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COPYRIGHT REGISTRATIONS: EASY TO GET BUT NOT ALWAYS UPHOLD

by
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"We Don't Need No Stinking Certificates"

Under the United States laws, copyright arises automatically when an author has fixed his original work in a "tangible medium of expression," as required by 17 U.S.C. 102(a). The classes of works entitled to copyright protection include literary, musical, dramatic, pantomime and choreographic works, pictorial, graphic and sculptured works, motion pictures and other audio-visual works, sound recordings and architectural works, compilations and derivative works. An author may thereafter register his copyright claim with the Copyright Office, but it is important to note that the act of registration is not what creates the copyright.

Oh, Go Ahead and Get A Certificate

A copyright registration on a work of authorship is typically very easy to obtain. The Copyright Office conducts only a cursory investigation before granting or (rarely) denying a copyright. Only two statutory elements are required: originality and fixation.

Originality is a constitutional requirement for copyright (from Article I, § 8, cl. 8, which grants to Congress the power to "secur[e] for limited Times to Authors... the exclusive Rights to their respective Writings"). Case law has established that mere independent creation is required. Striking uniqueness, ingenuity or novelty are not required to meet the originality requirement (*Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951)). A mere "modicum" of creativity is sufficient.

Accordingly, most works claimed by clients can successfully be registered with the Copyright Office. However, the practitioner should be aware that these registrations can be challenged in court and courts will apply a much more rigorous analysis in determining if the copyright registration was validly issued. In such a judicial proceeding, a certificate of registration granted within five years of first publication is prima facie evidence that the copyright is valid. 17 U.S.C. § 410(c). However, the section also provides that the evidentiary weight given to the certificate is within the discretion of the court.

Compilation Copyrights:

It's Not How Hard You Worked At It That Counts In recent years, the court's attention has been directed to the validity of "compilation" copyrights. It is well accepted that "compilations" are copyrightable. 17 U.S.C. § 101 defines a compilation as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." (Emphasis added.) A compilation may consist entirely of elements which are themselves non-copyrightable (generally facts in the public domain), but may still be given copyright protection if the selection, coordination or arrangement of those elements exhibits some originality.

The Copyright Office has regularly granted registrations on compilations. The U.S. Supreme Court recently considered the validity of a compilation copyright in *Feist Publication Inc. v. Rural Telephone Service Co. Inc.*, 111 S.Ct. 1282, 113 L.Ed.2d 358, 18 U.S.P.Q.2d 1275 (U.S. 1991) and found it to be invalid. Plaintiff published a typical telephone directory. Defendant, a publishing company specializing in telephone directories covering

large geographic area, was refused a license on plaintiff's white pages listings, and so took the listings it needed without plaintiff's consent.

The court found that an "undeniable tension" exists in the two propositions that while facts in and of themselves are never copyrightable, compilations of facts generally are. The Supreme Court resolved this tension by holding that compilations, to be copyrightable, must feature an original selection or arrangement of facts, with the copyright being limited to the particular selection or arrangement. "In no event may copyright extend to the facts themselves." The Supreme Court resolved several conflicting Circuit Court decisions by holding that "originality," and not "sweat of the brow," remains the touchstone of copyrightability. "[C]opyright rewards originality, not effort."

The Supreme Court found that while it was undisputed that defendant took a substantial amount of factual information from plaintiff's directory, defendant had not copied anything that was "original" to plaintiff's directory. (Plaintiff's directory was in alphabetical order). That is, plaintiff had not "selected, coordinated, or arranged" the uncopyrightable factual elements in any original way. Rather, plaintiff's selection was "devoid of even the slightest trace of creativity."

A Little Creativity Gets You A Lot

A Second Circuit case very shortly thereafter distinguished Feist on the facts, and upheld the validity of a copyright granted to plaintiff by the Copyright Office. In *Key Publications Inc. v. Chinatown Today*, 945 F.2d 509, 20 U.S.P.Q.2d 1122 (2d Cir. 1991), plaintiff's classified yellow pages of a telephone directory designed for use by the New York Chinese- American community was held sufficiently original to be copyrightable. The Second Circuit stated that the originality requirement was "not particularly rigorous" and simply meant "not copied, and exhibiting a minimal amount of creativity."

In *Key Publications*, the court held that plaintiff's exclusion from the directory of businesses which she didn't think would stay open for very long, such as certain insurance brokers and take-out restaurants, indicated sufficient thought and creativity in selection to warrant copyrightability. Plaintiff also included categories which were of particular interest to the Chinese-American community, such as "Bean Curd & Bean Sprout Shops," and this arrangement also involved creativity. Since plaintiff's arrangement involved more than "de minimus thought," her copyright was valid.

The Ninth Circuit has similarly narrowed the scope of protection for a compilation, holding that compilations are entitled to only very limited copyright protection, and defendant infringes only if it "bodily appropriates" virtually all of plaintiff's work. In *Harper House, Inc. v. Thomas Nelson*, 889 F.2d 197, 12 U.S.P.Q.2d 1779 (9th Cir. 1989), the Court upheld the validity of plaintiff's copyright in its "Running Mate" organizer. After noting that the Copyright Office had determined that the Running Mate organizers were copyrightable, the appeals court agreed with the district court that sufficient testimony had been offered at trial to support a finding of originality in the selection, coordination and arrangement of elements that made up the Running Mate

It's All A Matter Of Perspective

Defendants in *Folio Impressions Inc. v. Buyer California*, 937 F.2d 759, 19 U.S.P.Q.2d 1418 (2d Cir. 1991), an infringement action concerning a rose fabric design which plaintiffs had registered, contended that plaintiff's registration was invalid for lack of originality. The court considered three separate elements: the rose, the placement of the rose, and the fabric background. Regarding design of the rose, defendant offered no proof at trial to overcome the presumption of validity to which plaintiff was entitled as a result of its certificate of registration, and so plaintiff's copyright was upheld with respect to the design of the rose itself. But with respect to the background of plaintiff's fabric, defendant offered expert testimony showing that the creator of the background had copied from an unspecified public domain source. The Second Circuit, citing Feist, upheld the district court's determination that plaintiff's copyright in the background was not original and therefore not copyrightable.

But the appeals court overturned the district court ruling concerning copyrightability of the arrangement of the roses on the fabric (in straight lines and turned in various directions), finding that plaintiff's decision as to where to place the roses was an artistic decision, and that defendant had presented no evidence that plaintiff had copied this placement from any source. This case illustrates that a different result may be reached from a micro versus a macro perspective of the work.

Fudging Can Get You In Trouble

The practitioner must be scrupulous in what he represents to the Copyright Office when applying for a registration. In *Whimsicality, Inc. v. Rubie's Costume Co., Inc.*, 891 F.2d 452, 13 U.S.P.Q.2d 1296 (2nd Cir. 1989), the Second Circuit held that plaintiff's copyright in its costumes was invalid as a result of its misrepresentation to the Copyright Office in its application for registration that the costumes were "soft sculptures." Plaintiff's attorney admitted that plaintiff was aware that if it had applied for registration of "costumes" the application would probably be rejected (because the Copyright Office considers costumes to be clothing, which are "useful articles" and by statute not copyrightable). The appeals court explicitly refused to reach the issue of validity based on originality, since plaintiff did not have a valid registration as a result of its knowing misrepresentation. Moreover, the court remanded for a reconsideration of whether attorney's fees should be awarded to defendant based on plaintiff's bringing its action in bad faith.

However, a district court for the Southern District of California did uphold a copyright on costumes granted by the Copyright Office. *National Theme Productions, Inc. v. Jerry B. Beck, Inc.*, 696 F.Supp. 1348 (S.D. Cal. 1988). The court first stated that "[T]his court has previously ruled that costumes have an intrinsic utilitarian function" and so cannot be copyrighted as costumes. While finding that the particular costumes at issue were indeed useful articles, the court also held that the design elements were conceptually separable from the utilitarian elements; the costumes were not "designed to optimize their function as clothing." Therefore, the costumes were copyrightable as "applied art."

Although the reasoning of *National Theme* has been questioned, this case can be distinguished from *Whimsicality* in that the applicant was forthcoming about what he was attempting to copyright. Plaintiff deposited packaging inserts with its application, which served as labels for the costumes and contained a photograph of a model wearing the costume. Plaintiff claimed copyright in "Text, Graphics[,] Photographs, and Original Artistic Expression of Accessory Items Shown in Photographs -- No claim is made on designs of clothing, but in designs of artwork on clothing." Unlike plaintiff in *Whimsicality*, plaintiff in *National Theme* had not knowingly misrepresented that its costumes were something other than clothing, e.g. "soft sculptures."

In *Ashton-Tate Corp. v. Fox Software, Inc.*, 760 F.Supp. 831 (C.D.Cal. 1991), plaintiff almost lost its very valuable copyright in a dBase line of computer programs, through invalidation as a result of an omission in its copyright application, before the judge rescinded his Order. Plaintiff sued for infringement; defendant asserted plaintiff's copyright was invalid as a result of fraud and inequitable conduct on the Copyright Office. The judge first issued an Order finding that plaintiff's copyright was invalidated as a result of plaintiff's knowing failure to disclose in its application that its computer programs were derived from a public domain program developed by the Jet Propulsion Laboratory. Three months later, the judge issued an Amended Order rescinding the earlier order, without comment, and denied defendant's motion for summary judgment based on invalidation of plaintiff's copyright.

Ralph Oman, Register of Copyrights, filed a Declaration in the *Ashton-Tate* case, executed a little over a month after the first Order was issued, which was published with the Amended Order (1991 Copyright Law Decisions No. 26,714). In his Declaration, Mr. Oman stated, "Unlike the patent examination system, the Copyright Office examination process does not include a search or examination of prior art, and the Copyright Office does not normally conduct any detailed comparison of preexisting works disclosed on an application to determine the extent of any changes or new materials added in a derivative work." ... "If *Ashton-Tate* had disclosed in its Original Registration Certificates the information that was later disclosed in its Supplementary Registration Certificates, including the existence of additional preexisting works, the Copyright Office would still have processed the applications and issued registration certificates to *Ashton-Tate*." "Where a copyrightable work is merely influenced or inspired by a preexisting work, but there has been no substantial copying of protectable expression from the preexisting work, the Copyright Office does not expect or require that preexisting work to be disclosed on the application for registration."

Conclusion

The practitioner should be aware that almost any work of authorship that is "original" (that is, displays a de minimus amount of creativity) is registerable with the Copyright Office, and should be registered. Since the procedures for applying for and receiving a copyright are so simple, all works of authorship should be registered with the Copyright Office. The practitioner must exercise care to be precise when describing the work for which copyright is claimed. While the presumption of validity created by a copyright registration will

not generally be overcome by an innocent misstatement (Whimsicality at 455), the presumption will be overcome by proof of a deliberate misrepresentation. However, the practitioner must also bear in mind that copyrights issued on works which display only a very minimal amount of originality are subject to invalidation in a subsequent court proceeding. Copyright litigation is invariably expensive.

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