United States Copyright Office
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August 20, 2013

Berenato & White, LLC
Attn: Joseph Berenato, III
6550 Rock Spring Drive, Suite 240
Bethesda, MD 20817

Re: Heart Designs (8) & Heart Designs (6)
Correspondence ID: 1-DNEZTO & 1-DNEZYO

Dear Mr. Berenato:

The Review Board of the United States Copyright Office (the "Board") is in receipt of your second requests for reconsideration of the Registration Program's refusals to register the fourteen works at issue. You submitted these requests on behalf of your client, Harold Prantner, on December 19, 2012. Administratively, your previous registration requests for the works at issue were addressed under two separate correspondence identification numbers (1-DNEZTO & 1-DNEZYO). However, because the issues associated with all fourteen of the works are similar, for the purpose of second reconsideration, we will address all fourteen claims in this one letter. I apologize for the delay in the issuance of this determination. After periods of inaction, staff departures, and budgetary restrictions, the Register of Copyrights has appointed a new Board and we are proceeding with second appeals of registration refusals as expeditiously as possible.

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

I. DESCRIPTION OF THE WORKS

The fourteen works at issue (the "Works") each include either the name of a geographic location or a holiday, printed in a standard font, with the letter "Y" in the name of the location or holiday replaced by a red heart-shaped graphic. The below images are photographic reproductions of the Works from the deposit materials:

Kentucky with heart



Martha's Vineyard with heart



Lynchburg with heart



Wyoming with heart



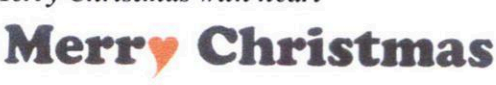
Pennsylvania with heart



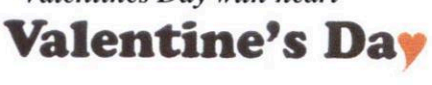
Monterey with heart



Merry Christmas with heart



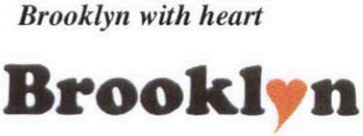
Valentines Day with heart



Hollywood with heart



Brooklyn with heart



Daytona Beach with heart



Key West with heart



Beverly Hills with heart



Maryland with heart



II. ADMINISTRATIVE RECORD

On March 27, 2013, the United States Copyright Office (the "Office") issued two letters notifying Harold Prantner (the "Applicant") that it had refused registration of the above mentioned Works. *Letters from Registration Specialist, Robin Jones, to Joseph Berenato* (March 27, 2013). In its letters, the Office stated that it could not register the Works because they lack the authorship necessary to support a copyright registration. *Id.*

In two letters dated June 26, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(b), the Office reconsider its initial refusals to register the Works. *Letters from Joseph Berenato to*

Copyright RAC Division (June 26, 2012) ("First Requests"). *Id.* Upon reviewing the Works in light of the points raised in your letters, the Office concluded that the Works "do not contain a sufficient amount of original and creative artistic or graphic authorship" and again refused registration. *Letters from Attorney-Advisor, Stephanie Mason, to Joseph Berenato* (September 19, 2012).

Finally, in two letters dated December 19, 2012, you requested that, pursuant to 37 C.F.R. § 202.5(c), the Office reconsider for a second time its refusal to register the Works. *Letter from Joseph Berenato to Copyright R&P Division* (December 19, 2012) ("Second Request").

In arguing that the Office improperly refused registration, you claim the Works include 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 Requests* at 2. In support of this argument, you claim that the Applicant's careful selection and arrangement of the Works' constituent elements possess a sufficient amount of creative authorship to warrant registration. Specifically, you claim the Applicant's decision to substitute an original heart design for the letter "Y" in each of the Works is "unique" and "cannot be deemed 'trivial.'" *Id.*

In addition to *Feist*, your argument references several cases in support of the general principle that, to be sufficiently creative to warrant copyright protection, a work need only possess a "modicum of creativity." *Id.* You also reference several cases that demonstrate works comprised of otherwise unprotectable elements are acceptable for copyright protection if the selection and arrangement of their elements satisfies the requisite level of creative authorship. *Id.*

Your letters include pages of screenshots depicting "Google search" results that allegedly demonstrate "the typical design in the public domain is to replace the word 'love' with a heart," as opposed to the letter "Y." *Id.* at 2-12. They also include several additional examples of "the multitude of ways in which to incorporate a heart into a design" and a long list of examples of registered works with the word "heart" and a geographic place name in the title. *Id.* at 11-14, Exhibit B. Despite admitting that you have not actually viewed the works (only their titles) you claim that they suggest "there are additional ways in which to display words with a heart." *Id.* at Exhibit B.

III. DECISION

A. *The Legal Framework*

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 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").

Of course, 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. Nevertheless, 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 establish the level of creativity necessary to warrant protection. 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. et. al.*, 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 the 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, as well) 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*, 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 Works*

After carefully examining the Works, and applying the legal standards discussed above, the Board finds that all fourteen of the Works fail to satisfy the requirement of creative authorship.

First, the Board has determined that none of the Works' constituent elements, considered individually, are sufficiently creative to warrant protection. As noted, 37 C.F.R § 202.1(a), 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.* Here, the Works consist of a trivial variation of the common heart shape and a word or short phrase printed in an ordinary font. Consistent with the above regulations, neither the heart shapes, the words or short phrases, the font the Applicant used to letter the words or short phrases, nor the Works' simple color schemes are eligible for copyright protection. *See id.* (prohibiting the registration of basic symbols or designs); *see also Racenstein & Co., Inc. v. Wallace dba ABC Window Cleaning Supply*, 51 U.S.P.Q. 2d 1031 (S.D.N.Y. 1999) (indicating a word or short phrase, alone, generally cannot support a copyright claim); *see also Coach, Inc. v. Peters*, 386 F. Supp 2d 495, 498-99 (indicating mere variations in typographic ornamentation or lettering cannot support a copyright claim); *and see Boisson v. Banian, Ltd.*, 273 F.3d 262, 271 (2d Cir. 2001) (indicating mere coloration cannot support a copyright claim). Thus, we conclude that the Work's constituent elements do not qualify for registration under the Copyright Act.

Second, the Board finds that the Works, considered as a whole, fail to meet the creativity threshold set forth in *Feist*. 499 U.S. at 359. As explained, the Board accepts the principle that combinations of unprotectable elements may be eligible for copyright registration. However, in order to be accepted, 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). Viewed as a whole, the Works consists of the simple replacement of the letter "Y" in the names of various geographic places and holidays with an ordinary, red heart shape with a curved or extended tail. This basic pairing of unprotectable words and short phrases with a common, unprotectable shape is, at best, *de minimis*, and fails to meet the threshold for copyrightable authorship.[1] *Feist,* 499 U.S at 359; *see also Atari Games,* 888 F.2d at 883. Accordingly, we conclude that the Works, as a whole, lack the requisite "creative spark" necessary for registration. *Feist,* 499 U.S at 359; *Satava*, 323 F.3d at 811.

Your assertion that replacing the letter "Y" in a word or short phrase with a heart-shaped design is "truly unique" does not add to your claim of sufficient creativity. *Second Requests* at 2. As discussed above, the Board does not assess novelty or uniqueness in determining whether a work contains the requisite minimal amount of original authorship necessary for registration. *See* 17

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[1] The Board is aware that the word "Kentucky" in the work *Kentucky with a heart* is colored blue and that each letter in the word has at least one white star shape appearing on it. The addition of a second color and what can be viewed as either unprotectable star shapes or unprotectable typographic ornamentation does not change our opinion regarding the copyrightability of the Work. *See Coach, Inc.*,386 F. Supp 2d at 498-99; *and see Boisson*, 273 F.3d at 271.

U.S.C. § 102(b); *see also Bleistein*, 188 U.S. 239. Thus, even if accurate, the mere fact that the Works consists of a unique, novel arrangement of familiar words and shapes would not qualify the Works as copyrightable.

Finally, the Board rejects your suggestion that the Office should assess the copyrightability of the Works by comparing them to the select works you have pulled from the Official Register. The Board follows the long-standing principle that works are to be examined independently, on their own merits, under the standards set forth in the Copyright Act and the Code of Federal Regulations. *See Homer Laughlin China Co. v. Oman*, 22 U.S.P.Q.2d (BNA) 1074, 1076 (D.D.C. 1991) (where the court stated that it was not aware of "any authority which provides that the Register must compare works when determining whether a submission is copyrightable."); *accord, Coach, Inc.*, 386 F. Supp. 2d at 499 (indicating the Office "does not compare works that have gone through the registration process."). Again, each work submitted for registration is evaluated on its own merits, with the Office applying the relevant statutory and regulatory guidelines. The fact that an individual examiner might have previously accepted a work that is, arguably, not more creative than the Works at issue, does not require the Office to register subsequent works that it finds contain *de minimis* authorship.

In sum, the Board finds that the Applicant's selection and arrangement of the elements that comprise the Works lack a sufficient level of creativity to make the Works registerable under the Copyright Act.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the works entitled: *Kentucky with heart; Martha's Vineyard with heart; Lynchburg with heart; Wyoming with heart; Pennsylvania with heart; Monterey with heart; Merry Christmas with heart; Valentines Day with heart; Hollywood with heart; Brooklyn with heart; Daytona Beach with heart; Key West with heart; Beverly Hills with heart;* and *Maryland with heart*. This decision constitutes final agency action on this matter. 37 C.F.R. § 202.5(g).

Maria A. Pallante
Register of Copyrights

BY: _____
William J. Roberts, Jr.
Copyright Office Review Board