



# COPYRIGHT CLAIMS BOARD

Docket number: 24-CCB-0010

February 5, 2024

David Bibiyan

CLAIMANT

v.

Abdulsalam Issa

RESPONDENT

## ORDER TO AMEND NONCOMPLIANT CLAIM

The Copyright Claims Board finds that your claim does not comply with the requirements of the CASE Act and related regulations. The claim cannot move forward unless it is amended.

If you wish to proceed with this claim, you must file an amended claim by **March 6, 2024**. If you do not, the Board must dismiss your claim without prejudice, although you may file again in the future before the Board or in federal court. If you file an amended claim and it is found compliant, you will be notified and directed to proceed with service. There is no additional filing fee for an amended claim. 17 U.S.C. § 1506(f)(1)(B).

To make your amended claim compliant, you must resolve the issues identified below. 37 C.F.R. § 224.1(c)(2). You may also choose to correct or edit any errors or other information in your claim before you file it again. You do not need to provide a legal argument in your claim – just a statement of facts and circumstances. Being specific in your description gives the other party and the Board more information about your claim. There is no character limit, so please be as detailed as possible.

### Copyright Registration

You have raised a claim of copyright infringement before the Board. The claim must include the copyright registration number and effective date of registration for the allegedly infringed work or, if it has not yet been registered, the service request number for a pending application to register the copyright. 37 C.F.R. §§ 221.1(b) & 222.2(c)(7)(ii)(C)-(D).

Your claim correctly listed the service request number for an application for registration of the allegedly infringed work. That registration has since issued. If you submit an amended claim, state in the “Works infringed” section that the copyright has been registered, and include the registration number VA0002379026 and the December 25, 2023 effective date of registration.

### Allegedly Infringed Work

If you submit an amended claim, it must clarify certain discrepancies between the work identified in the registration and your description of the allegedly infringed work in the “Works infringed” section of the claim.

The Certificate of Registration for VA0002379026 lists the title of the registered work as “Own the Avenue Website,” and notes, “Basis for registration: Registration does not extend to any useful article depicted.

Registration extends to deposited photographs only. 17 USC 101, 102(a), and 113.” The registration covers your authorship in photographic works, specifically, in the photographs deposited with the Copyright Office to support your application for registration. A Board review of Copyright Office records found that your deposit was a 471-page PDF, with the file name “owntheavenue\_catalogue\_2023-2024\_v5.pdf,” which appears to include more than 100 screenshots of the website OwntheAvenue.com. The screenshots depict thousands of items of merchandise, primarily decals, stickers, and license plate frames.

In the “Works infringed” section of the claim, the title of your work is “Endless Night Galaxy.” In the “Describe the work” section, you state:

It has a specific distinctive universe / galaxy pattern on the background, with kanji / Japanese art portrayed at the top, with the galaxy behind it, and the script endless \* nights with the star in the middle – and the quotations, with the universe / galaxy all in conjunction with each other.

Several different items with those elements appear in supplemental documents filed with the claim. A sticker or decal with those elements appears in documents labeled [endless night 1.jpg](#) and [IMG\\_6732.PNG](#), and a license plate with those elements appears in a document labeled [IMG\\_6731.PNG](#).

However, it is not clear whether you allege that one or all of those items was infringed, and it is not clear that any of those items is part of the copyright registration claimed. A Board review of the deposit copy submitted with the application for registration VA0002379026 revealed images of similar merchandise items, but none appear to match any image in the supplemental documents filed with this claim.

The copyright registration covers your authorship in the photographs of the website deposited with the Copyright Office, but it does not extend to the merchandise items depicted in the deposited photographs—nor does it cover material *not* depicted in the deposited photographs. Copyright protects only “original works of authorship.” 17 U.S.C. § 102(a). To be original, the work must be independently created by the author, without copying from other works, and must possess at least some minimal degree of creativity. See *Feist Publications, Inc. v. Rural Telephone Serv. Co., Inc.*, 499 U.S. 340, 346 (1991) (“originality requires independent creation plus a modicum of creativity”). More information about copyrightable authorship is available in Sections 302, 308, 311, and 313 of [Chapter 300](#) of the *Compendium of U.S. Copyright Office Practices, Third Edition* (“*Compendium*”).

A photograph may display copyrightable authorship involved in creating the image, for example, “positioning, background, lighting, shading, and the like.” *Mesbwerkes, Inc. v. Toyota Motor Sales U.S.A.*, 528 F.3d 1258, 1264 (10th Cir. 2008). However, “the law is becoming increasingly clear: one possesses no copyright interest in reproductions . . . when these reproductions do nothing more than accurately convey the underlying image.” *Id.* at 1267 (citation omitted). In such cases, “a photograph does not and cannot create a copyright in the underlying subject matter.” *Masterson Marketing, Inc. v. KSL Recreation Corp.*, 495 F. Supp. 2d 1044, 1048 (S.D. Cal. 2007). Accordingly, the Copyright Office examiner reviewing your application for registration notified your counsel by email on December 26, 2023, “when you register a photograph, you may not also register the object or artwork depicted in that photograph on the same application as these are separate works.” The examiner added two days later, “Please be aware that registering the website materials will not cover the individual artworks in the website.”

If you submit an amended claim, it must clarify which work is the allegedly infringed “Endless Night Galaxy” work and identify where it appears in the deposit submitted for registration. If the image files you submitted with the claim are not images of allegedly infringed works covered by the registration, you may remove them and submit different files with the amended claim. You must also identify some creative aspect of the deposited photograph (rather than the underlying license plate frame, sticker, or decal) that copyright may protect. You must state or show how the photograph added some creative expression to the underlying work. *See* Section 909.3(A) of [Chapter 900](#) of the *Compendium*.

The Certificate of Registration for VA0002379026 also states that the registered work was created in 2010 and first published January 1, 2011. However, the [endless night 1.jpg](#) document filed with the claim indicates that the Endless Nights sticker or decal was created or modified on December 21, 2020. If you allege infringement of that sticker or decal in your amended claim, include facts that clarify this discrepancy.

### **Copyright Infringement – Elements**

Your claim must make enough factual allegations to support each “element” of the claim. Information about the elements required to assert a claim of copyright infringement is available in the [Starting an Infringement Claim](#) chapter of the CCB Handbook. The elements of a copyright infringement claim are:

1. You own a valid copyright in the work, or have been given an exclusive license to the copyright rights at issue in the work,
2. The respondent used one of your exclusive rights in the work without permission,
3. The respondent had access to your work, and
4. The respondent’s work is substantially similar to the original elements of expression in your work.

Your claim does not provide clear facts to support any of those elements of the claim, as described below. If you file an amended claim, it must include enough details about the elements for the Board and the respondent to understand the facts of the alleged infringement.

### **Ownership**

As noted above, it is not clear which work you claim is the allegedly infringed work, or that the work is actually part of the VA0002379026 registration. If you file an amended claim, you must identify a specific work as the allegedly infringed work, and show that before this claim was filed, the work was either registered or subject to a pending application for registration. *See* 17 U.S.C. § 1505(a).

### **Infringing Activity**

Your claim does not present enough facts to clearly state how the respondent used any exclusive rights you have in the allegedly infringed work without permission.

Copyright law grants exclusive rights to copyright owners. These include the right to reproduce, distribute, and publicly perform the work, and to make a “derivative work,” which is a work based on the original work. Someone who does one of those activities without the copyright owner’s permission may be infringing the copyright, unless

they have a legitimate defense. More information about exclusive rights is available on page 3 of the [Starting an Infringement Claim](#) chapter of the CCB Handbook.

In the “Describe the infringement” section of the claim, you assert that the respondent “took my entire image and art work, and copy and pasted it into their own catalogue.” You allege that infringing acts occurred on eBay.com. A supplemental document, labeled [CN Copyright US 391283.pdf](#), indicates that the respondent disputed a claim that certain eBay listings included infringing materials, but it is not apparent which works appeared in any of those listings.

Your VA0002379026 registration covers photographic works that, as noted above, do not clearly include a depiction of the “Endless Nights” items shown in the supplemental documents filed with this claim. It is not clear if you are accusing the respondent of infringing your registered photographic work—for example, by copying a photograph or making a derivative work based on that photograph—rather than copying the underlying license plate frame, sticker, or decal depicted in the supplemental documents.

To maintain an infringement claim based on your current registration, you must submit an amended claim that clearly identifies or shows some creative aspect of the *photograph* deposited with Copyright Office that the respondent used without permission, not just the license plate frame, sticker, or decal itself. If the claimant is using the registered work without authorization, clearly state how.

## **Access**

Your claim does not provide facts that indicate how the respondent had access to your work. “Access” means a reasonable opportunity to view your work before the alleged infringement took place. Your claim does not clearly state allegations about where or how your work was available before the alleged infringement so that the respondent had an opportunity to see it. The [IMG 6732.PNG](#) file indicates that an “Endless Nights” sticker or decal appeared on OwntheAvenue.com, but your claim does not clearly indicate that the sticker or decal is the allegedly infringed work, and does not describe that website or indicate that it was accessed by or accessible to the respondent.

To address this issue, you must file an amended claim with allegations that make access a reasonable possibility, not just hypothetically or theoretically possible. Acceptable allegations of access may include that your work (a) was sent directly to the respondent or a close associate of the respondent; (b) was widely disseminated or was available to the public or respondent; or (c) is so strikingly similar to the work that appeared on the respondents’ website that they could not have created it independently.

Alternatively, you can upload copies of your work and the allegedly infringing work if they demonstrate that the works are so strikingly similar that they could not have been created independently. Image files included with your claim may include a copy of the allegedly infringed work, but they are not clearly identified, and you have not provided a copy of the allegedly infringing work. If you include copies of the works at issue as supplemental documents, they must be clearly labeled and identified so they can be properly compared to each other.

## Substantial Similarity

Your claim also does not include enough facts that explain the similarities between your work and the allegedly infringing work. If it is not readily apparent from supplemental documents that are submitted with the claim, you must provide more specific allegations about how your work and the allegedly infringing work are similar.

In the “Describe the infringement” section, you state that the respondent “took my entire image and art work, and copy and pasted it into their own catalogue,” but you do not describe or show any particular *photographic* elements covered by your registration that the respondent has used, as opposed to graphic elements of the merchandise items described in the “Describe the work” section and depicted in supplemental documents. It is not clear if you are alleging that the respondent copied a copyright-registered photographic work, rather than items depicted in the deposit or in the supplemental documents. In addition, the claim does not clearly describe the allegedly infringing work or include it as a supplemental document. As a result, the claim does not provide enough information to enable the Board to understand the similarity of the works.

If you submit an amended claim, it must include more factual allegations that support the element of substantial similarity. Please provide more details and background regarding this element in your amended claim, including a clear, detailed statement regarding which of your works, and which portions of that work, were taken by the respondent in the allegedly infringing work, or documents that are sufficient to show the similarities. If you include copies of the works at issue as supplemental documents, then as discussed above, they must be clearly labeled and identified so they can be properly compared to each other.

To submit an amended claim, log into your eCCB account and take the following steps:

1. From your dashboard, click the “**Amend claim**” button and select your docket number from the dropdown list.
2. Your claim will unlock for editing. The information you originally entered will appear in the same order as in your original claim.
3. Make the necessary edits. If you have filed supplemental documents, you must re-upload any documents you wish to include in the amended claim on the “**Documentation**” page. Please include only documents directly related to your claim, and label them clearly.
4. Once you have completed your edits, continue to click through the fillable claim form until you reach the “**Review**” page. The Review page includes all the information that you have provided in the claim up to this point. Carefully double-check the information on this page. If you have any corrections, you can select “**Edit**” to revise any entries necessary. Each section of information has an “**Edit**” button, which will take you back to that section so you can make changes. After you make changes, you can click “**Save & review**” to return to the Review page. Please review your claim carefully. Once you submit your amended claim, you will be unable to edit the claim while it is in compliance review.
5. Once you have completed your review and any revisions, you must confirm that the information in your claim is accurate and truthful to the best of your knowledge. To complete the declaration, type your full

name into the “**Digital signature**” box near the bottom of the “**Review filing**” page and click “**Agree & submit.**”

If you have questions, please contact [asktheboard@ccb.gov](mailto:asktheboard@ccb.gov). Include your docket number in the subject line. The Board is unable to provide legal advice. We can only provide legal information and assistance concerning Board procedures and requirements. If you would like to seek further guidance from a lawyer or a law student at reduced or no cost, please visit the [Pro Bono Assistance](#) page on ccb.gov. You may also refer to the [Compliance Review](#) chapter of the CCB Handbook for more assistance.

Copyright Claims Attorney