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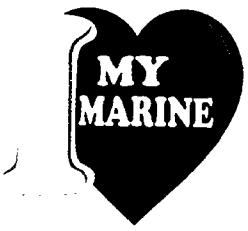
RE: I (HEART) MY MARINE
Copyright Office Control Number: 61-215-7171(N)

Dear Mr. Yeager:

I write on behalf of the Copyright Office Review Board ("Board") in response to your Second Request for Reconsideration dated September 22, 2004 requesting reconsideration of a refusal to register a graphic design entitled "I (Heart) My Marine."[1] The Board has carefully examined the application, the deposit and all correspondence concerning this application, and affirms the denial of registration of this work. The Board has also reviewed Eagle Crest, Inc.'s registrations for the works entitled "I Love My Marine" and "I Love My Sailor," and will be taking appropriate administrative steps to cancel those registrations.

I. DESCRIPTION OF WORK

The subject graphic design consists of a red heart accompanied by the words I, My and Marine written in white, bulbous typeface. The word "I" is positioned to the left of and partially overlapping the heart. The words "My" and "Marine" appear centered and on top of the heart. The "I" features some gold shadowing, as does the heart.



II. ADMINISTRATIVE RECORD

A. Initial Application and Office's Refusal to Register

On April 22, 2003, the Copyright Office ("Office") received a Form VA application from J. Steve Nettles, a principal of your client Mitchell-Proffitt Company, to register a graphic design. The application stated, "No claim is made to the words 'I' or 'my marine'." The Office

[1] The Board notes that some of the previous correspondence and your revised application refers to this work as "I Love My Marine" or "D38-M." For purposes of this letter, the Board refers to the work according to the title designated on the initial application, "I (Heart) My Marine."

received this application contemporaneously with applications for more than thirty other works submitted by or on behalf of Mitchell-Proffitt. Due to questions that arose with respect to many of the applications, a series of phone calls and correspondence among the Copyright Office, Mitchell-Proffitt and you as its attorney ensued. This letter recounts only those, or portions of those, directly relevant to the Board's present analysis of the registerability of "I (Heart) My Marine."

In a letter dated June 13, 2003, Visual Arts Section Examiner Sandra D. Ware refused registration of this work because she concluded it lacks the authorship necessary to support a copyright claim. (Letter from Ware to Nettles of 6/13/2003, at 4; Ms. Ware sent an identical letter on the same date to Attorney Yeager.) Ms. Ware explained that copyright protects original works of authorship, where "original" requires the work to have been independently created and to possess a minimal degree of creativity. (*Id.*) She noted that copyright law does not protect familiar designs (such as hearts), basic geometric shapes, words and short phrases, typographic ornamentation, lettering or coloring. (*Id.*) She further explained that the Office does not consider the aesthetic appeal or commercial value of a work, nor the time and effort expended to create a work, when evaluating copyrightability. (*Id.*) After considering the subject work in light of these standards, Ms. Ware concluded that registration was not available. Ms. Ware also recounted procedural defects with respect to the designation of the nature of authorship and date of publication on the initial application as well as extraneous or unacceptable statements. (*Id.* at 1-5.)

B. Resubmission of Revised Application

On July 22, 2003, the Office received from Mr. Nettles and Attorney Yeager a revised application for the subject work, accompanied by revised applications for numerous other works as well. The revised application for "I (Heart) My Marine" included changes in the work's title, nature of authorship designation, completion date, publication date and agent designation. It also identified the work as published as a contribution to the Mitchell-Proffitt Company Catalog. Space 6a identified as preexisting material, "The words: 'I' and 'My Marine.' The public domain heart representation." In Space 6b, it claimed the material added to this work was "Graphic design and highlights of the heart and the uniquely created logostyle used to represent the letter 'I.' Compilation of the words and graphic image."

C. Office's Response to Resubmission

On August 4, 2003, Debby B. Weinstein, Supervisor of the Visual Arts Section, responded to the applicant's July 22, 2003 resubmission explaining that the claim in "I (Heart) My Marine" cannot be registered for the reasons stated in the Office's June 13, 2003 rejection letter. (Letter from Weinstein to Nettles of 08/04/2003, at 2.) She explained that the applicant

must follow the request for reconsideration process (formerly referred to as an appeal) in order for the Office to reconsider its refusal, and included a leaflet detailing that procedure. (*Id.*)

D. First Request for Reconsideration

In a letter dated December 11, 2003, Mr. Nettles requested reconsideration of the Office's refusal to register the subject graphic design. Mr. Nettles clarified that "[a]lthough the artwork in question is used in a series of decals, we are only appealing one item because the image is what we seek to protect (not the lettering or the symbol) and the image is the same in several products." (Letter from Nettles to Chief Receiving and Processing Division of 12/11/2003, at 1.) He explained that Mitchell-Proffitt submitted this artwork for an individual registration, even though the Copyright Office registered a catalog in which the artwork also appears. (*Id.*)

Although disclaiming any rights to the familiar symbol representing the heart or to the words "I" or "My Marine," Mr. Nettles specifically claimed copyright protection in the "abstract dog bone like image" representing the "I" and the placement of this image to mask part of the heart. (*Id.* at 2.) He stated such "rendering was conceived and created by our own artist and not copied form any other source." (*Id.*) Mr. Nettles attached to this request a copy of the revised application as previously received by the Copyright Office on July 22, 2003.

E. Examining Division's Response to First Request for Reconsideration

In response to Mr. Nettles' request and in light of the points raised in his letter of December 11, 2003, Attorney Advisor Virginia Giroux of the Examining Division reexamined the application. She too determined that the subject graphic design does not contain a sufficient amount of original and creative authorship to support a copyright registration. (Letter from Giroux to Nettles of 6/21/2004, at 1.) Ms. Giroux explained that in order to be copyrightable, a work must not only be original, but it must also possess more than a *de minimis* quantum of creativity. (*Id.*) (citing *Feist Pubs. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)). While this threshold is very low, she explained that not all independent efforts will qualify, as in the case of the subject work. (*Id.* at 2.) She cited *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951) in further support of the proposition that sufficient authorship must constitute more than a trivial variation of public domain elements. Ms. Giroux noted that the requisite creativity can arise from a work's constituent elements alone or from the combination thereof. (*Id.* at 1.)

After describing the subject graphic design, Ms. Giroux concluded that "[t]he dog bone and heart shapes, or any minor variation thereof, are common and familiar shapes, in the public domain and are, therefore, not copyrightable." (*Id.*) (citing 37 C.F.R. § 202.1 (2003)). She explained this same regulation provided that words, short phrases and coloring per se are also

not copyrightable. (*Id.*) She found that the work contains no other elements capable of sustaining a copyright registration and that the simple combination and arrangement of the existing elements was insufficient as well. (*Id.* at 2.)

Ms. Giroux cited *Compendium II: Compendium of Copyright Office Practices* § 503.02(a) (1984) ("*Compendium II*") as well as several cases to support the proposition that although simple variations of standard designs and their simple arrangements may be aesthetically pleasing, they do not furnish a basis upon which to support a copyright registration. (*Id.* at 2) (citing *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986), *Forstmann Woolen Co. v. J.W. Mays,* Inc., 89 F. Supp. 964 (E.D.N.Y. 1950), *Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q. 1074 (D.D.C. 1991), *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988) and *Tompkins Graphics, Inc. v. Zipatone, Inc.*, 222 U.S.P.Q. 49 (E.D. Pa. 1983)).

Ms. Giroux also explained that in determining copyrightability, the Office does not consider a work's aesthetics, attractiveness, uniqueness, visual effect, symbolism or commercial success, nor the time and effort expended in creating the work. (*Id.* at 1.) She summarized that "[b]ecause there are no elements in this design, either alone or in combination, upon which a copyright registration is possible, we regret that we must again refuse copyright registration for this particular work." (*Id.* at 4.)

F. Second Request for Reconsideration

In the present request for reconsideration dated September 22, 2004, you request the Office to reconsider for a second time its refusal to register the copyright claim in the "I (Heart) My Marine" graphic design. (Letter from Yeager to Board of 9/22/2004, at 1.) You argue that *Feist* relates primarily to a compilation of facts, and is not relevant to "the clear artistic merits of the instant artwork presented for registration." (*Id.*) You quote substantial portions of *Mattel, Inc. v. Goldberger Doll Mfg. Co.*, 365 F.3d 133 (2d Cir. 2004), which discuss the copyrightability of a doll's face that includes the arguably common features of an upturned nose, bow lips and widely spaced eyes. (*Id.* at 2-3.) You state that even if the dog bone and heart shape in the subject work are common shapes, they are not in the public domain in the form presented by the author and are not barred from copyrightability. (*Id.* at 3.) You conclude that "[t]he arrangement, layout, specific highlights on the dog bone representation and on the heart representation, and placement of [the] heart partially behind the dog bone all contribute to the author's work and expresses [sic] originality . . . . For example, the overlap of the 'I' and the 'heart shape' and the highlights inclusions are deliberate artistic choices and each possess [sic] the requisite 'minimum degree of creativity.'" (*Id.* at 4.)

On December 30, 2004, you supplemented the second request for reconsideration. Specifically, you called the Office's attention to two other graphic works entitled "I Love My

Marine" and "I Love My Sailor," which the Office previously registered in the name of another claimant. You asked that the Board consider these registrations in evaluating the instant application.

III. DECISION

A. The Legal Framework

1. Copyrightable Subject Matter

Graphic designs are indeed eligible for copyright protection. *See*, 17 U.S.C. 102(a)(5) (2003); *Compendium II,* 502. However, the fact that some graphic designs can qualify for copyright protection does not mean that all graphic designs necessarily will.

All copyrightable works, be they graphic designs or otherwise, must also qualify as "original works of authorship." 17 U.S.C. 102(a). As used with respect to copyright, the term "original" consists of two components: independent creation and sufficient creativity. *Feist*, 499 U.S. at 345. First, the work must have been independently created by the author, *i.e.*, not copied from another work. Mr. Nettles has stated, "The rendering was conceived and created by our artists and not copied from any other source." (Letter from Nettles to Chief, Receiving and Processing Division of 12/11/2003, at 2.) The Board accepts this statement at face value, and has no reason to doubt its validity. Therefore, the first component of the term "original" is not at issue in the analysis set forth herein. Second, the work must possess sufficient creativity. Although the Board recognizes your point that *Feist* specifically addressed facts and not graphic designs, (Letter from Yeager to Board of 9/22/2004, at 1), *Feist*'s holding regarding the statutory originality requirement applies universally to any copyrightability analysis, regardless of the authorial content of the work. For the reasons set forth below, the Board has determined that the subject graphic design fails to embody the requisite amount of creativity, and therefore it is not entitled to copyright registration.

2. The Creativity Threshold

In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the standard set forth in *Feist*, 499 U.S. at 345, where the Supreme Court held that only a modicum of creativity is necessary to support a copyright. The Court noted that the "requisite level of creativity is extremely low; even a slight amount will suffice." (*Id.*) You cite *Mattel,* which in turn cites this same passage from *Feist*, as support that works containing even a small amount of creative expression and common features can sustain a copyright registration. (Letter from Yeager to Board of 9/22/2004, at 2-3.) The Board recognizes this principle, as demonstrated by the fact that in *Mattel*, the Office did indeed

register the dolls even though each of their faces embodied common features such as an upturned nose, bow lips and widely spaced eyes.

However, the *Feist* Court also ruled that some works (such as the work at issue in that case) fail to meet the standard. 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," 499 U.S. at 363, and 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; *see also,* 37 C.F.R. 202.10(a) ("In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form."); 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* 2.01(b) (2002) ("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.").

Even prior to the *Feist* decision, the Office recognized the modest, but existent, requisite level of creativity necessary to sustain a copyright claim. *Compendium II* states, "Works that lack even a certain minimum amount of original authorship are not copyrightable." *Compendium II*, 202.02(a). With respect to pictorial, graphic and sculptural works, *Compendium II* states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Compendium II*, 503.02(a).

In implementing this threshold, the Office and courts have consistently found that standard designs, figures and geometric shapes, such as a heart, are not sufficiently creative to sustain a copyright claim. *Compendium II*, 503.02(a) ("[R]egistration cannot be based upon the simplicity of standard ornamentation . . . . Similarly, it is not possible to copyright common geometric figures or shapes . . . ."); *Id.* 202.02(j) ("Familiar symbols or designs . . . or coloring, are not copyrightable."); *Id.* 503.03(b) ("No registration is possible where the work consists solely of elements which are incapable of supporting a copyright claim. Uncopyrightable elements include common geometric figures or symbols, such as a hexagon, an arrow, or a five-pointed star . . . ."). *See also*, 37 C.F.R. 202.1(a) ("[F]amiliar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained."). Letter from Giroux of 6/21/2004, at 1 - 2.

Moreover, simply making minor alterations to these otherwise standard shapes will not inject the requisite level of creativity. *Catalda Fine Arts*, 191 F.2d at 102-03 (What "is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'"); *Compendium II*, 503.02(a) ("[Registration cannot be based upon] a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations.").

Words, short phrases, slogans, typeface, typographic ornamentation, lettering and coloring are also unable to sustain a copyright claim in and of themselves. *See*, 37 C.F.R.

202.1(a) ("Words and short phrases such as . . . slogans; mere variations of typographic ornamentation, lettering or coloring" . . . "are examples of works not subject to copyright and applications for registration of such works cannot be entertained."); *Id.* 202.1(e) ("Typeface as typeface" is not subject to copyright protection.); *Compendium II,* 503.02(a) ("mere coloration cannot support a copyright even though it may enhance the aesthetic appeal or commercial value of a work."); *Id.* 506.03 ("the copyright claim cannot be based solely upon mere variations of typographic ornamentation, lettering, or coloring."); *Id.* 202.02(i) ("Words and short phrases such as names, titles, and slogans are not copyrightable."); *Id.* 202.02(j) ("mere variations of typographic ornamentation, lettering, or coloring, are not copyrightable. Typeface is not copyrightable."); *Id.* 305.01 ("Names, titles, slogans, and other short phrases or expressions are not copyrightable, even if such expressions are novel, distinctive, or lend themselves to a play on words.").

We also point out that the Copyright Office, in its statutory mandate under 17 U.S.C. 410 to examine a work in order to determine whether the material deposited for the work constitutes copyrightable subject matter and whether other legal and formal requirements of Title 17 have been met, evaluates each work of authorship on its own merits and analyzes the work's authorship in accordance with the *Feist* guidelines and with applicable regulatory and Office practice provisions. There is no comparison of works made by the Copyright Office, either comparison among those works being submitted for registration or comparison between a work being submitted and one that has been registered. The general principle is set out in *Compendium II*, 108.03. Thus, the fact that a particular work may or may not have been registered is not relevant to the application of Office examining practices and procedures with respect to a specific submission for registration.

3. Selection, Coordination and Arrangement

It is true that some combinations of common or standard shapes or other unprotectible elements can embody sufficient creativity with respect to how the elements are combined or arranged to support a copyright. *See, Feist*, 499 U.S. at 358 (the Copyright Act "implies that some 'ways' [of compiling or arranging uncopyrightable material] will trigger copyright, but that others will not"; determination of copyright rests on creativity of coordination or arrangement). However, merely combining non-protectible elements does not automatically establish creativity where the combination or arrangement itself is simplistic. For example, in *Jon Woods Fashions*, 8 U.S.P.Q.2d at 1870, the district court upheld the Register's decision that a fabric design consisting of striped cloth over which a grid of 3/16" squares was superimposed, even though distinctly arranged and printed, did not contain the minimal amount of original artistic material to merit copyright protection. Similarly, the Eighth Circuit upheld the Register's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in cursive script below the arrow. *John Muller & Co.*, 802 F.2d at 990. Similar to these cases, the Board has determined that the "I (Heart) My Marine" graphic

original enough that their combination constitutes an original work of authorship.") (emphasis in the original). The totality of this simplistic combination of public domain and non-protectible elements, even with the partial overlapping of the "I" over the heart, is simply not sufficiently creative to support a copyright registration.

You extensively quote *Mattel* for the proposition that the incorporation of common features in a work does not preclude copyright. (Letter from Yeager to Board of 9/22/2003, at 2-3.) Again, the Office agrees with this general proposition, as demonstrated by the fact that in that case, the Office issued copyright registrations for the dolls at issue. However, the Office must independently evaluate each work submitted for registration to determine if it meets the minimal, but existent, statutory requirements. With respect to the dolls in *Mattel*, each of their faces included an upturned nose, bow lips and widely spaced eyes. However, as you quoted, "[t]here are innumerable ways of making upturned noses, bow lips, and widely spaced eyes," 365 F.3d at 135, and those general categories of features were expressed with sufficient creativity in the dolls at issue in *Mattel* to warrant copyright registration. In contrast, there are a limited number of ways to express the letters of the English language and a standard, symmetrical heart; thus, the graphic design at issue here fails to embody sufficient creativity to sustain a copyright registration. You also argue that the "dog bone" and "heart shape" "are not in the public domain in the form presented by the author." (Letter from Yeager to Board of 09/22/2004, at 3.) However, your client, the author, has already conceded that it does not seek protection for the "public domain heart representation." (Line 6a of revised application; Letter from Nettles to Chief, Receiving and Processing Division of 12/11/2003 at 2.) Even without this concession, the author has simply not added any sufficient creativity to the representation of either a standard heart or a dog bone to warrant copyright protection.

C. Other Considerations

Several other factors that you and/or your client present, while perhaps important on personal or commercial levels, have no bearing on the determination of whether or not copyright registration is available for this work. For example, the revised application for registration refers to "the uniquely created logostyle used to represent the letter 'I'." (Line 6b of revised application.) Uniqueness is material to a patent analysis, though, not a copyrightability analysis. As is well-settled, two identical works may both be registered for copyright protection, provided that each was independently created and contains the requisite level of creativity. Uniqueness is neither necessary nor is it always sufficient to support a copyright registration.

You also argue that "the overlap of the 'I' and the 'heart shape' and the highlights inclusions are deliberate artistic choices." While this may well be true, the Office considers only the authorship elements actually expressed in the deposit materials submitted for

registration. Although such authorship elements may, indeed, represent deliberate artistic choices, if those elements, either in themselves or in their overall combination, do not rise to the level of original authorship as required in *Feist*, no registration is possible. Such is the case here.

IV. CONCLUSION

For the reasons stated above, the Copyright Office Review Board affirms the refusal to register the graphic design entitled "I (Heart) My Marine." This decision constitutes final agency action on this matter.

Sincerely,

/S/

Nanette Petruzzelli
Special Legal Advisor for Reengineering
for the Review Board
United States Copyright Office