August 9, 2002

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James V. Costigan, Esq.
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1185 Avenue of the Americas
New York, NY 10036

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Re: MANTLE PIECE
Control No. 60-610-6198(H)
LINEA SILVER
Control No. 60-711-7586(H)
SANTA FE/VERDIGRIS
Control No. 60-713-1496(H)
OVAL, GREEN/GOLD
Control No. 60-713-2466(C)
STEPS, BRASS; APOLLO; and MACINTOSH, BLACK
Control No. 60-713-3017(H)

101 Independence
Avenue, S.E.

Washington, D.C.
20559-6000

Dear Mr. Costigan:

This is in response to your letter of July 25, 2000, requesting a second appeal of the Copyright Office Examining Division's refusal to register the above titled works. I apologize for the delay in responding. For the reasons stated below, the Copyright Office Appeals Board affirms the Examining Division's refusal to register because the works lack *sufficient original authorship*.

Administrative Record

During the month of October of 1998, your client American Tack & Hardware Company filed a series of copyright applications for the above titled works. Each of these works is a light switch wall plate. Visual Arts Examiner William Briganti refused registration for OVAL, GREEN/GOLD, Visual Arts Examiner Joy Mansfield refused registration for MANTLE PIECE and SANTA FE/VERDIGRIS, and Visual Arts Examiner John Martin refused registration for LINEA SILVER; STEPS, BRASS; APOLLO and MACINTOSH, BLACK.

On June 19, 1999, you filed a letter with the Examining Division requesting a first appeal of the seven rejections. You stated that the seven wall plates were a group of related

works collectively known as the Montage Series Wallplates and therefore submitted them together for review. You acknowledged that the seven wall plates are "useful articles" as defined in section 101 of the Copyright Act, but argued that each contained conceptually separable elements that merited copyright registration. For each of the wall plates, you asserted that their centers may be physically separated from the outer frame and that "the separated original design may be used to decorate a picture frame or a mirror frame."

On March 28, 2000, Attorney Advisor Virginia Giroux responded to your appeal and upheld all seven rejections of the wall plate designs. Ms. Giroux applied the separability test for useful articles articulated in section 505.04 of the Compendium of Copyright Office Practices, Compendium II. Although the center of the wall plate detached from its outer frame, Ms. Giroux determined that this did not meet the physical separability test of section 505.04 because the sculptural elements of the wall plates for which registration was sought were not themselves physically separable from the wall plates. She then analyzed the wall plates to determine if there were sculptural elements that were conceptually separable from the utilitarian functions of the wall plates, and concluded that five of the wall plates did possess conceptually separable elements: MANTLE PIECE; LINEA SILVER; SANTA FE VERDIGRIS; STEPS, BRASS; and APOLLO. However, for each of these wall plates, Ms. Giroux determined that the conceptually separable elements were nothing more than common geometric shapes that are not subject to copyright protection. 37 C.F.R. 202.1. She also concluded that there while the arrangement of these common geometric shapes may be aesthetically pleasing, they did not furnish a basis for registration because they exhibited no copyrightable authorship.

For the OVAL, GREEN/GOLD and MACINTOSH, BLACK wall plates, Ms. Giroux concluded that there were not any elements that were conceptually separable from the utilitarian function of the items. Consequently, these wall plates were also not registerable.

On July 25, 2000, you submitted your second appeal of the Examining Division's refusal to register any of the seven wall plates. Your letter focused primarily on issues of conceptual separability, saying little about the requirement of of copyrightable authorship. For the reasons stated below, the Copyright Office Board of Appeals affirms the decision of the Examining Division.

Separability

In your second appeal, you again submit that the center portion of each of the seven wll plates is removable and that the separated portion could be used to decorate a picture frame or a mirror frame. We assume that you mean that outer frame of the wall plate, with the center portion removed, could serve as a picture or mirror frame. You also assert in your second appeal that the center portion, once removed, could be used as the decorative

endplate on a bookend or as a wallhanging, provided that the two screw holes and the toggle switch hole were removed or covered up.

Useful articles that have detachable parts can often be used in multiple ways, some of them useful and others purely aesthetic. However, the capability of the removed parts to serve other purposes has no bearing on the copyrightability analysis. Sections 505.02 and 505.04 of Compendium II articulate the standard applied by the Copyright Office for designs that are physically separable. Section 505.02 provides that "[r]egistration 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." If the useful article has physically separable parts or elements, then these parts or elements must themselves possess the necessary creativity to warrant registration. "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 in 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." Physical removal of the center portion of each wall plate would destroy the wall plates' ability to serve as light switch covers. In determining the copyrightability of a useful article, the Copyright Office bases its determination on what the useful article is (in this case, light switch covers), not upon what other useful article or articles the item could become if it were physically pulled apart.

Consequently, the Montage series wall plates must be considered under the conceptual separability test described in section 505.03 of Compendium II. That section provides:

> Conceptual separability means that the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for example, or as free-standing sculpture, as another example, independent of the shape of the useful article. For example, the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article. The artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works – one an artistic work and the other a useful article.

The Office also notes the factors that should not be taken into consideration when applying the separability test: 1) the aesthetic value of the design; 2) the fact that the shape could have been designed differently; or 3) the amount of work that went into the making of the design. Compendium II, §505.05.

De Minimis Authorship

No registration is possible where the work consists solely of elements that are incapable of supporting a copyright claim. Uncopyrightable elements include geometric figures or symbols, such as a hexagon, and arrow, and a five-pointed star. Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958)(cardboard star with two folding flaps allowing star to stand for display not a copyrightable work of art).

> [R]egistration cannot be based upon standard designs which lack originality, such as common architectural moldings, or the volute used to decorate the capitals of Ionic and Corinthian columns. Similarly, it is not possible to copyright common geometric figures or shapes in three dimensional form, such as th cone, cube or sphere. The mere fact that a work of sculpture embodies uncopyrightable elements, such as standard forms of ornamentation or embellishment, will not prevent registration. However, the 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).

This rule, long applied by the Office in examining claims, is consistent with the Supreme Court's observation in Feist Publications v. Rural Telephone Services, 499 U.S. 340, 363 (1991), 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," 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.

In examining the seven wall plates, the Appeals Board agrees with Attorney Advisor Giroux that five of the wall plates – MANTLE PIECE; LINEA SILVER; SANTA FE VERDIGRIS; STEPS, BRASS; and APOLLO – do have some elements which are conceptually separable from the wall plate, but all of these elements are nothing more than combinations of simple geometric designs. MANTLE PIECE consists of a simple graduated step design on all four sides with simple rectangles at the top. LINEA SILVER is nothing more than horizontal lines in parallel. SANTA FE VERDIGRIS consists of a simple zig zag shape on all four sides accompanied by small circular holes. STEPS, BRASS is a graduated step design consisting of nothing more than four rectangles laid over the top of one another, each slightly smaller than the rectangle below it. APOLLO consists of parallel lines on all four sides, suggestive of a simple colonnade, with raised pyramids at each corner. None of the geometric shapes present in these wall plates, either alone or in combination, are sufficient to warrant registration.

With respect to MACINTOSH , BLACK, the Board determines that there are conceptually separable elements – the double squares in each of the four corners of the wall plate. This simple double square design does not warrant registration. And with respect to OVAL GREEN/GOLD, the Board agrees with Attorney Giroux that there does not exist any authorship that is conceptually separable from the wall plate without completely destroying the shape of the article. *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess (1976)(separable pictorial, graphic or sculptural design must exist independently of the article without destroying its basic shape).

In short, the Board can find no copyrightable authorship in any of the wall plates that are the subjects of this appeal.

Finally, you request that the Board consider the wall plates subject to this appeal in comparison with previously registered wall plates from the Montage collection. The Copyright Office does not compare designs in the course of examining works for registration. Homer Laughlin China v. Oman, 22 U.S.P.Q. 2d 1074 (D.D.C. 1991), citing Compendium II §108.03. Each work submitted for registration is evaluated on its own merits, applying the principles stated above. The fact that an individual examiner might have – perhaps erroneously – accepted for registration a work that arguably is nor more creative than the subject works does not require the registration of the latter works when the Board finds them wanting. Indeed, if the Board were to accept your invitation to review the earlier-registered wall plates, the result might well be a decision to cancel those registrations if the Board were to conclude that they contained no separable copyrightable authorship.

For the reasons stated above, the Copyright Office Board of Appeals concludes that non of the seven wall plates can be registered for copyright protection. This decision constitutes final agency action on this matter.

Sincerely,

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