). As such, the dimensions of the square block elements and the spacing between these elements are not separable features that can be considered in the creativity of the separable design. *See Star Athletica*, 137 S. Ct. at 1010 (citing 17 U.S.C. §101, “to qualify as a pictorial, graphic, or sculptural work on its own, the feature cannot itself be a useful article or ‘[a]n article that is normally a part of a useful article’ (which is itself considered a useful article)”).

The Office, therefore, focuses its analysis on the copyrightability of the separable aspects of the white block-shaped design when imagined separately from the useful article into which it is incorporated, which are square and rectangular shapes, and curved and straight line indentations. These constituent elements of the Work are not copyrightable. 37 C.F.R. § 202.1(a) (prohibiting registration of “familiar symbols or designs . . . or color[s]”); U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 906.1 (3d ed. 2021) (“COMPENDIUM (THIRD)”) (“The Copyright Act does not protect common geometric shapes, either in two-dimensional or three-dimensional form. . . . including . . . straight or curved lines . . .”). The question, then, is whether the combination of these Work’s elements is sufficiently creative.

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<sup>1</sup> The design also includes the brown ridged shapes at the toe and heel of the sole, but Cole Haan does not claim copyright in this portion of the sole. *See* Second Request at 5–6.

<sup>2</sup> *See Men’s ZERØGRAND*, COLE HAAN, <https://www.colehaan.com/mens-zerogrand> (last visited Aug. 23, 2022).

<sup>3</sup> *See ZERØGRAND Wingtip Oxford*, COLE HAAN, <https://www.colehaan.com/zero-grand-wingtip-oxford-british-tan-java/C29411.html> (last visited Aug. 23, 2022).

While some combinations of common or standard design elements may contain sufficient creativity to support a copyright, not every combination will meet this threshold. *See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 358, 363 (1991). The combination of elements in the Work fails to meet the threshold for protection.

Cole Haan describes the block element as a “tooth-like shape” which is itself a combination of “shapes, contours, grooves, and dimensions” and argues that, although it is not claiming copyright in the individual shape, each tooth shape is a “distinct, imaginative design.” Second Request at 4–5. Even after considering Cole Haan’s description, the Board concludes that the block shape amounts to a standard geometric block with slight variations. Mere variations on a standard geometric shape or familiar symbol do not possess a sufficient amount of creativity to transform the uncopyrightable shape into a copyrightable work. 37 C.F.R. § 202.1(a); COMPENDIUM (THIRD) §§ 906.1–906.2. Therefore, no shape contained in the Work, alone, is sufficiently creative to support registration.

Likewise, the combination of square and rectangular block elements and indentations does not contain a sufficient amount of creativity for copyright protection. Cole Haan claims copyright protection in the “different tooth-like shapes taken together, as a whole,” and argues that “the combination of the differently-shaped ‘teeth’ elements and the spaces between them, all taken together . . . form the visual impression of the Work.” Second Request at 4–6 (emphasis omitted). Cole Haan, however, fails to identify any creativity in the visual impression of the Work, and as discussed, the varying heights of the block elements and spaces are not included in the separable design. The Work as a whole combines a repeating shape along a straight line with a gradually increasing height. The combination of shapes in a row or line is a standard arrangement that is typical and commonly found in designs applied to shoe soles.<sup>4</sup> This combination, therefore, is not sufficiently creative to support registration.

Cole Haan highlights the “similarities between the widths and rounded upper tips of the line indentations and the spaces,” and argues that “when the alternating spaces and line indentations of the teeth . . . sole are viewed together as a whole, they form a common design scheme from the foremost tooth near the toe region of the sole to the rearmost tooth near the heel region of the sole.” *Id.* at 7. Rather than demonstrating creativity, a symmetrical, repeating design speaks to the garden-variety and expected nature of the Work. A sufficiently creative arrangement of shapes in an unusual pattern may provide a basis for copyrightability, but a repeating series of evenly-spaced shapes amounts to a garden-variety pattern that falls short of the Copyright Act’s requirements for protection. *See Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) (“[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

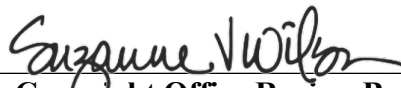
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<sup>4</sup> *See, e.g., Nike Air VaporMax Plus*, NIKE, <https://www.nike.com/t/air-vapormax-plus-mens-shoes-nC0dzF/DQ4688-300> (last visited Aug. 23, 2022); *Nike Air Force 1 '07*, NIKE, <https://www.nike.com/t/air-force-1-07-mens-shoes-L3SMQI/DJ2739-100> (last visited Aug. 23, 2022); *Nike x sacai VaporWaffle White and Gum*, NIKE, <https://www.nike.com/launch/t/nike-sacai-vaporwaffle-white-gum> (last visited Aug. 23, 2022); *Nike Waffle One By You*, NIKE, <https://www.nike.com/u/custom-nike-waffle-one-by-you> (last visited Aug. 23, 2022); *Retropy E5 Shoes*, ADIDAS, <https://www.adidas.com/us/retropy-e5-shoes/H05677.html> (last visited Aug. 23, 2022); *Climacool Vento Shoes*, ADIDAS, <https://www.adidas.com/us/climacool-vento-shoes/H67642.html> (last visited Aug. 23, 2022); *Lems Trailhead hiking sneakers*, J.CREW, <https://www.jcrew.com/p/mens/categories/shoes/sneakers/lems-trailhead-hiking-sneakers/BB294> (last visited Aug. 23, 2022).

their combination constitutes an original work of authorship.”); *see also* COMPENDIUM (THIRD) § 906.1 (providing example of picture with solid color background and evenly spaced circles as a combination of common shapes that lacks sufficient creative expression). The addition of a curved indentation on one side of the sole does not add enough creativity to an otherwise expected arrangement of shapes.

#### IV. CONCLUSION

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



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**U.S. Copyright Office Review Board**

Suzanne V. Wilson, General Counsel and

Associate Register of Copyrights

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Director of Policy and International Affairs

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