



United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

December 31, 2019

Anil V. George, Esq.
NBA Properties, Inc.
Olympic Tower—645 Fifth Avenue
New York, NY 10022

**Re: Second Request for Reconsideration for Refusal to Register NBA Logos,
Correspondence IDs: 1-3G65DNY and 1-3G6RHHW; SR # 1-6028239859,
1-6028239907, 1-6080136621**

Dear Mr. George:

The Review Board of the United States Copyright Office (“Board”) has considered NBA Properties, Inc.’s (“NBA’s”) second request for reconsideration of the Registration Program’s refusal to register two-dimensional artwork claims in the works titled “HEATCHECK GAMING with MH (Stylized) as Flame Design” (“HeatCheck Flame”), “MH (Stylized) as Flame Design” (“MH Flame”), and “Conga Drum and Basketball Design” (“Conga Drum”) (collectively “Works”). After reviewing the applications, deposit copies, and relevant correspondence, along with the arguments in the second requests for reconsideration, the Board affirms in part and reserves in part the Registration Program’s denials of registration.

I. DESCRIPTION OF THE WORKS

The Works are three two-dimensional artworks, depicted below.



*MH (Stylized) as Flame Design
 (“MH Flame”)*



*HEATCHECK GAMING with MH (Stylized)
 as Flame Design (“HeatCheck Flame”)*



Conga Drum and Basketball Design (“Conga Drum”)

II. ADMINISTRATIVE RECORD

The NBA filed applications to register HeatCheck Flame and MH Flame on November 21, 2017. It filed the application for Conga Drum on December 8, 2017. In a June 11, 2018 letter, a Copyright Office registration specialist refused to register both HeatCheck Flame and MH Flame because they lacked copyrightable authorship. Letter from W. King, Registration Specialist, to Anil George, NBA Properties, Inc. (June 11, 2018). Three days later, on June 14, 2018, the Office refused to register the Conga Drum design on the same grounds. Letter from K.S., Copyright Examiner, to Anil George, NBA Properties, Inc. (June 14, 2018).

In letters dated September 5 & 13, 2018, the NBA requested that the Office reconsider its initial refusal to register the Works. Letter from Anil George, NBA Properties, Inc., to U.S. Copyright Office (Sept. 5, 2018);¹ Letter from Anil George, NBA Properties, to U.S. Copyright Office (Sept. 13, 2018) (collectively “First Requests”). After reviewing the Works in light of the points raised in the First Requests, the Office re-evaluated the claims and again concluded that the Works lacked sufficient creative authorship. The Office found that the “letters and words” in the HeatCheck Flame and MH Flame failed to employ sufficiently creative selection, coordination, or arrangement. Letter from Stephanie Mason, Attorney-Advisor, to Anil George, NBA Properties, Inc. at 3 (Mar. 15, 2019) (Correspondence ID # 1-3G65DNY). Additionally, the Office concluded that Conga Drum employed only “common and familiar shapes” without adding sufficient creative expression or arrangement to transform the work into copyrightable authorship. Letter from Stephanie Mason, Attorney-Advisor, to Anil George, NBA Properties, Inc. at 2–3 (Mar. 15, 2019) (Correspondence ID # 1-3G6RHHW).

In letters dated June 14, 2019, the NBA requested that the Office reconsider for a second time its refusal to register each of the Works. Letter from Anil George, NBA Properties, Inc., to

¹ The NBA sent separate letters on September 5 regarding HeatCheck Flame and MH Flame. Because the letters were identical, other than their subject line, the Board will treat them as a single combined letter for purposes of citation.

U.S. Copyright Office (June 14, 2019) (“Flame Second Request”);² Letter from Anil George, NBA Properties, Inc., to U.S. Copyright Office (June 14, 2019) (“Conga Drum Second Request”). In its letters, the NBA emphasized the low threshold of creativity necessary for copyrightability, arguing that the Works were “unique identifiers of a professional esports basketball team” that were specifically “crafted with the sport, team affiliation and history, and locale in mind.” Flame Second Request at 1; Conga Drum Second Request at 1. The NBA noted the “public association of teams with their trademarks and service marks” and that such association occurs “almost instantly upon [] adoption.” Flame Second Request at 1; Conga Drum Second Request at 1. The NBA also broadly argued that the uncopyrightable common shapes in the Works are combined in a creative, distinctive way when considered as a whole. Flame Second Request at 2; Conga Drum Second Request at 2.

III. DISCUSSION

A. *The Legal Framework – 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 Publications, Inc. v. Rural Telephone Service 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

² As with the first requests for reconsideration, the NBA sent separate letters for HeatCheck Flame and MH Flame, which are functionally identical. The Board treats them as the same letter for citation purposes, using the pagination of the letter for HeatCheck Flame, which includes an extra line break and keeps the block quote on the same page as its introductory sentence.

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.” U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § § 906.1 (3D ED. 2014) (“COMPENDIUM (THIRD)”); *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.

Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. *See id.* § 310.2. The attractiveness of a design, the espoused intentions of the author, the design’s visual effect or its symbolism, the time and effort it took to create, or the design’s commercial success in the marketplace are not factors in determining whether a design is copyrightable. *See, e.g., Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

B. Analysis of the Work

After carefully examining the Work and applying the legal standards discussed above, the Board finds that the HeatCheck Flame contains the requisite separable authorship necessary to sustain a thin claim to copyright, but MH Flame and Conga Drum do not.

Both the HeatCheck Flame and the MH Flame employ the same flame design, with the former work including the text “HEATCHECK GAMING” underneath the design. This flame design, which uses a distorted red “M” over a stylized “H” that are “mere variations of uncopyrightable letters,” which are “building blocks of expression” that cannot be copyrighted. COMPENDIUM (THIRD) § 906.4. The text “HEATCHECK GAMING” likewise is a “short phrase such as [a] name” that is not subject to copyright. 37 C.F.R. § 202.1(a).

Viewing the HeatCheck Flame work as a whole, however, reveals sufficient creative choices in arrangement and composition with the requisite spark of creativity to support copyright. The distortion of the stylized M, arranged above a stylized H with white space to give the appearance of a flame, as well as its combination with text that uses colors to separate the words “Heat” and “Check” on the first line, are sufficient in aggregate to travel over the line of copyrightability. The Board reverses the refusal to register the copyright claim in the HeatCheck Flame logo, but cautions, however, that the small number of unprotectable elements gives the resulting copyright only thin protection. *See Satava v. Lowry*, 323 F.3d 805, 812 (9th Cir. 2003) (protecting only the Work’s original and creative elements “against only virtually identical copying”).

Because multiple copyright claims cannot cover duplicate material, however, the Board affirms the refusal to register the MH Flame. *See* COMPENDIUM (THIRD) § 602.4(E) (the Office “will not knowingly issue multiple registrations for the same claim, because this would confuse the public record”). The NBA did not explain whether the MH Flame or the HeatCheck flame was created first in time, nor did it suggest that one was published before the other. Because applicants may only include “one work per registration,” COMPENDIUM (THIRD) § 511, the Office would not register both claims unless the MH Flame was created first in time and the additional text and changes in HeatCheck Flame could support an independent copyright claim as a derivative work. COMPENDIUM (THIRD) § 507.1 (derivative work may only be registered where the new authorship “contains a sufficient amount of original authorship”). The additional text in the HeatCheck Flame cannot carry the work over the line of copyrightability. Absent additional information from the NBA, the Office assumes the NBA submitted “the most recent or most complete version” in its application for HeatCheck Flame, COMPENDIUM (THIRD) § 512.1, and grants registration of that application (and not MH Flame) on that basis.

The Conga Drum application fails for the same reasons as the MH Flame: the NBA has already successfully registered this material in a prior claim. Four days before submitting the application for Conga Drum, the NBA submitted an application for “CAPITAL CITY GO-GO with Conga Drum and Basketball Design,” which was eventually registered as VA0002136669 with an effective date of December 4, 2017. That work is depicted below.



Because the difference between the conga drum depicted in “CAPITAL CITY GO-GO” and the application for Conga Drum is insufficient to support a derivative work claim, and because there is already an issued registration for the work claimed in Conga Drum, the Board affirms its refusal to register the Work.

Finally, the Board notes that applicants are permitted to withdraw requests for reconsideration or amend them for “honest omission or mistake.” COMPENDIUM (THIRD) §§ 1708.4, 1708.5. As discussed above, once the Office granted the application for CAPITAL CITY GO-GO on February 1, 2019, the *Compendium*’s prohibition on multiple registrations for the same work precluded registration of Conga Drum. See Letter from Stephanie Mason, Attorney-Advisor, to Anil George, NBA Properties, Inc. at 1 (Feb. 1, 2019) (granting first request for reconsideration because work contained “a sufficient, although minimal, amount of original and creative artistic or graphic authorship that may be regarded as copyrightable”); COMPENDIUM (THIRD) § 602.4(E). The NBA would have been permitted to withdraw its request from reconsideration on that basis if it had sought to do so. In the event of confusion about when amendment of a request may be appropriate, or how to disclose when the same visual material is included in multiple applications, questions may always be directed to the Office.

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 “Conga Drum and Basketball Design” and “MH (Stylized) as Flame Design.” The Board reverses the refusal to register “HEATCHECK GAMING with MH (Stylized) as Flame Design.” Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.



U.S. Copyright Office Review Board
Karyn A. Temple, Register of Copyrights
and Director, U.S. Copyright Office
Regan A. Smith, General Counsel and
Associate Register of Copyrights
Catherine Zaller Rowland, Associate Register of
Copyrights and Director, Public Information and
Education