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July 23, 1999

Dana Stangel-Plowe, Esq.
Debevoise & Plimpton
875 Third Avenue
New York, New York 10022

Re: Star Clock and Star Mirror; Sun Clock and Sun Mirror; Bottle Cap Lamp and Candlestick
Copyright Control Number: 60-508-9854(L)

Dear Ms. Stangel-Plowe:

The Copyright Office Board of Appeals has reviewed your request for reconsideration of the Office's refusal to register the above-referenced works. After a careful examination of the application, deposit material, and all related correspondence, as well as statutory and case law, the Board has determined that "Star Clock and Star Mirror," "Sun Clock and Sun Mirror," and "Bottle Cap Lamp and Candlestick" cannot be registered, because each work lacks sufficient copyrightable authorship to support a claim to copyright registration.

Administrative Record

On March 13, 1997, the Copyright Office received applications, fees, and photocopies as deposits from claimant Richard Ladd, who wished to register five titles, all described as "3-Dimensional Sculptures Furniture." The works appear to be furniture and accessory pieces adorned by bottle caps.

In a letter dated July 19, 1997, Visual Arts Examiner James Shapleigh explained that the works could not be registered because they lacked the sculptural authorship necessary to support claims. Mr. Shapleigh wrote that there was no copyrightable authorship in any of the five works submitted.

First Request for Reconsideration

In a letter dated August 5, 1997, you explained that Mr. Ladd's work was well known overall, and asserted that the five Ladd works embodied sufficient originality to support copyright registration. You described the works and added that the designs for the pieces were the result of "years of artistic development and innovation." First appeal letter at 1.

You cited three cases initially as support for your argument that as long as there is a minimal degree of creativity in the arrangement of familiar shapes, a work may be registered for copyright protection. These were Odegard, Inc. v. Costikyan Classic Carpets, Inc., 963 F.Supp. 1328 (S.D.N.Y. 1997) (finding random arrangement of asterisk-like symbols on carpeting design copyrightable in case involving derivative works); Theotokatos v. Sara Lee Personal Products, 971 F.Supp. 332 (N.D. Ill. 1997) (finding designs copyrightable); and Runstadler Studios, Inc. v. MCM Ltd. Partnership, 768 F.Supp. 1292 (N.D. Ill. 1991) (sculpture made of glass pieces embodied original copyrightable authorship).

Office's Second Response: Registration of Two Works, Refusal to Register Three Works

The Office responded in a letter dated October 21, 1997, from Attonrey-Advisor Virginia Giroux, stating that after reviewing the Ladd works, the Office had determined that "Vertical or Horizontal Mirror" and "Bottle Cap Short Box" would be registered as sculptural works. The letter explained why the remaining three works could not be registered.

The letter discussed the concept and definition in copyright law of a "useful article," noting that registration is possible only for separable authorship embodied in a work. It described the Office standard in that regard, citing Compendium of Copyright Office Practices, Compendium II § 505.03 (1984). It noted that examples of conceptually separable works that may be registered include the carving on the back of a chair or pictorial matter engraved on a glass vase. Office's second refusal letter at 1-2.

The letter also discussed copyrightable authorship, noting that to be registered, a work must be original and must contain at least a minimal amount of creative authorship. See Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951). The bottle caps used in the designs in question consisted of sequences of circular rings arranged in standard geometrical forms. The letter concluded that this would not constitute copyrightable authorship under copyright regulations at 37 C.F.R. § 202.1 and noted that the

works did not meet the authorship standard articulated in Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991).

Ms. Giroux's letter stated that the "effects" created by the arrangements of bottle caps in the works submitted may have been the result of creative effort, but did not embody copyrightable authorship, citing John Muller & Co. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986) and Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q.2d 1879 (S.D.N.Y. 1988).

The cases you cited in your correspondence, Odegard, Runstadler Studios, and Theotokatos, were distinguished because they "involved authorship that is more complex than the works at hand." Office's second refusal letter at 3. Thus, the three works at issue could not be registered.

Applicant's Second Appeal Letter

In a letter dated December 10, 1997, you requested reconsideration of the refusal to register the three remaining Ladd works. You recounted the history of correspondence concerning the works, noting that two were registered after first reconsideration. You stressed that the threshold for registrable authorship under Feist is very low, so that the works should be registered, and again noted that authorship in the works was original as well as creative. Second appeal letter at 2.

Reviewing Bottle Cap Lamp and Candlestick, Star Clock and Star Mirror, and Sun Clock and Sun Mirror, you claimed that "[n]one of the designs can fairly be said to be obvious or inevitable or lacking in creative authorship." Id. at 3. In addition, you cited Prestige Floral Societe Anonyme v. California Artificial Flower Co., 201 F.Supp. 287 (S.D.N.Y. 1968) (artificial flower copyrightable because it reflected originality, independent judgment, and skill).

You argued that the works embodied copyrightable elements including the choice of bottle caps made to create varying shapes and dimensions, and placement of bottle caps at angles in relation to each other to create effect. Second appeal letter at 4. You claimed that the choices Mr. Ladd made resulted in copyrightable original authorship.

You disagreed with the Office's assertion in its second refusal that the designs involved in cases you had cited were "more complex" than your client's designs. You also cited Concord Fabrics, Inc. v. Marcus Bros. Textile Corp., 409 F.2d 1315 (2d Cir. 1969) (fabric design marking of a circle within a square within a square); Prince Group, Inc. v.

MTS Products, 967 F.Supp. 121 (S.D.N.Y. 1997) (irregularly shaped polka dots in fabric design registered by the Copyright Office validly registered); Folio Impressions, Inc. v. Byer California, 937 F.2d 759 (2d Cir. 1991) (upholding copyright in design of roses placed in rows in fabric design registered by the Copyright Office); and Feist, to argue that the Ladd works contained sufficient authorship for copyright protection.

Decision of the Copyright Office Board of Appeals

The Appeals Board upholds the Examining Division's decision not to register these works because they lack sufficient original authorship to support claims to copyright protection.

Useful Articles

The works in question are clocks, mirrors, a lamp and a candlestick. Although you do not address the issue, all are clearly useful articles. The fact that these works are useful articles does not necessarily disqualify them from copyright protection, but registration is possible only if there is authorship separable from the utilitarian aspects of the articles.

Copyright law defines a useful article as "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 (definition of "useful article"). The statute further provides that copyright protection and registration is possible only if and to the extent that a work contains pictorial, graphic or sculptural features that are separable from the utilitarian aspects of the article. 17 U.S.C. § 101 (definition of "pictorial, graphic, and sculptural works"). Congress clarified its intent with respect to the shape of useful articles in the legislative history of the 1976 Copyright Act. Specifically, the House Report accompanying the current copyright law 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.

H.R. Rep. No. 94-1476, at 55 (1976).

Based on these provisions of law and the legislative history, the Office applies a separability test that is contained in Section 505 of Compendium II. Section 505 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.

Compendium II, § 505.02. The requisite separability may be either conceptual or physical. *Id.* See. H.R. Rep. No.1476, 94th Cong., 2d Sess. 55 (1976).

Physical Separability. Compendium II § 505.04, provides the following guidance with respect to physical separability:

> The physical separability test derives from the principle that a copyrightable work of sculpture which is later incorporated into a useful article retains its copyright protection. Examples of works meeting the physical separability test include a sculptured lamp base of a Balinese dancer, or a pencil sharpener shaped like an antique car. However, since the overall shape of a useful article is not copyrightable, the test of physical separability is not met by the mere fact that the housing of a useful article is detachable from the working parts of the article.

The Board has found no basis to conclude that any of these works meet the test for physical separability. In fact, your arguments for copyrightability based on the overall shape of each of the useful articles in question demonstrate the lack of physical separability.

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). If the artistic features can be imagined separately and independently from the useful article without destroying its basic shape, those features may be conceptually separable. *Id.* Section 505.03 provides a useful example:

> Thus, carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for registration.

The Board has found it difficult to identify sculptural features that are independent of the shape of each of the useful articles in question. The clearest case for conceptual separability appears to be in the graphic elements on the face of each of the bottle caps, but Mr. Ladd can and does claim no authorship in those elements. Moreover, the elements that you emphasize in your letter all relate to the shape of each of the works, which you claim represents sculptural authorship. Because that claim to authorship relates to the shape of each of the useful articles, your arguments about Mr. Ladd's creativity are not particularly helpful at this stage of the inquiry. To remove those elements would destroy the basic shape of each of these useful articles. See Compendium II, § 505.03:

> The test of conceptual separability, however, is not met by merely analogizing the general shape of a useful article to works of modern sculpture, since the alleged "artistic features" and the useful article cannot be perceived as having separate, independent existences. The shape of the alleged "artistic features" and of the useful article are one and the same, or differ in minor ways; any differences are de minimis. The mere fact that certain features are nonfunctional or could have been designed differently is irrelevant under the statutory definition of pictorial, graphic, and sculptural works. Thus, the fact that a lighting fixture might resemble abstract sculpture would not transform the lighting fixture into a copyrightable work.

See also Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), where 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. *Id.* at 800.

Legislative history also demonstrates that it s irrelevant that the appearance of the article may be unique or decorative. As was stated in 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. 94-1476, at 55 (1976).

One might argue that some or all of the bottle caps in the works are separable features because they adorn the items rather than function as part of those objects. However, it appears that in most or all cases the bottle caps actually are integral parts of the useful

articles, being the material from which the useful articles are made and forming the shapes of the useful articles. The bottle caps do not appear to be the type of surface embellishments such as a "carving on the back of a chair, or pictorial matter engraved on a glass vase," see Compendium II, § 505.03, that qualify as conceptually separable authorship. And of course, Mr.Ladd cannot claim to be the author of the sculptural or graphic elements of any of the bottle caps themselves.

De Minimis Authorship

Because the Examining Division, in ruling on your first appeal, assumed that the works "may contain physically or conceptually separable elements," first appeal letter at 2, and addressed whether the works contained sufficient creative authorship to be copyrightable, the Board has also examined the works to determine whether, regardless of the issue of separability, there is copyrightable authorship. The Board could find no (or at best, *de minimis*) authorship.

The Board acknowledges that, as you argue, the required level of authorship is modest. *See* Feist Publications. However, some works fail to meet that standard. The Court held in Feist that the originality required for copyright protection consists of "independent creation plus a modicum of creativity." 499 U.S. at 346. 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, and that there can be no copyright in works in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359. The Court also recognized that some works, such as a "garden-variety white pages directory devoid of even the slightest trace of creativity," are not copyrightable. *Id.* at 362.

The Compendium II has long recognized this principle, stating that "[w]orks that lack even a certain minimum amount of original authorship are not copyrightable. Such works are often described as 'de minimis,' in reference to the principle embodied in the Latim maxim 'de minimis non curat lex.'" Compendium II, § 202.02(a). With respect to pictorial, graphic & sculptural works, the class within which the subject works would fall (*see* 17 U.S.C. § 102(a)(5)), the Compendium II states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Id.*, § 503.02(b). The Compendium recognizes that it is not aesthetic merit, but the presence of creative expression that is determinative of copyrightability, *id.*, and that "registration cannot be based upon standard designs which lack originality,. . . . Similarly, it is not possible to copyright common geometric figures or shapes in three-dimensional form, such as the cone, cube, or sphere. . . . [T]he creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard

forms or shapes with minor linear or spatial variations." *Id.* See also Compendium II, § 503.02(a) and section 202.1(a) of the Copyright Office regulations, 37 C.F.R. § 202.1(a) ("familiar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained").

The case law confirms these principles. *See* 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); John Muller & Co., *supra* (logo of four angled lines forming arrow with the word "Arrows" in cursive script held not copyrightable); Magic Market, 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., *supra* (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)).

You do not appear to contest the fact that each of the articles for which registration is sought consist of 'familiar elements" (Second appeal letter at 2). Rather, your argument is that Mr.Ladd's authorship consists of his "artistic placement and configuration" of those elements, resulting in "original and creative sculptural designs." The Board finds that each of the designs in question consists of a combination of basic shapes, none of which exhibit original authorship when examined individually. The question, then, is whether the combination of familiar shapes in any of the articles in question exhibits sufficient authorship.

The "Sun Clock" and "Sun Mirror" each consist of a round object (a mirror or a clock), framed by two concentric rings of bottle caps. Without considering the use of the bottle caps, this configuration is clearly inadequate to meet even the minimal creatively requirements of Feist. Essentially, you are seeking to register a design consisting of two concentric circles. See second appeal letter at 4. Mr. Ladd's decision to construct the article out of bottle caps does not consitute cognizable authorship. Nor is it sufficient that in the outer circle, the bottle caps are "oriented in a manner perpendicular to the mirror" and in the inner circle, the bottle caps "are placed flat on the surface." See second appeal letter at 4. You have also asserted that the bottle caps in the inner circle are 'sequenced according to color," but you have not provided color images that reveal such a sequence, and in any event it is highly doubtful that such a sequence of colors would rise to the level of copyrightable authorship.

The "Star Clock" and "Star Mirror" each consist of a round object (a mirror or a clock), a circle (composed of bottle caps) from which 16 rays radiate at equidistant intervals. The rays are in three different lengths: the longest rays are at 0°, 90°, 180°, and 270°(or 12:00, 3:00, 6:00 and 9:00); the intermediate rays are placed halfway between each pair of the longest rays at 45°, 135°, 225°, and 315°; the shortest are placed halfway between each pair of the intermediate rays at at 22.5°, 67.5°, 112.5°, 157.5°, 202.5°, 247.5°, 292.5°, and 337.5°. This regular, predictable placement of simple geometric figures (straight lines) around another simple geometric figure (a circle) is insufficient to constitute copyrightable authorship.

The "Bottle Cap Lamp" and Bottle Cap Candlestick" each consist of a straight rod (made of a stack of bottle caps) circled by two (candlestick) or three (lamp) rings of equal size and an additional ring of somewhat larger size at the base, in a commonplace pattern similar to those found in many popular and long-existing lamps and candlesticks.

The Board does not deny that Mr. Ladd's decision to make these articles out of bottle caps results in an aesthetically pleasing effect, or that the decision to use bottle caps is a creative and artistic idea. But if the shapes of each of these articles are not copyrightable, the fact that the articles are composed of bottle caps does not add any authorship; the decision to use bottle caps is clearly an idea not subject to copyright protection. See 17 U.S.C. §102(b).

Nor is the selection and arrangement of these basic shapes sufficient to supply the authorship that is missing from the shapes themselves. As is apparent from the descriptions set forth above, the combination of elements in each case is too simple to qualify for copyright protection. Again, "[T]he creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations." Compendium II, § 503.02(b).

The cases you rely on in support of registration involved works in which original authorship was more apparent than it is with respect to Mr. Ladd's works. In Odegard, the court found that the plaintiff's designs were not "precise and rigidly geometric," but rather were "consciously designed ... to be less rigid than previous 'star designs.'" 963 F. Supp. at 1331. The court found that "the plaintiff's less rigid and non-geometric figures are distinct from traditional eight-pointed figures," id. *at* 1335, and had "the required 'unmistakable dash of creativity.'" *Id.* Also contributing to the finding of copyrightability was the court's finding that "the plaintiffs' arrangement of these motifs, and their use in this particular design scheme of small motifs, arranged so as to leave considerable negative space, would be sufficiently original to be copyrightable." *Id.* Such elements are absent from Mr.Ladd's creations. While you attempt to analogize the spaces between the rings to

the "negative space" commented upon by the court in Odegard, the court was clearly talking about something more than a small gap between two or three rings. Rather, the court was discussing the overall layout of the design, including the artistic choice to leave considerable space between each of the "asterisks" that was a component of authorship in that case.

Tennessee Fabricating Co. v. Moultrie Mfg. Co., 421 F.2d 279 (5th Cir. 1970), a pre-Feist case, involved a "filigree pattern of the unit was formed entirely of intercepting straight lines and arc lines," but in a way that the court found "was original with the artist employed by plaintiff." The case sheds no further light on the nature of the pattern, apart from the fact that it appeared on an "architectural metal casting unit intended for use in combination or singly for a decorative screen or room divider to 'finish up' a space." Tennessee Fabricating certainly does not stand for the proposition that any combination of intercepting straight lines and arc lines satisfies the originality requirement in copyright law. Some such combinations will be sufficient; others will not.

In Folio Impressions, the court said nothing about the copyrightability of the rose itself apart from the fact that the defendant had failed to overcome the presumption of validity that arose out of the Copyright Office's issuance of a certificate of registration. The case involved an image of a rose. Certainly, such an image may be copyrightable if it is drawn with sufficient creativity and originality. Further light is shed by the findings of the district court in Folio Impressions, which concluded that the rose in that case was original, observing, "Each single rose blossom contains a three-pronged stem topped by a precisely drawn configuration of lines resembling a bloom with the lines arranged in exactly the same way. Respecting the originality of the Folio Rose itself, the court finds that Folio's rose blossom is an original creation." Folio Impressions, Inc. v. Byer California, 752 F. Supp. 583, 588 (S.D.N.Y. 1990). The district court further observed that the rose consisted of "a disjointed configuration of thick and thin lines" and that, in comparison to the defendant's rose, it had " sharper edges, a three pronged stem, and presents a much more geometrically stylized appearance. *Id.* at 591-92. Thus, it is fair to conclude that the rose in Folio Impressions was a work of art sufficiently original for copyright protection. Folio Impressions offers no guidance as to the copyrightability of Mr. Ladd's works. Folio Impressions also found that the arrangement of the plaintiff's roses, consisting of placing the roses in a straight line but turning them so that they faced in various directions, was copyrightable. 937 F.2d at 764. You have not asserted any similar claim of original arrangement based upon the orientation of figures in various directions.

In Runstadler, the court observed that the artist's "choice of location, orientation and dimensions of the glass panes, and the degree of arc of the spiral, show far more than a trivial amount of intellectual labor and artistic expression on plaintiff's part." 768 F. Supp. at 1295-96. In Prestige Floral, the court concluded that the creator of the

artificial flowers in question made "numerous and detailed decisions as to 'proportion, form, contour, configuration, and conformation,'" and that plaintiff's lilac reflects originality and a substantial degree of skill and independent judgment." 201 F. Supp. at 291. Prince Group involved polka dots that were "irregularly shaped, and not the perfect circles of a standard polka dot." 967 F. Supp. at 125. The polka dots were shaded, "that is, there is a crescent of white around half of the perimeter of each of the dots which is different from the standard uniformly colored polka dot, and they consist of several different colors. Thus, the shape and the shading of the dots are sufficiently original to meet the threshold of creativity." *Id.* In addition, the court emphasized the plaintiff's "decision to place the polka dots in imperfect and conflicting diagonal lines at varying distances from each other giving the appearance of randomness, ... thus, establishing a sufficient level of creativity for copyright validity." *Id.*

In Theotokatos, the court found creativity in the plaintiff's arrangement of national flags, Olympic rings, torch, and historical references in his designs, noting that the "arrangements do not follow any established pattern of presenting flags and Olympic symbols." 971 F. Supp. at 339. The court found a "'more than trivial' amount of creative effort to his designs in determining the exact layout of the national flags of past host countries and the central torch design with its specific combination of the Olympic torch and rings with the flags of the United States and Greece and the historical references to commemorate the one-hundred year anniversary of the Summer Olympic Games." *Id.* Thus, copyrightable authorship was found in the author's selection and arrangement of particular flags and Olympic symbols in a particular order. No such selection and arrangement is present in Mr. Ladd's works.

Moreover, in each of the cases cited above, the court reached the issue of copyrightability only after applying the presumption of validity arising from the Copyright Office's issuance of a certificate of registration. See 17 U.S.C. § 410(c). Of course, no such presumption is present in this case.

Concord Fabrics, a brief *per curiam* opinion involving a motion for a preliminary injunction, did not address the issue of copyrightability, which apparently was not contested. Therefore, it sheds no light on the issue.

In the cases you rely on, the courts upheld the validity of registrations issued by the Copyright Office for works determined to possess more (albeit sometimes little more) than de minimis authorship. In other cases, courts have upheld the Office's refusals to register works of *de minimis* authorship, giving deference to the expertise the Office has developed while administering the copyright law. See John Muller & Co, *supra*; Jon Woods Fashions, *supra*; Homer Laughlin China Co. v. Oman, 22 U.S.P.Q. 2d 1074 (D.D.C. 1991)

(upholding Register's determination that there was insufficient creative authorship in "Gothic" chinaware design pattern to merit copyright protection).

Conclusion

Because there is no authorship separable from the utilitarian aspects of these useful articles, and because any arguably separable authorship is *de minimis* at best, the Copyright Office Board of Appeals affirms the Examining Division's decisions not to register the works "Star Clock and Star Mirror," "Sun Clock and Sun Mirror," and "Bottle Cap Lamp and Candlestick." This decision constitutes final agency action.

Sincerely,

David O. Carson
General Counsel
for the Appeals Board
United States Copyright Office