



United States Copyright Office

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**RE: Second Request for Reconsideration for Refusal to Register Ornamental Thermostat Digital Image – ++ and 8 others;
Correspondence IDs: SR#s 1-799982978, 1-799982830, 1-799983000,
1-799982924, 1-799982902, 1-799982956, 1-799982692, 1-799982714, and
1-799982530**

Dear Mr. Sadowski:

The Review Board of the United States Copyright Office (the “Board”) has examined Maxitrol Company’s (“Maxitrol’s”) second requests for reconsideration of the Registration Program’s refusal to register two-dimensional artwork copyright claims in the works “Ornamental Thermostat Digital Image – ++,” “Ornamental Thermostat Digital Image – Circle with Three Current Elements,” “Ornamental Thermostat Digital Image – Bulb, Line, and Four Shortened Lines,” “Ornamental Thermostat Digital Image – Light Bulb Sensing Current Element,” “Ornamental Thermostat Digital Image – Two Boxes, Circle, Two Connected Lines,” “Ornamental Thermostat Cover with Ten Images,” “Ornamental Thermostat Cover with Eight Images,” “Ornamental Thermostat Cover with Six Images,” and “Ornamental Thermostat Cover with Four Images” (collectively, the “Works”). After reviewing the applications, deposit copies, and relevant correspondence in these cases, along with the arguments in the second request for reconsideration, the Board affirms the Registration Program’s denial of registration.

I. DESCRIPTION OF THE WORKS

The Works consist of nine two-dimensional designs. Five of the Works are icons used on a digital thermostat: “Ornamental Thermostat Digital Image – ++,” “Ornamental Thermostat Digital Image – Circle with Three Current Elements,” “Ornamental Thermostat Digital Image – Bulb, Line, and Four Shortened Lines,” “Ornamental Thermostat Digital Image – Light Bulb Sensing Current Element,” and “Ornamental Thermostat Digital Image – Two Boxes, Circle, Two Connected Lines” (collectively the “Digital Image Works”). Four of the Works are digital thermostat covers with varying icons: “Ornamental Thermostat Cover with Four Images,” “Ornamental Thermostat Cover with Six Images,” “Ornamental Thermostat Cover with Eight Images,” and “Ornamental Thermostat

Cover with Ten Images” (collectively the “Cover Works”). The Works are depicted and described as follows:

Digital Image Works:

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| <p>“Ornamental Thermostat Digital Image – ++” is a black design outlined in blue that consists of two “+” symbols arranged diagonally.</p> |  |
| <p>“Ornamental Thermostat Digital Image – Circle with Three Current Elements” is a black design outlined in blue that consists of a hollow black circle with three curved lines of ascending length positioned above it.</p> |  |
| <p>“Ornamental Thermostat Digital Image – Bulb, Line, and Four Shortened Lines” is a black design outlined in blue that consists of a standard thermometer shape. The lines that represent temperature scale demarcations are white.</p> |  |
| <p>“Ornamental Thermostat Digital Image – Light Bulb Sensing Current Element” is a black design outlined in blue that consists of a standard light bulb shape. The concave oval shape representing a glare reflecting off of the light bulb and a thin line at the bulb’s base are white and outlined in blue.</p> |  |
| <p>“Ornamental Thermostat Digital Image – Two Boxes, Circle, Two Connected Lines” is a black design outlined in blue that consists of a standard clock face positioned in the center of a square shape with a blue and black border. The border of the bottom-right portion of a second square is visible below the bottom right portion of the square that contains the clock face. The clock hands are white and show the time of two o’clock.</p> |  |

Cover Works

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|--|---|
| <p>“Ornamental Thermostat Cover with Four Images” is a thermostat cover with four images. The first image is a traditional power symbol, a circle that is 5/6th of the way complete with a vertical line stationed in the opening at the top of the circle. The second image is an hourglass depicted as full on the bottom and 3/4 full on the top (this image has previously been registered with the Copyright Office). The last two images constitute an “up” arrow and a “down” arrow.</p> |  |
| <p>“Ornamental Thermostat Cover with Six Images” is a thermostat cover with six images. It includes the four images in “Ornamental Thermostat Cover with Four Images” and two additional images: a thermometer, depicted as a tall rectangular stem attached to a circular shape at the bottom, with four small horizontal rectangular boxes on the overall rectangle to indicate temperature, which is depicted in black, blue, and white; and a white clock inset within a black square with a white outline, which is set atop an identical square, giving the image a three dimensional effect.</p> |  |
| <p>“Ornamental Thermostat Cover with Eight Images” is a thermostat cover with eight images—the six images in “Ornamental Thermostat Cover with Six Images” and two additional images: a fan with four balloon-shaped blades stemming from the center and that are bent slightly to the right to indicate motion and are enclosed by a thin circle (this image has previously been registered with the Copyright Office); and a light bulb with a blue border.</p> |  |
| <p>“Ornamental Thermostat Cover with Ten Images” is a thermostat cover with ten images—the eight images in “Ornamental Thermostat Cover with Eight Images” and two additional images: two plus signs set atop one another with the one on the top placed to the left of the bottom plus sign, with the plus signs in white coloring surrounded by a blue border; and an image resembling flames that consists of three shapes facing upward with the largest situated in the center with two smaller shapes on either side (a variation of this image has previously been registered with the Copyright Office).</p> |  |

II. ADMINISTRATIVE RECORD

On August 10, 2012, Maxitrol filed nine applications to register copyright claims in the Works. In an October 31, 2012 letter, a Copyright Office registration specialist refused to register the claims, finding that they “lack the authorship necessary to support a copyright claim.” Letter from Annette Coakley, Registration Specialist, U.S. Copyright Office, to Jeffrey A. Sadowski, Howard & Howard Attorneys PLLC (Oct. 31, 2012).

In a January 30, 2013 letter, Maxitrol requested that the Office reconsider its initial refusal to register the Works. Letter from Jeffrey A. Sadowski, Howard & Howard Attorneys PLLC, to U.S. Copyright Office (Jan. 30, 2013) (“First Request”). After reviewing the Works in light of the points raised in the First Request, the Office reevaluated the claims and again concluded that the Works do not contain a sufficient amount of original and creative artistic authorship to support copyright registration, nor could any of the Works be registered as a compilation, because “they do not contain the type of selection, coordination and arrangement necessary to support a copyrightable compilation.” Letter from U.S. Copyright Office, to Jeffrey A. Sadowski, Howard & Howard Attorneys PLLC 1 (May 30, 2013). Further, the Office concluded that the Works represent useful articles that do not contain any authorship that is both separable and copyrightable. *Id.* at 3.

In an August 29, 2013 letter, Maxitrol 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 Jeffrey A. Sadowski, Howard & Howard Attorneys PLLC, to U.S. Copyright Office (Aug. 29, 2013) (“Second Request”). In that letter, Maxitrol disagreed with the Office’s conclusion that the Works do not include the minimum amount of creativity required to support registration under the Copyright Act. Specifically, Maxitrol claimed that each of the Digital Image Works is copyrightable, because even “simple abstraction[s]” can be registered if they are not copied from anything in the public domain. *Id.* at 5. Further, Maxitrol argued that the Office “did not define anything against which each item was measured” and therefore Maxitrol “cannot detail the numerous differences from whatever could be cited [as being unoriginal].” *Id.* Maxitrol argued that, for the Digital Image Works, “to provide a unique, independently created design in the context of simple structures is an effort that cannot be easily categorized as ‘trivial.’” *Id.* at 6. Maxitrol also claimed that the Cover Works each qualify for copyright registration because they were independently created, and are compilations of arranged icons, with “artistic flair” sufficient for copyright registration. *Id.* at 2.

III. DECISION

a. The Legal Framework

1. 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 and described in *Feist*. 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 standardized designs or familiar symbols, or geometric shapes, for such a work to be registrable, those shapes must result in a work that, as a whole, is sufficiently creative. U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES §§ 906.1 (geometric shapes), 906.2 (familiar symbols and designs) (3D ED. 2014) (“COMPENDIUM (THIRD)”); 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.

Finally, Copyright Office registration specialists (and the Board) do not make aesthetic judgments in evaluating the copyrightability of particular works. The attractiveness of a design, the espoused intentions of the author, the design's visual effect or appearance, its symbolism, the time and effort it took to create, or the design's commercial success in the marketplace are not factors in determining whether a design is copyrightable. See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903); COMPENDIUM (THIRD) §§ 310.2 (aesthetic value, artistic merit, and intrinsic quality), 310.3 (symbolic meaning and impression), 310.7 (time, effort, or expense), and 310.10 (commercial appeal and success).

2) *Useful Articles and Separability*

Copyright law does not protect 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 craftsmanship that have been incorporated into a useful article may be eligible for copyright protection if they constitute pictorial, graphic, or sculptural works pursuant to 17 U.S.C. § 102(a)(5). The protection for such works is limited, however, in that it extends only “insofar as [the works’] form but not their mechanical or utilitarian aspects are concerned.” *Id.* at 101. In other words, a design incorporated into a useful article is only eligible for copyright protection to the extent that the design includes artistic “features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” *Id.*; see also *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978) (holding that 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 Office employs two tests to assess separability: (1) a test for physical separability; and (2) a test for conceptual separability. See COMPENDIUM (THIRD) § 924.2; see also *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041 n.2 (9th Cir. 2014) (finding that the Office’s interpretation of conceptual separability is entitled to deference); *Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. 1995) (finding that the Office’s tests for physical and conceptual separability are “a reasonable construction of the copyright statute[]” consistent with the words of the statute,” existing law, and the legislature’s declared intent in enacting the statute).

To satisfy the test for physical separability, a useful article must contain pictorial, graphic, or sculptural features that can be physically separated from the article by ordinary means. See COMPENDIUM (THIRD) § 924.2(A). To satisfy the test for conceptual separability, a useful article must contain pictorial, graphic, or sculptural features that can be visualized—either on paper or as a freestanding sculpture—as a work of authorship that is separate and independent from the utilitarian aspects of the article and the overall shape of the article. In other words,

the feature must be [able to be] imagined separately and independently from the useful article without destroying the basic shape of that article. A pictorial, graphic, or sculptural feature satisfies this requirement only if the artistic feature and the

useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article.

COMPENDIUM (THIRD) § 924.2(B). If the feature is an integral part of the overall shape or contour of the useful article, that feature cannot be considered conceptually separable because removing it would destroy the basic shape of the article. *See id*; *cf.* H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668 (citing a carving on the back of a chair or a floral relief design on silver flatware as examples of conceptually separable design features).

If the useful article does not contain any features that can be physically or conceptually separated from its utilitarian function, the Office will refuse to register the claim because Congress has made it clear that copyright protection does not extend to any aspect of a useful article that cannot be separated from its utilitarian elements. If the Office determines that the work contains one or more features that can be separated from its functional elements, the Office will examine those features to determine if they contain a sufficient amount of original authorship to warrant registration.

IV. ANALYSIS OF THE WORKS

After careful examination, the Board finds that all of the Works fail to satisfy the requirement of creative authorship and thus are not copyrightable.

a. Digital Image Works

Despite Maxitrol's claim that the Digital Image Works are original and creative "unique abstractions," the Board finds that none of the works are eligible for copyright protection. Familiar symbols or designs, or minor variations thereof—such as those that comprise the Digital Works—are not copyrightable. *See* 37 C.F.R. § 202.1(a) (prohibiting registration of "familiar symbols or designs"); COMPENDIUM (THIRD) §§ 313.4(J) ("[f]amiliar symbols and designs are not copyrightable" and thus "the Office cannot register a work consisting of a simple combination of a few familiar symbols or designs with minor linear or spatial variations"), 906.1 (arrows, mathematical symbols, standard industry designs, and common geometric shapes are not registerable).

While *Feist* sets a low bar, there is a narrow category of works that fall outside copyright coverage. The five Digital Image Works fall within this category because they are commonplace to a multitude of industries, including the heating and electrical industry. The level of creative authorship involved in these configuration of unprotectable elements is, at best, *de minimis*, and too trivial to merit copyright registration. First, "Ornamental Thermostat Digital Image – ++" consists of two familiar shapes—two plus signs—that are not combined in a creative way. Instead, they simply are placed atop one another at an angle, in a manner that does not warrant protection. Second, "Ornamental Thermostat Digital Image – Circle with Three Current Elements" simply is a hollow circle with three curves positioned above the circle. The circle itself is a simple geometric shape, as are the three curves. This image uses the same, or incredibly similar, elements as a host of other images commonly used to denote the strength of signal connectivity, and are thus not protected by copyright law. Third, "Ornamental Thermostat Digital Image – Bulb, Line, and Four Shortened Lines" is a simplistic thermometer design that is a familiar symbol used frequently to denote

temperature information. It is not an abstract combination of a bulb, line, and four shortened lines, but instead is a familiar depiction of a traditional thermometer that is not sufficiently creative to warrant copyright protection. Fourth, “Ornamental Thermostat Digital Image – Light Bulb Sensing Current Element” is a simplistic image of a light bulb that is not sufficiently creative under the Copyright Act. Finally, “Ornamental Thermostat Digital Image – Two Boxes, Circle, Two Connected Lines” is a standard black clock face that incorporates additional unprotectable elements such as a square shape. The icon image simply does not have the creative spark necessary for copyright protection.

Maxitrol implies that the time and expense it took to create the Digital Image Works qualifies those works for registration. Second Request at 6. But the key to registrability is originality and creativity, not the time and expense it takes to create an image. Additionally, Copyright Office registration specialists and the Board do not make aesthetic judgments in evaluating the copyrightability of particular works. See COMPENDIUM (THIRD) § 310.2. The attractiveness of a design, the espoused intentions of the author, the design’s visual effect or appearance, its symbolism, the time and effort it took to create, or its commercial success in the marketplace, do not influence the Office’s decisions. See *Bleistein*, 188 U.S. at 251. Thus, the fact that a work consists of a specific shape or style for purposes of aesthetic appeal does not necessarily mean that the work, as a whole, constitutes a copyrightable work of art, and does not sway the Board to find that the Digital Image Works are protectable.

b. Cover Works

Here, Maxitrol claims that the Cover Works qualify for copyright registration because they were created independently and are compilations with “artistic flair” sufficient to satisfy creativity standards. Second Request at 2. After carefully examining the Cover Works and applying the legal standards discussed above, viewed as a whole, the Board finds that these works are not copyrightable. The Cover Works consist of a plain casing and four to ten images displayed as typical thermostat icons or buttons. These constituent elements either are already registered (the fan and hourglass images¹) or are not protectable as discussed above² or because they are additional mere familiar designs such as simple arrows. Thus, the question is whether the combination of elements in each of the Cover Works is protectable as a compilation.

First, is undisputed that the Cover Works are useful articles because they have an intrinsic utilitarian function as a thermostat interface. See 17 U.S.C. § 101. As discussed above, the design features of a useful article may become eligible for copyright registration when they contain original authorship that is either physically or conceptually separable from the utilitarian aspects of the article. The Board does not question that the Cover Works contain design elements—the images on the thermostat covers—that are conceptually separable from the Works’ utilitarian function. The Board,

¹ Additionally, a minor variation of the flame design is registered with the Copyright Office.

² Upon review of Maxitrol’s prior registrations in Ornamental Thermostat Digital Image - Five Flames, Registration No. VAu001110858, Ornamental Thermostat Digital Image - Fan and Blocks, Registration No. VAu001110860, and Ornamental Thermostat Screen Digital Image - Timer Image, Registration No. VAu001110908, the Board questions the validity of these registrations and thus is referring them to the Copyright Office’s Registration Program for potential cancellation pursuant to 37 C.F.R. § 201.7. The Registration Program will contact Maxitrol regarding the results of that referral.

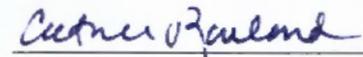
however, finds that none of these features possesses the requisite amount of creative authorship to warrant copyright registration.

It is true that public domain elements, such as familiar symbols or designs, or previously registered works may satisfy the requirement for copyrightable authorship as a compilation through their selection, coordination, or arrangement. Here, judging each of the Cover Works, although the images on the face of each one are conceptually separable, the separable two-dimensional icons on each thermostat cover do not contain sufficient original and creative artistic authorship in their selection, coordination, or arrangement to support copyright registration as a compilation. The selection, coordination, or arrangement of the constituent elements that comprise the four Cover Works is dictated by the functions of a thermostat, not by creative choice. Selection and placement of standard power buttons, arrows, timers, fans, flames, and the other thermostat icons are typical of thermostats or on other controllers in the heating or electrical industries. Thus, the Board finds that the level of creative authorship involved in these configurations of elements is, at best, *de minimis*, and far too trivial to enable copyright registration. *See Feist*, 499 U.S. at 359.

V. CONCLUSION

For the reasons stated herein, the Review Board of the U.S. Copyright Office affirms the refusal to register the copyright claims in the Works. Pursuant to 37 C.F.R. § 202.5(g), this decision constitutes final agency action on this matter.

BY:


Catherine Rowland
Copyright Office Review Board