December 2, 1996

RE: LUMPIES and PRIMITIVE HEARTHSIDES
Control No. 60–506–4332 C

Dear Mr. Crawford:

This concerns your letter dated July 26, 1996, requesting an Appeals Board determination regarding the registration of two decorative candles entitled LUMPIES and PRIMITIVE HEARTHSIDES. The Appeals Board has considered your appeal and affirms the refusals to register.

Administrative Record

On April 30, 1996, you submitted two applications covering these two candles as three–dimensional works of sculpture. The claims were submitted under special handling procedures, which were invoked due to pending litigation in the Eastern District of Pennsylvania.

In a letter dated May 8, 1996, copyright examiner John Ashley refused registration for PRIMITIVE HEARTHSIDES. He noted that the overall shape of the work was standard or familiar and that no design element could be found in the work which satisfied the originality and creativity requirements of the copyright law. As to the work LUMPIES, Mr. Ashley requested more information, since he determined that registration might be considered if the bumps on LUMPIES which gave the candle its irregular shape were the result of sculptural choices. He asked for a brief memorandum from

your client indicating that she chose where to place the lumps and what size they should be. He also suggested that additional photographs might better reveal the shape.

You filed a first appeal on May 23, 1996, requesting reexamination. In that letter, you argued that public acclaim for your client's works attested to their creativity and originality and stated that both LUMPIES and PRIMITIVE HEARTHSIDES were produced by a hand–made process. Finally, you asserted that the criteria for copyrightability had been met with respect to (1) human authorship, (2) creativity, and (3) originality.

Following this appeal, the Examining Division inquired into the process for creation of these works. In a telephone conversation you told Mr. David Levy that the lumps are created through a hand dipping process and each candle comes out different. The primitive hearthside candle is also dipped in "particulate" matter. On July 11, 1996, Mr. Levy, Attorney Advisor for the Visual Arts Section, again refused registration. He based this refusal on two grounds: that the candles were useful articles which did not contain separable copyrightable authorship and, further that, assuming separability, the overall shape of both candles and of all surface variations were common and that such common shapes are not subject to copyright protection. He also stated that copyright could not protect a process or idea.

You directed a second appeal to the Appeals Board on July 26, 1996, and submitted actual deposits of both works at that time. In this letter, you questioned the Office's overturning of the examiner's decision that LUMPIES was subject to registration. You also asserted that under recent

announcements of the Register of Copyrights the Appeals Board should apply the rule of doubt. You characterized the Office's prior refusals to register as essentially finding "[T]here are insufficient artistic differences between these works and their utilitarian progenitors, i.e. votive candles." (Letter from Crawford to Copyright Office Board of Appeals of 7/26/96, at 1). You argued that your client's

> [W]orks are decorative candles, not utilitarian candles only meant to shed light....[L]UMPIES and PRIMITIVE HEARTHSIDES...contain numerous features that are totally separate from the sometime utilitarian feature (lighted candle) of the works. On the LUMPIES the exterior surfaces are pleasantly irregular and have a primitive, non-commercial look having nothing to do with its possible utility as a candle. The PRIMITIVE HEARTHSIDES work contains an irregular granular surface and shape including a domed top, unlike any other votive candle. That surface is likewise divorced from any utility as a candle. It does, however, significantly contribute to its artistic role as a decorative candle.

Id. at 2. (Emphasis in original).

Finally, you asserted that the candles meet the separability test of the copyright law and cited Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980), as being on point where a work is utilitarian and ornamental. You urged that case mandated registration "where the artistry is separate from, and not necessary to, the utilitarian aspect of the work..." (Letter from Crawford to Copyright Office Board of Appeals of 7/26/96, at 3).

Registration Requirement for Useful Articles

You assert that this work is registrable as a pictorial, graphic or sculptural work under section 102(a)(5) of the copyright law. When such a work is embodied in a "useful article," the copyright law requires a certain type of artistic contribution to be registrable under section 102(a)(5). A useful article is "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the

article or to convey information. An article that is normally a part of a useful article is considered a 'useful article'." 17 U.S.C. § 101 (1994).

Moreover, the definition of "pictorial, graphic and sculptural works" limits copyrightability of the design of a useful article to "pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." Id.

The question before the Board is whether these candles satisfy the statutory definition for this type of work. The Board concludes that they do not. Congress clarified its intent with respect to the shape of useful articles in the legislative history. Specifically, the House Report accompanying the current copyright law states that:

> In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design....[A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that physically or conceptually can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design — that is, even if the appearance is determined by aesthetic (as opposed to functional) considerations, only elements, if any, which can be identified separably from the useful article as such are copyrightable.

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976) (emphasis added).

Conceptual Separability of Overall Shape

You assert that the candles in question are sometimes used only as decoration. You characterize the Office's refusal to register as being premised on a finding that "there is insufficient artistic differences between these works and their utilitarian progenitors, i.e. votive candles." This characterization misstates the position of the Office. These candles may be distinctively decorative. On that matter the Office takes no position. Even if the candles in this case are primarily decorative, they still have a useful purpose and under the copyright law must be treated as useful articles. The definition of useful article in section 101 of the copyright law identifies a useful article 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 (1994). The statute further provides that registration is possible only if and to the extent that the works contain pictorial, graphic, or sculptural features that are separable from the useful article. Id. The legislative history confirms that this separability may by physical or conceptual. See H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976).

The Office's implementation of the copyright statute, including its legislative history, is reflected in Compendium II of the Copyright Office Practices which states that the required conceptual separability is met when "artistic or sculptural features...can be visualized as free–standing sculpture independent of the shape of the useful article, i.e, the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article." U.S. Copyright Office, Compendium of Copyright Office Practices II, §505.03 (1984).

Esquire, Inc. v. Ringer, 591 F.2d. 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979), although decided under the 1909 law, most clearly enunciates the rule underlying the Office's principal reason for refusal. Esquire held that the Copyright Office regulation properly prohibited copyright registration for the overall shape or configuration of an utilitarian article, no matter how aesthetically pleasing that shape or configuration may be. Id. at 800. In fact, Section 505.03 of Compendium of Copyright Office Practices II is a direct successor to the Copyright Office regulation which was affirmed in Esquire as an authoritative construction of the statute as explicitly stated in legislative history. Id. at 802–03. See also Custom Chrome, Inc. v. Ringer, 35 U.S.P.Q. 2d 1714, 1718 (D.D.C. 1995), where the court stated that the Office's "conceptual separability test" as it is enunciated in Compendium II is consistent with the holding in Esquire, later cases decided under the present law, and the legislative history.

The Office applies the rule established in Esquire and later cases that, despite an original and creative shape, the overall design or configuration of an utilitarian article may not be copyrighted if it is not capable of existing as a work of art conceptually independent of the utilitarian object in which it is incorporated. 591 F.2d 796, 805 (D.C. Cir. 1978). The Appeals Board concludes that the principles espoused in Esquire also apply to the designs of the candles in this case. There would appear to be no clearly shaped separable work of sculpture on which to base a copyright registration. The overall shapes of these candles may be distinctive, pleasing, and the result of intellectual labor. The candles, however, do not contain physically or conceptually separate artistic authorship. Neither the overall shape of the candles nor the shape of the surface variations contain such authorship. LUMPIES has the overall shape

of a votive candle; it is a small standard half–cylinder candle. PRIMITIVE HEARTHSIDES is a larger candle but in the same standard half–cylinder shape. Although both candles contain variations, bumps, or encrustations on the surface of the candles, these variations, either created by temperature of the work or rolling the wax in particulate matter not invest the works with separable, copyrightable authorship.

In Norris Industries, Inc. v. Intern. Tel. & Tel., Corp., 696 F.2d 918 (11th Cir. 1983), the court of appeals rejected assertions that the hubcaps in question were purely ornamental articles and affirmed the findings of the lower court and the Register of Copyrights that the items were useful articles. In the instant case, the decorative appeal of the candles does not alter the fact that they serve a useful purpose. Registration of these useful works is thus dependent on whether there is physically or conceptually separable authorship. You assert that the case of Kieselstein–Cord v. Accessories By Pearl, Inc., 632 F.2d 989 (2d Cir. 1980) supports registration of the two candles in this case. We disagree. While not representational, the belt buckle in Kieselstein–Cord contained fanciful shapes and lines which were separately identifiable.

Secondary consideration:
De Minimis Authorship

The Copyright Office found that the candles in question do not contain sufficient copyrightable authorship to support registration. In determining whether a useful article is entitled to registration, the Examining Division looks first at whether or not there is any separable artistic authorship — whether it be physically or conceptually separable. If there is such authorship, then the Examining Division considers whether such authorship rises to the level of authorship required under the law.

17 U.S.C. § 102 (1994).

The distinctive appearance of the candles appears attributable to the idea of primitive candles, and the process used to make the candles appear primitive. Ideas and processes, however, cannot be copyrighted. 17 U.S.C. §102(b) (1994).

The surfaces of both candles are irregular, but even if we were to consider the lumps or irregularities on the candles as sufficiently conceptually separate from the overall useful design, they are, nevertheless, too minimal to support a copyright claim. Unlike the belt buckles in Kieselstein, these candles are insufficient to meet the concededly low standard of originality as that standard is enunciated in Feist Publications Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340, 363–64 (1991). In this case, the candles possess a basically cylindrical shape with a domed top. This shape is too simple to support a copyright claim. See Compendium II §505.03 (1984); 37 C.F.R. § 202.1(a) (1995). A common shape or a simple variation thereof lacks the originality and creativity needed to support a copyright claim. Even aesthetically pleasing designs may not be registered for copyright protection if the design lacks a minimum amount of original authorship. See Jon Woods Fashions v. Curran, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988) (deference shown to Register's decision in rejecting de minimis fabric design); Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F. Supp. 964 (E.D.N.Y. 1950)(reproduction of standard fleur–de–lis could not support a copyright claim without additional original authorship).

Rule of Doubt Registration

Under the copyright law, useful articles must contain separately identifiable artistic authorship on which a copyright claim can be based. The candles in this case fail to meet that test. The Appeals Board did not find it appropriate to register the candles under the rule of doubt. That rule applies where:

> ...there is a reasonable doubt about the ultimate action which might be taken under the same circumstances by an appropriate court with respect to whether (1) the material deposited for registration constitutes copyrightable subject matter or (2) the other legal and formal requirements of the statute have been met.

U.S. Copyright Office, Compendium of Copyright Office Practices, Compendium II 100–5 SEC. 108.07 (1984).

In the instant case, the Office, exercising its authority and discretion to determine copyrightability under 17 U.S.C. § 410(a) (1994), concludes that there is no separable and copyrightable authorship present in these useful articles. The works do not present a novel question for registration in either the subject matter or in any other of the formal requirements for registration. Further, although the area of conceptual separability is a difficult one, the Office does not apply the rule of doubt in every such claim to copyright in useful articles in which an applicant disagrees with the Office's assessment of non–separability.

Finally, as to your assertion about LUMPIES originally being found copyrightable, the first examiner simply asked for more information before making a determination. Upon receiving additional

information, including that given in a telephone conversation, the Examining Division found that a registration was not warranted for LUMPIES.

In summary, these works are both useful articles lacking separately identifiable artistic authorship, and, in the alternative, they reflect simple shapes lacking the modicum of original authorship needed to sustain a claim to copyright. Under either analysis, there is no copyrightable expression on which to base a registration.

For the reasons stated in this letter, we affirm the refusal to register the submitted claim and are closing the file in this case. This decision constitutes the final agency action on this matter.

Sincerely,

Nanette Petruzzelli

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