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OFFICE

July 20, 1999

Re: Clock Collection
Control No. 60-601-2753(H)
Applicant: M.Z. Berger & Co., Inc.

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CONGRESS

Dear Mr. Helfgott:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated January 12, 1998, addressed to the Assistant Chief of the Examining Division. On behalf of your client, Wayne E. Crist, you appealed the Copyright Office's refusal to register a work entitled "Clock Collection" which consists of a single work, a clock. The Copyright Office Board of Appeals affirms the Examining Division's refusal to register.

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Administrative Record

On October 2, 1996, the Copyright Office received a Form VA application for copyright registration from M.Z. Berger & Co., Inc ("Berger"). The application was for a work entitled "Clock Collection" which was described in the application as an ornamental and decorative enhancement for a clock.

In a letter dated February 28, 1997, the Examining Division refused to register Clock Collection. The letter stated that the law does not extend copyright protection to useful articles, But that any element that is separable from the useful work and that contains a minimum amount of original artistic material is copyrightable. The Examining Division determined that the application in question is for a useful article because the work functions as a clock, and denied registration because it found no elements that are separable from the clock.

In a letter dated March 13, 1997 you sought reconsideration of the refusal to register the claim. You asserted that the clock contains both physical and conceptually separable features. With regard to physical separability, you argued that the clock and the bottle shaped design could be separated without spoiling the artistic features of the

decorative bottle shape. You applied the conceptual separability test adopted by the Court in Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987). On the basis of that test, you argued that the author was not constrained or influenced by functional considerations in designing the decorative bottle shape; therefore the decorative elements are conceptually separable.

You also stated that the decorative bottle shape is copyrightable. You pointed out that the author is claiming copyright in the overall design, not its individual elements which include basic geometric shapes that do not satisfy the requirement of having a minimal amount of artistic creativity. You described the bottle shape as having a "subtle blend of sculptural angles, shapes, and contours" rather than being one simple geometric shape.

In response, in a letter dated November 25, 1997, the Examining Division again denied registration to Clock Collection. The letter recited the earlier refusal to register on the basis that the works are useful articles that have no physically separable elements. The letter pointed out that the test for conceptual separability employed by the Copyright Office is not based on Brandir Int'l Inc. v. Cascade Pacific Lumber Co. Rather, the Office follows the test found in Compendium of Copyright Office Practices, Compendium II ("Compendium II"), § 505.03 (1984). On the basis of that test, the Examining Division found that the shape of the useful article and the shape of the "artistic bottle shaped" design were identical. *See* Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978) and Norris Indus., Inc. v. Int'l Tel. and Tel. Corp., 696 F.2d 918 (11th Cir. 1983). The Examining Division viewed the bottle shape casing as part of the utilitarian article that cannot be separated from the clock without destroying the basic shape of the clock.

The Examining Division also determined that even if the decorative elements were physically or conceptually separable, they consist of minor variations of familiar symbols and designs. The Examining Division concluded that the work fails to meet the minimal amount of creativity required for copyright protection under Feist Publications Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991).

In a letter dated January 12, 1998, you submitted a second request for reconsideration. You again argued that the sculptural features of the clock are physically and conceptually separable from the utilitarian function of the clock. Applying the physical separability test set forth in Compendium II, Copyright Office Practices, Section 505.04, you said that the square clock can be removed from the frame leaving the decorative bottle shape intact. Applying the conceptual separability test set forth in

Compendium II, Section 505.03, you said that the decorative bottle shape can be imagined separately from the functional clock features. You distinguished this work from the useful article that was refused copyright protection in Esquire v. Ringer because the useful article in Esquire was identical to its decorative elements. Distinguishing the clock from the work at issue in Esquire, you argued that the decorative bottle shape is superfluous sculptural design serving no function, which is separate from the useful article itself.

You also responded to the Examining Division's conclusion that, if the decorative elements are separable, they do not contain copyrightable authorship because they lack the minimal amount of creative expression. You argued that the decorative bottle shape is not a common bulbous shape, like an ordinary bottle, but a unique shape that incorporates a series of sloping surfaces.

Physical and Conceptual Separability

You do not contest that a clock is a useful article, and the Board finds that the clock for which registration is sought is a useful article. The fact that the clock is a useful article does not necessarily disqualify it from copyright protection, but registration is possible only if there is authorship separable from the utilitarian aspects of the clock. The Board of Appeals has concluded that there are no component parts of the clock that are separable from its utilitarian aspects.

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 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"). 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 of the Copyright Office Practices. 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.

U.S. Copyright Office, Compendium of Copyright Office Practices 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).

You have argued that there is both physically and conceptually separable authorship in the clock. We shall address physical and conceptual separability in turn.

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 clock, and there is no reason to conclude that it is the case. Instead, you argue that the "clock *could be* physically removed from the decorative shape such that the sculptural features exist independently of the utilitarian clock aspect of the article." (Emphasis added.) The fact that part of a work *could* be severed from the remainder of the work does not make it physically separable in the sense contemplated by § 505.04. See Masquerade Novelty, Inc. v. Unique Industries, Inc., 1990 U.S. Dist. LEXIS 556 (E.D. Pa. 1990) ("A test of physical separability is employed when two or more objects have been combined to create a useful article").

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.

You argue that "the artistic features of the clock design, that of a decorative bottle, can be imagined separately from the functional clock portion of the design. Without too much of a strain of imagination, one could envision a fully realized decorative bottle existing side by side with the functional clock." But the fact remains that, with the possible exception of the semi-precious stones embedded in the work, the separable

authorship that you attempt to identify is found in the shape of the clock itself. While the semi-precious stones could be analogized to a carving on the back of a chair or pictorial matter engraved on a glass vase, the shape of the clock itself, even if it is a shape reminiscent of a bottle, is by definition the shape of the useful article.* One could remove a carving from the back of a chair or pictorial matter engraved on a glass vase without destroying the shape of the article itself. One could not remove what you call the "sculptural features of the clock design" without destroying the shape of the article itself. The difference between the aspects of a useful article that might be conceptually separable and those, such as the article's shape, which may not, is illuminated by the observation of the court in Norris Industries v. Intern. Tel. & Tel. Corp., 696 F.2d 918 (11th Cir. 1983), where the court discussed "conceptually separable elements of useful articles such as a carving on the back of a chair and a floral relief design on silver flatware." The court observed, "These items are ornamental, superfluous designs contained within useful objects." *Id.* at 923-24. The same obviously cannot be said of the shape of the useful object itself.

As § 505.03 of Compendium II states,

> 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.

Nor does the fact that the clock may resemble the shape of a bottle transform the clock into a copyrightable work.

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* However, the placement of the stones in a square pattern around the edge of the clock face could fairly be described as being a part of, or dictated by, the square shape of the clock face.

This conclusion is consistent with 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. 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. (Emphasis omitted)

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

Section 505 of Compendium II is a direct successor to the Copyright Office regulation that was affirmed by the D.C. Circuit Court in Esquire, Inc. v. Ringer. Esquire clearly enunciated the rule underlying the Office's legal analysis of whether a work is separable from the utilitarian article in which it is incorporated. Based on explicit statements in the statute's legislative history (quoted above), the Court found that the Office's regulation was an authoritative construction of the copyright law. *Id.* at 802-803. As Esquire held, despite an original and creative shape, the overall design or configuration of a utilitarian article 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. *Id.* at 800.

Nor is it relevant that the appearance of the clock 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).

***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 are any design elements that are separable from the function of the useful article, which was discussed above. If there is any separable work, then the Examining Division considers whether such work rises to the level of authorship required by law. 17 U.S.C. § 102(a). The Board recognizes that the placement of semi-precious stones around the square perimeter of the clock face is separable from the shape of the clock, except to the degree that the stones are placed in a manner that conforms to the square shape of the clock face. The question with respect to the stones is whether the choice and placement of stones rises to the level of copyrightable authorship.

We note that you have not specifically argued that the choice or placement of semi-precious stones in the clock constitutes copyrightable authorship. However, because you mention the "semi-precious stones embedded in a frame of gold tone on a background of silver tone" as part of your description of the "design choices made by the author," we assume that such an argument has been presented to the Board.

To be sure, the required level of authorship is modest. *See* Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991). 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 Board has concluded that the decorative details found in the placement of the semi-precious stones around the clock face are not copyrightable because any authorship is *de minimis*. The stones are placed in a square pattern, a common geometric shape or arrangement that lacks the originality and creativity needed to support a copyright claim. 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). The Compendium elaborates that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." Compendium II, § 503.02(b) (1984). 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. 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 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. (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)).

If the arrangement of the stones is not copyrightable, all that is left is the choice of stones. You do not argue that there was any copyrightable authorship in that selection, and none is apparent from the deposit.

Finally, the Board notes that even if the "bottle shaped clock design" were separable from the clock itself, nevertheless any authorship in that shape would be *de minimis*. The shape of the clock is hexagonal, with sloping sides around the face of the watch, and with a round knob at the top. As discussed above, such simple geometric shapes do not rise to the level of copyrightable authorship.

In conclusion, registration is denied because the decorative details in the clock are not separable from the utilitarian function of the work in which they are incorporated. Further, even assuming that the decorative details were separable, they are not copyrightable because their authorship is *de minimis*.

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

Sincerely,

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

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