



December 14, 2020

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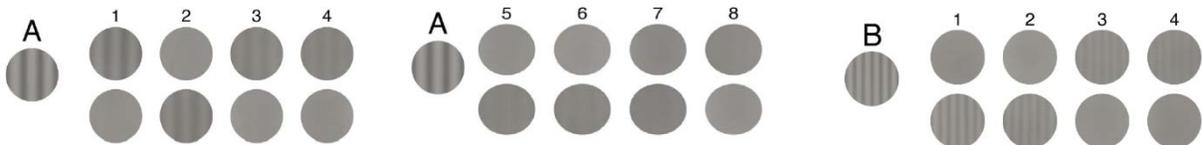
**Re: Second Request for Reconsideration for Refusal to Register ABCD1–8
(Correspondence ID: 1-3UCO2F3; SR # 1-6926420661; 1-6926544987;
1-6926669128; 1-6926750424; 1-6929654271; 1-6929654548; 1-6929794637)**

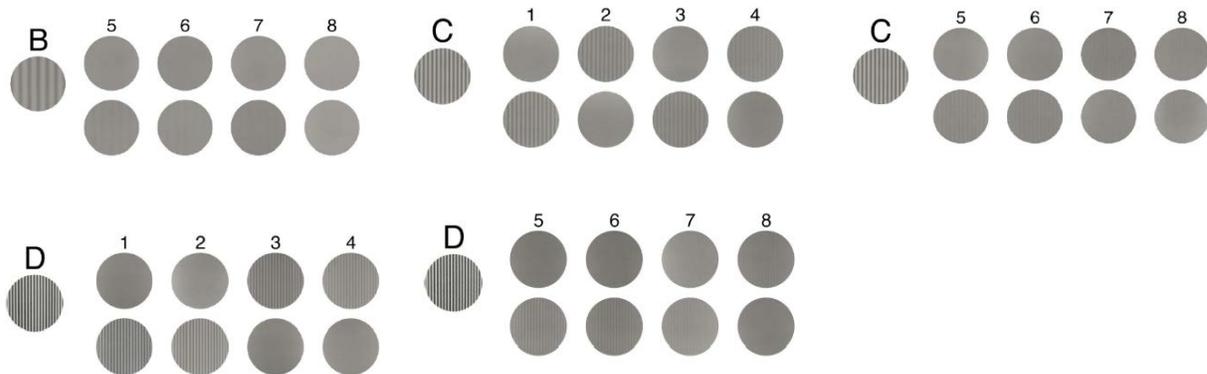
Dear Ms. Moyer-Henry:

The Review Board of the United States Copyright Office (“Board”) has considered Guardian Health Sciences (“Guardion’s”) second request for reconsideration of the Registration Program’s refusal to register two-dimensional art claims in the works titled A1234, A5678, B1234, B5678, C1234, C5678, D1234, and D5678 (collectively, the “Works”). After reviewing the applications, deposit copies, and relevant correspondence, along with the arguments in the second requests for reconsideration, the Board affirms the Registration Program’s denials of registration.

I. DESCRIPTION OF THE WORKS

The Works, part of an eye exam, each consist of nine circles: one circle on the left and four columns of two circles to the right. On the inside of the left circle are a series of vertical lines of two repeating widths rendered in two contrasting values of grey. Certain of the circles in the right-side columns contain the same series of repeating width vertical lines, rendered in grey with greater or lesser differences in value, while the remaining circles are solid grey. Above the circle to the left is a letter, A, B, C, or D (with each letter corresponding to a specific pattern of vertical lines across Works). Above the each column of circles is a sequential string of numbers “12345” or “5678.” The Works are as follows:





II. ADMINISTRATIVE RECORD

On September 5 and 6, Guardion filed applications to register copyright claims in the Works. In eight separate letters, a Copyright Office registration specialist refused to register the claims, finding that the Works “lack[] the authorship necessary to support a copyright claim.” Initial Letters Refusing Registration from U.S. Copyright Office, to Kari Moyer-Henry (June 20, 2019, Aug. 12, 2019, Apr. 9, 2019, Apr. 11, 2019).

In separate letters, Guardion requested that the Office reconsider its initial refusal to register the Works. Letters from Kari Moyer-Henry to U.S. Copyright Office (July 8 2019, July 10 2019, Sept. 9 2019, Nov. 7, 2019) (“First Requests”). After reviewing the Works in light of the points raised in the First Requests, and an Email sent by Applicant stating that “[t]he designs are just one aspect of a diagnostic tool for macular degeneration and related conditions,” Email from Kari Moyer-Henry, to U.S. Copyright Office (Oct. 9, 2019), the Office re-evaluated the claims and again concluded that the Works were useful articles that did not contain separable original authorship, noting that “the circles and their interior [. . .] cannot be ‘imagined apart’ from the bridge or nosepiece or exist on their own as a standalone pictorial graphic, or sculptural work,” and further found that the “simple circles and shades of grey [. . .] do not contain a sufficient amount of creative authorship to support a copyright registration.” Refusal of First Requests for Reconsideration from U.S. Copyright Office, to Kari Moyer-Henry (Dec. 18, 2019).

In a letter dated December 18, 2019, Guardion 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 Kari Moyer-Henry, to U.S. Copyright Office (Dec. 18, 2019) (“Second Request”). In that letter, Guardion argued that the Works satisfy the first prong of the separability test for useful articles because the grey interior is the utilitarian portion of the design and everything else, including “the array of circles wherein a single circle is positioned on the far left of the image followed by four columns of circles, each column consisting of two circles and further having a letter or number above each column can be ‘imaginatively separated’ from the grey interior.” *Id.* at 2. Further, Applicant argued that the designs are sufficiently original because, while “the shape of a circle is clearly in the public domain, Applicant’s expression of the number and arrangement of the circles along with the varied shading within the circles is original.” *Id.* at 5.

III. DISCUSSION

A. *The Legal Framework*

1) *Distinction Between Ideas and Expression*

Section 102(b) of the Copyright Act provides that copyright protection for expressive works does not extend to “any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” 17 U.S.C. § 102(b). Section 102(b) codifies the longstanding principle, known as the idea-expression dichotomy, that copyright law protects the original expression of ideas, but not the underlying ideas themselves. The Supreme Court in 1879 held that the copyright in a book describing a bookkeeping system, with blank forms and ruled lines and headings, did not give the copyright owner the right to prevent others from using the bookkeeping system described nor “the exclusive right to make, sell, and use account-books prepared upon the plan set forth in such book.” *Baker v. Selden*, 101 U.S. 99, 102–04 (1879).

“Mathematical principles, formulas, algorithms, or equations” are ineligible for copyright protection under section 102(b). See COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 313.3(A) (3d ed. 2014) (“COMPENDIUM (THIRD)”). Though the Office is permitted to register a sufficiently original artistic description, explanation, or illustration of an idea, procedure, process, system, method of operation, concept, principle, or discovery, the registration is “limited to the copyrightable literary, musical, graphic, or artistic aspects of the work.” COMPENDIUM (THIRD) § 313.3(A). This principle is manifested in the Office’s regulations, which bar copyright protection for “[i]deas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing.” 37 C.F.R. § 202.1(b).

Copyright’s merger doctrine, which states that idea and expression merge together when the expression cannot be separated from the idea, is a closely related principle that bars copyrightability of certain works. See, e.g., *Baker*, 101 U.S. at 103 (explaining that if the “art” that a book “teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public”); *CCC Info. Servs., Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 68 (2d Cir. 1994) (“[W]hen the expression is essential to the statement of the idea, the expression also will be unprotected, so as to insure free public access to the discussion of the idea.”).

2) *Originality*

A work may be registered if it qualifies as an “original work[] of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102(a). In this context, the term “original” consists of two components: independent creation and sufficient creativity. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). 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.* Only a modicum of creativity is necessary, but the Supreme Court has ruled that some works (such as the alphabetized telephone directory at issue in *Feist*) fail to meet even this low 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 virtually nonexistent.” *Id.* at 359.

The Office’s regulations implement the longstanding requirement of originality set forth in the Copyright Act. *See, e.g.*, 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”); *id.* § 202.10(a) (stating “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. Nevertheless, not every combination or arrangement will be sufficient to meet this test. *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”). A determination of copyrightability in the combination of standard design elements depends 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.C. Cir. 1989).

A mere simplistic arrangement of non-protectable elements does not demonstrate the level of creativity necessary to warrant protection. For example, the United States District Court for the Southern District of New York upheld the Copyright Office’s refusal to register simple designs consisting of two linked letter “C” shapes “facing each other in a mirrored relationship” and two unlinked letter “C” shapes “in a mirrored relationship and positioned perpendicular to the linked elements.” *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 496 (S.D.N.Y. 2005). Likewise, the Ninth Circuit has held that a glass sculpture of a jellyfish consisting of clear glass, an oblong shroud, bright colors, 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 language in *Satava* is particularly instructive:

It 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).

Similarly, while the Office may register a work that consists merely of geometric shapes, for such a work to be registrable, the “author’s use of those shapes [must] result[] in a work that, as a whole, is sufficiently creative.” COMPENDIUM (THIRD) § 906.1; *see also Atari Games Corp.*, 888 F.2d at 883 (“[S]imple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and in court.”). Thus, the Office would register, for example, a wrapping paper design that consists of circles,

triangles, and stars arranged in an unusual pattern with each element portrayed in a different color, but would not register a picture consisting merely of a purple background and evenly-spaced white circles. COMPENDIUM (THIRD) § 906.1.

B. Analysis of the Works

After carefully examining the Works and applying the legal standards discussed above, the Board finds that the Works do not contain the requisite authorship necessary to sustain a claim to copyright.

First, the individual elements of the Works' design and their overall combination are dictated by the underlying system of an eye exam, and thus are not subject to copyright protection under the merger doctrine. Specifically, as Applicant states, "[t]he designs are just one aspect of a diagnostic tool for macular degeneration and related conditions." Email from Kari Moyer-Henry, to U.S. Copyright Office (Oct. 9, 2019). Copyright protects the original expression of ideas, but not the underlying ideas themselves and systems are typically not subject to copyright protection. *See* 37 C.F.R. § 202.1(B) (citing as "examples of works not subject to copyright . . . [i]deas, plans, methods, systems, or devices as distinguished from the particular manner in which they are expressed or described in a writing."); COMPENDIUM (THIRD) § 313.3(A) ("[A]ny work or portion of a work that is an idea, procedure, process, system, method of operation, concept, principle, or discovery does not constitute copyrightable subject matter and cannot be registered.").

When, as here, an expression cannot be separated from the idea that it embodies, the merger doctrine prevents it from being eligible for copyright protection. Each component of the Works was selected and arranged as a necessary and inherently functional part of an eye exam. Patients view the shaded circles, combined with several pairs of circles (each pair corresponding to two lenses, one for each eye) containing additional grey shading as part of the assessment. The numbers and letters over the circles allow the test administrator to track and identify the patient's response to each combination of image and lens. Further, the overall organization of the circles stacked in two rows of four with one circle to the left of the rows contribute to the overall system and functioning of the eye exam. Thus, the Works do not constitute copyrightable subject matter; to find otherwise would allow the Applicant to inappropriately "prevent others from . . . implementing procedures, processes, systems, or methods of operation described in such works." 37 C.F.R. § 313.3(A); *see also Feist*, 499 U.S. at 344–45 (explaining that "[t]he most fundamental axiom of copyright law is that 'no author may copyright his ideas or the facts he narrates.'" (citation omitted). Granting copyright protection for the specific arrangement and selection of elements of the Works would effectively grant Applicant a monopoly for a specific eye exam system, which the merger doctrine protects against. *Zalewski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 102–03 (2d Cir. 2014) (finding that under the "merger doctrine," if an idea "can only be expressed in a limited number of ways," those means of expression "cannot be protected, lest one author own the idea itself"); *CCC Info. Servs., Inc.*, 44 F.3d at 68.

Second, even if the Works were eligible for protection under section 102(b), none of the Works individually meet the low threshold of creativity to warrant copyright protection. Each Work consists of nine identically-sized geometric shapes (circles), each with solid or uniformly-

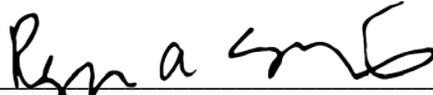
striped grey shading, combined with a letter and four numbers placed over top of and identifying either the single left circle or one of the pairs of circles on the right. The grey shading consists of either a solid grey color or vertical lines of repeating widths rendered in contrasting values of grey. These individual elements are insufficiently creative to warrant copyright protection. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of “familiar symbols or designs”); COMPENDIUM (THIRD) § 906.1 (“[T]he Copyright Act does not protect common geometric shapes, either in two-dimensional or three-dimensional form . . . including . . . circles”); *Id.* at § 906.4 (“As a general rule, typeface, typefont, lettering . . . and typographic ornamentation are not registrable.”) (citing 37 C.F.R. § 202.1(a), (e))).

Nor is the combination of these elements sufficiently creative. While the combination of uncopyrightable elements can result in a copyrightable work, such a work must be “as a whole . . . sufficiently creative and original.” COMPENDIUM (THIRD) § 906. Here, eight circles are depicted in four columns of two circles each, with a ninth circle placed to the left and centered vertically between the upper and lower rows of circles. The numbers “1, 2, 3, 4” or “5, 6, 7, 8,” respectively, appear in a sequential line above each column of two circles, with the letter “A,” “B,” “C,” or “D,” above the single circle on the left. Arranging identically-sized circles next to each other, each filled in with either a solid gray color or regular, repeating vertical lines, combined with identifying letters and numbers, is a basic configuration that is insufficiently creative to warrant copyright protection. *See id.* at § 905 (“In all cases, a visual art work must contain a sufficient amount of creative expression. Merely bringing together only a few standard forms or shapes with minor linear or spatial variations does not satisfy this requirement.”). Without more, the combination of individual elements, consisting of geometric shapes, uniform shading, letters, and numbers arranged in a basic configuration, are insufficient to meet the threshold of creativity necessary for copyright protection.¹

¹ Whether a work constitutes copyrightable subject matter is a threshold question to copyright protection eligibility. Because the Board finds that the Works are unoriginal and do not constitute copyrightable subject matter, it is unnecessary to engage in a useful article analysis here, which could present an additional hurdle to overcome.

IV. CONCLUSION

For the reasons stated herein, the Review Board of the United States Copyright Office affirms the refusal to register the copyright claim in the Work. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action in this matter.



U.S. Copyright Office Review Board

Regan A. Smith, General Counsel and
Associate Register of Copyrights

Catherine Zaller Rowland, Associate Register of
Copyrights and Director, Public Information and
Education

Kimberley Isbell, Deputy Director of Policy and
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