United States Copyright Office
Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

July 3, 2006

Ronald M. Daignault, Esq.
Jones Day
222 East 41st Street
New York, New York 10017

Re: HEARTAGRAM
Copyright Office Control Number: 61-321-1046(J)

Dear Mr. Daignault:

I am writing on behalf of the Copyright Office Review Board ("Board") in response to your October 18, 2005 second request for reconsideration of the refusal of the Copyright Office ("Office") to register a graphic design entitled the "Heartagram." The Board has carefully examined the application, the deposit and all correspondence concerning this application, and affirms the denial of registration of this work.

I. DESCRIPTION OF THE WORK

The subject graphic design, according to you, consists of a heart shape combined with and superimposed on an upside down pentagram with two of its upward points rounded. The design could also be described as a combination of a triangle shape over the center of a heart shape, giving the impression of one continuous design shape, surrounded by a circle.



II. ADMINISTRATIVE RECORD

A. Initial Application and the Office's Refusal to Register

On January 21, 2005, the Office received a Form VA application on behalf of your client, Heartagram, Inc., to register the two-dimensional artwork entitled "Heartagram." On the same day the Office also received a letter from Sami Valkonen on behalf of your client, Heartagram, Inc., requesting special handling of its application for registration of "Heartagram."

In a letter dated January 26, 2005, Visual Arts Section Examiner Ivan Proctor refused registration of "Heartagram" because he concluded it lacks the authorship necessary to support a

copyright claim. He explained that copyright does not protect familiar symbols or designs or basic geometric shapes. He further explained the relevant standards for meeting the creativity requirement under the copyright statute and settled case law.

B. First Request for Reconsideration and Examining Division's Response

In a letter dated April 1, 2005, you requested that the Office reconsider its refusal to register "Heartagram." Your principal argument was that the specific selection, combination and arrangement of symbols in "Heartagram" meets the minimum creativity threshold set forth in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991) because of the innumerable and varied ways in which the author could have created his design. You also stated that it is improper to dissect a work into component parts and separately analyze the parts for copyrightability. Thus, you argued that, taken as a whole, "Heartagram" does meet the required minimal level of original authorship. In addition, you argued that "Heartagram" is the result of the author's attempt to convey the unison of love and darkness, and that it represents an entirely new and unique design. You also cited to cases in which a combination of non-copyrightable elements were capable of sustaining copyright protection as a whole.

In a letter dated July 19, 2005, Examining Division Attorney Advisor Virginia Giroux responded to your First Request for Reconsideration, stating that the Office was unable to register a copyright claim in "Heartagram" because it lacks the artistic or graphic authorship necessary to support a copyright registration. She further explained that "[h]earts and pentagrams, or any minor variation thereof, are common and familiar shapes in the public domain, and are, therefore, not copyrightable." (Citing 37 C.F.R. § 202.1) She also cited to *Compendium of Copyright Office Practices II*, § 503.02(a) (1984) (hereinafter *Compendium II*), explaining that "[e]ven the simple combination and arrangement of the two public domain shapes coupled with the two rounded points of the pentagram, **as a whole**, is not sufficiently creative to constitute a copyrightable 'work of art.'" (Emphasis in original.)

Ms. Giroux also explained that a work may create a certain impression, illusion or convey a certain message, but it does not necessarily mean that the work is copyrightable. This is because the visual effect or impression that a work conveys suggests some aspect of mental activity on the part of the viewer, and has no bearing on the composition of the work itself. Thus, she explained that although the author of "Heartagram" may have been attempting to convey the unison of love and darkness, it does not mean the work as a whole is copyrightable. She also stated that uniqueness is relevant in the patent context, not in copyright. She went on to say that all designs involve choices, and it is not the possibility of choices that determines copyrightability, but rather whether the particular resulting expression contains copyrightable authorship.

C. Second Request for Reconsideration

In a letter dated October 18, 2005, you sought reconsideration of the Examining Division's decision to refuse copyright registration for "Heartagram." You argued that Ms. Giroux conflated the terms "originality" and "creativity," and that the legal reasoning behind her

decision was unclear. You argued again that because of the selection, coordination and arrangement of elements, "Heartagram" meets the standard of creativity under *Feist*. You pointed out that three of the four cases Ms. Giroux cited pre-date the *Feist* decision, and even if they were good law they would not apply to the instant case. You analogized "Heartagram" to the Prince symbol (a combination of the public domain symbols for male and female) for which the 7th Circuit confirmed copyrightability (citing *Pickett v. Prince*, 207 F.3d 402 (7th Cir. 2000)). Finally, you asserted that the availability of other forms of legal protection, such as trademark law, should not be considered in determining the copyrightability of "Heartagram."

III. DECISION

A. The Legal Framework

1. Copyrightable Subject Matter

Under the Copyright Act, graphic designs are eligible for copyright protection. 17 U.S.C. § 102(a)(5). However, a graphic design must qualify as an "original work of authorship" in order to gain copyright protection. 17 U.S.C. § 102(a). In your second request for reconsideration, you cite to a footnote in *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n,* 805 F.2d 663 (7th Cir. 1986) to distinguish the terms "originality" and "creativity." However, the Seventh Circuit in that case also stated "[t]he requirement of originality actually subsumes two separate conditions, *i.e.*, the work must possess an independent origin and a minimal amount of creativity." 805 F.2d at 668. It is settled Supreme Court case law that in the copyright context, the term "original" has two components: independent creation and sufficient creativity. *Feist*, 499 U.S. at 345. Thus, creativity is a component of originality, not a separate and distinct element from originality, as you argued.

The Office, as stated in the Examining Division's response to your first request for reconsideration, does not dispute the fact that "Heartagram" was independently created by your client. Therefore, independent creation is not at issue in the following analysis. However, for the reasons set forth below, the Board has determined that "Heartagram" does not embody sufficient creativity to support a copyright registration.

2. The Creativity Threshold

In determining whether a particular work embodies sufficient creativity to support a copyright registration, the Board follows the standard set forth in *Feist*, 499 U.S. at 345, where the Supreme Court held that only a modicum of creativity is necessary. The Supreme Court also held, however, that some works fail to meet that very low threshold, stating 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." *Id.* at 363; *see also* 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."). As the court stated in *Satava v. Lowry*, 323 F.3d 805, 810 (9th Cir), *cert. den.*, 540 U.S. 983

(2003), "[a]lthough the amount of creative input by the author required to meet the originality standard is low, it is not negligible" (citing *Feist*).

Even prior to the *Feist* decision, the Office adhered to this standard, requiring a "certain minimal amount of original creative authorship . . . for registration in Class VA or in any other class." *Compendium II*, § 503.02(a). The cases cited by the Examining Division support this principle. *See John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986) (upholding refusal to register a logo consisting of four angled lines forming an arrow with the word "arrows" in cursive script below, noting the design lacked the minimal creativity necessary to support a copyright registration); *Forstmann Woolen Co. v. J.W. Mays, Inc.*, 89 F. Supp. 964 (E.D.N.Y. 1950) (holding a label with the words "Forstmann 100% Virgin Wool" interwoven with three fleur-de-lis was not copyrightable); *Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q.2d 1074 (D.D.C. 1991) (upholding refusal to register "gothic" chinaware pattern composed of simple variations and combinations of geometric designs due to insufficient creative authorship to merit copyright protection); *Jon Woods Fashions, Inc. v. Curran*, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988) (upholding refusal to register a fabric design consisting of striped cloth with small grid squares superimposed on the stripes where Register concluded the design did not meet the minimal level of creative authorship necessary for copyright protection).

Additionally, prior to *Feist* the Office's registration practices followed settled precedent recognizing that some works of authorship contain only a *de minimis* amount of authorship and thus are not copyrightable. Pre-*Feist* case law did not recognize a demanding standard for copyrightability. *See, e.g. Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951)("'[o]riginal' in reference to a copyrighted work means that the particular work 'owes its origin' to the 'author.' No large measure of novelty is necessary.") This does not mean, however, that no standard existed at all. The court in *Catalda* held that the distinguishable variation in a work of authorship for which copyright protection is sought must be "more than a 'merely trivial' variation." 191 F.2d at 102-03. Forty years later, *Feist* again confirmed that the "standard of originality is low, but it does exist." 499 U.S. at 362. The Office does not find that the pre-*Feist* cases cited by the Examining Division applied a standard for copyrightability that it incompatible with the standard recognized in *Feist*.

The Office and courts have consistently found that standard designs, figures and geometric shapes are not sufficiently creative to support a copyright claim. *Tompkins Graphics, Inc. v. Zipatone, Inc.*, 222 U.S.P.Q. 49 (E.D. Pa. 1983) ("basic geometric shapes have long been in the public domain and therefore cannot be regulated by copyrights."). Nor are simple alterations to otherwise standard shapes or familiar designs eligible for copyright protection. *See Catalda*, 191 F.2d at 102-03.; *see also Compendium II*, § 503.02(b) ("the creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations."); *Satava v. Lowry*, 323 F.3d at 811 (discussed *infra*).

In the *Feist* decision, the Supreme Court stated that some arrangements or combinations of unprotectable elements can embody sufficient creativity to support a copyright registration. 499 U.S. at 358. However, merely combining unprotectable elements where the combination or arrangement is itself simplistic will not automatically establish sufficient creativity. Such is the

case here. For these reasons and as discussed in more detail below, the Board has determined that the combination and arrangement of the constituent elements in "Heartagram" are not sufficiently creative to support a copyright registration.

B. Analysis of the Work

"Heartagram" consists of three elements, which can be described in alternative ways depending on the observer's viewpoint. You have described "Heartagram" as consisting of an upside down pentagram and a heart. The design could also be viewed as consisting of a heart and a triangle. In either case, the deposit copies received by the Office show that design shape enclosed by a circle. Since the Board must analyze the work based upon deposit copies, the circle element has been included as an element of "Heartagram" for purposes of this analysis.

It is well-settled that "[i]f the work consists entirely of uncopyrightable elements, registration is not authorized." *Compendium II*, § 503. However, in *Satava v. Lowry*, the Ninth Circuit acknowledged that a combination of unprotectable elements may qualify for copyright protection. 323 F.3d at 811. The court cited *Feist*, among other cases, for the teaching that the "principal focus should be on whether the selection, coordination and arrangement are sufficiently original to merit protection" and held that "a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship." *Id.* Regardless of whether in "Heartagram" the viewer sees an upside down pentagram and heart within a circle, or a heart and triangle within a circle, pentagrams, hearts, triangles and circles are all standard geometric shapes and are not themselves eligible for copyright protection. Therefore, the only way for "Heartagram" to support a copyright registration is if the particular combination and arrangement of elements have a sufficient level of creativity. However, for the following reasons, the Board has determined they do not.

You argue that the author of "Heartagram" "used his creativity to select from innumerable possible shapes available to him that would best convey his desired expression." (Letter from Daignault to Board of 10/18/05, at 3). However, the number of possibilities available to an author in creating a work is not necessarily relevant. Any author creating a graphic design has, in theory, an unlimited number of choices and options. However, it is the resulting expression of the selected elements that must be analyzed. The Board also notes that with respect to pictorial, graphic and sculptural works, it is not aesthetic merit or symbolic representation, but the presence of creative expression that is determinative of copyrightability. Thus, it is not relevant to the Board's consideration of this appeal that the selection of a plain, unadorned heart and pentagram together (as you describe) may represent love and darkness. The concept the author of "Heartagram" may have wished to express is not protected by copyright. 17 U.S.C. § 102(b) ("In no case does copyright protection for an original work of authorship extend to any idea . . . [or] concepts, . . . regardless of the form in which it is described, explained, illustrated, or embodied in such work."); *see also* 37 C.F.R. § 202.1(b) ("ideas . . . as distinguished from the particular manner in which they are expressed [are] not subject to copyright"). Moreover, as the court noted in *Satava v. Lowry*, "Only by vigorously policing the line between idea and expression can we ensure both that artists receive due reward for their

original creations and that proper latitude is granted other artists to make use of ideas that properly belong to us all." 323 F.3d at 813.

The arrangement of the elements is likewise lacking in sufficient creativity to support a copyright registration. First, enclosing images within a circle is a common form of presentation. Second, the heart shape inside the circle is perfectly centered, another common way of depicting images. Third, the triangle is placed within the circle so that its top point matches the point of the heart exactly. Fourth, the design is symmetrical, yet another common form of depicting design elements. Finally, the arrangement consists of at most three elements: a heart superimposed over a triangle within a circle. See *Satava, supra* (copyright protection available "only if those elements are numerous enough and their selection and arrangement original enough"); ; *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1147 (9th Cir. 2003) ("Lamps Plus's mechanical combination of four preexisting ceiling-lamp elements with a preexisting table-lamp base did not result in the expression of an original work of authorship as required by § 101."). Therefore, the Board finds there is nothing about the selection or arrangement of unprotectable elements in "Heartagram" that rises to the requisite level of creativity to support a copyright registration.

C. Other Considerations

Throughout your first and second requests for reconsideration, you refer to "Heartagram" as a "distinctive" and "novel" graphic design. However, these arguments are misplaced. Originality is the relevant threshold in the copyright context, whereas distinctiveness is relevant in the trademark context and novelty is relevant in the patent context.

You also analogize "Heartagram" to the Prince symbol that was in dispute in the case of *Pickett*, and pointed out in your second request for reconsideration that the Examining Division did not distinguish the Prince Symbol from "Heartagram." The Seventh Circuit did not, as you stated in your second request for reconsideration, confirm the copyrightability of the Prince symbol; the plaintiff in that case conceded copyrightability, *Pickett*, 207 F.3d at 404, and, while the court noted the resemblance of the Prince symbol to the Egyptian hieroglyph *ankh*, it observed that "the parties make nothing of this, so neither shall we." *Id.* at 403. With respect to the fact that the Office did issue a registration for the Prince symbol, as a general rule we do not compare works against already-registered works to determine respective copyrightability. *Compendium II*, § 108.03; see *Homer Laughlin China*, 22 U.S.P.Q.2d 1074. Each work must stand on its own. In addition, your reliance on *Pickett* is misplaced since the Prince symbol embodies much more creativity and complexity than "Heartagram," and does not appear to be composed merely of public domain elements.

IV.CONCLUSION

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

Sincerely,

/s/

David O. Carson
General Counsel
for the Review Board
United States Copyright Office