



Failure to Plead Originality of Copyright Design is Fatal to Complaint

- *Journal of Intellectual Property Law and Practice*, January 8, 2010

Author(s): Charles R. Macedo

LA Printex Industries, Inc. v Forever 21 Inc., No. 09-3382, US District Court for the Central District of California, 27 October 2009.

Abstract

A copyright infringement claim must plead the originality of the plaintiff's work if it is to state a cause of action.

Legal context

Copyright, as the name implies, provides the owner of a copyright the ability to control who has the 'right' to 'copy' the copyright material. Unlike patent law, in order to be qualified for copyright protection in the USA, the material need not be novel (i.e. new compared to that which existed before), it merely needs to be original. Under US law, the threshold level of originality to obtain copyright protection is 'extremely low'. In *LA Printex Industries, Inc. v Forever 21 Inc.*, the US District Court for the Central District of California explored the parameters of the minimal level of originality that is necessary to be entitled to copyright protection, and the elements necessary to plead such a cause of action.

Facts

LA Printex creates graphic artworks for use on textiles, which are sold primarily in the fashion industry. Forever 21 is a well-known retailer of women's clothing. LA Printex is the owner of a registered US copyright for four fabric designs, including a design for 'two dimensional graphic artwork with stylized nautical anchors as its primary elements'. (Slip op. at 2). LA Printex describes this copyright pattern: 'the anchors are fancifully drawn, and laid out across the design pane, or "repeat," in a jaunty, off-set pattern' (Id.).



LA Printex sued Forever 21 for copyright infringement of the Anchor Design. Forever 21 moved



to dismiss the pleadings on the grounds that the Anchor Design depicted an anchor symbol that is part of the public domain and does not evidence the requisite degree of creativity and originality to warrant copyright protection.

Analysis

Presumption of validity

Under US copyright law, a registered US copyright is presumed valid. As the court explained, ‘the registration of a copyright certificate constitutes prima facie evidence of the validity of a copyright in a judicial proceeding commenced within five years of the copyright’s first publication’ (*Id.* at 4 (citing 17 USC § 410(c))). Thus, while the court recognized that ‘[o]nce such a certificate is obtained, therefore, the burden shifts to the alleged infringer to demonstrate the invalidity of the registrant’s copyright. However, the presumption of validity is not difficult to rebut. An accused infringer can rebut the presumption of validity by simply offer[ing] some evidence or proof to dispute or deny the plaintiff’s prima facie case of infringement’. (*Id.* at 4–5 (citation and quotation marks omitted)).

The court recognized that, applying these principles, LA Printex’s pleadings established that its copyrights were registered less than 5 years prior to the complaint being filed, so the burden was on defendants to establish that the copyright in question was invalid.

Originality

Next, the court considered the standards for ‘originality’ under US copyright law, and applied those standards to LA Printex’s pleadings.

For an item to be entitled to copyright protection, it must exhibit some form of originality. The threshold level of originality required is admittedly low; ‘novelty, uniqueness and ingenuity’ are not required. Rather, Plaintiff need only show that (1) the author of the work independently created the work—that is, without copying from another work, and (2) the work displays some minimal level of creativity. The author must have ‘some contribution to the work which is irreducibly his own.’ This test of originality is the sine qua non of copyrightability and is a constitutional requirement.

(*Id.* at 5–6 (citations omitted)).

The Court then discussed both of the elements which establish originality as applied to LA Printex’s pleadings.

Independent creation. With respect to the independent creation element, the court explained the relevant standard as follows:

Plaintiff’s work must be the product of independent creation to warrant any copyright protection. This simply means that the plaintiff did not copy the work from something already in existence, but rather created it from his own independent efforts. Thus, a work will not be denied copyright protection simply because it is substantially similar to a work previously



produced by others, and hence, is not novel.

(*Id.* at 6 (citation and quotation marks omitted)).

To illustrate this standard, the court quoted Judge Learned Hand's famous explanation:

Borrowed the work must indeed not be, for a plagiarist is not himself pro tanto an 'author'; but if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an 'author,' and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's.

(*Id.* citing *Sheldon v Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936)).

Forever 21 pointed to various examples of anchors that were used by others to establish that LA Printex's anchor design was not original. The Court dismissed this argument at the pleadings stage since, 'even if the Court accepts Defendant's argument that Plaintiff's anchor design is substantially similar, if not identical, to symbols or designs in the public domain ..., as long as Plaintiff alleges that it independently created the anchor design (and sufficient creativity is demonstrated), Plaintiff's copyright claim is sufficient'. (*Id.* at 6–7 (footnote omitted)). However, since LA Printex did not plead that its works were independently created, the court dismissed the pleadings with leave to replead.

Minimal level of creativity. The court then considered whether the work has met a sufficient level of creativity. With respect to what constitutes a sufficient 'quantum of originality' the court, relying on US Supreme Court precedent in *Feist Publications v Rural Telephone Service Co.*, 499 US 340 (1991), recognized that 'the requisite degree 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 may be. Thus, any distinguishable variation from prior works will constitute sufficient originality to support a copyright provided that such variation is the product of the author's independent efforts, and is more than merely trivial.

(*Id.* at 8–9 (citation and quotation marks omitted)).

The court also described various ways in which the 'requisite originality for copyright protection' can be found, including a 'combination of unoriginal (and therefore uncopyrightable) elements' (*Id.* at 9 (citing *Express, LLC v Fetish Group, Inc.*, 424 F. Supp. 2d 1211 (C.D. Cal. 2006))). Thus the court recognized that 'a compilation of facts is copyrightable so long as the author's choices as to selection and arrangement of those facts exhibits a degree of creativity', in contrast to, 'where the arrangement itself is inevitable, obvious, or dictated by functionality,' in which case such a compilation is not. (*Id.*)

The court also recognized that 'thin' copyright protection may nonetheless be available 'even where individual elements of an author's work are not copyrightable, and the



combination of such elements is also not original enough to deserve protection’ (Id. at 10). In this regard, the court explained: ‘A “thin” copyright only protects the author’s original contribution to the work; thus it will only prohibit “virtually identical copying”’ (Id. (citing *Express*, 424 F. Supp. 2d at 1226)).

The court then applied these principles to conclude that Forever 21 did not present sufficient evidence to establish that LaPrintex’s anchor design did not possess the requisite degree of originality or creativity as a matter of law to be granted judgment on the pleadings. In particular, the court rejected, at this stage in the proceedings, Forever 21’s arguments based on the symbol itself being ‘in the public domain for several years’ and that the arrangement of ‘a single-well recognized and unprotectable symbol with different orientations’ fell below the threshold level of originality for compilation to warrant copyright protection. (Id. at 12). In reaching this determination, the court found that LA Printex’s ‘creative arrangement of the anchor symbol in rows drawn slightly askew, with different orientations, and different sizes is distinct from anything submitted by [Forever 21] as part of the public domain, and is sufficiently creative to warrant copyright protection.’ (Id. at 15–16). The court also found significant that Forever 21 ‘has not submitted any evidence to the Court to indicate that Plaintiff’s combination of anchors of various sizes and varying orientations is common or standard in fabric designs.’ (Id. at 16).

In sum, the court concluded:

The Court therefore finds that Plaintiff’s anchor design is sufficiently original to warrant some copyright protection, which is all that is necessary to defeat Defendant’s arguments regarding originality at this stage in the pleadings.

However, because Plaintiff failed to plead facts evidencing independent creation, as stated above, the Court will grant Defendant’s motion for judgment on the pleadings with leave to amend.

(Id. at 17).

Practical Significance

LA Printex illustrates the low threshold of originality necessary to obtain copyright protection in the USA. It also confirms the necessity to plead that a work is original in order to state a claim for copyright infringement. While ultimately LA Printex might not succeed in its claim for copyright infringement, at least for now it can continue to assert its copyright against Forever 21 once it has resubmitted its pleadings.

[Charles R. Macedo](#)



Amster, Rothstein & Ebenstein LLP, New York, NY

[Charles Macedo](#) is author of [The Corporate Insider's Guide to US Patent Practice](#), published by Oxford University Press in 2009. [Charles R. Macedo](#) is a partner at Amster, Rothstein & Ebenstein LLP. The firm's practice focuses exclusively on all facets of intellectual property law. The author can be contacted at cmacedo@arelaw.com.