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March 12, 1999

J. Allison Strickland, Esq.
Fross, Zelnick, Lehrman & Zissu, P.C.
633 Third Avenue
New York, New York 10017-6754

Control Number: 60-601-875(W)
Re: VIZIO HINGE BOX

Dear Ms. Strickland:

On behalf of the Copyright Office Appeals Board, I am responding to your March 2, 1998 letter appealing a refusal to register the VIZIO hinge box of your client Movado Group, Inc. The letter constituted a second appeal of the refusal to register this work.

The Board has examined application, the work, and the correspondence from your firm concerning the application. It has also examined the actual VIZIO hinge box that you supplied pursuant to the Board's request of June 23, 1998. We thank you for submitting the box, which assisted the Board in its review of the appeal. However, after careful examination of the actual work and consideration of all correspondence from your firm concerning this claim, the Board denies registration because this work does not demonstrate any copyrightable subject matter.

Summary of Administrative Record

The Copyright Office received an application for registration of the Vizio hinge box on November 4, 1996. By letter dated March 27, 1997, Visual Arts Examiner John Ashley refused registration on the ground that the work, as a useful article, did not contain any features that could be identified as separable authorship that also constitute a copyrightable work of art.

The Office received your appeal of Mr. Ashley's refusal on May 12, 1997. You disagreed with the conclusion that the VIZIO hinge box does not contain separable elements that are capable of copyrightability, arguing that the level of creativity required to support copyright registration is minimal. You urged that even a work made of familiar shapes and symbols may be copyrightable if their arrangement exhibits the requisite originality.

On December 12, 1997, the Examining Division advised you in a letter from Virginia Giroux, Visual Arts Section Attorney, that it had denied the first appeal. The Examining Division agreed that a minimal amount of creativity is required, and that familiar shapes and symbols may be arranged in a copyrightable way, but still concluded that this particular useful article contained no physically or conceptually separable elements that, alone or in combination, could be regarded as copyrightable.

On second appeal, you asserted that the overall shape of the article should not be excluded from consideration and that the design on the box lid, an intricate arrangement of lines creating the appearance of depth, should be given special attention. You also stated, in support of the hinge box's conceptual separability, that the hinge conjures up in the mind a visual reference to the bracelet of the VIZIO watch. You asserted that the Examining Division should have taken into account the design on the top of the box, the semi-circular hinge, the choice of material from which the box was made, and the shape of the box.

Useful Article

In drawing a clear line between copyrightable works of applied art and uncopyrighted works of industrial design, Congress withheld protection from the shape of an industrial product — even though it might be aesthetically satisfying and valuable — unless the shape contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article. See 17 U.S.C. § 101 (definition of "pictorial, graphic, and sculptural works"); H.R.Rep. No. 94-1476, at 55 (1976).

You appear to understand that there can be no protection for the shape of the box; your March 2, 1998 letter states (at p. 2) that "Applicant does not seek protection for the shape of the box, but it does seek protection for the overall inter-relatedness of the aesthetic design features as they appear in the context of the box." You state that copyrightability may be found because the shape of the box "resulted from specific aesthetic design considerations not driven by" the article's utilitarian nature.

The fact remains that the box is a useful article — "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. The function of the box is to serve as a container for a watch. Although the box may also serve aesthetic ends of its designer, it remains a useful article as defined by the Copyright Act.

Separability

Because the VIZIO hinge box is a useful article, the question before the Board is whether the it 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 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. 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).

The Board has examined the VIZIO hinge box for both physical and conceptual separability and has been unable to discern any authorship separable from the shape and utilitarian aspects of the article on either basis. The Board has discerned one aspect of the box design, identified in your March 8, 1998 letter as a protectible design element, which is separable: the design on top of the box which, in your words, "is comprised of an intricate arrangement of lines and shadings in a repeating three-dimensional pattern." We discuss whether that design contains sufficient authorship to support copyright registration in the next section. First, however, we address whether any of the other elements identified by you as elements of authorship are physically or conceptually separable from the utilitarian aspects of the box.

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 VIZIO hinge box, and there is no reason to believe that it is the case.

Conceptual Separability. You do contend that aspects of the design of the VIZIO hinge box are conceptually separable. 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. Thus, the Compendium states, in section 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.

The principles expressed in Esquire and the Compendium are applicable to the design in this case. The work consists of box with a hinge connecting the top of the box from its base. The design of the box, including its overall shape, the hinge and the material* from which the box is made, is utilitarian and cannot support a copyright claim. The box is simply a cube, the ordinary shape that a box takes, broken only by the cylindrical shape of the hinge inserted at midpoint halfway into the back of the box. The shape of the hinge is also an ordinary, garden variety shape found, for example, on all door hinges. Neither the box nor the hinge, each shaped in its traditional way, exhibits anything beyond utilitarian shape.

You assert that the hinge "conjures up in the mind of the beholder" a separable concept because it "incorporates a visual reference to the bracelet of the VIZIO watch." We cannot evaluate this assertion of the subjective impression of one who looks at the box and the watch because our files contain no evidence of the appearance of the VIZIO watch or its bracelet. In any event, the hinge is in the shape of a conventional hinge; if the watch bracelet contains the same shape, that similarity does not result in copyrightable authorship in the hinge of the box.

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

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* Although you argue that the selection of the material from which a sculptural work is made involves a deliberate decision and choice of one medium over another, you cite no authority for the proposition that the choice of material (e.g., the choice to make a sculpture out of marble rather than bronze) is an act of original authorship that, either by itself or in combination with other factors, would confer copyright protection on a work. Nor is the Board aware of such authority. Just as the shape of a useful article is not separable from its utilitarian aspects, the material from which the article is made also is not separable from its utilitarian aspects.

protection. The Board concludes that it does not. The design consists of nothing more than a series of concentric circles — a common geometric figure arranged in a series of regular rows. Familiar symbols, such as circles and portions thereof, without more, are not copyrightable. Compendium II, §503.02(a) (1984). The statement in Atari that "simple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection," is inapplicable here. There is no distinctive selection or combination of simple shapes in the design of the box's surface. There is one simple shape, repeated regularly.

As such, the box is unlike the works mentioned in the cases you cite. Tennessee Fabricating Co. v. Moultrie Manufacturing Co., 421 F.2d 279, 282 (5th Cir. 1970) (room divider design made up of intercepting straight lines and arc lines, described as a filigree pattern, which by definition is intricate ornamental work); In Design v. Lynch, 689 F. Supp. 176, 177-78 (S.D.N.Y.) *aff'd,* 863 F.2d 45 (2d Cir. 1988)(design of background, superimposed parallelograms of different sizes, orientations, color, took the court three paragraphs to describe); Amplex Mfg. Co. v. A.B.C. Plastic Fabricators, Inc., 184 F.Supp. 285 (E.D.Pa. 1960) (overall authorship consisted of pictorial illustrations of various products which required court to determine whether subpart of a copyrightable design was copyrightable); Reader's Digest Association, Inc. v. Conservative Digest Inc., 821 F.2d 800 (D.C.Cir. 1987) (predominantly a trade dress case, finding on copyright claim that there was a " distinctive arrangement and layout" of various individual elements, resulting in a "unique graphic design and layout"); Concord Fabrics, Inc. v. Marcus Brothers Textile Corp., 409 F.2d 1315, 1316 (2d. Cir. 1969) (intricate designs of circles within squares within squares, with ornamentation within circles, between the squares and around the outer square, and frames around the border running in opposite directions and figures around the outer part of the circle); Folio Impressions v. Byer California, 937 F.2d 759 (2d Cir. 1991)(basic figure, a rose, was copyrightable, placed in horizontal rows repeated against an ornate background); Soptra Fabric Corp. v. Stafford Knitting Mills, Inc., 490 F.2d 1092 (2d Cir. 1974) (numerous elements in addition to strips of crescents, scalloping between the strips and multiple rows of semicircles in a distinct pattern; court observed that "Good eyes and common sense may be as useful as deep study of reported and unreported cases, which themselves are tied to highly particularized facts," citing Couleur International Ltd. v. Opulent Fabrics, Inc., 330 F.Supp. 152, 153 (S.D.N.Y. 1971)).

Finally, you note that the description of the ring box in Dan Kasoff, Inc. v. Gresco Jewelry Co., 204 F.Supp 694 (S.D.N.Y. 1962) *aff'd*, 308 F.2d 806 (2d Cir. 1962), could "just as easily describe" the watch box in this case. Although the description may resemble your assessment of the authorship in this work, the Board has also viewed the actual ring box and found the artistic content in that work to be vastly more substantial than that in this design. The Kasoff ring box is embedded with a gem and pearl pattern of

sculptured ribbon in a fanciful criss-cross design, and has an embossed woven pattern around the circumference of the box.

This work is more like that in Jon Woods Fashions Inc., v. Curran, 8 U.S.P.Q. 2d 1879 (S.D.N.Y. 1988); (2 inch stripes with grid superimposed held not copyrightable); John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986); (logo not copyrightable); and OddzOn Products, Inc. v. Oman, 16 U.S.P.Q. 2d 1225 (D.D.C. 1989), *aff'd*, 924 F.2d 346 (D.C.Cir. 1991). In OddzOn, the court of appeals affirmed the Register's refusal to register the *Koosh* ball, a spherical ball made up of wiggly filaments which project out from a core, because it did not exhibit enough creativity beyond its shape to warrant copyright protection. So here, beyond its shape, the hinge box exhibits only the finish on the top of the box. Although you distinguish Jon Woods Fashions and John Muller & Co. as involving "simple two-dimensional" works, that is not a distinction from the one conceptually separable element of the design of the VIZIO hinge box, which is the two-dimensional design appearing on the surface of the top and bottom of the box.**

Finally, you submit that if there remains any doubt as to the copyrightability of the work, the rule of doubt requires registration. The short answer is that there is no doubt as to the copyrightability of the work: it is not copyrightable. Therefore, the Board has no alternative but to refuse registration.

This decision letter constitutes final agency action. The box is being returned under separate cover.

Sincerely,

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

** You describe that design as being "three-dimensional." Although the design may be somewhat three-dimensional in *appearance*, the surface itself is actually two-dimensional.