

September 29, 1998

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101 Independence
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Washington, D.C.
20559-6000

RE: Basketball Hoop Table: Control No. 60-504-3751(W)

Dear Mr. Boots:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated August 5, 1997, appealing a refusal to register a furniture design entitled: BASKETBALL HOOP TABLE. The letter was addressed to the Register of Copyrights and constituted the second appeal of the refusal to register the work. The appeal was forwarded to the Copyright Office Board of Appeals.

The Copyright Office Board of Appeals has examined the copyright claim and considered all of the points raised by your firm. After carefully reviewing the claim, the Board of Appeals affirms the Examining Division's decision to refuse registration because the work is a useful article which does not contain any separable copyrightable authorship.

Administrative Record

On October 20, 1995, the Copyright Office received applications, fees and identifying reproductions for two furniture designs. One design was for a folding decorative screen entitled PIANO KEYS, and the other was for a table utilizing a basketball hoop entitled BASKETBALL HOOP TABLE.

In a letter dated February 7, 1996, a Visual Arts examiner refused registration of both designs on the grounds that they lacked the artistic or sculptural authorship necessary to support a copyright claim.

In a letter dated June 4, 1996, you appealed the refusal to register the design entitled BASKETBALL HOOP TABLE. You argued that the "work comprises a creative combination of a rectangular hardwood floor base having a stylish beveled peripheral edge, a sleek, black support column having a rectangular cross section and extending upwardly

from the base adjacent a short side or end thereof, and a brightly colored basketball hoop structure supported by the black column adjacent the upper end of the column." Citing Feist Publications, Inc. v. Rural Telephone Serv. Inc., 499 U.S. 340 (1991) and Atari Games Corp. v. Oman, 888 F.2d 878 (D.C. Cir. 1989), you stated that the legal requirements for establishing creativity were extremely low and were met by the work in this case.

While the first appeal was pending, you submitted a supplement to your first letter in correspondence dated December 11, 1996. In this supplemental submission, you stated the United States Patent and Trademark Office ("PTO") "recently allowed U.S. design patent application ...directed to this design on November 27, 1996." Your supplemental statement included drawings of the design patent which had been allowed. You asserted that the PTO's action supported a finding that the design in issue met the minimum originality and creativity standards under the copyright law; that the design was both novel and nonobvious. You also asserted that the fact that the design is of useful article did prevent registration because the artistic aspect of the combination of elements presented a three-dimensional sculptural work identifiable separately from "merely a utilitarian support structure for a tabletop."

In a letter dated April 9, 1997, David Levy, Attorney Advisor for the Visual Arts Section, responded by maintaining the refusal to register on the basis of failure to meet the separability standards relating to useful articles. Mr. Levy concluded: "all of these parts [of the work] are part of the utilitarian work itself and do not contain any separable authorship." While Mr. Levy acknowledged that the creativity standard for copyright is low, he concluded that in this case the furniture design did not even meet that modest requirement.

With regard to design patent, Mr Levy concluded: "[t]he fact that a design patent has issued for this work does not mean it is necessarily copyrightable. The criteria for copyrightability and patentability are not the same."

In a letter dated August 5, 1997, you filed a second appeal addressed to the Register of Copyrights, arguing that the work contains sufficient creative expression to support a copyright claim; that the artistic aspects of the combination of elements create a separately identifiable work capable of supporting registration of the useful article; that issuance of a design patent proves the ornamental nature of the article; and finally, that at a minimum registration should be made under the rule of doubt.

Physical and Conceptual Separability

After reviewing the deposit and correspondence, the Copyright Office Board of Appeals agrees with the Examining Division's conclusion that the decorative table was a useful article lacking separately identifiable sculptural or pictorial authorship.

Section 101 of the Copyright Act 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. You accept the characterization of the table as a useful article. August 5, 1997 letter, p. 3. The Board agrees that as a table (presumably a coffee table), the BASKETBALL HOOP TABLE is a useful article.

The statute further provides that "works of artistic craftsmanship" may be protected by copyright "insofar as their form but not their mechanical or utilitarian aspects are concerned," and that the design of a useful article is protectible "if, and only to the extent that, such design incorporates 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.* (definition of "pictorial, graphic and sculptural works").

The question before the Board is whether the BASKETBALL HOOP TABLE satisfies the statutory requirement of separable pictorial, graphic or sculptural authorship. The Board concludes that it does not. Congress clarified its intent with respect to the shape of useful articles in the legislative history of the Copyright Act of 1976. Specifically, the House Report accompanying the Act states that:

> [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 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.

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

The Office's implementation of the copyright statute, including its legislative history, on this issue is reflected in Compendium II of the Copyright Office Practices, which states that claims in three-dimensional useful articles will be registered if there are 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 ("Compendium II"), § 505.02 (1984). The requisite separability may be either conceptual or physical. *Id.* See. H.R. Rep. No.1476, 94th Cong., 2d Sess. 55 (1976).

Although you argue that the utilitarian function of the BASKETBALL HOOP TABLE does not prevent registration, you do not specifically argue that the work is either physically or conceptually separable. Nevertheless, the Board has examined the work for both physical and conceptual separability and has been unable to discern any authorship separable from the shape of the article on either basis.

Physical Separability. The pictorial, graphic, or sculptural features of a work may be said to be physically separable from the shape of the work when a nonutilitarian work that is copyrightable as a pictorial, graphic or sculptural work is later incorporated into a useful article. In such cases, the preexisting copyrightable authorship remains registrable. Compendium II, § 505.04. You do not argue that this is the case with respect to the BASKETBALL HOOP TABLE, and there is no reason to conclude that it is the case.

Conceptual Separability. Conceptual separability exists 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." Compendium 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 regarding conceptual separability. Esquire held that the Copyright Office regulation properly prohibited copyright registration for the overall shape or configuration of a

utilitarian article, no matter how aesthetically pleasing that shape or configuration may be. *Id.* at 800. In fact, section 505.03 of Compendium 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 the 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).

The Office applies the rule established in Esquire that, even when there is an original and creative shape, the overall design or configuration of a utilitarian article is not copyrightable 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. The Board of Appeals concludes that the principles expressed in Esquire are applicable to the design in this case. The work consists of a floor base, and a black support column on which is mounted a hoop and net (containing a basketball). Even if the basketball hoop and basketball could be considered separable, both are themselves utilitarian and cannot support a copyright claim.

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, noting that "functional components of useful articles, no matter how artistically designed, have generally been denied copyright protection unless they are physically separable from the useful article." *Id.* at 924. In the instant case, the aesthetic appeal of the various components of the BASKETBALL HOOP TABLE does not alter the fact that they serve a useful purpose and are integral to the shape of the table. The Board cannot find any separable authorship that would justify registration of this work.

Secondary Consideration: De Minimis Authorship

Because the Board has concluded that there is no authorship in this work that is separable from its utilitarian aspects, most of the arguments in your letter, which address the originality requirement, are unhelpful. However, the Board has considered whether there would be sufficient authorship to support a registration if the basketball hoop and basketball contained in the design were conceptually separable. Even then, the Board would be unable to conclude that there is sufficient authorship in the BASKETBALL HOOP TABLE to justify registering the work.

In considering this work for copyright registration, the Board of Appeals is uncertain whether the basketball hoop and basketball are real or merely facsimiles. If they are real, the items cannot support a copyright claim because they are utilitarian objects. If they are facsimiles, they represent mere trivial variations of these familiar utilitarian objects, and as such, cannot be considered copyrightable.

The most distinctive feature of your client's work appears to be incorporating a basketball hoop into a table design. Clearly a copyright cannot be based on a basketball hoop or a trivial variation of a basketball hoop. Nor can the idea of incorporating a basketball hoop into a furniture design support a copyright claim.

Under Copyright Office regulations, familiar symbols and designs are not copyrightable. 37 C.F.R. § 202.1. This principle is supported by numerous judicial decisions. *See* John Muller & Co. v. New York Arrows Team, Inc., 802 F.2d 989 (8th Cir. 1986)(logo of four angled lines forming an 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 v. Curran, 8 USPQ2d 1870 (S.D.N.Y. 1988)(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 with the meaning of 17 U.S.C. § 5(g)(1909)). A basketball hoop and a basketball are equally familiar objects which, when incorporated into a design, are ineligible for copyright protection. Neither the case of Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991), nor Atari Games Corp. v. Oman, 888 F.2d 878 (D.C. Cir. 1989), depart from this long-recognized principle.

Design Patent

Your appeal letter cites issuance of a design patent as proof of the ornamental nonfunctional aspects of the design. However, the issuance of a design patent is irrelevant to a determination on copyright registration. 37 C.F.R. § 202.10(a). The design patent statute and the copyright law provide fundamentally different tests of eligibility. The House Report of the 1976 Copyright Act, H.R. Rep. No. 1476, 94th Cong. 2d Sess. 55 (1976), cited "the shape of an automobile, airplane, ladies' dress, food processor, or any other industrial product" as being outside of the scope of copyright if the items lacked separately

identifiable artistic authorship. These items may qualify for design patent protection without separately identifiable artistic authorship if they meet the tests under the design patent statute. The election doctrine was abandoned in 1995 due, in part, to the differences in the nature of protection. 60 FR 15605-15606 (1995).

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 furniture design in the case fails to meet that test. The Board of Appeals did not find it appropriate to register the work 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.

Compendium II, § 108.07.

In the instant case, the Office, exercising its authority and discretion to determine copyrightability under 17 U.S.C. § 410(a)(1995), concludes that there is no separable and copyrightable authorship present in this useful article. The work does not present a novel question for registration either in 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 nonseparability.

For the reasons stated above, no registration can be made for these works.

This letter constitutes final agency action.

Sincerely,

David O. Carson
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for the Appeals Board
U.S. Copyright Office

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