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FROM FACTS TO FORM: EXTENSION AND APPLICATION OF THE *FEIST* “PRACTICAL INEVITABILITY” TEST AND CREATIVITY STANDARD

I. INTRODUCTION

This Note will analyze the results of extending the “practical inevitability” test and creativity standard in the holding of *Feist Publications, Inc. v. Rural Telephone Service Co.*¹ from works involving the compilation of facts to other works including computer programs, sculpture, signs, fabric patterns and chinaware patterns. It will also discuss the Copyright Office’s review of copyright applications for functional objects. The Note will continue with an analysis of the ramifications of the policy of judicial deference to the Register of Copyright’s decision on creativity when reviewing a copyright denial. It will conclude with a discussion of the judicial policy that an action for infringement is the most appropriate place to determine the creativity element necessary for obtaining a copyright for functional objects.

II. THE BASIS OF COPYRIGHT PROTECTIONS

The right of an author under the common law to have the sole right of initial printing and publishing of his or her work was decided in England by Lord Mansfield writing for the majority in *Millar v. Taylor*.²

In the United States, constitutional copyright protection subsists in original works of authorship.³ The two requirements for authorship, independent creation and creativity, arise from the statutory phrase “original works of authorship” which in turn has its basis in the Constitution.⁴ In order

1. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282 (1991).

2. 1588-1774 Eng. Rep. 119 (1769), *quoted in* *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 762 (2d Cir. 1991).

3. U.S. CONST. art I, § 8, cl. 8; 17 U.S.C. § 102 (1988).

4. U.S. CONST. art I, § 8, cl. 8; 17 U.S.C. § 102. *See also Feist*, 111 S. Ct. 1282; *Store Decor v. Stylex Worldwide Indus., Ltd.*, 767 F. Supp. 181 (N.D. Ill. 1991).

to be certified as a pictorial, graphic or sculptural work appropriate for copyright protection, the work must incorporate some creative authorship in its delineation or form.⁵

III. THE "PRACTICAL INEVITABILITY" TEST AND CREATIVITY STANDARD OF FEIST

The Supreme Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*⁶ addressed the constitutional origins of copyright and determined a standard of creativity to be applied to all works. Although the Court could have restricted its holding to the white pages telephone directory which was the subject of the dispute, the Court used the opportunity for a thorough discussion of the requirement of creativity in copyrighted works.

The issue in *Feist* was whether the white pages listings in a telephone directory, which compiled an alphabetical listing of the names of telephone subscribers together with their addresses and telephone numbers, had the requisite creativity to be afforded copyright protection.⁷ The Court held that a work is "original" and qualifies for copyright protection if the work is independently created by the author and possesses some minimal degree of creativity.⁸ Originality for copyright purposes is constitutionally mandated for all works.⁹

The Supreme Court held that the vast majority of works "make the grade."¹⁰ The requisite level is extremely low, even a slight amount will suffice.¹¹ However, "originality" does not require "novelty;" a work may be original even though it is very similar to other works so long as the similarity is fortuitous, not the result of copying.¹²

5. 37 C.F.R. § 202.10(a) (1991).

6. 111 S. Ct. 1282 (1991).

7. *Id.* at 1282. Rural Telephone Service was a public utility providing service to communities in Kansas. Rural was required by Kansas regulations to compile a directory including white and yellow pages. The information was obtained from subscribers when they obtained service. Feist Publications, Inc. was a publishing company that specialized in area wide telephone directories. When Rural refused to license its white pages listings to Feist, the information was extracted without consent. Although Feist altered many of Rural's listings, several were identical to listings in Rural's directory. The district court granted summary judgment to Rural in an infringement suit, which was affirmed on appeal. *Id.* at 1286.

8. *Id.* at 1287.

9. *Id.* at 1288.

10. *Id.* at 1287.

11. *Id.*

12. *Id.*

Prior to *Feist* the level of creativity necessary for a showing of copyrightability had been described as “very slight,” “minimal”¹³ or “modest.”¹⁴ The Court in *Feist* held creativity is the fundamental copyright principle that mandates the law’s seemingly different treatment of facts and factual compilations.¹⁵ No one may claim originality as to facts because facts do not owe their origin to authorship.¹⁶

Copyright secures authors the right to their original expression, but stimulates others to create freely upon the ideas and information conveyed by prior works.¹⁷ Under the “sweat of the brow theory” copyright was a compensation for the difficult work that compiling facts required.¹⁸ In *Feist* the Supreme Court rejected the “sweat of the brow” doctrine because it contradicted basic copyright law principles of “originality” and protection for expressions of facts, not facts themselves.¹⁹

“Originality” and not “sweat of the brow” is the standard of copyright protection in fact based works such as telephone directories.²⁰ Even the choice and organization of facts cannot be so mechanical or habitual as to require no creativity whatsoever.²¹ The white pages listings in *Feist*’s telephone directory were entirely typical.²² The Court described the directory as a “garden-variety white pages directory, devoid of even the slightest trace of creativity.”²³ However, the penultimate reason for denial was that the Court found the alphabetical arrangement of the telephone directory not only unoriginal, it was *practically inevitable*.²⁴

A person picking up the white pages to find a telephone number would not only expect but demand that the listings be

13. *West Publishing Co. v. Mead Data Cent.*, 799 F.2d 1219, 1223 (8th Cir. 1986).

14. *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970), *cert. denied*, 401 U.S. 977 (1971).

15. *Feist*, 111 S. Ct. at 1288.

16. *Id.*

17. *Id.* at 1290 (citing with approval *Harper & Row Publishers v. National Enter.*, 471 U.S. 539, 555-57 (1985)).

18. *Id.*

19. *Id.*

20. *Id.* at 1295.

21. *Id.* at 1296.

22. *Id.*

23. *Id.*

24. *Id.* at 1297.

in alphabetical order. To list them otherwise would be non-functional. The only use for the white pages directory is to obtain the telephone numbers of known persons. While other compilations of telephone numbers might be helpful, informational or even entertaining, the practical reason behind the white pages listings in a phone book is to quickly and efficiently provide telephone numbers ordered by subscriber's name. To achieve this purpose only an alphabetical listing works. A non-alphabetical listing system for names would be time consuming and therefore costly to use. Practical considerations dictate its arrangement.

The Court found that there was no practical alternative to the arrangement of the uncopyrightable facts in Feist's white pages directory. Any copyrightable selection or arrangement having creative expression had necessarily been forced to succumb to the practical alphabetical arrangement, and could not exist.

The fundamental objective of copyright protection is not to reward the toil of authors but to promote progress through science and the useful arts.²⁵ Augmenting on and expanding through access to the ideas and information of others is encouraged.²⁶

In a rapidly developing technological society unfettered access to all ideas is essential. Copyright protection is functional, not privileging. The benefit flows to society, not individuals. Copyright forces the improvement and creation of expressions of ideas to cultivate useful arts as well as goods and services.

This societal benefit is achieved by refusing unlimited copying of old expressions of ideas. The practical aspects of any work, including its facts or ideas, are not protected by copyright. This results in a "practical inevitability" test. If the expression is dictated by functional or practical concerns it is not copyrightable.

The *Feist* Court did not make new law but instead reaffirmed basic copyright principles with the "practical

25. U.S. CONST. art. I, § 8, cl. 8. *Accord*, *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975), *quoted in Feist*, 111 S. Ct. at 1290.

26. *Feist*, 111 S. Ct. at 1290.

inevitability" test. The test can be applied to any copyright situation and guarantees unlimited access to the practical ideas and information that a free enterprise society needs. It also promotes change and growth by restricting copying of original expressions of ideas and stimulating innovative expansion on creative thought processes. For authors to achieve copyright protection they must find different creative expressions of information and ideas. New is not the same as creative.

IV. RECENT JUDICIAL EXTENSION OF THE *FEIST* "PRACTICAL INEVITABILITY" TEST TO OTHER TYPES OF WORKS

As stated previously, prior to *Feist* the level of creativity necessary for a copyright had been described as more than some, but not very much.²⁷ Because all works are in part non-copyrightable, (the idea of "book" is not copyrightable although the book is), the standard after *Feist* is that a work must be *devoid of even the slightest trace of creativity*.²⁸ To be copyrighted a work must have creative selectivity, arrangement, or non-functional elements not dictated by "practical inevitability." It is only when form completely follows function that copyright cannot be permitted. Functions and facts lack "creativity."

The *Feist* Court did not limit the general rule it was purporting to lay down to compilations but instead reiterated the basic standard for originality.²⁹ The method of measuring for originality may vary but the standard remains the same for every work of authorship.³⁰ The *Feist* standard of originality has now been extended beyond compilations to fabric patterns, sculptures, computer programs and chinaware design.

In *Allen-Myland v. International Business Machines*, an action for copyright infringement of a computer program, the *Feist* creativity standard and the "practical inevitability" test were applied.³¹ The district court on reconsideration held that

27. See, e.g., *West Publishing Co. v. Mead Data Cent.*, 799 F.2d 1219, 1223 (8th Cir. 1986); *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir. 1970).

28. *Feist*, 111 S. Ct. at 1297.

29. *Allen-Myland v. International Business Mach.*, 770 F. Supp. 1004, 1007 (E.D. Pa. 1991).

30. *Id.* at 1008.

31. *Id.* at 1004-06. *Allen-Myland* had asked for reconsideration of the district court's earlier decision in *Allen-Myland v. International Business Mach.*, 746 F. Supp. 520 (E.D. Pa. 1990), in light of the *Feist* decision. In the first decision the court

Feist did not disprove specifically of decisions requiring the originality of a multi-element work to be considered as a whole, especially when the elements are designed to work together.³²

The district court also held that Allen-Myland copied information which was original to IBM programmers and the computer program was not a factual compilation.³³ After finding that the method for measuring originality for a factual compilation would not apply to the contents of the computer program, the district court held that the standard for originality in *Feist* was mandatory as the Supreme Court reaffirmed basic copyright law on the meaning of the term.³⁴ The district court was free to look for originality anywhere on the computer tape, not just in its arrangement, selection or coordination.³⁵

Allen-Myland contended that the computer program, described as a microcode, lacked originality in part because the contents of portions of the program were created after the rest of the microcode. If true, this later material would be necessarily dictated by the programming choices IBM had already made.³⁶ This would prevent copyright of this later material under the "practical inevitability" test of *Feist*. The district court did not agree with Allen-Myland and based its holding on the evidence presented. The court discredited Allen-Myland's supporting testimony and held that the IBM research team did not develop the microcode in pieces but as one design activity altogether.³⁷ The court also held that IBM's choice among many possibilities of table structure, instruction arrangement and other information were protected expression under *Feist*.³⁸

The *Feist* "practical inevitability" test and creativity standard were applied to a fabric pattern in *Folio Impressions v. Byer California*.³⁹ The appellate court first determined that the

held Allen-Myland liable for infringing IBM's copyright in its 3090 microcode. In reaching its conclusion, the court did not analyze the contents of the tape containing the infringed materials in isolation from the rest of the microcode. *Id.*

32. Allen-Myland v. International Business Mach., 770 F. Supp. 1004, 1008 (E.D. Pa. 1991).

33. *Id.*

34. *Id.*

35. *Id.*

36. *Id.* at 1011.

37. *Id.*

38. *Id.* at 1012.

39. 937 F.2d 759 (2d Cir. 1991). *Folio Impressions Inc. (Folio)* imported and sold fabric to women's clothing manufacturers including a rose design which it later registered with the Copyright Office. *Byer California* thereafter obtained a swatch of

pictorial representation of a rose was copyrighted.⁴⁰ Then the court held that the background on which the copyrighted rose was placed was not original and was not copyrighted.⁴¹

The arrangement of copyrighted roses against the non-copyrighted background was examined for creativity justifying its own copyright.⁴² The court held that because the symmetrical placement of the roses on the background was not designed to ease manufacture (the *Feist* "practical inevitability" test) it was an artistic decision.⁴³ The court determined that even though the pattern was one of only slight originality and little creative output it was still copyrightable under *Feist*.⁴⁴

The *Feist* "practical inevitability" test and creativity standard were applied to freestanding glass sculptures in *Runstadler Studios, Inc. v. MCM Ltd. Partnership*,⁴⁵ an action for copyright infringement. Defendants sought to show that the creativity of the copyrighted sculpture "Spiral Motion" was

the fabric and showed it to a designer and asked for a similar design. The Byer's contract designer created its own design, Byer purchased the fabric and sold thousands of garments using a similar design pattern. Folio obtained an injunction on stipulation with Byer. Following a bench trial the district court held that the background of the original Folio rose design was non-copyrightable as in the public domain, and the pattern in which the roses were placed against the background was not original. The district court held that Folio did have a valid copyright to the rose itself, but concluded that there had been no infringement. The injunction was lifted, judgment entered and Folio appealed. *Id.* at 762.

40. *Id.* at 763. Because Folio had a certificate of copyright registration for the rose and defendants offered no proof to rebut the attendant presumption of validity, Folio was entitled to copyright protection for the rose as a matter of law. *Id.*

41. *Id.* at 763-64. Expert testimony showed that the source of the background was in the public domain and, contrary to the assertions of Folio, the background could not have been independently created in one day but must have been photocopied. *Id.*

42. *Id.* at 765. The roses in the fabric pattern had been placed in straight lines and turned so that the roses faced in various directions. The pattern was created by "clip art," a design process where the designer had photocopied the rose, pasted them onto a background and photocopied the result. *Id.* at 764.

43. *Id.* at 765.

44. *Id.* The copyright extended only to the arrangement of the Folio rose in straight lines, not to the idea of arranging roses in straight lines. *Id.* at 764-65.

45. 768 F. Supp. 1292 (N.D. Ill. 1991). In 1983 Runstadler Studio Inc. (Runstadler) produced "Spiral Motion," a sculpture composed of 39 clear glass rectangles, overlying each other to produce an arc of 405 degrees. Runstadler was issued a certificate of copyright registration on "Spiral Motion" in 1988. MCM Limited Partnership sold a similar sculpture created in 1986 by a co-defendant composed of 17 glass rectangles producing an arc of 360 degrees. Runstadler brought suit for copyright infringement and claims for deceptive trade practices under Illinois law. Following hearings the district court found that "Spiral Motion" had been indirectly copied and Runstadler moved for permanent injunction. *Id.* at 1294-95.

insufficient to afford copyright protection which would preclude their liability for copyright infringement.⁴⁶

The district court turned to *Feist* to note that the creativity required for a valid copyright was extremely low.⁴⁷ The court first held that "Spiral Motion's" shape and dimensions were made by choice, thereby passing the "practical inevitability" test of *Feist*.⁴⁸ The court then held that "Spiral Motion" possessed the required creativity to qualify as an original work of authorship because the choice of location, orientation and dimensions of the glass panes showed far more than the trivial amount of creativity necessary.⁴⁹

The *Feist* "practical inevitability" test and creativity standard were applied to a set of plastic signs in *Sem-Torq, Inc. v. K mart Corp.*⁵⁰ Sem-Torq brought an action for infringement against a competitor and sought to have the signs protected by copyright as a compilation.⁵¹

The appellate court held that the choice of colors, legends, phrases and pairings of the individual Sem-Torq signs were mandated by the functional nature of the signs and not the result of creativity.⁵² The signs did not pass the "practical inevitability" test of *Feist*. The court necessarily held that the individual signs were not copyrightable as devoid of even the slightest trace of creativity.⁵³

46. *Id.* at 1295.

47. *Id.*

48. *Id.* at 1295-96.

49. *Id.* at 1297. The denial of the defendant's copyright by the Copyright Office as an improper "idea" copyright was successfully used to defend the action as plaintiff could not copyright the "idea" either. Defendant's spiral was found expressive and visually different from "Spiral Motion" and therefore not an infringement of plaintiff's copyright. *Id.* at 1298-99.

50. 936 F.2d 851 (6th Cir. 1991). Sem-Torq developed five plastic double-sided signs to be sold as a "set." Each had a different legend on each side such as "For Sale" backed with "For Rent." The legends were selected based on "seasonal, demographic, and geographic" factors. The sign "set" was displayed in a tiered rack, with each sign in an individual pocket. The Sem-Torq signs were sold separately. Co-defendant Hy-Ko developed its own double sided signs designed to fit in the existing racks after learning from K mart of successful test sales of the Sem-Torq signs. Hy-Ko used twelve preexisting legends and artwork from Hy-Ko signs already sold by Hy-Ko to K mart. Hy-Ko's "set" consisted of six signs on which were "logically" paired legends such as "House For Sale" backed with "For Sale by Owner." Sem-Torq brought suit against K mart and Hy-Ko for copyright infringement, and state law claims of unfair competition, unjust enrichment, and breach of contract. Summary judgment was granted in favor of K mart and Hy-Ko. Sem-Torq appealed. *Id.* at 852-53.

51. *Id.* at 854.

52. *Id.*

53. *Id.* at 854-55.

The appellate court then held that because the signs were sold separately and not as a set, the signs did not constitute an original work of authorship as a compilation.⁵⁴

Each of the above cases reached the determination of copyrightability by first applying the "practical inevitability" test of *Feist* followed by the creativity assessment. In each case if the "practical inevitability" test were passed the constitutionally-mandated level of creativity existed and the non-functional and original portions of the work were copyrightable. We now turn to a case where the exact opposite result was reached.

The *Feist* creativity standard and the "practical inevitability" test were applied by the Copyright Office and the D.C. District Court to deny a copyright for lack of creativity in *Homer Laughlin China Co., v. Oman*.⁵⁵ The suit reviewed the Copyright Office's denial of an application for copyright of a chinaware pattern.⁵⁶

Plaintiff filed under the Administrative Procedure Act⁵⁷ contending that the Copyright Office's refusal to register the chinaware pattern "Gothic" was improper.⁵⁸ The issue before the district court was whether the United States Register of Copyrights abused his discretion in denying plaintiff's application to register a claim to copyright in the chinaware design pattern "Gothic." The district court held that the Register had not abused his discretion.⁵⁹

54. *Id.* at 855.

55. 1991 Copyright L. Rep. (CCH) ¶ 26,772 (D.D.C. July 30, 1991). Plaintiff, Homer Laughlin, created "Gothic" as a china pattern in early January 1988, which enjoyed considerable commercial success. On April 15, 1988 plaintiff filed its initial application for copyright of "Gothic." The Copyright Office rejected the application because familiar shapes and symbols were not copyrightable nor were simple variations or combinations of basic geometric designs capable of supporting a copyright registration. *Id.*

Plaintiff refiled its application on February 13, 1989 and the Copyright Office again denied it on April 1, 1989 because "[t]he work you submitted for copyright registration is a useful article . . . [and] Congress stated that it did not intend to protect the designs of useful articles." *Id.*

On September 29, 1989 plaintiff sought reconsideration but the rejection was affirmed on January 16, 1990 because "the authorship presented must be considered in its entirety . . . [b]ut overall authorship on each of these pieces of china is really a familiar chinaware presentation which constitutes too minimal an amount of original creative authorship to meet even the low standard of authorship required for a work to be copyrighted." *Id.*

The final action refusing to register the copyright came in a letter from the Register on November 1, 1990. *Id.*

56. *Id.*

57. 5 U.S.C. §§ 701-706 (1988).

58. *Homer Laughlin*, 1991 Copyright L. Rep. (CCH) at 24,508.

59. *Id.*

The court determined that in approving "Gothic" for copyright, the question for the Register was whether "Gothic" contained certain levels of creativity and originality.⁶⁰ The court held that the Copyright Office's incantation of the regulation barring registration of familiar designs was a shorthand method of expressing the conclusion that "Gothic" did not embody a sufficient degree of creative authorship.⁶¹

The district court noted that *Feist* held the requisite level of creativity was extremely low, even a slight amount would suffice.⁶² Then without further comment or application of the *Feist* creativity standard, the district court held that it was not an abuse of discretion to deny the copyright.⁶³

The district court's rationale was that the Register's refusal to copyright the chinaware design pattern "Gothic" was not final since Homer Laughlin could gain full judicial review of copyrightability in an infringement action.⁶⁴

V. COPYRIGHT OFFICE REVIEW OF FUNCTIONAL OBJECTS

Because chinaware is a useful article, we will now examine the statutory requirements for copyright registration of useful articles and observe that the "practical inevitability" test had been statutorily mandated for useful articles long before *Feist*.

A useful article is one having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.⁶⁵ The registration of useful

60. *Id.* at 24,507 (citing *John Muller & Co. v. New York Arrows Soccer Team*, 802 F.2d 989, 990 (8th Cir. 1986)).

61. *Id.* at 24,508.

62. *Id.*

63. *Id.* The second reference to creativity was in the third letter, where copyright was denied because "the authorship presented must be considered in its entirety . . . [b]ut overall authorship on each of these pieces of china is really a familiar chinaware presentation which constitutes too minimal an amount of original creative authorship to meet even the low standard of authorship required for a work to be copyrighted." *Id.*

64. *Id.* Plaintiff had raised three contentions in its argument for reconsideration: first, that the Register had not clearly explained the basis for his refusal to register "Gothic" on the basis of insufficient creative authorship; second, that the procedures for review of the chinaware pattern were deficient; and third, that the commercial success, expense, human effort, professional skills and expertise of the designer and artistic recognition qualified "Gothic" for a copyright. *Id.* The third argument is the "sweat of the brow" theory thoroughly discredited in *Feist*.

65. 17 U.S.C. § 101 (1988).

articles presents the Copyright Office with one of the most difficult issues arising under the Copyright Act.⁶⁶

Congress excluded the design of useful articles from the realm of copyright except when the design incorporates artistic features that can be identified separately from and are capable of existing independently of the utilitarian aspects of the article.⁶⁷ This is the "practical inevitability" test as formulated in *Feist*, which mandates that this test applies to all copyrights.⁶⁸

It was the intent of Congress that unless the shape of an automobile, airplane, ladies dress, food processor, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of the article, the design would not be copyrighted.⁶⁹

In *OddzOn Products, Inc. v. Oman*, a case predating *Feist*, the Copyright Office affirmed that elements of an object that were inextricably interwoven with the utilitarian aspects of the article could not be taken into account in the creativity assessment when it denied copyright for the "Koosh" ball.⁷⁰

The district court on review similarly indicated that it would have been arbitrary for the Copyright Office to deny registration because the "Koosh" ball's shape approximated a sphere.⁷¹ The court determined that it was not merely that the

66. *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346, 349 (D.C. Cir. 1991) (quoting Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y. 339 (1990)).

67. *Id.*

68. *Feist*, 111 S. Ct. at 1297.

69. *OddzOn*, 924 F.2d at 349 (citing H.R. 1476, 94th Cong., 2d Sess. 55, reprinted in 1976 CODE CONG. & ADMIN. NEWS 5659, 5668).

70. *Id.* at 348. *OddzOn* plaintiffs had invented the "Koosh" ball which is a patented, trademarked product formed of hundreds of floppy, wiggly, elastomeric filaments radiating from a core. The Copyright Office refused to register the ball as a soft sculpture. *OddzOn* had sought copyright registration for the "Koosh" ball to block importation of less expensive knockoffs. *Id.* at 347-48.

The Copyright Office addressed both the visual character and the "tactility" or feel of the "Koosh" ball. The examiners regarded the "Koosh" ball's shape as a familiar symbol or design because the ball's filaments, rudimentally formed a sphere, and according to the Copyright Office, there was no copyrightable authorship in creating such a familiar shape. The texture of the object was perceived by the examiners as a functional part of the work, and therefore not a foundation for registration. The examiner held "[w]e cannot register a claim for . . . the way a work functions, because Congress did not authorize protection for the functional aspects of articles." *Id.*

71. *Id.* at 348.

"Koosh" ball approximated a sphere, it was also that there was not enough additional creative work beyond the object's basic shape to warrant a copyright.⁷² The "Koosh" ball had only a single basic shape, a sphere.⁷³ In reviewing the district court's affirmance of denial of the copyright for the "Koosh" ball, the D.C. Circuit held that the position of the Copyright Office was clear and that the visual aspect of the "Koosh" ball (a single sphere) did not reflect the minimal degree of creativity required for a copyright.⁷⁴

However, *Feist* and all its progeny in infringement cases would require opposite results in both *Oddzon* and *Homer Laughlin* and grant copyright. The Copyright Office's denial of copyright after the determination that an object has passed the "practical inevitability" test conflicts with the Supreme Court's determination of constitutionally protected creativity entitled to copyright in *Feist*. The conflict is caused by the standard of review applied by the courts to the denial of copyright by the Copyright Office for the lack of creativity.

VI. THE DEFERENTIAL STANDARD OF REVIEW

It is the practice of the Copyright Office to issue copyright registration under reservation and to resolve doubtful claims in favor of registration.⁷⁵ When, after registration, the Register of Copyrights determines that the applicant has met the legal and formal requirements, the Copyright Office registers the claim and issues the applicant a certification of registration under the seal of the Copyright Office.⁷⁶

If the Copyright Office refuses registration, the applicant may seek immediate judicial review in an action under the Administrative Procedure Act.⁷⁷

The Register is currently given a significant degree of deference, and the Register's decision may be overturned only upon

72. *Id.*

73. *Id.* The district court applied the Copyright Act definition of "pictorial, graphic and sculptural works to the conceptual separability test in *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144 (2d Cir. 1987), and held it was not an abuse of discretion for the Copyright Office to rank the tactile qualities of the "Koosh" ball as dependent upon, and inseparable from, the utilitarian features of the object, and hence not protectable by copyright. *Id.*

74. *Id.* at 349.

75. *Sem-Torq, Inc. v. K mart Corp.*, 936 F.2d 851, 853 (6th Cir. 1991).

76. 17 U.S.C. § 410 (1988).

77. 5 U.S.C. § 701-706 (1988); 17 U.S.C. § 701(d) (1988).

an abuse of discretion standard.⁷⁸ In its determination of abuse of discretion by the Register in denying a copyright, the reviewing court looks at the reasons stated in the final agency decision.⁷⁹ The appellate stance in reviewing a refusal to register is the same as that for the district court, a deferential abuse of discretion standard.⁸⁰

The Copyright Office must explain if or why it was employing a categorical distinction of registrability thresholds for the contested work and other works.⁸¹ *Feist* casts this in grave doubt as the registrability threshold for all works is now the same. A work that passes the "practical inevitability" test is copyrightable.

If the reviewing court is unable to discern from the final agency action disqualifying the application for registration how the register was applying the relevant statutory prescriptions the case must be returned for the requisite rational explanation.⁸²

It is the position of the D.C. District and D.C. Circuit Courts that the costs of forcing too fine an analysis and too extensive an explanation of a denial of registration are not worth the benefits, particularly when reviewing a question which has unavoidably subjective aspects such as how much creativity is sufficient to force the copyright office to register a proffered work.⁸³ The Register's determination that a deposited object's visual aspect does not reflect the minimal degree of creativity required for copyright, adequately explains copyright denial and will not require reversal under the deferential abuse of standard of review.⁸⁴

It is the current policy of the Copyright Office that familiar symbols or designs are not subject to copyright.⁸⁵ However,

78. *OddzOn*, 924 F.2d at 348.

79. *Atari Games Corp. v. Oman*, 888 F.2d 878, 881 (D.C. Cir. 1989). The failure of the district court in *Homer Laughlin* to restrict its decision to the final refusal letter of the Register may constitute reversible error. See *Homer Laughlin China Co. v. Oman*, 1991 Copyright L. Rep. (CCH) ¶ 26,772, at 24,508 (D.D.C. July 30, 1991).

80. *Atari*, 888 F.2d at 881.

81. *OddzOn*, 924 F.2d at 348.

82. *Atari*, 888 F.2d at 881. See also *Fort Bragg Ass'n. of Educators v. F.L.R.A.*, 870 F.2d 698, 701 (D.C. Cir. 1989); *City of Vernon v. FERC*, 845 F.2d 1042, 1046-49 (D.C. Cir. 1988).

83. *Atari*, 888 F.2d at 887 (Silberman, J., concurring).

84. *OddzOn*, 924 F.2d at 347-48. In *OddzOn*, the court tacitly held that the only suitable forum for determination of conceptual separability (i.e. the "practical inevitability" test) was in an action for copyright infringement. *Id.* at 347.

85. 37 C.F.R. § 202.10 (1991). In *Homer Laughlin*, the Copyright Office made two references to the level of creativity found in plaintiff's chinaware pattern. The appli-

simple shapes when selected or combined in a distinctive manner indicating some ingenuity have been accorded copyright.⁸⁶ Notwithstanding the Copyright Office's assertions in *Homer Laughlin* to the contrary, unique combinations of standard shapes may be copyrighted.⁸⁷ Copyright is intended to encourage original work.⁸⁸ It does not mean that relatively simple works are not entitled copyright protection.⁸⁹ Component parts neither original to the applicant nor copyrightable may, in combination, create a separate entity that is both original and copyrightable.⁹⁰

In determining creativity, the Register is generally recognized to possess considerable expertise over such matters as a result of having to make such determinations on a daily basis, and such a determination required the exercise of informed discretion.⁹¹

The Copyright Office is not held to be arbitrary by adhering to the conceptual separability test of the Second Circuit (now supplanted by the "practical inevitability" test of *Feist*).⁹² However, the question of conceptual separability ("practical inevitability") does not come under the purview of the court when reviewing the denial of registration of copyrights.⁹³

Another ground for deference to the Copyright Office's denial of copyright for lack of creativity is that determination of copyrightability may be sought in an infringement action.⁹⁴

cation was first denied because familiar shapes are not copyrightable nor are simple variations or combinations of basic geometric designs capable of supporting a copyright registration. *Homer Laughlin*, 1991 Copyright L. Rep. (CCH) ¶ 26,772.

86. See, e.g., *Soptra Fabrics, Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir. 1974) (fabric design with strip of crescents with scalloping or ribbons with rows of semicircles); *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1316 (2d Cir. 1969) (fabric design of circle within a square within a circle).

87. *Runstadler Studios, Inc. v. MCM Ltd. Partnership*, 768 F. Supp. 1292, 1295 (1991).

88. See *id.*

89. See *id.*

90. See *Apple Barrel Prod., Inc. v. Beard*, 730 F.2d 384, 388 (5th Cir. 1984). See also *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 764-65 (2d Cir. 1991).

91. *Norris Indus., Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983).

92. *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346, 350 (D.C. Cir. 1991). See also *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987), for a discussion of this test.

93. *OddzOn*, 924 F.2d at 349.

94. *Atari Games Corp. v. Oman*, 888 F.2d 878, 880 (D.C. Cir. 1989).

The determination on review that the Copyright Office's denial is not an abuse of discretion, does not dictate the outcome if the same question were brought in a copyright infringement action.⁹⁵

In an infringement action, the court need not defer to an agency's action or interpretation.⁹⁶ However, in at least one recent decision a district court held that to sustain a suit for copyright infringement the item must be registered in accordance with the Copyright Act.⁹⁷

A district court is not required to accept validity of copyright registration where the certificate of registration was not made until five years after first publication of the work.⁹⁸ A copyright certificate remains valid in the absence of fraud.⁹⁹

In a trademark infringement action, the refusal to admit evidence that a manufacturer attempted but failed to have a design registered under the Copyright Act is not an abuse of discretion.¹⁰⁰

The position of the Copyright Office and the courts that getting a copyright later is just as good as getting one sooner is untenable. The existence of a valid copyright does have effect on an infringement action.

In copyright infringement cases, because firsthand evidence of copying often is unobtainable, copying may be inferred where defendant had access to copyrighted material and the assertedly infringing work is substantially alike.¹⁰¹ Registration might have evidentiary impact in an action against an infringer and would prevent the Register's appearance at the infringement action as a party hostile to the claimant on the issue of registrability.¹⁰² Another important aspect of prior copyright protection is the availability of preliminary injunction to a copyright holder in an infringement action.¹⁰³

95. *OddzOn*, 924 F.2d at 350.

96. *Atari*, 888 F.2d at 889 (Silberman, J., concurring).

97. *Bauer Lamp Co. v. Shaffer*, 941 F.2d 1165, 1171 (11th Cir. 1991).

98. *Sem-Torq, Inc. v. K mart Corp.*, 936 F.2d 851, 853-54 (6th Cir. 1991).

99. *Bauer*, 941 F.2d at 1171.

100. *Id.*

101. *Store Decor v. Stylex Worldwide Indus., Ltd.*, 767 F. Supp. 181, 184 (N.D. Ill. 1991).

102. *Atari Games Corp. v. Oman*, 888 F.2d 878, 881.

103. *Lakedreams v. Taylor*, 932 F.2d 1103, 1107 (5th Cir. 1991). To obtain a preliminary injunction in a copyright infringement suit the moving party must show

A copyright may be valuable outside of its evidentiary presumption in an infringement action. Copyright owners may request the customs service to seize infringing copies.¹⁰⁴ Another reason is that the advantages, requirements, and protections of copyright differ from trademark.¹⁰⁵ The property of a bankruptcy estate encompasses intellectual property, such as interests in copyrights.¹⁰⁶

VII. *FEIST* MANDATES CHANGE IN THE STANDARD OF REVIEW OF COPYRIGHT DENIALS

The minimal creativity standard of *Feist* raises a fundamental problem: Is denial of copyright by the Copyright Office to functional objects for insufficient creativity after passing the "practical inevitability" test an abuse of discretion?

In all works, including functional objects, non-copyrightable elements exist. Prior to *Feist* the level of creativity necessary for copyright protection had been described as "very slight," "minimal" or "modest." After *Feist*, a work must be *devoid of even the slightest trace of creativity* to be denied copyright. The courts must apply the "practical inevitability" test. Copyright can be denied only when form follows function. The method of measuring for originality may vary but the standard remains the same for every copyright.

"(1) a substantial likelihood of success on the merits, (2) a substantial threat that failure to grant the injunction will result in irreparable injury, (3) the threatened injury outweighs any damage that the injunction may cause the opposing party, and (4) the injunction will not disserve the public interest." *Id.* (quoting *Allied Mktg. Group, Inc. v. CDL Mktg., Inc.*, 878 F.2d 806, 809 (5th Cir. 1989)). The evidentiary weight of a copyright certificate may be compelling in the success on the merits issue. *Id.*

104. 19 C.F.R. § 133.31 (1991). The procedures to stop importation of articles that infringe a valid and enforceable United States Patent before the U.S. International Trade Commission are more cumbersome. 19 U.S.C. § 1337 (a)(b)(1) (1988). Only copyright claims which have been registered may be recorded with customs for import protection. 19 C.F.R. § 133.31. A classic example of the desirability of this advantage is found in *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346 (D.C. Cir. 1991). The Copyright Office refused to register the "Koosh" ball as a soft sculpture. OddzOn had a trademark and a patent on the "Koosh" ball but sought copyright registration to block importation of less expensive knockoffs. *Id.*

105. See *Esercizio v. Roberts*, 944 F.2d 1235, 1238-39 (6th Cir. 1991). The "trade dress" protected from infringement by the Lanham Trademark Act is the image and overall appearance of a product and embodies that arrangement of identifying characteristics or decorations connected with a product, whether by packaging or otherwise, intended to make source of product distinguishable from another and to promote its sale. *Id.*

106. *Inslaw v. United States*, 932 F.2d 1467 (D.C. Cir. 1991). Trademark protection accrues with use, while copyright protection begins with registration. *Bauer Lamp Co. v. Shaffer*, 941 F.2d 1165, 1171 (11th Cir. 1991).

The Supreme Court's adoption in *Feist* of a "practical inevitability" test of the threshold which a work must exceed to achieve copyright as creative necessitates that any functional object which can meet the current statutory requirements that its creative visual elements be separable from its utilitarian aspects is *ipso facto* copyrightable.

A faithful application of the *Feist* standard would require certification by the Register of Copyright of all useful articles that can show visual elements not related to their function. Any higher standard that Copyright Office requires for useful objects to attain copyright is directly contrary to the Supreme Court's holding in *Feist* that the constitutionally mandated standard requires protection for any expression beyond "practical inevitability."

The contrary result is achieved by an unjustified deferential standard of review by the D.C. District and Circuit Courts. The Register's creativity determinations are erroneously held to require considerable expertise and require the exercise of informed discretion. Because the *Feist* mandated creativity standard is so low, experts are not necessary to make the creativity determination and there is no need for the reviewing court's deference.

If there are visual elements in a functional object's design not based on practical considerations, copyright is both justified and mandatory. If non-practical visual elements exist then they are creative. If they are creative then they pass constitutional muster. It is no longer proper for a reviewing court to defer to the Register's determination on creativity after the initial determination that non-practical visual elements exist. Denial of copyright subsequent to this determination is an abuse of discretion.

VIII. CONCLUSION

The denial of copyright until the instigation of an infringement suit after determining the work meets the "practical inevitability" test is an interference with property, procedural, and evidentiary rights. The outcome in the succeeding infringement action can only be that the work is creative and entitled to copyright.

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The reviewing courts should strictly adhere to *Feist* and overturn as an abuse of discretion all denials of copyright by the Copyright Office after the determination that elements which pass the “practical inevitability” test exist.

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