SR# 1-925123271

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

October 30, 2014

Hitt Gaines, P.C.
Attn: Heidi Parker
Palisades Central II
2435 North Central Expressway, Suite 1300
Richardson, TX 75083-2570

Re: CONTOUR INTEGRATION MACULAR PERIMETRY TEST
Correspondence ID: 1-LYPVC3

Dear Ms. Parker:

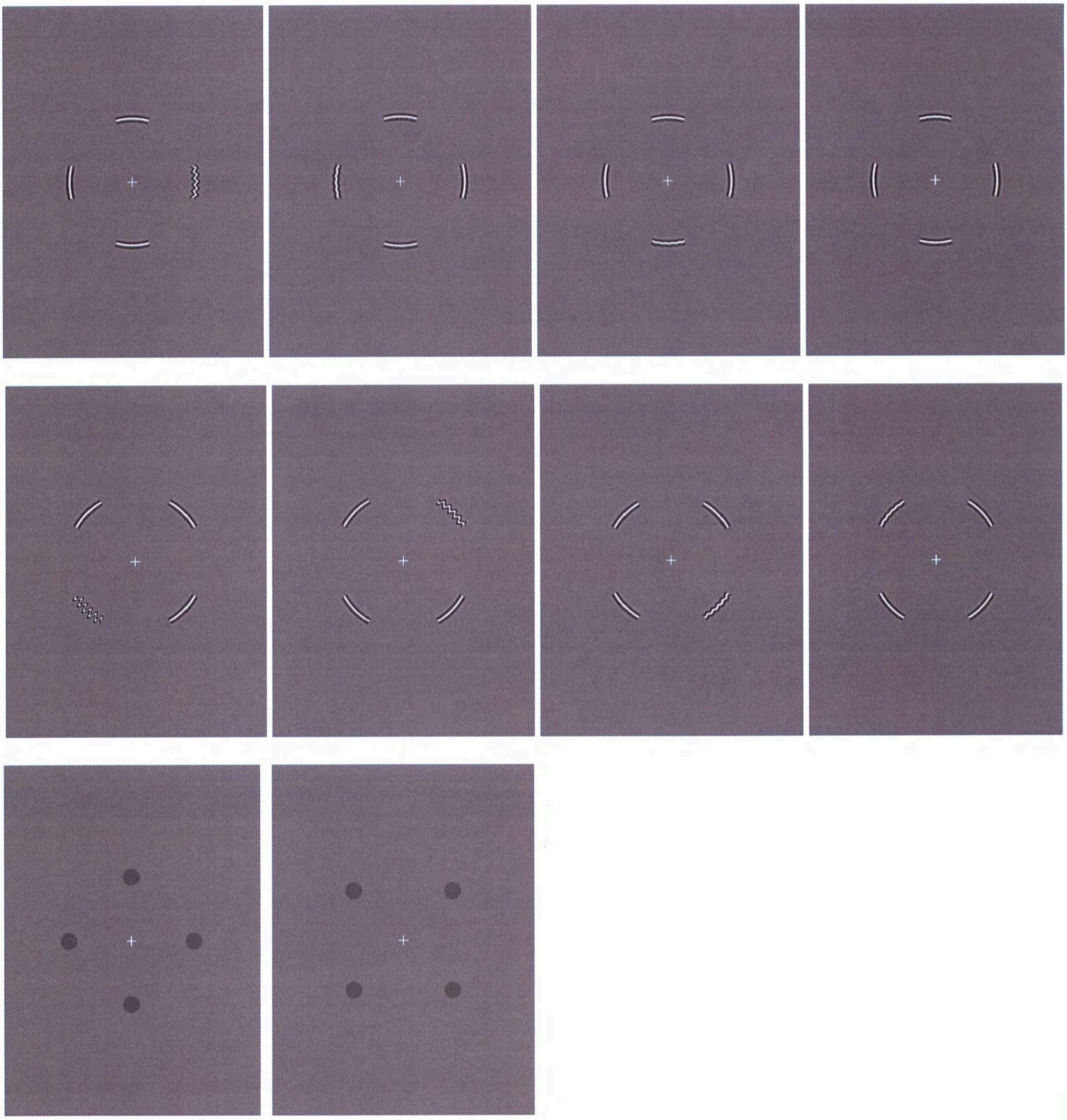
The Review Board of the United States Copyright Office (the "Board") is in receipt of your second request for reconsideration of the Registration Program's refusal to register the work entitled: *Contour Integration Macular Perimetry Test*. You submitted this request on behalf of your client, Vital Art and Science, Inc., on May 14, 2014.

The Board has examined the application, the deposit copies, and all of the correspondence in this case. After careful consideration of the arguments in your second request for reconsideration, the Board affirms the Registration Program's denial of registration of this copyright claim. The Board's reasoning is set forth below. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action on this matter.

I. DESCRIPTION OF THE WORK

Contour Integration Macular Perimetry Test (the "Work") consists of a series of ten images. Eight of the images contain four curved segments that are evenly spaced, arranged in a circular configuration, and centered around a plus symbol ("+"). The curved segments consist of white bands edged on both sides by darker bands. In each of these eight images, one of the four curved segments appears "wavy or squiggly." The two remaining images each contain four dark circles that are evenly spaced, arranged in either a square or diamond configuration, and centered around a plus ("+") symbol. All ten images are colored in "gray-scale."

The following are photographic reproductions of the ten images from the deposit materials.



II. ADMINISTRATIVE RECORD

On September 23, 2013, the United States Copyright Office (the "Office") issued a letter notifying Vital Art and Science, Inc. (the "Applicant") that it had refused registration of the Work. *Letter from Robin Jones, Registration Specialist, to Michael Bartlett* (Sept. 23, 2013). In its letter, the Office stated that it could not register the Work because it lacks the authorship necessary to support a copyright claim. *Id.*

In a letter dated December 12, 2013, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusal to register the Work. *Letter from Heidi H. Parker to Copyright RAC Division* (Dec. 12, 2013) ("First Request"). Upon reviewing the Work in light of the points raised in your letter, the Office concluded that the Work "does not contain a sufficient amount of original and creative authorship necessary to support a claim in copyright" and again refused registration. *Letter from Stephanie Mason, Attorney-Advisor, to Heidi H. Parker* (Mar. 31, 2014).

Finally, in a letter dated May 14, 2014, you requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Work. *Letter from Heidi H. Parker to Copyright R&P Division* (May 14, 2014) ("Second Request"). In arguing that the Office improperly refused registration, you claim the Work includes at least the minimum amount of creativity required to support registration under the standard for originality set forth in *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340 (1991). *Second Request* at 2. In support of this argument, you claim the Work "is the result of years of research and clinical studies, culminating in unique, carefully designed and clinically validated test images" and that "these images form the basis of a retinal vision test, which delivers an intuitively easy-to-use and accurate self-test delivered on a smartphone or tablet device." *Id.* You further assert that the Applicant's claim of copyright in the individual images that comprise the Work is directed to "the expression of the combination of [mathematically formulated] shapes, in a researched and precise color, contour and size so as to express and determine the progression of serious retinal diseases." *Id.* at 3.

III. DECISION

A. *The Legal Framework*

1. *Separability*

Copyright protection does not generally extend to useful articles, which are defined as "article[s] 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. Works of artistic authorship that may be useful articles themselves or may be incorporated into a useful article, can be protected as pictorial, graphic, or sculptural works pursuant to 17 U.S.C.

§ 102(a)(5). However, this protection is limited in that it extends only "insofar as [the designs'] form but not their mechanical or utilitarian aspects are concerned." *Id.* at § 101.

A design that has been incorporated into a useful article is only eligible for copyright protection to the extent that the design includes "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, utilitarian aspects of the article." *Id.*; *see also Esquire, Inc. v. Ringer,* 591 F.2d 796, 800 (D.C. Cir. 1978) (holding copyright protection is not available for the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be"). The Board employs two tests to assess separability: (1) a test for "physical separability" and, (2) a test for "conceptual separability." *See Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q. 2d 1714 (D.D.C. 1995) (finding that the Copyright Office's tests for physical and conceptual separability are "a reasonable construction of the copyright statute" consistent with the words of the statute, present law, and the legislature's declared intent in enacting the statute); *see also Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038 (9th Cir. 2014).[1]

To satisfy the test for "physical separability," the pictorial, graphic, or sculptural features of the work must be capable of being physically separated from the utilitarian aspects of the useful article by ordinary means without impairing the utility of the article. *See, e.g., Mazer v. Stein*, 347 U.S. 201 (1954) (holding that a sculptured lamp base depicting a Balinese dancer did not lose its ability to exist independently as a work of art when it was incorporated into a useful article); *see also Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) (upholding the copyright in a sculpture of an antique telephone that was used as a casing to house a pencil sharpener because the sculpture was physically separable from the article without impairing the utility of the pencil sharpener). To satisfy the test for "conceptual separability," the pictorial, graphic, or sculptural features of the work must be able to be imagined separately and independently from the work's utilitarian aspects without destroying the work's basic shape. *See, e.g.,* H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* U.S.C.C.A.N. 5659, 5668 (indicating a carving on the back of a chair or a floral relief design on silver flatware are examples of conceptually separable design features). A work containing design features that cannot be physically or conceptually separated from the work's intrinsic utilitarian functions are ineligible for registration under the Copyright Act.

2. *Originality*

All copyrightable works must qualify as "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). As used with respect to copyright, the

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[1] In *Inhale*, the Ninth Circuit gave deference to the Office's interpretation of the "separability" doctrine, noting that "'Courts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function.'" 755 F.3d at 1042.

term "original" consists of two components: independent creation and sufficient creativity. *See Feist*, 499 U.S. at 345. First, the work must have been independently created by the author, *i.e.*, not copied from another work. *Id.* Second, the work must possess sufficient creativity. *Id.* While only a modicum of creativity is necessary to establish the requisite level, the Supreme Court has ruled that some works (such as the telephone directory at issue in *Feist*) fail to meet this threshold. *Id.* 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." *Id.* at 363. It further found that there can be no copyright in a work in which "the creative spark is utterly lacking or so trivial as to be nonexistent." *Id.* at 359.

The Office's regulations implement the long-standing requirements of originality and creativity set forth in the law and, subsequently, the *Feist* decision. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of "[w]ords and short phrases such as names, titles, slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring"); *see also* 37 C.F.R. § 202.10(a) (stating "[i]n order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form").

Some combinations of common or standard design elements may contain sufficient creativity, with respect to how they are juxtaposed or arranged, to support a copyright. However, not every combination or arrangement will be sufficient to meet this grade. *See Feist,* 499 U.S. at 358 (finding the Copyright Act "implies that some ways [of selecting, coordinating, or arranging uncopyrightable material] will trigger copyright, but that others will not"). Ultimately, the determination of copyrightability in the combination of standard design elements rests on whether the selection, coordination, or arrangement is done in such a way as to result in copyrightable authorship. *Id.*; *see also Atari Games Corp. v. Oman*, 888 F.2d 878 (D.D.C. 1989).

To be clear, the mere simplistic arrangement of unprotectable elements does not automatically demonstrate the level of creativity necessary to warrant registration. For example, the Eighth Circuit upheld the Copyright Office's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in a cursive script below the arrow. *See John Muller & Co., Inc. v. NY Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986). Likewise, the Ninth Circuit held that a glass sculpture of a jellyfish that consisted of elements including clear glass, an oblong shroud, bright colors, proportion, vertical orientation, and a stereotypical jellyfish form did not merit copyright protection. *See Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003). The court's language in *Satava* is particularly instructional:

> [i]t is true, of course, that a combination of unprotectable elements may qualify for copyright protection. But it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Our case law

> suggests, and we hold today, 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. (internal citations omitted; emphasis in original).

Finally, Copyright Office registration specialists and the Board do not make aesthetic judgments in evaluating the copyrightability of particular works. They are not influenced by the attractiveness of a design, the espoused intentions of the author, the design's uniqueness, its visual effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace. *See* 17 U.S.C. § 102(b); *see also Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). The fact that a work consists of a unique or distinctive shape or style for purposes of aesthetic appeal does not automatically mean that the work, as a whole, constitutes a copyrightable "work of art."

B. *Analysis of the Work*

After carefully examining the Work and applying the legal standards discussed above, the Board finds the *Contour Integration Macular Perimetry Test* not eligible for copyright registration for two reasons. First, the Work is a useful article that does not possess design elements that are separable from its utilitarian function as "a test for evaluating the progression of a patient's retinal disease." *Second Request* at 1. Second, even if the individual images that you identify as eligible for registration were separable from the Work's utilitarian function, those images are not sufficiently creative to support a claim to copyright.

1. Useful Article Analysis

As discussed above, a "useful article" is defined by statute as 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 (2007). The Board accepts the general principle that design features incorporated into utilitarian articles are not automatically disqualified from copyright registration. But to be eligible for registration such design features must be either physically or conceptually separable from the utilitarian aspects of the useful article. *See Esquire,* 591 F.2d at 800.

The Work at issue is a test for evaluating maculopathy. The Board has determined that this test is a useful article because it may be used for the purpose of "evaluating the progression of a patient's retinal disease." *Second Request* at 1. Thus, to be eligible for registration, the Work's design features must be either physically or conceptually separable from the Work's utilitarian function. *See Esquire,* 591 F.2d at 800.

Despite your claim that the images comprising the Work warrant registration as two-dimensional artwork, the Board finds that the images are neither physically nor conceptually separable from the Work's intended function. As explained in the Office's rejection of the Applicant's *First Request*, any elements that are functionally driven or subsumed within a procedure, system, or process are not within the ambit of copyright protection. *Response to First Request* at 1; *see also* 17 U.S.C. § 102(b) ("in no case does copyright protection extend to an idea, procedure, process, technique, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, illustrated, or embodied in a work"). Because we cannot perceive a way to separate the individual images from the overall Work without destroying its usefulness as a process, procedure or technique for evaluating the progression of retinal disease, we find that the Work, including the individual images, is ineligible for copyright registration.

2. Originality Analysis

Even if the images within the Work could be separated from its utilitarian function as a vision test, both the individual elements that comprise these images and the selection, coordination, and arrangement of those elements lack the sufficient level of creativity to warrant registration.

Section § 202.1(a) of the Copyright Office's regulations identifies certain elements that are not copyrightable. These elements include: "[w]ords and short phrases such as names, titles, slogans; familiar symbols or designs; [and] mere variations of typographic ornamentation, lettering, or coloring." *Id.* As noted above, the Work is comprised of combinations of the following elements: (1) short, curved lines that are either smooth, "wavy," or "squiggly" in appearance; (2) a basic plus ("+") symbol; (3) standard circles; and, (4) a "gray-scale" color scheme. Simple variations of curved lines, circles, and mathematical symbols are ineligible for copyright protection. *See id.* (prohibiting the registration of familiar symbols or designs). Simple "gray-scale" color schemes are also ineligible for copyright protection. *See id.*; *see also Boisson v. Banian, Ltd.*, 273 F.3d 262, 271 (2d Cir. 2001) (indicating mere coloration cannot support a copyright claim). Thus, the Board concludes that none of the images' constituent elements qualify for registration under the Copyright Act.

Likewise, the Board finds that the images fail to meet the creativity threshold set forth in *Feist,* 499 U.S. at 359 even when they are considered as a whole. The Board accepts the principle that combinations of unprotectable elements may be eligible for copyright registration. However, in order to be registered, such combinations must contain some distinguishable variation in the selection, coordination, or arrangement of their elements that is not so obvious or minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." *Id.*; *see also Atari Games,* 888 F.2d at 883 (finding a work should be viewed in its entirety, with individual noncopyrightable elements judged not separately, but in their overall interrelatedness within the work as a whole). Each image

consists of a simple arrangement of either four curved segments (smooth, wavy, or squiggly) or four circles, centered around a plus symbol and colored in "gray-scale." The arrangement of these elements is driven by their functionality in measuring retinal disease, not their creativity, and as such, it fails to meet the threshold for copyrightable authorship. *Feist,* 499 U.S. at 359; *see also Atari Games,* 888 F.2d at 883.

Your assertion that the selection and arrangement of the elements that comprise these images are "the result of years of research and clinical studies, culminating in unique, carefully designed and clinically validated test images . . ." does not add to you claim of sufficient creativity. *Id.* at 2. Nor does your assertion that the Work's author created the wavy or squiggly lines included in the images "by varying the smooth contour according to a mathematical formula . . . generated by a sinusoidal wave modulation." *Second Request* at 2. In determining whether a design contains the requisite minimal amount of original authorship necessary for registration the Board does not assess the uniqueness, visual effect, or symbolism of a design, or the amount of time or effort that the author took to create it. *See* 17 U.S.C. § 102(b); *see also Bleistein*, 188 U.S. 239. And in any event, these assertions confirm that the work is a useful article that merely implements a process, procedure, or technique that is ineligible for copyright protection.

IV. CONCLUSION

In sum, the Board finds that the Work is a useful article that does not include design elements that are separable from its utilitarian function. Even if the images that you identify as eligible for registration could be separated from the utilitarian function of the Work, the Board finds that the individual elements that comprise the images, as well as the selection, organization, and arrangement of those elements lack the sufficient level of creativity to warrant registration under the Copyright Act.

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the work entitled: *Contour Integration Macular Perimetry Test*. This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: _____

Erik Bertin
Copyright Office Review Board