COPYRIGHT
OFFICE

September 25, 1997

RE: Heath Company, Decorative Lantern Housing,
Control No. 60-506-112.(F)

Dear Mr. Gray:

This is in response to your letter dated April 30, 1997, addressed to David Levy, Attorney Advisor, Visual Arts Section, Examining Division. On behalf of your client, Heath Company, you appealed the Copyright Office's refusal to register a work entitled "Dual Brite Motion Sensing Cast Aluminum Lantern SL-4194," retitled "Decorative Lantern Housing" on appeal. This work is a housing for a light fixture and is comprised of a glass section with metal sculptures at the top and base of the glass section.

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The Copyright Office Board of Appeals affirms the Examining Division's refusal to register. The lantern housing that contains the light is not copyrightable because it is not separable from the utilitarian, functional aspects of the useful object in which it is incorporated. Although the sculptural designs on the top and base of the lantern housing are separable from the utilitarian aspects of the useful object in which they are incorporated, they are not copyrightable because their authorship is *de minimis*.

Washington
D.C.
20559

Administrative Record

On December 7, 1995, the Copyright Office received a Form VA application for copyright registration from John S. Paniaguas, Esq., of your firm, as the authorized agent of Heath Company. Heath Company sought to register a work, described as a sculpture, that was originally titled "Dual Brite Motion Sensing Cast Aluminum Lantern SL-4194."

In a letter dated May 7, 1996, the Copyright Office refused to register the work. The Office found that the work was a useful article. The letter stated that the work did not have any separately identifiable pictorial, graphic or sculptural feature, which is necessary for a useful article to be protected by copyright. Because of the lack of separable authorship, the Copyright Office refused registration.

In a letter dated June 24, 1996, Mr. Paniaguas asked the Copyright Office to reconsider Heath Company's application for copyright registration. He requested that the title be amended to "decorative lantern housing" to clarify that Heath Company was not seeking copyright protection for the base, housing, electrical fixture and light bulb, but rather for the "uniquely shaped metal or metal-like structure in a generally hexagonal shape."

Mr. Paniaguas asserted that the decorative lantern housing satisfies the separability requirement of the definition of a useful article in Section 101 of the copyright law. He argued that the decorative housing serves no purpose related to the utilitarian function of the light fixture. The light fixture could work without the lantern housing. In support, he compared the lantern housing to the work granted copyright protection in Parfums Givenchy, Inc. v. C & C Beauty Sales, Inc, 832 F. Supp. 1378 (C.D. Cal. 1993) and further differentiated the work denied protection in Brandir Intern., Inc., v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2nd Cir. 1987). To demonstrate that the lantern housing is "ancillary to the utilitarian aspects of the light fixture," counsel submitted Exhibit A which shows examples of different outdoor lighting fixtures that do not have shades or protective housing.

Counsel further asserted that the court in Esquire v. Ringer, 591 F.2d 796 (D.C.Cir. 1978), cert. denied, 440 U.S. 908 (1979), found implicitly that the housing of an outdoor lamp may be copyrightable, but denied registration in that case on the basis that plaintiff did not limit the scope of the application to the housing. Mr. Paniaguas argued that, since this error was cured by amending Heath Company's application to "housing," registration should be granted to Claimant, Heath Company, because (1) Esquire recognized that a housing for an outdoor lamp may be registered and (2) Claimant's work satisfies the Sec. 101 separability requirement that permits a work of art incorporated into a manufactured article to be copyrighted, citing Mazer v. Stein, 347 U.S. 201 (1954).

In a letter dated December 31, 1996, the Copyright Office again refused to register the decorative lantern housing. The Copyright Office explained that unique qualities of a design were not relevant to a determination of registrability. The refusal for registration was based on the fact that the lantern and the housing are both utilitarian. The housing serves the function of containing the light fixture. The Copyright Office stated that all the elements of the work are part of the useful article, containing no separable copyrightable features, thereby distinguishing this work from those at issue in Mazer v. Stein and Parfums Givenchy v. C & C Beauty Sales, Inc. The Copyright Office also clarified the decision in Esquire, explaining that the Circuit Court upheld the Copyright Office's statutory interpretation that a useful object is one having "an" utilitarian function rather than having "solely" an intrinsic utilitarian function. Esquire at 804. Based on that interpretation, the Court stated that the overall design or configuration of a utilitarian object may not receive copyright protection, "no matter how aesthetically pleasing" it may be. Id. at 804.

In a letter dated April 30, 1997, acting as counsel for Heath Company, you submitted a second request for reconsideration. You stated that the decorative lantern housing is a superfluous design feature that is physically separable from the light fixture. Relying on Exhibit A that accompanied the first request for reconsideration, you argued that outdoor lights do not normally have housing components. Therefore, the decorative lantern housing is not part of a useful article. You interpreted the definition of useful work in Section 101 to mean that, "although copyright protection for the overall shape or configuration of an article will be

denied if 'an' intrinsic function of the work is utilitarian, particular artistic features of the article may be copyrightable under the separability test." Therefore, the decorative lantern housing is eligible for copyright because previous case law has found protection for features of useful articles analyzed as being separable from the functional aspects of such articles. In support, you cited several cases, including, Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980) and Ted Arnold, Ltd. v. Silvercraft Co., 259 F. Supp 733 (S.D.N.Y. 1966).

In support of the principle that incorporation of an ornamental work, such as a sculpture, into a useful work does not bar copyright protection for the sculptural elements of a work, you also cited Compendium II of Copyright Office Practices, Sec. 505.04; Ted Arnold Ltd. and Mazer v. Stein. You submitted that the housing and light fixture share no common features because the decorative housing is not necessary to encase the light bulb and, as evidence of that, pointed out that the housing is physically separable from the light fixture. You also restated some of the arguments made in the first letter requesting reconsideration.

Conceptual Separability

After reviewing the application, the Copyright Office Appeals Board reached the conclusion that some, but not all, of the component parts of the decorative lantern housing can be identified as separable from the utilitarian aspects of the useful object in which they are incorporated.

The definition of a useful article in Section 101 of the copyright law is 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. Sec. 101 (1994). The statute further provides that registration is possible only if and to the extent that a work contains pictorial, graphic or sculptural features that are separable from the useful article. Id.

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 "registration of claims to copyright in three-dimensional useful articles can be considered only on the basis of separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence apart from the shape of the useful article." U.S. Copyright Office, Compendium of Copyright Office Practices II, Sec. 505.02 (1984).

Section 505 of Compendium II is a direct successor to the Copyright Office regulation that was affirmed in Esquire. Based on explicit statements in the statute's legislative history, the District Court of Appeals found that the Office's regulation was an authoritative construction of the copyright law. Id. at 802-803. Esquire and later cases held that, despite an original and creative shape, the overall design or configuration of a utilitarian object may

not be copyrighted if it is not "capable of existing as a work of art independent of the utilitarian article into which [it is] incorporated." Esquire at 803-804. In Esquire, the Court held that the Copyright Office properly refused copyright registration for a useful article, in that case a light fixture, notwithstanding how aesthetically pleasing the useful article's shape or configuration may have been. Esquire at 800. Esquire most clearly enunciates the rule underlying the Office's legal analysis of whether a work is separable from the utilitarian object in which it is incorporated.

The Appeals Board found that the decorative sculptural details that append to the top and the bottom of the lantern housing are separable from the utilitarian function of the useful article in which they are incorporated. These sculptural details consist of geometric shapes arranged into a decorative knob similar to the shape of a finial. The House Report accompanying the current copyright law states that:

> 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 of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And even if the three dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.

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

The Copyright Appeals Board found that the sculptural top and bottom finial-like design elements on the lamp housing are analogous to the separable elements of carving on the back of a chair or a floral relief design on silver flatware. As such, these sculptural design elements are capable of existing as works of art independent of the utilitarian article in which they are incorporated. However, these design elements represent *de minimis* authorship. See discussion *infra*.

The rest of the lantern housing does not meet this test of separability. The housing is described in the first letter requesting reconsideration of Heath Co.'s application as a "uniquely shaped metal ... structure in a generally hexagonal shape" with "six uniquely shaped openings within which glass pieces are situated around the circumference." Only elements that can be identified separately from the utilitarian aspects of the useful article are copyrightable. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976). The hexagonal shaped housing is not separable from the function of the light fixture since it serves the purpose of containing the

light. This is a common feature of outdoor light fixtures, notwithstanding the evidence presented in Exhibit A. Although the light fixture could be disassembled to remove the housing, that is not relevant to the issue of whether the housing is separable from the utilitarian function of the useful object. Part of the definition of a useful article in Section 101 of the Copyright Law is that "an article that is normally a part of a useful article is considered a 'useful article.'" A light shade or protective covering is normally a part of a light fixture.

In further support of that point, the housing is part of a specific type of useful object, a lantern. Typically a lantern is distinguished by the fact that the light is contained within a protective case with transparent openings. See, e.g., Webster's New Collegiate Dictionary 647 (1974). Therefore, the housing is part of the useful article that is the lantern because it protects the light by containing it and the light is visible through the surrounding glass.

Nor is it relevant that the appearance of the lantern housing is unique or decorative. As was quoted above from the House Report accompanying enactment of the current copyright law, "The test of separability ... does not depend upon the nature of the design -- even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the [utilitarian aspects of the] useful article as such are copyrightable." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976). Consequently, as was stated in the Copyright Office's response to Mr. Paniaguas, unique or aesthetically pleasing qualities of the structure are not relevant to a determination of whether a component of a useful article is registrable.

Secondary Consideration:
De Minimis Authorship

In determining whether a useful article is entitled to registration, the Examining Division follows a two part analysis. First, it looks at whether or not there is any separable artistic authorship, as was done above. If there is separability, as was found with regard to the decorative sculptural details on the top and base of the lantern housing, then the Examining Division considers whether such work rises to the level of authorship required by law. 17 U.S.C. Sec. 102(a) (1994). Although the Examining Division did not proceed to this second step in the analysis, the Copyright Office Appeals Board did so because, unlike the Examining Division, it found some elements of the work to be separable.

The required level of authorship is modest. See Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991). Further, the Copyright Office follows the policy set forth in a long history of case law, beginning with Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903), which requires examination to be made on the basis of finding a certain modicum of original authorship, and not on a subjective determination of the quality or aesthetic value of a work submitted.

The Appeals Board found that the decorative sculptural details on the top and bottom of the lantern housing are not copyrightable because their authorship is *de minimis*. Nor can registration be made on the basis that the first rejection only found that there was no separable authorship and did not address this second part of the analysis.

The sculptural elements on the top and bottom of the lantern are simple variations of common design components. The common geometric shapes or arrangements lack 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 original authorship).

Under Copyright Office regulations, familiar symbols and designs are not copyrightable. 37 C.F.R. Sec. 202.1. This principle is supported by numerous judicial decisions. See John Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986) (logo of four angled lines forming arrow with the word "Arrows" in cursive script held not copyrightable); Magic Marketing, Inc. v. Mailing Services of Pittsburgh, Inc., 634 F. Supp. 769 (W.D.Pa. 1986) (envelopes printed with solid black stripes and a few words such as "priority message" or "gift check" did not exhibit minimal level of creativity necessary for copyright registration); Jon Woods Fashions, Inc. (upholding Register's decision that fabric design of striped cloth with grid of squares was not copyrightable); Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958) (cardboard star with circular center for photographs, and two folded flaps allowing star to stand for display, not a work of art within the meaning of 17 U.S.C. Sec. 5(g) (1909).

In conclusion, registration is denied because the lantern housing is not separable from the utilitarian function of the work in which it is incorporated. Further, although the sculptural designs on the top and base of the housing are separable from the utilitarian aspects of the useful article, those components are not copyrightable because their authorship is *de minimis*. These sculptural elements consist of common shapes arranged in simple designs insufficient to sustain copyright registration.

For the reasons stated in this letter, the Appeals Board affirms the refusal to register the submitted claim and is closing the file in this case. This decision constitutes final agency action on this matter.

Sincerely,

Nanette Petruzzelli

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