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September 30, 2002

Sherry Gunn Hanlon
Blackwell Sanders Peper Martin, LLP
720 Olive, 24th Floor
St. Louis, Missouri 63101

Re: Cub Condo Design No. 1
Control Number: 60-701-1042(B)
Cub Condo Valentine Design
Control Number: 60-7-3-6928(B)

Dear Ms. Hanlon:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated August 7, 2000, on behalf of your client Build-A-Bear Workshop L.L.C., appealing a refusal to register the works "Club Condo Design No. 1," and "Cub Condo Valentine Design." The Copyright Office Board of Appeals has carefully examined the applications, the deposits, and all correspondence related to the above-referenced works. It has also reviewed those cases which you cite where registration was made and which you claim are analogous to your client's. The Board has determined that a registration cannot be made in a claim in three dimensional sculpture for these works. It has also determined that registrations can be made in claims in two-dimensional artwork on the surface of the sculpture. The Board therefore is affirming the decision of the Examining Division.

**Administrative Record**

The Copyright Office received the applications for, respectively, "Cub Condo Design No. 1" on March 4, 1999, and "Cub Condo Valentine Design" on April 7, 1999. The nature of both works was described as "three dimensional sculpture and artwork." In a letter to attorney Alan S. Nemes dated September 14, 1999, Examiner Ivan Proctor refused to register the claim in the three-dimensional sculpture for the work entitled Cub Condo" Design No. 1, noting that it was a useful article without separable copyrightable authorship. He did, however, offer to make a registration for the artwork on the sculpture upon the completion of a revised application. On November 10, 1999, Examiner Joy Mansfield sent a similar rejection letter to Mr. Nemes concerning the work entitled Cub Condo Valentine Design.[1]

[1]Both examiners gave Mr. Nemes 120 days to reply and limit the claim to artwork.

On January 12, 2000, attorney Sondra D. Schol wrote Mr. Procter asking for a reconsideration of the refusal to register Cub Condo Design No. 1. Although Ms. Schol admitted that the work in question was a "carrying case," or "packaging" for a purchaser, she also asserted that it was a sculptural work intended to be used as a toy house. (Schol letter of January 12, 2000 at 2). Ms. Schol cited the case of Gay Toys, Inc. v. Buddy L. Corp, 703 F.2d 970 (6th Cir 1983) in support of her argument that her client's work was copyrightable as a toy and not a useful article. She argued that the shape of the box, the openings, the roof, the window frames, and flower boxes are pictorial works of authorship. Finally she asserted that the Office has registered sculptural works which are toy houses. On February 11, 2000, Ms. Schol sent a letter styled a First Appeal to Joy Mansfield concerning Cub Condo Valentine Design, asserting that the refusal to register was made on the basis of insufficient copyright authorship and that the work contained a "sufficient degree of creativity to meet the minimum requirement for originality and authorship."

On April 11, 2000, Virginia Giroux, Attorney-Advisor for the Examining Division, responded to both of Ms. Schol's requests for reconsideration. Ms. Giroux upheld the earlier refusals to register these works as three-dimensional sculptures. She noted that the Schol letters did not dispute that the works had a functional purpose, to serve as a "carrying case," and that in order to be classified as a "useful article," a work need only have one known utilitarian function. She further noted that if a work is a useful article, it needs to have separable copyrightable authorship in order to be subject to registration. She again offered a registration for the "2-dimensional artwork." Despite the fact that the Office does not compare works, Ms. Giroux looked at the previous registrations to which Ms. Schol had referred in her letter to Mr. Procter and confirmed that the sole function of each was merely to portray the appearance of the article and that each contained a sufficient amount of authorship to support a registration.

In a letter dated August 7, 2000 and styled Second Appeal, you requested reconsideration of the refusal to register these two works. You assert that refusal to register based on the premise that the works were useful articles was inaccurate. You stress that the works were designs of toy playhouses that could be registered for copyright protection. You argue that even though the works can be useful, they are toys, not useful articles. You rely on Gay Toys, Inc. v. Buddy L. Corp., 703 F.2d 970 (6th Cir. 1983) for the argument that toys, including models of actual objects, are not useful articles, and although functional as toys, such works are not intrinsically utilitarian. As such, works submitted as toys may not be denied registration based on evaluation that they are useful articles. You also claim that the Office denied registration because the applicant's works are commercially marketed, and make a point that this is irrelevant when considering whether to register a work.

## DECISION

The Board begins with a review of the works in question. The two works at issue are boxes or containers largely used for carrying or storing objects such as toys. Although it is

possible that one may play with the containers, their main aspect is functional. Consequently, the Board agrees with the Examining Division that the works have at least one intrinsic utilitarian function, *i.e.*, the capacity to be used for storage and transport purposes.[2] Therefore, for the purpose of analyzing your application for registration, the functional nature of the works requires that they be treated as useful articles under copyright law.[3] The Board must, therefore, necessarily determine whether there is sufficient separable authorship to support registrations for three-dimensional sculpture.

**Useful Articles and Separability**

As Ms. Giroux explained in response to the first request for reconsideration, the analysis used in examining a work in the useful article category starts with a determination of whether the work contains any pictorial, graphic, or sculptural authorship that is physically or conceptually separable from the utilitarian aspects of the article. The Office's test for conceptual separability is set out in section 505.03 of the Compendium of Copyright Office Practices, Compendium II (1984).

Under applicable copyright law and practices, a useful article may be entitled to copyright protection only if it contains pictorial, graphic or sculptural features that "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C.§ 101 (definition of pictorial, graphic or sculptural works) (emphasis added).

Separability The legislative history of the Copyright Act of 1976 provides some guidance on the separability analysis. 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

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[2] While the Board agrees that the commercial exploitation of a work is not to be considered in determining whether that work is a useful article, it also notes that the Examining Division's determination that these works are useful articles was not based on its commercial exploitation, but rather on the fact that the works in question are boxes and that these boxes have an intrinsic utilitarian function of storing or carrying items, including toys.

[3] A useful article is defined 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. See also letter of Ivan Proctor to Alan S. Nemes of September 14, 1999.

> 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.

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

The Office uses a separability test, set forth in section 505.02 of the Compendium of Copyright Office Practices, Compendium II, (1984) ("Compendium II"), which is based on the statutory definitions and legislative history. Section 505.02 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. Determination of separability may be made on either a conceptual or physical basis.
>
> *Physical Separability*. The test for physical separability is as follows:
>
> 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 sculptural 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.

Compendium II, § 505.04 (1984). The Board has found no basis to conclude that either Cub Condo Design No. 1 or Cub Condo Valentine Design meets the test for physical separability. Any actual physical removal of the sculptural components, *e.g.*, the house shape and sloped roof, or the cut-out features, e.g., door and windows, would not be possible without destroying the work in its entirety. Because there are no identifiable, physically separable elements, the Board then

considered whether there were any conceptually separable elements in these works.

*Conceptual Separability*. Conceptual separability exists when pictorial, graphic, or sculptural features are "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. Section 505.03 provides a useful example:

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

The Board can find no sculptural features that are independent of the shape of the useful article in question. The Board agrees with Ms. Giroux that the sculptural aspects–the house shape and sloped roof– and the cut-out features–door and windows–are part of the overall shape, contour, and configuration of the container or carrying case itself. To remove these elements would destroy the basic shape of the useful article. As section 505.03 of the Compendium II states:

> The test for conceptual separability, however, is not met by 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* Esquire v. Ringer, 591 F.2d 795 (D.C. Cir. 1987)(upholding refusal to register an outdoor lighting fixture); *see also* Norris Industries, Inc. v. International Tel. & Tel. Corp., 696 F.2d 918 (11th Cir. 1983)(wire-spoked wheel cover non-copyrightable useful article not containing any separable sculptural design). Here, the house shape and sloped roof as well as the cut-out windows and doors are "part of the overall shape, contour, and configuration of the carrying case itself, not conceptually separable from the work's utilitarian function without destroying its basic shape."

You also argue that the works in question are similar to the toy model airplane in Gay Toys, Inc. v. Buddy L. Corp., 703 F.2d 970 (6th Cir. 1983), where the court found that a toy airplane was "merely a model which portrays a real airplane" having no intrinsic utilitarian function other than the portrayal of the real airplane, *id.* at 973, 974, and are thus not useful articles. The Board disagrees with your conclusion that each of these designs is "a toy model of a house, and is thereby protectible without regard to how it is used. If the toy airplane at issue

in Gay Toys was filled with shampoo, the design of the plane would still have been protected. Whether the plane was capable of containing other items would not affect the sculptural aspects which made it eligible for copyright protection." Hanlon letter of August 7, 2000 at 2. As Ms. Giroux explained, Gay Toys is distinguishable from the case at hand because there the court found that the toy airplane was not a useful article because it had no intrinsic utilitarian function, as it was merely a model which portrayed a real airplane and was a copyrightable three-dimensional work of applied art. Here, however, the designs in question do more than just portray a toy house; each has an intrinsic utilitarian function, namely, it is a container or carrying case for stuffed animals. Furthermore, earlier admissions concede that the works in question have a useful function.[5]

**Two-dimensional artwork**

As Ms. Giroux and the two examiners noted, the two-dimensional graphics applied to the surface of the Cub Condo containers are conceptually separable from the boxes themselves and exhibit sufficient original authorship to support registration. The Board affirms this assessment. Should your client wish to pursue registrations for two-dimensional authorship, please advise us within 30 days of the date of this letter.

**Conclusion**

In summary, neither Cub Condo Design #1 nor Cub Condo Valentine may be registered as three dimensional sculptural works because they function as useful articles. The two dimensional authorship of graphic art that adorn the containers are not the subject of this appeal, although they have been found to be copyrightable. The containers themselves lack the modicum of separable original authorship needed to support a copyright claim. For these reasons, the Appeals Board affirms the refusal to register these works as three-dimensional sculptures. This decision constitutes final agency action on this matter.

Sincerely,

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

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[5] "[T]hus, the utilitarian nature of the work is merely a carrying case or packaging as such." January 12, 2000 letter from Sondra D. Schol to Ivan Proctor.