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January 19, 2017

Ms. Karyn A. Temple Claggett
Register of Copyrights and Director (Acting)
United States Copyright Office
101 Independence Avenue, Southeast
Washington, D.C. 20559-6000

Via email

Dear Register Temple Claggett:

Re: Request for Meeting Regarding Logo Registration Practices and Guidance

The International Trademark Association (“INTA”) is an association of brand owners and intellectual property law practitioners who are keenly interested in the interaction of various forms of related rights such as copyright in order to ensure stronger brand protection. Our Copyright Committee concentrates on the impact of copyright law and the enforcement of trademark rights. A particular area of focus is the protection of logos under trademark and copyright law. In this regard, INTA would be grateful to have an opportunity to discuss with the U.S. Copyright Office (“Office”) the examination of registration applications for logo designs and respectfully requests a meeting with the appropriate personnel. Our objective would be to seek ways for greater guidance and consistency in instances where a work of visual art submitted for registration is recognized by a Registration Specialist as a logo, and how that impacts whether the Office registers the work.

To be sure, INTA applauds the work of the Office’s corps of Registration Specialists. Nonetheless, we believe that opening a dialogue to provide further clarity on logo examination practices would benefit examiners, applicants and their attorneys. This might be accomplished by improving consistency of originality assessments through the adherence to the principles of aesthetic non-discrimination as applied to logos, which are an important and influential form of visual art. In particular, a work’s status as a logo (and thus a trademark) should not hinder, nor entirely prevent it from being registered, even though copyright and trademark law are distinct legal doctrines. Accordingly, the availability of protection under one doctrine should not impede protection under the other. To facilitate our discussion with the Office, the INTA Copyright Committee’s Logos Subcommittee prepared the attached paper on the issue for your consideration.

Register Karyn A. Temple Claggett
January 19, 2017
Page 2

Thank you in advance for the Office's consideration of this request. INTA's Senior Director of Government Relations Deborah Cohn (dcohn@inta.org; 202-261-6570) will contact your office in the near future to see if a meeting date can be arranged which would include the Chair of INTA Copyright Committee, Dale Cendali, and the Chair of its Logo Subcommittee, Noel Cook.

Sincerely yours,

A handwritten signature in black ink, appearing to read "Etienne Sanz de Acedo". The signature is written in a cursive, somewhat stylized font.

Etienne Sanz de Acedo
Chief Executive Officer
International Trademark Association

Attachment

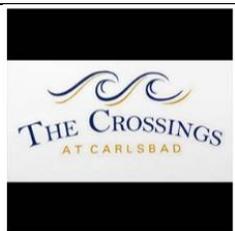
cc: Sarang V. Damle
General Counsel and
Associate Director of Copyrights

Robert J. Kasunic
Associate Register of Copyrights and
Director of Registration Policy & Practice

POINTS FOR DISCUSSION ON LOGO REGISTRATION

A. Possible Inconsistency between the U.S. Federal Courts and the Board of Review

The following are some examples, on the left, of works found to be copyrightable by U.S. federal courts or the Copyright Office Board of Review (“BOR”) and, on the right, logo designs held not copyrightable in recent years by the BOR:

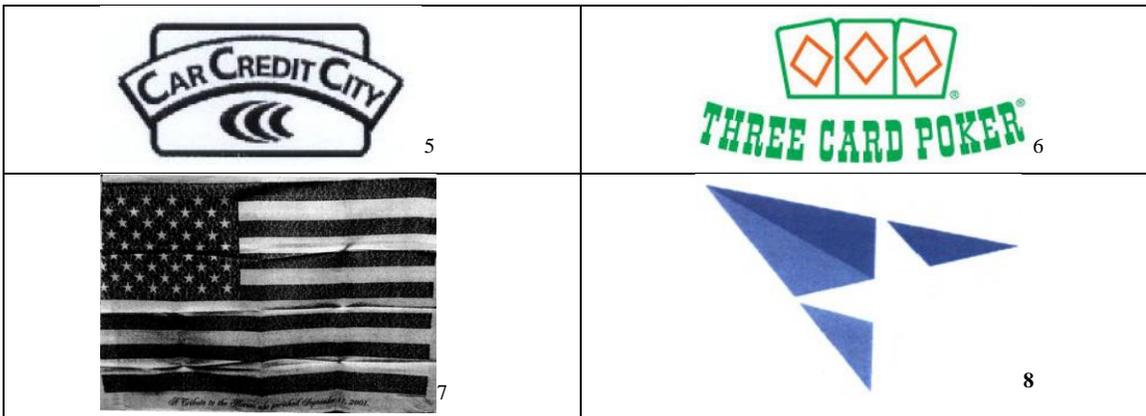
<u>Protection Granted</u>	<u>Protection Denied</u>
 1	 2
 3	 4

¹ *Jada Toys v. Mattel, Inc.*, 518 F.3d 628, 636 n. 6 (9th Cir. 2008) (“the combination of the words used, the stylization of the flame graphic, and the colors chosen, suggest that elements of the flame logo are protectable for purposes of a copyright infringement action”).

² See *Re: Subway Logo, Correspondence ID: 1-7V60DL, Review Board of the United States Copyright Office* (July 16, 2013), available at https://ipmall.law.unh.edu/sites/default/files/hosted_resources/CopyrightAppeals/2013/SubwayLogo.pdf

³ *City of Carlsbad v. Shah*, 850 F.Supp.2d 1087 (S.D. Cal. 2012) (awarding statutory damages for copyright infringement where infringing work was identical except for the replacement of “Carlsbad” with “Marbrisa”).

⁴ See *Re: Geen Squad (logo), SR 1-73998603, Review Board of the United States Copyright Office* (April 13, 2012), available at https://ipmall.law.unh.edu/sites/default/files/hosted_resources/CopyrightAppeals/2012/Jaworski120413.pdf



The seemingly inconsistent handling of logos in these examples and others—some of which INTA has been unable to include due to attorney-client confidentiality issues or barriers to public viewing of registered works—prompts INTA’s request for a meeting to discuss the issues surrounding copyright protection for logos. Furthermore, the examples cited are from appeals, and our view is that initial refusal letters are, if anything, seemingly more varied and inconsistent.

B. Questionable Rationales for Refusal of Logo Registration

Refusal letters and copyright regulations suggest that logos are being denied registration because of (1) a perceived lack of originality under *Feist*, (2) aesthetic discrimination, and (3) due to their perceived status as trademarks.

⁵ See *Re CCC Logo*, Control No. 61-321-0950(S), Review Board of the United States Copyright Office (August 10, 2006), available at

http://ipmall.info/sites/default/files/hosted_resources/CopyrightAppeals/2006/CCC%20Logo.pdf

(noting the registration of the full Car Credit City Logo, Reg. No. VAu000635117, while refusing a second application to register the “Triple C” design appearing below “Car Credit City” as the basis for a separate registration.)

⁶ See *Re: Three Card Poker Logo*, Correspondence ID: 1-4489K9, Review Board of the United States Copyright Office (October 28, 2011), available at

http://ipmall.info/sites/default/files/hosted_resources/CopyrightAppeals/2011/RyanGile111028.pdf

⁷ See *Re: Patriots Day Flag*, Control No. 61-310-1616(W), Review Board of the United States Copyright Office (June 8, 2012), available at

http://ipmall.info/sites/default/files/hosted_resources/CopyrightAppeals/2012/CharlesDougherty.pdf at *7:

“Specifically, the placing of the first and last name on each of text, culminating in the name of the last of the victims, Andrew Zucker, three and one-half lines before the end of the thirteenth stripe on the flag, and the population of the remainder of the thirteenth stripe with three and one-half lines of the repeated phrase, ‘God Bless America’ may represent that modicum of creative expression required for copyright protection. Had the list of names been arranged in such a fashion that Mr. Zucker’s name appeared at the very end of the stripe, the Board would not have been able to discern any protectible expression.”

⁸ See *Re Tristar Logo*, Correspondence ID: 1-IVJTJF, Review Board of the United States Copyright Office (May 29, 2014), available at

http://ipmall.info/sites/default/files/hosted_resources/CopyrightAppeals/2014/TristarStarLogo2014.pdf

We would like to make the following observations. First, each of the logos in the right hand column above was denied because of a finding that the logo at issue did not meet the requirements of originality under *Feist*. As acknowledged by Compendium III, Sec. 913.1, a logo should be deemed copyrightable “if it embodies ‘some creative authorship in its delineation or form.’” (quoting 37 C.F.R. § 202.10(a)). Second, the refusal letters also contain express references to trademark law, including: a statement that the submitted work “consists entirely of trademark content but not any copyrightable...content”; implying a mutual exclusivity of intellectual property forms that does not exist; or terse observations that since the work submitted is a logo the applicant may wish to visit www.uspto.gov for information on trademark registration. As described below, none of these rationales is consistent with copyright law and harms authors of creative works.

1. Perceived Lack of Originality

Refusals to register logos are inconsistent with the U.S. Supreme Court’s seminal decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*, which conversely is another authority typically cited in refusals. Yet, *Feist* makes clear that the standard for originality, and thus copyright protection, is low:

To qualify for copyright protection, the work must be original to the author. Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least **some minimal degree of creativity**. To be sure, the requisite level of creativity is **extremely low; even a slight amount will suffice**. The vast majority of works make the grade quite easily, as they possess **some creative spark**, no matter how crude, humble or obvious it might be.

499 U.S. 340, 345 (1991) (internal quotations and citations omitted) (emphasis added).

Given this low threshold for creativity, the Starbucks logo,⁹ the X-Men logo,¹⁰ and the Mighty Morphin Power Rangers logo,¹¹ as shown below, have been found copyrightable by courts.

⁹ *Starbucks Corp. v. Morgan*, No. 99 Civ. 1404, 2000 WL 949665 (S.D.N.Y. July 11, 2000).

¹⁰ *Twentieth Century Fox Film Corp. v. Marvel Enterprises, Inc.*, 155 F.Supp.2d 1 (S.D.N.Y. 2001).

¹¹ *Dees v. Saban Entertainment, Inc.*, F.3d 146, 1997 WL 745660 (9th Cir. 1996).



Additionally, such modest works as Mondrian-esque clothing designs with simple geometric shapes, *N. Coast Indus. v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1035 (9th Cir. 1992), floor plans, *Zalewski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 101 (2d Cir. 2014); Chinese yellow pages, *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters.*, 945 F.2d 509, 514 (2d Cir. 1991); estimates of coin values, *CDN Inc. v. Kapes*, 197 F.3d 1256, 1257-58, 1260-61 (9th Cir. 1999); a Chinese restaurant menu, *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 548 (S.D.N.Y. 2001); and even baseball pitcher's statistics, *Kregos v. Associated Press*, 937 F.2d 700, 702, 704 (2d Cir. 1991), have been found worthy of copyright protection.

Other authorities typically cited by Registration Specialists in refusals confirm that the standard of creativity is low and thus support the registration of logos. Nimmer, for example, in the section often cited by examiners, states that determining whether a work meets the requirement of a quantum of creativity "is not, however, among the more troublesome questions of degree inherent in copyright law, as the line to be drawn includes **almost any independent effort** on the side of sufficient originality." 1-2 Nimmer on Copyright § 2.01 (2015) (emphasis added). Nimmer also notes that "[a] visual art work that is used as a trademark, logo, or label may be registered [with the Copyright Office] if it satisfies 'the requisite qualifications for copyright,' *i.e.* that it has 'some creative authorship in its delineation or form.'" Nimmer on Copyright § 913.1 (quoting 37 C.F.R. § 202.10) (2016). Furthermore, Justice Holmes in *Bleistein v. Donaldson Lithographing Co.*, made clear that, "[p]ersonality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act." 188 U.S. 239, 250 (1903). Thus, reliance on these authorities to deny the registration of logos which involve many creative choices is misplaced.

2. Aesthetic Discrimination against Logos

The boilerplate language in some refusal letters also contains statements, as mentioned above, that may be perceived as suggestive of aesthetic discrimination, *i.e.*, artistic judgment of works in determining whether a work is eligible for copyright protection. Yet, this type of aesthetic discrimination was explicitly disallowed by the U.S. Supreme Court in *Bleistein*.¹² In *Bleistein*, Justice Holmes attempted to eliminate aesthetic

¹² For unclear reasons, *Bleistein* is one of the authorities typically cited when logos are refused registration.

discrimination from copyright law by stating: “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.” 188 U.S. at 251. Artistic judgments on the part of Registration Specialists or others, when determining copyrightability, are not consistent with Supreme Court precedent.

3. Perceived Status as Trademarks

The denial of copyright registration for creative works simply because they are logos, therefore protected by trademark law, is also inconsistent with case law. A given work may be protected by independent copyright and trademark rights. For instance, the leading treatise on trademark law noted that “[t]he courts have generally held that patent, trademark and copyright are separate and independent forms of protection. As a general principle, the presence or absence of one does not automatically preclude protection under another.” 1 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 6:5 (4th ed. 2016); see also *In re DC Comics, Inc.*, 689 F.2d 1042, 1052 (C.C.P.A. 1982) (“If the [drawing or design are] copyrightable subject matter, these rights of limited duration are not the totality of rights Congress has provided for the subject product designs but merely part of them. Thus, their existence does not afford a basis for refusing to grant a registration for [design] as a trademark, if it would otherwise qualify for registration under the Lanham Act.”); *Frederick Warne & Co., Inc. v. Book Sales, Inc.*, 481 F. Supp. 1191 (S.D.N.Y. 1979) (“Because the nature of the property right conferred by copyright is significantly different from that of trademark, trademark protection should be able to co-exist, and possibly overlap, with copyright protection without posing preemption difficulties.”). Thus, logos should not be denied copyright registration simply because they may also serve as a source identifier.

C. Impact on Owners of Creative Works

Denying registration for logos places the owners of such creative works at a significant disadvantage. For instance, without a registration, the author of a creative work cannot claim *prima facie* validity of its copyright. See 2-7 Nimmer on Copyright § 7.16 (2015); (“[T]he copyright registration constitutes *prima facie* evidence of the validity of the copyright and the facts stated in the certificate.”). Not having a registration also significantly hinders an author’s ability to enforce its rights, as it cannot obtain statutory damages or attorneys’ fees. See 17 U.S.C. § 412 (to recover statutory damages and/or attorneys’ fees, work must be registered prior to infringement). Nor are the benefits of the Digital Millennium Copyright Act available to the owners of creative works that are protected only by trademark law.

The potential availability of trademark protection does not make up for these significant losses, as trademark law has an entirely different set of rules governing protection and enforcement. Indeed, the creator of the logo, who typically would own the copyright, may not be the owner of any trademark rights as the artist may not be using the logo to sell any goods or services. Compare 17 U.S.C. § 201 (“Copyright in a work protected under this title vests initially in the author or authors of the work.”), with 15 U.S.C. § 1057(c) (trademark ownership derives from use of mark in commerce). Further, to enforce a trademark, unlike a copyright, the owner must show that the junior user’s mark creates a likelihood of consumer confusion. See Thomas McCarthy, 4 McCarthy on

Trademarks and Unfair Competition § 23:1 (4th ed.) (“Likelihood of confusion’ is the fundamental test of both state common-law and statutory trademark infringement and federal statutory trade mark infringement.”). Thus, a junior user’s work may infringe the creator’s copyright by copying protectable expression, without the same use constituting trademark infringement where consumers are unlikely to be confused.

D. Other Points for Discussion

INTA recognizes the difficulty of articulating standards that can be easily understood and consistently applied, but we believe that a commonly understood and consistently applied approach should be our shared goal. Accordingly, other potential improvements that might be worthy of discussion include:

1. Office issuance of further guidance specifically regarding the standards of its Registration Specialists’ applications of *Feist* and 37 CFR § 202.1(a) to logos and/or the possibility of expanding the boilerplate discussions of logo copyrightability in refusal letters, Office circulars and/or Compendium III; and
2. the potential publication of the Copyright Office Board of Review decisions, which would provide immediate assistance to applicants seeking to understand the bases for refusals.

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