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May 11, 2005

Ms. Jessica L Turko and Ms. Beth H. Alter
Kramer Levin Naftalis and Frankel LLP
919 Third Avenue
New York, NY 10022

Re: TOP PANEL FOR LOCOMOTIVE REMOTE CONTROL UNIT
Control Number: 61-204-4244(K)

Dear Ms. Turko:

The Copyright Office Review Board has reviewed your request to reconsider the Examining Division's denial of a claim to register the TOP PANEL FOR LOCOMOTIVE REMOTE CONTROL UNIT on behalf of Canac Inc. After reviewing the materials submitted in support of the claim, the Board has determined that the work cannot be registered because it is a useful article that does not contain separable authorship that is also copyrightable.

I. ADMINISTRATIVE RECORD

The initial application for TOP PANEL FOR LOCOMOTIVE REMOTE CONTROL UNIT was submitted by Beth H. Alter, on behalf of Canac Inc., and received by the Copyright Office on January 23, 2002. The application claimed 3-dimensional sculptural and technical drawing authorship. This registration was refused by Senior Examiner Geoffrey R. Henderson because the work was determined to be a useful article that did not contain any separable features that were copyrightable. Letter from Henderson to Alter of 1/29/2002 at 1.

The letter of rejection stated that in order to be copyrightable, a useful article must contain authorship that is either physically or conceptually separable and that any such separable artwork or sculpture must contain a minimal amount of original artistic material. In addition, the letter went on to say that "copyright does not protect familiar symbols and designs, minor variations of basic geometric shapes, lettering and typography, or mere variations thereof. Id. at 1-2. Mr. Henderson concluded that any separable elements of this work are not copyrightable "because they represent either an insufficient amount of original authorship or one or more of the non-copyrightable elements mentioned above, or a minor non-copyrightable variation thereof." Id. at 2.

A. First request for reconsideration [first appeal]

On March 28, 2002, the Copyright Office received your request for reconsideration of the refusal to register these works on behalf of your client, Canac Inc. You argued that the work is not a useful article within the meaning of the Copyright Act and, even if it is determined to be such, the work is comprised of separable features which exhibit sufficient creative authorship. Further, you assert that even if the Copyright Office finds the work unregistrable as a sculptural work, "the compilation of features of Applicant's work are entitled to registration as two-dimensional artwork and text. Letter from Alter and Turko to the Examining Division of 3/28/2002 at 2.

Your first argument, that the work is not a "useful article," is based on the statutory definition, which you quote: "A useful article is an article having an intrinsic utilitarian function that is not merely . . . to convey information." Letter from Alter and Turko of 3/28/2002 at 2. You state that the intrinsic utilitarian function of the panel is to convey information and thus is not a useful article within the meaning of the Act. Since it is not a useful article, no separability analysis is required.

In the alternative, you argue that if the Copyright Office finds that the work is a useful article, the panel is copyrightable because it incorporates pictorial and graphic copyrightable features that are separable from the utilitarian aspects of the article. You state that the panel is physically separable from the utilitarian article and is physically capable of existing independently of the utilitarian aspects of the remote control unit to which it is applied. Letter from Alter and Turko of 3/28/2002 at 3.

Again, in the alternative, you argue that even if the Copyright Office finds that the work does not meet the test for physical separability, the panel is conceptually separable under the test in Compendium of Copyright Office Practices, Compendium II, (1984). You state that the graphic artwork and lettering in specific arrangement can be imagined separately from the useful article without destroying the remote control's basic trapezoidal shape. Letter from Alter and Turko of 3/28/2002 at 4. Further, you argue that "where the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists." Hart v. Dan Chase Taxidermy Supply Co., 884 F. Supp. 71, 75 (N.D.N.Y. 1995), *quoting* Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987). You state that neither the "overall design of the Applicant's work nor the individual elements of graphic artwork and lettering on Applicant's panel in their specific formats in particular is essential to the functioning of the work. Letter from Alter and Turko of 3/28/2002 at 4. Additionally, you argue that the shapes used and the arrangement of text and lines are not dictated by the function of the panel, but are the result of aesthetic judgment. Id.

You stress that the panel could have been designed in a variety of different ways and that this fact is probative of conceptual separability, *citing* Severin Montres, Ltd. v. Yidah Watch Co., 997 F. Supp. 1262 (C.D. Cal. 1997), *aff'd*, 165 F.3d 917 (9th Cir. 1998). Letter from Alter and Turko of 3/28/2002 at 5.

You also argue that the low threshold for originality established in Feist Pubs., Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 347 (1991), together with the availability of alternative ways of expressing the work, is evidence that the originality requirement has been met. You cite Taylor v. Four Seasons Greetings LLC, 171 F. Supp. 2d 970, 974 (D. Minn. 2001) and Thimbleberries Inc. v. C & F Enters. Inc., 142 F. Supp. 2d 1132, 1139-40 (D. Minn, 2001). Your letter suggests that the shape of the panel, the number of columns of information, the use of captions, and the use of decorative lines, the combination of lettering, the location, size, and variety of symbols, and the choice of whether to use words or symbols, in combination, evidence more than the minimal degree of creativity required to obtain copyright protections. Letter from Alter and Turko of 3/28/2002 at 6. Even if the individual elements are not copyrightable, you argue that the panel as a whole is protectible as a compilation. Id. at 7, *citing* Harper House, Inc. v. Thomas Nelson, Inc., 12 U.S.P.Q.2d 1779. 1786 (9th Cir. 1989) and Apple Barrel Prods., Inc. v. Beard, 730 F.2d 384, 387-88 (5th Cir. 1984).

Your letter also states that the Applicant is not seeking protection of an idea or concept, but a particular expression of an idea that could have been expressed in more than one way. Even if there is little choice of selection and arrangement of the expression possible due to the nature of the work, you assert that courts have held works to contain sufficient compilation authorship in some cases, e.g., protection of maps, *citing* Rockford Map Publishers, Inc. v. Directory Serv. Co. of Colorado, Inc., 768 F.2d 145 (7th Cir. 1985), cert denied, 474 U.S. 1061 (1986). You continue, "although there may be some elements Applicant is compelled to include in its panel due to the panel's utilitarian function, Applicant has demonstrated creative authorship both in its choices of which works, symbols and graphic design elements to include in its work and in its choice of how to arrange these features. Letter from Alter and Turko of 3/28/2002 at 8.

Lastly, you submit that the work is copyrightable as a "2-dimensional artwork" and "text" because the selection and arrangement of literary and artistic features are sufficiently original to merit copyright protection. Quoting the legislative history of the 1976 Act, you state that the design on the Applicant's panel is itself a graphic work which is still capable of being identified as a graphic work even after its application to the utilitarian article. To the extent that the Copyright Office finds the work protectible as 2-dimensional artwork and text, you request amendment of the application to reflect such a determination. Letter from Alter and Turko of 3/28/2002 at 9.

B. Examining Division's response to first request for reconsideration

On July 30, 2002, Examining Attorney Advisor Virginia Giroux responded to your letter on behalf of the Examining Division. Ms. Giroux stated that despite your claim that the work is not a useful article, Section 101 of the copyright law defines a "useful article" as an "article having an intrinsic function that is not merely to portray the appearance of an article or to convey information. An article that is part of a useful article is considered a useful article." 17 U.S.C. 101. She continued that the statute further provides that the "design of useful article shall be considered a pictorial, graphic, or sculptural work only if and to the extent that such design incorporates pictorial, graphic, or sculptural features that can be identified separately from are capable of existing independently of the utilitarian aspects of the article without destroying its basic shape. Legislative history confirms that the separability must be physical or conceptual. *See* H.R. Rep. No. 94-1476, 94th Cong. 2d Sess. (1976). In this case, both the locomotive remote control unit and the top panel fall within the ambit of useful articles. Letter from Giroux to Turko of 7/30/2002 at 1.

Ms. Giroux then explained the Copyright Office's test for determining separability:

> In examining a work within the useful article category, the Copyright Office must first determine whether the work has any textual, pictorial, graphic, or sculptural authorship that is either physically or conceptually separable and not dictated by functional considerations. In applying this standard, the Copyright Office examines such a work to determine whether it contains physically or conceptually separable elements that can be regarded as a "work of art" apart from the shape of the article in order to support a copyright registration. Examiners do not make aesthetic judgements; nor are they influenced in any way by the attractiveness of the design, its visual effect or appearance, its uniqueness, its layout or format, the time and effect it took to create, or its commercial success in the marketplace during the examining process. *See* Compendium II, Copyright Office Practices, Sec. 505.03 (1984). The question is whether there is sufficient original and copyrightable separable authorship within the meaning of the copyright law and settled case law.

Letter from Giroux of 7/30/2002 at 1-2.

Ms. Giroux stated that the Examining Division conceded that there are graphic and textual elements on the surface of the panel that are conceptually separable, but that the

separable elements were found to be uncopyrightable. She acknowledged your reference to the separability test set forth in Brandir International v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987), but informed you that the Copyright Office follows the conceptual separability principles set forth in Esquire v. Ringer, 591 F.2d 796 (D.C. Cir. 1978) and as explained in Compendium II, section 505.03. Compendium II states that conceptual separability occurs when the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for example, or as a free-standing sculpture, as another example, independent of the shape of the article without destroying its basic shape. Examples include the carving on the back of a chair or pictorial matter engraved on a glass vase. Letter from Giroux of 7/30/2002 at 2.

Ms. Giroux also explained that in order to be regarded as copyrightable, a work must not only be original, but it must also "possess more than a *de minimis* quantum of creativity,"*citing* Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991), and that creative authorship must be more than a trivial variation of public domain elements, *citing* Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1991). Further, she pointed out that names, titles, words, and short phrases, numbering and lettering are not copyrightable, nor are circles, straight and curved lines, rectangles, triangles, or any minor variations of standard geometric shapes, *citing*, 37 C.F.R. 202.1. Letter from Giroux of 7/30/2002 at 2.

Ms. Giroux stated that the separable elements on this panel, namely, " a series of words or terms and numbers.... vertical and horizontal lines separating six groups of terms as well as some circular, triangular, and rectangular shapes surrounding or next to the terms," do not rise to the level of copyrightable authorship necessary to support a copyright registration. She continued, while these "simple arrangements may be aesthetically pleasing, but they do not furnish a basis upon which to support a copyright claim" and cited John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986); Jon Woods Fashions, Inc. v. Curran, 8 USPQ2d 1879 (S.D.N.Y. 1988); Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y. 1950); Magic Marketing Inc. v. Mailing Services Of Pittsburgh, Inc., 634 F. Supp. 959 (W.D. Pa. 1986). Ms. Giroux also cited Kitchens of Sara Lee v. Nifty Foods Corp., 266 F.2d 54 (2d Cir. 1959), noting that in that case, the court held that "the Copyright Office's position that . . .words, short phrases and expressions... are among the works not subject to copyright protection constituted a fair summary of the law." Letter from Giroux of 7/30/2002 at 2-3.

Ms. Giroux responded to your argument of compilation authorship in the selection, coordination, and arrangement of the elements appearing on the surface of the panel by explaining that the Examining Division viewed the selection of the terms used on the panel as "predetermined or limited by the functionality of the locomotive remote control unit, and therefore, do not contain the selective judgment necessary to support a claim in the

compilation of terms, *citing* Friedman & Grolier Enterprises, Inc., 179 USPQ476 (1976). She stated that the Examining Division conceded that the "arrangement, and placement of the elements on the surface of this work are not predetermined," but that the Examining Division viewed the placement, positioning, and arrangement of the graphic and textual elements on this work in the nature of format and layout, and, therefore, not copyrightable and she referred to Compendium II, sections 305.06 and 305.07 and ML 260. Letter from Giroux of 7/30/2002 at 3.

Ms. Giroux noted that the Copyright Office accepts and follows the Supreme Court's articulation of the modest degree of originality and creativity necessary for copyrightability propounded in Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991), as well as the principle set forth in Atari Games Corp. v. Oman, 888 F.2d 878 (D.C. Cir. 1989), that a work be viewed in its entirety, with individual noncopyrightable elements judged not separately but rather in their overall inter-relatedness within the work as a whole. As to both points, however, Ms. Giroux explained that the Examining Division finds that the graphic and textual elements, either individually or in their combination, fail to rise to the level of creative authorship necessary to sustain copyright registration. Ms. Giroux then distinguished several other cases that you cited in support of your argument and conveyed the Examining Division's determination that registration was again refused. Letter from Giroux of 7/30/2002 at 4-5.

C. Second request for reconsideration [second appeal]

On December 30, 2002, the Copyright Office Review Board received your second request for reconsideration. You begin by acknowledging Ms. Giroux's determination that the work is a useful object that contains conceptually separable features. However, you dispute Ms. Giroux's assessment, arguing that "since the intrinsic utilitarian function of the Applicant's panel is to convey information, Applicant's panel is not a useful article within the meaning of the Copyright Act." Letter from Alter and Turko to the Board of Appeals of December 30, 2002 at 3, fn 1. In support of this interpretation, you cite the statutory definition of a "useful article," which reads in part as follows: "A useful article is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. §101.

However, the thrust of your request is not predicated on the functionality of the panel. Instead, you seek to refute Ms. Giroux's contention that neither the features nor their arrangement are sufficiently original or creative to merit copyright protection. Consequently, your request focuses on two points: 1) the originality and creativity of the design elements, and 2) the originality and creativity of the selection and arrangement of the features of Appellant's work.

You assert that the originality and creativity embodied in ten identifiable elements of the top panel "far exceed" the threshold for creativity required to sustain a copyright. Moreover, you maintain that when considered together, as they must be, *citing* Atari Games Corp. v. Oman, 888 F.2d 878, 883 (D.C. Cir. 1989), these elements create a work with more than a spark of creativity. You contend, however, that the Office did not consider the totality of the work, focusing instead on the individual components of the work and their lack of originality. Your main argument in the second request for reconsideration is that the combination of elements comprising the TOP PANEL is sufficiently creative and original to support the registration claim.

In support of your position, you cite Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2nd Cir. 1951) for its finding that in order for the standard of originality to be met, all that is required is that the work constitute more than a "trivial variation" of public domain elements and assert that the TOP PANEL design easily meets this test. You also reference four other designs for locomotive remote control panels to demonstrate the uniqueness of the TOP PANEL design and to demonstrate that there are numerous ways to arrange the elements. From this fact, you conclude that the Applicant's design passes the "merely trivial variation" test for copyrightability solely on the basis that the elements can be arranged in a number of ways.

You also note that the exclusive use of public domain elements to make the design does not disqualify a work from registration since it is the originality and creativity in the arrangement and layout that decide the question, *citing* Reader's Digest Ass'n v. Conservative Digest, Inc., 821 F.2d 800 (D.C. Cir. 1987). You then identify a string of cases where the courts held that certain simple designs were copyrightable and assert that the Applicant's work is far more complex than the noted works in the cited cases and, therefore, should be registered. *See*, Tennessee Fabricating Co. v. Moultrie Mfg. Co., 421 F.2d 279 (5th Cir. 1970); Willard v Estern, 206 F. Supp. 2d 723 (D.V.I. 2002); Concord Fabrics, Inc. v. Marcus Bros. Textile Corp., 409 F.2d 1315 (2d Cir. 1969); and In Design v. Lynch Knitting Mills, Inc., 689 F. Supp. 176 (S.D.N.Y. 1988).

Next, you advocate the position that the Applicant's work is registrable as a compilation based upon the careful selection and arrangement of the textual and graphic elements. Specifically, you dispute Ms. Giroux's assessment that the selection of elements is determined by the functional requirements of the remote control because the work contains certain elements not found on other remote control panels and omits some elements found on other panels. Because of these differences, you maintain the Applicant "exercised selective judgment in designing its control panel and made selections which were not limited or predetermined by the operation of the panel." Letter from Alter and Turko of December 30, 2002 at 9. In support of this position, you offer an affidavit from Phil Olekszyk, an expert on the safety and efficacy of locomotive components, who identifies specific elements chosen by the Applicant that are not predetermined by the

operation of the panel: the shape of the panel; the number of columns on the panel; the use of captions as titles for the columns; the use of decorative lines that create borders on the panel for the columns; the use of decorative lines which form curved corners; the interruption of the decorative lines by the captions that describe the content within the borders defined by the decorative lines; the creation of irregular geometric shapes by the decorative lines; the use of a combination of upper and lower-case lettering; the location, size, and variety of symbols which appear on the panel, and the choice of whether to use words or symbols on the panel. Id. at 10.

You also present arguments for registering Applicant's work even if the Office were to find that the selection of the elements were predetermined by the operation of the remote control unit. Specifically, you note that compilations may be copyrightable even when the content of the work is predetermined by the nature of the work, *citing* Rockford Map Publishers, Inc. v. Directory Serv. Co. of Colorado, Inc., 768 F.2d 145 (7th Cir. 1985), cert. denied, 47 U.S. 1061 (1986). You state that in such cases, the court examines the arrangement and presentation of the elements rather than the elements themselves in deciding whether the work exhibits the spark of creativity needed to support a copyright. Following this reasoning, you maintain that though some elements may be dictated by function, sufficient creativity exists in the selection and presentation of the words, symbols and graphic design of TOP PANEL to support a registration. Letter from Alter and Turko of December 30, 2002 at 11.

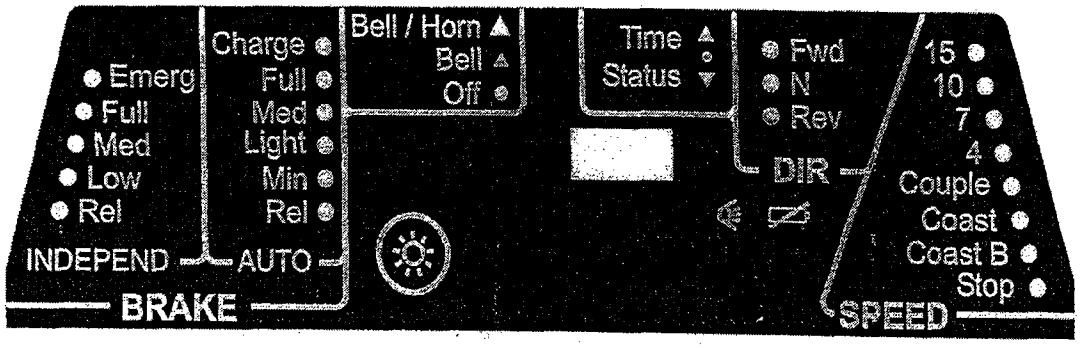
You dispute Ms. Giroux's characterization of the arrangement as a format or layout design which, by themselves, do not garner copyright protection because of the Office's position that format and layout configurations fall within the realm of uncopyrightable ideas or concepts. Moreover, you argue that the request for registration lies in the expression of the idea or concept set forth in the work. Once again, you make reference to the fact that different configurations of the elements exist on other remote control panels, thereby evidencing that the expression is not compelled by the underlying system or method. You also rebut Ms. Giroux's citation to Compendium II, Section 301, relating to books designs, noting that those layout and format considerations are restricted to nondramatic literary works whereas Applicant's work is a work of visual art that are not bound by the rules for nondramatic literary works. Id. at 12-13.

Finally, your fundamental argument is that, viewed in its entirety, Applicant's arrangement and combination of elements supports a claim of copyright. Your premise relies on the fact that courts have found that "simple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and the court,"*citing* Atari, 888 F.2d at 883. Starting from the presumption, as conceded by Ms. Giroux, that the elements of the TOP PANEL are not predetermined by functionality, your position is that the elements, when viewed together, create a work which possesses "far more than the minimal degree of creativity required

to obtain copyright protection." Id. at 14. You maintain that Ms. Giroux did not consider the work as a whole and therefore erroneously rejected the copyrightable compilation of elements. Id.. at 14-15.

II. DESCRIPTION OF THE WORK

The work consists of a flat, trapezoidal panel normally affixed to a remote control unit. It has a dark background and is divided into four vertical and two mildly-sloping vertical columns, of the same angled slope as the angle on the border of the trapezoid. Each column contains a full or partial border and the columns consist of full or partial words next to which are some form of status indicator or button. The representation of the panel submitted as a deposit is reproduced below:



III. DISCUSSION

The Copyright Office Review Board affirms the denial of registration of the TOP PANEL application for registration for the following reasons.

A. The work is a "useful article"

The Review Board unanimously finds that the TOP PANEL is a "useful article" within the meaning of that term as defined in 17 U.S.C. §101. Despite your characterization of the work's intrinsic purpose of conveying information, the Board finds that your reading of the definition is incorrect.

The section 101 definition states, in part, "[a] useful article is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. §101. While the TOP PANEL does convey information, the information conveyed is directly related to the functional attributes of the useful article. Indeed, the information conveyed is largely dictated by functional

constraints. The TOP PANEL also does not "merely" convey information, as would a newspaper or a sign. The TOP PANEL functions as an integral part of the device that allows operators to understand the meaning of the indicator lights. The device would be largely useless without such information.

Further, the information conveyed is not determined by creative authorship, but is dictated by the function of that particular indicator. While it is possible that there was some selection of the specific words used, that selection was extremely limited given the particular meaning of each indicator. There was no ability to arrange the words in a creative manner, since the arrangement was physically dictated by the functional purpose of the particular indicator lights.

The section 101 definition also states that " [a]n article that is normally a part of a useful article is considered a "useful article." 17 U.S.C. §101. There is no question that a remote control device normally contains information about the function of buttons or indicators. An indicator without an express function would be of limited value because a user would be required to memorize the meaning of each indicator light, thereby increasing the potential for operator error. Therefore, the TOP PANEL does not merely convey information that is unrelated to the utilitarian function of the remote control device, but is a necessary or "useful" component of the useful article, a component that is normally a part of a remote control.

B. Separability

The Review Board agrees that the work contains some separable elements, but these elements contain insufficient creative authorship to sustain a claim of copyright.

You claimed in your first request for reconsideration that the work contains physically separable elements. The Review Board finds that the TOP PANEL as a whole cannot be physically separated from the remote control without destroying the basic functionality of the remote control unit. Although the remote control device would operate without the top panel, the user would not know the purpose of a button or indicator. The purpose of a remote control device is to allow a user to operate a machine or device remotely. Without critical information about the meaning of buttons or indicators, the purpose of the remote control is drastically diminished. It is also clear that the TOP PANEL is not a preexisting work that was simply later incorporated into a useful article but rather that the TOP PANEL's overall design was dictated by the functional components of the device. The mere fact that the TOP PANEL "is detachable from the working parts of the article" is an insufficient basis for asserting physical separability. Compendium II, section 505.03.

Turning to conceptual separability, if separable features are identified, "these features must contain the minimal level of originality and creativity required by the Copyright Act in order for the work to be copyrightable." Letter from Alter and Turko of December 30, 2002 at 3. The Review Board agrees with your characterization of the analysis, but parts company with you in the assessment of the overall creative authorship established by those separable features.

The Copyright Office follows the conceptual separability principles set forth in Esquire v. Ringer, 591 F.2d 796 (D.C. Cir. 1978) and as explained in Compendium II, section 505.03. Compendium II states that conceptual separability occurs when the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for example, or as a free-standing sculpture, as another example, independent of the shape of the article without destroying its basic shape. Examples include the carving on the back of a chair or pictorial matter engraved on a glass vase. Compendium II, section 505.03.

You state that separable, creative elements include:

- the flat surface of the panel;
- the shape of the panel;
- the number of columns on the panel;
- the use of captions as titles for the columns;
- the use of decorative lines that create borders on the panel for the columns;
- the use of decorative lines which form curved corners;
- the interruption of the decorative lines by the captions that describe the content within the borders defined by the decorative lines;
- the creation of irregular geometric shapes by the decorative lines;
- the use of a combination of upper and lower-case lettering;
- the location, size, and variety of symbols which appear on the panel; and
- the choice of whether to use words or symbols on the panel.

The Board finds that a number of these features that you cite are not conceptually separable from the useful article. The flat surface of the panel is necessary for the utilitarian function of providing information about the indicators. The captions of the columns provide functional information about the purpose of particular rows of indicators. Without such heading information, the function of a particular row of indicators is ambiguous. The use of standard symbols on the panel also serve a functional purpose, providing meaning to indicators without the necessity of words or abbreviations. Similarly, the placement of these symbols is dictated by functions of the device rather than creative selection or arrangement of artistic or decorative features. Even the number of columns is dictated by the number of rows of physical indicators. The column borders

serve a functional purpose of focusing the eye to groups of related indicators. Even though the Review Board finds that these features are not conceptually separable due to their functional nature, the Board does not rely solely on this determination. Even had the Board found that the some of the features discussed in this paragraph were primarily decorative, the TOP PANEL would still contain insufficient creative authorship to sustain a copyright registration.

C. Creative authorship

In your letter, you state that the elements you list as separable and creative cannot be considered in isolation, but must be considered as a whole in order to assess the sufficiency of creative authorship. Neither the Review Board nor Ms. Giroux's analysis dispute that "separable" elements must be considered in their entirety. As Ms. Giroux expressly stated: "[e]ven the combination and arrangement of the shapes, terms, and numbers on the surface of the work do not rise to the level of copyrightable authorship necessary to support a copyright registration." Letter from Giroux of 7/30/2002 at 2. Like Ms. Giroux, the Review Board finds that the conceptually separable elements, whether viewed alone or in combination, do not reveal sufficient creative authorship to sustain a copyright registration. In essence, the separable elements that you identify represent *de minimis* embellishments of the functional features of the panel or *de minimis* embellishments on public domain shapes, symbols or words.

Before examining the combination of features, the Board first analyzes the individual elements alleged to be separable and creative. The flat surface of the panel is a standard feature of a remote control device which reveals no creative authorship whatsoever. The shape of the panel is a minor embellishment of a common geometric shape – a trapezoid. The fact that the top corners are rounded or that the bottom corners are angled perpendicular to the base does not alter the public domain status of this shape. "Uncopyrightable elements include common geometric figures or symbols, such as a hexagon, an arrow, or a five-pointed star. . . ." Compendium II, section 503.03(b). A slight variation of a trapezoid is not copyrightable subject matter.

The number of columns on the panel is dictated by the number of columns of the indicators. Thus, there is no creative selection or arrangement of the number of columns, because there are no columns that are unrelated to the functional components, i.e., there is no creative or arbitrary choices. While the use of "decorative lines that create borders on the panel for the columns" is not essential to the function, such lines are nonetheless slight variations on common geometric shapes (linear, rectangular, or triangular shapes) that merely embellish the functional columns of indicators. Similarly, the curved corners of these decorative lines do not demonstrate creative authorship, but merely serve as slight variations of the common geometric shapes. The fact that these lines form "irregular decorative shapes" is of no consequence to the registrability analysis. The "irregular"

nature of the geometric shapes is merely a *de minimis* variation of a common, public domain geometric shape. Such trivial variations or modifications are not copyrightable.

The use of captions is, once again, a functional addition to the information placed on the remote control. Although this information may not be absolutely necessary to the function of the device, the purpose of adding the information is to provide increased functionality, i.e., to convey the general purpose of the indicators or buttons in different columns. Consistent with judicial opinions, including Feist, Copyright Office regulations preclude protection for individual words as well as familiar symbols and designs. 37 C.F.R. 202.1 (a). The selection of the specific word used in each caption is extremely limited by the functional nature of the indicators or buttons in the column. Similarly, the coordination or arrangement of the uncopyrightable caption within the decorative line is also limited. To the extent that a choice had to be made exactly where and how to place the caption, in the present situation, the choice was merely trivial and was always on a point along the horizontal line. Even though the placement of certain elements enhanced the aesthetic value of the useful article, the aesthetic value of a *de minimis* arrangement alone cannot support a claim of copyright. Compendium II, section 505.05.

The use of a combination of upper and lower-case letters cannot support a claim of creative authorship. Such a binary typographical choice is so trivial that it falls well below the level of creative authorship necessary to sustain a registration. The particular choices of capitalization present in the TOP PANEL are also not only trivial but expected. In each of the columns, the listed functions of the indicators contain only the first letter capitalized. The column categories are indicated in all capital letters. This is such a common convention that a claim of creative authorship in these "choices" is wholly without merit.

The choice of whether to use words or symbols is similarly trivial. For the most part, words or abbreviations were used to correspond with the function of the indicator lights. The three symbols used – a battery with a line through it, a light symbol and a circle with a sun-like symbol inside it – are common, unprotectible symbols. The selection of these symbols is not only trivial, but the choice was limited by the indicator in the useful article itself. Similarly, the arrangement was dictated by the design of the device and involve no expressive coordination or arrangement beyond the particular symbol selected. The fact that such elements on the TOP PANEL could have been designed differently is not relevant to whether a work is copyrightable. Compendium II, section 505.05. Since the words, abbreviations and symbols themselves are dictated by the function of the indicators on the remote controls, the limited choices available and the common expressive elements used do not represent copyrightable expression that meets the minimal level necessary to sustain a registration.

The Review Board specifically finds that when the work at issue here is viewed as a whole and all separable elements are combined, the entirety of the work still does not meet the requisite level of creative authorship to sustain a copyright registration. Since most of the elements contained in the TOP PANEL are not "merely" expressive, but are functional components of the useful article, these elements must be filtered out of the whole considered for copyrightability. All that remains when the inseparable features are filtered out is the flat surface, the trapezoidal shape and the column borders. When these conceptually separable features are considered together, they represent a *de minimis* embellishment on the inseparable features, i.e., trivial ornamentation of functional elements.

As Compendium II states, it is not possible to copyright "a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spacial variations." Compendium II, section 503.02(a). Here, the combination of a triangle shape, a trapezoid shape and five other common rectangular shapes does not rise to the level of creative authorship. *See, e.g.,* John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986); Jon Woods Fashions, Inc. v. Curran, 8 USPQ2d 1879 (S.D.N.Y. 1988); Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y. 1950); Magic Marketing Inc. v. Mailing Services Of Pittsburgh, Inc., 634 F. Supp. 959 (W.D. Pa. 1986); and Kitchens of Sara Lee v. Nifty Foods Corp., 266 F.2d 54 (2d Cir. 1959).

Your letter states that "even if Applicant's panel consisted mainly or entirely of public domain elements, this would not preclude registration of Applicant's work." Letter from Alter and Turko of December 30, 2002 at 7. Citing Reader's Digest Ass'n v. Conservative Digest, Inc, 821 F.2d 800, 806 (D.C. Cir. 1987), you compare the "distinctive arrangement" in Applicant's work to the creation of a "unique graphic design and layout" found to be present in the Reader's Digest case. While the Review Board agrees that uncopyrightable elements may be combined in "such a way" so as to create a copyrightable whole, not all combinations meet the minimal level of creativity. Feist at 357. "The standard of originality is low, but it does exist." Id. at 362.

The Reader's Digest case is distinguishable from the present situation. In Reader's Digest the work was a graphic design, not a useful article. The "distinctive arrangement and layout" of elements was limited only by the dimensions of the cover page itself. Reader's Digest at 806. In the instant situation, the flat surface and the lines that create shapes around the indicators are largely the product of embellishment to the functional features rather than creative authorship. In TOP PANEL, it is not the situation that an ornamental design was arbitrarily added to the panel of the remote. Although the conceptually separable elements may not be functionally necessary to the remote control, these elements nevertheless bear a direct relationship to the functional components that are present on the device itself. As aesthetic embellishments of functional elements, both the selection and arrangement of the separable features are extremely limited by functional considerations. These functional

considerations diminish the claim for creative authorship such that the "end product is a garden-variety [remote control panel], devoid of even the slightest trace of creativity." Feist at 362.

All of the other cases that you cite in support of the minimal level of creativity contain the same distinguishing characteristic as Reader's Digest – none of the works involve an analysis of minimal creativity that is related to functional considerations. *See*, Letter from Alter and Turko of December 30, 2002 at 7-8. All four cases that you cite in support of sufficient creativity involve simple decorative patterns completely unrelated to functional considerations. Tennessee Fabricating Co. v. Moultrie Mfg. Co., 421 F.2d 279 (5th Cir. 1970) (on a decorative room divider); Willard v Estern, 206 F. Supp. 2d 723 (D.R.I. 2002)("petroglyph symbols in artistic designs" that were registered by the Copyright Office); Concord Fabrics, Inc. v. Marcus Bros. Textile Corp., 409 F.2d 1315 (2d Cir. 1969)(a textile pattern); and In Design v. Lynch Knitting Mills, Inc., 689 F. Supp. 176 (S.D.N.Y. 1988)(an abstract geometric design on a sweater). In each of the cases, there is little discussion of the nature of the creative authorship except to state that it is a very low standard. The cases do not dispute, however, that creative authorship is a standard and as the Court stated in Feist, while "the vast majority of compilations will pass this test, not all will." Feist at 359. The Review Board finds that the work at issue here does not pass the test. Not only is the pattern here largely dictated by functional constraints, it is also *de minimis* authorship under the cited case law that you fail to distinguish.

In John Muller & Co. , Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986), the artistic rendering of a stylized word and four stylized lines did not meet the test, yet you fail to establish a distinction except possibly *more* lines or words. Yet, unlike the N.Y. Arrows, TOP PANEL involves a useful article in which most of the elements you cite as "clearly exhibit[ing] more creative authorship" were dictated by the functional nature of the device. You also fail to make this distinction with Jon Woods Fashions, Inc. v. Curran, 8 USPQ2d 1879 (S.D.N.Y. 1988); Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y. 1950); and Magic Marketing Inc. v. Mailing Services Of Pittsburgh, Inc., 634 F. Supp. 959 (W.D. Pa. 1986).

Your primary argument is that the Copyright Office improperly determined that the selection of the elements was predetermined by functional considerations. In support of this claim, you state that the samples submitted to the Office reveal that Applicant's panel differs significantly from other locomotive remote control panels. Letter from Alter and Turko of December 30, 2002 at 9. This argument misses the point. The useful article is not designed to accommodate the creative authorship of a panel. As is clearly the case here, the panel explains the indicators of the useful article. The fact that other useful articles are designed differently (and thus the explanatory panels must be different too) does not address creative authorship but rather industrial design considerations.

Similarly, even if this case were simply a matter of *de minimis* separable authorship unrelated to functional considerations, the fact that something could have been designed differently is not a relevant consideration. Compendium II, section 505.05. Furthermore, none of the "selections" on the panel was wholly unrelated to the functional features of the panel and thus none was purely creative. While limited choices were obviously made, these choices were not of the nature of choices of creative authorship. "This is "selection" of a sort, but it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression." Feist at 362. At most, these were uncopyrightable choices of aesthetic enhancements of a functional device.

Your analogy that "[c]ourts have found compilations to be copyrightable even in cases in which the content of the compilation was predetermined by the nature of the work and its authors exercised only very little selectivity in deciding which elements to include" is similarly inapplicable to the present situation. There is a distinction between the useful article in this case and a factual work with a finite number of possible variations (e.g., the maps in Rockford Map Publishers). Although there are obvious constraints in presenting facts in a map, the constraints are not the focus of copyrightability. It is the creative expression, including selection, coordination and arrangement, that is the focus of the inquiry. Here, where the expression that is not dictated by functional considerations is so trivial, there is simply no basis on which a claim of copyright may rest. Surely, creative elements could have been added to this useful article that were unrelated to the function of the device. But the fact is that the elements that were added do not rise to reveal sufficient creative authorship.

Further, the fact that courts have found that factual compilations contain sufficient creative authorship is of no moment to your argument. In a compilation of factual or public domain elements, there is a question of selection as well as arrangement. For instance, in a map design, there are creative choices that may be made as to what elements to include in the map, e.g., restaurants, state parks, or any number of other focal points beyond the mere geographic contours. Such potentially copyrightable selections are completely absent in this case. The choice of a line as a border is so routine, that it fails to meet the minimal level of creativity required to maintain a claim of copyright. The other elements of the panel are not only factual in nature, as in the map situation, but are uncopyrightable functional elements. The selection of the term or abbreviation is not a creative choice, but a functional one. Similarly, the arrangement is not creative, but dictated by the functional components of the device itself. The fact that elements are "predetermined by the nature of the work" is different than elements that are *dictated by functional aspects of a useful article*. Letter from Alter and Turko of December 30, 2002 at 11. While it is true that the former may be copyrightable if there is sufficient creativity added to the work, elements dictated by function are not copyrightable. Were this not the case, the bar for protection of useful articles would be meaningless.

You argue that the TOP PANEL is a work of visual art that is protectable for its compilation authorship. While the panel could be a work of visual art were there sufficient copyrightable subject matter on it, the work as a whole does not reveal sufficient creative authorship. After conceptually separating the non-functional elements of the panel, an article that is normally a part of such a useful article, there is insufficient authorship to sustain a claim of copyright.

For the foregoing reasons, the Copyright Office Review Board affirms the denial of registration. This decision represents final agency action in this matter.

Sincerely,

/s/

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