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April 11, 2003

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Re: WORM LIGHT
Control No. : 60-706-0310 [L]

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Dear Mr. Beuerle:

I am responding to your second request for reconsideration of the copyright claim in the work WORM LIGHT submitted for registration in 2000. Before proceeding, I take this opportunity to apologize for the long delay in our response. The Copyright Office Board of Appeals has considered your arguments for registration of WORM LIGHT and has concluded that the work contains no separable features that are also copyrightable.

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I. Administrative Record

On February 28, 2000, the Copyright Office received an application for registration of the work WORM LIGHT. The application was sent by Richard G. Frenkel of the Los Angeles office of Lyon & Lyon and was submitted on behalf of Nyko Technologies, Inc., claiming copyright in the work. By letter dated March 1, 2000, Visual Arts Section examiner Joy Mansfield refused registration for the work. Ms. Mansfield stated that the work is a useful article in which separable features were identified but that these separable features did not represent a sufficient amount of original authorship to sustain a registration. [Mansfield 3/1/00 letter at 1, 2]

By letter dated July 27, 2000, Mr. Frenkel replied to Ms. Mansfield and appealed the refusal to register the claim. Mr. Frenkel pointed out that WORM LIGHT was created as a fanciful shape and that the shape was not functionally dictated [Frenkel 7/27/00 letter at 2]; that the District Court for the Central District of California, in a preliminary injunction grant, had determined that the trade dress of WORM LIGHT was not functional [Id., at 3]; that WORM LIGHT possessed physically and conceptually separable design elements [Id., at 4,6,7]; and that WORM LIGHT possessed the necessary degree of creativity mandated under relevant case law [Id., at 5].

In response to this first request for reconsideration [first appeal], the attorney for the Examining Division, Virginia Giroux, wrote on September 7, 2000, again refusing registration for WORM LIGHT. Ms. Giroux, unlike Ms. Mansfield, did not get to the analysis of whether separable features were copyrightable. Rather, Ms. Giroux concluded that the work in question contained no separable authorship. [Giroux 9/7/00 letter at 3]. Although she distinguished WORM LIGHT from the works in question in Mazer v. Stein, 347 U.S. 201 (1954) and in Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., 74 F.3d 488 (4th Cir. 1996) [Giroux 9/7/00 letter at 3], Ms. Giroux relied principally on the statute's legislative history as well as the Office's administration of registration principles found in the Compendium of Copyright Office Practices, Compendium II (1984) in concluding that the work in question exhibited no separable features, thus obviating the need for an analysis of creativity as required by Feist [Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991)]. [Giroux 9/7/00 letter at 1,2,4].

By letter dated January 3, 2001, you submitted a second request for reconsideration [second appeal] of the Office's refusal to register WORM LIGHT. You point out a contradiction in the Office's handling of the registration in this case: The examiner conceded that WORM LIGHT contained separable design elements. The examiner then concluded, however, that these elements did not constitute copyrightable authorship because they did not meet the Feist standard of sufficient creativity. The Examining Division attorney, however, concluded that the separability requirement had not been met for this work. [Beuerle 1/3/01 letter at 2]. You argue that WORM LIGHT does meet both the physical and the conceptual separability requirements and that it is, therefore, copyrightable. In support of your argument, you cite a number of cases as well as emphasizing Professor Denicola's law review article on useful articles and the separability issue. [Beuerle 1/3/01 letter at 3-8]. Further, citing case law, you argue that the creativity requirement under Feist is met in WORM LIGHT and point to the aesthetic considerations which underlie the creation of the work. [Beuerle 1/3/01 letter at 9, 10].

We now consider your arguments in detail and provide the Office's response in again refusing registration for WORM LIGHT.

II. Useful articles and separability

A. The statute

The copyright law sets forth the guiding principle regarding the extent of copyright protection for a useful article. The statute defines this protection in the following terms: "the design of a useful article... shall be considered a pictorial, graphic or sculptural work only if, and only to the extent that, such design incorporates 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. The legislative history accompanying the 1976 Copyright Act clarified Congress's intent with respect to copyright protection for useful

articles: "... to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976). The House Report further explains Congress's intention that "although the shape of an industrial product may be aesthetically satisfying and valuable, [Congress'] intention is not to offer it copyright protection..." Id. Specifically addressing the issue of the "shape" of an industrial product, the House Report goes on to state that:

> 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.

Id.

B. Copyright Office Compendium

Compendium II, the Copyright Office's manual of practices with respect to examination of claims to copyright registration, addresses registration of the works of the visual arts [chapter 500] which include the "pictorial, graphic and sculptural works" to which the statute refers. Chapter 500's treatment of separability provides guidelines which explain how the Copyright Office approaches the examination of useful articles in order to determine whether such articles incorporate the statutorily-required "pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the articles." In the case of conceptual separability, Compendium II, 505.03, states:

> Conceptual separability means that the pictorial, graphic and 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, i.e., 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.

In the case of physical separability, Compendium II, 505.04, states:

> 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. 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 Office's position and its Compendium articulation of that position is consistent with the statutory grounds for protectibility of pictorial, graphic and sculptural works which are incorporated within useful articles. The statute's definitional guideline for determining whether protectible features exist apart from the **utilitarian aspects** of the useful article does not explicitly delineate the meaning, i.e., the scope and range, of utilitarian aspects which must be taken into account in performing such separability judgment. Although "utilitarian aspects" might appear, on first consideration, to be language which is plain on its face, Congress saw fit to include the above cited explanatory discussion of the subject within the legislative history of the 1976 Copyright Act.

The House Report also specifically refers to Copyright Office regulations, promulgated in the 1940's, on this subject of separability as the regulations applied to useful articles and industrial design. The House Report [at 54] notes that the 1976 statutory language is "drawn from" those Office regulations and that part of the language is "an adaptation" of subsequent Office regulatory language which implemented Mazer v. Stein, 347 U.S. 201 (1954) [works of art incorporated into useful articles, such as mass-produced articles of commerce, may retain their copyright protection]. Courts, under both the 1909 and the 1976 Acts, have considered the appropriate extent of protection for artistic features incorporated into useful articles and have consistently recognized the expertise of the Copyright Office in its administration of the registration activity for this category of works, including confirming Office registration decisions. *See, e.g.,* Norris Industries, Inc. v. International Telephone and Telegraph Corp., 696 F.2d 918 (11th Cir. 1983); Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978); Vacheron and Constantin - Le Coultre Watches, Inc. v. Benrus Watch Company, Inc. 260 F.2d 637 (2d Cir. 1958); SCOA Industries, Inc. v. Famolare, Inc., 192 U.S.P.Q. 216 (S.D.N.Y. 1976); Ted Arnold, Ltd. v. Silvercraft Co., 259 F. Supp. 733 (S.D.N.Y 1966).

Concerning the Office's Compendium tests for separability, the relevant Compendium sections essentially confirm the case law which supports the long history of the Office's interpretation. In Esquire v. Ringer, referring to the useful article passage from the 1976 House Report, above, the United States Court of Appeals for the District of Columbia Circuit stated that the passage "indicate[s] unequivocally that the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright." Esquire, Inc. v. Ringer, 591 F.2d 796, 804 (D.C. Cir. 1978).

Although Esquire was decided under the 1909 Act, the Court made clear that its references to the provisions of the 1976 Act were appropriate because "the new Act was designed in part to codify and clarify many of the [Copyright Office] regulations promulgated under the 1909 Act, including those governing 'works of art.' " Id. at 803. The Office's position with respect to the interpretation of the separability issue was also confirmed by the 11th Circuit in Norris Industries, Inc. v. International Telephone and Telegraph Corporation in which the Court noted Congress' intention concerning the statutory language on separability and additionally noted that other federal courts have relied upon the Office for "expertise in the interpretation of the law and its application to the facts presented by the copyright application," based upon the Office's having "been concerned with the distinction between copyrightable and noncopyrightable works of art since the Copyright Act of 1870..." Norris, 696 F.2d at 922. And, although it was a case brought under the Administrative Procedure Act [5 U.S.C. 701 - 706], Custom Chrome, Inc. v. Ringer nevertheless once again confirmed that the Office's refusal– premised on the Compendium tests– to register motorcycle parts was not arbitrary, capricious, an abuse of discretion and otherwise not in accordance with law. 35 U.S.P.Q.2d 1714 (D.D.C. 1995).

C. Your separability arguments

1. Physical separability

You have stated that WORM LIGHT includes sculptural authorship that is physically separable. [Beuerle 1/3/01 letter at 3]. You base this conclusion on the fact that the "worm-shaped plastic casing of WORM LIGHT can be physically separated from the underlying utilitarian articles, i.e., plug, conductive wire and LED," i.e., that the "disassembly and separation" of the plug, wire and LED from the plastic casing can be "accomplished by ordinary means." [Id. at 3-4] You cite as authority for your position that the possibility of such disassembly of the components of WORM LIGHT leads to the conclusion of physical separability the cases of Ted Arnold, Ltd. v. Silvercraft Co., 259 F. Supp. 733 (S.D.N.Y. 1966) and Mazer v. Stein, 347 U.S. 201 (1954).

As we have indicated above, Compendium II, 505.04, states explicitly that the fact that housing of a useful article is detachable from the working parts of the article does not mean that the useful article, by that fact, exhibits physical separability. Ted Arnold, citing Mazer, points out that the antique telephone sculpture which served as the casing for a pencil sharpener still existed independently as a work of art, capable of sustaining copyright protection. 259 F. Supp. at 735-736. The court in Ted Arnold, indicating the lack of functionality with respect to the entire telephone sculpture at issue in that case, explained that the separable feature of the antique telephone sculpture was "no more necessary to encase a pencil sharpener than a statuette is to support a lamp." Id., at 735. We do not find a parallel between the Ted Arnold telephone sculpture and the casing which follows the outline of, and surrounds, the wiring and plug components of WORM LIGHT. It is a given that some kind of covering is necessary for the wiring and plug if they are to undergo manipulation and use by the consumer, and, thus, the

covering chosen– as part of the useful article– cannot be considered a physically separable feature of the useful article. We point out the second sentence of the statutory definition of "useful article": "an article that is normally a part of a useful article is considered a useful article." 17 U.S.C. 101. It is common, perhaps we can say even requisite, for electrical and electronic articles to contain casing or sheathing surrounding wiring, plugs, transistors, connectors, etc., in order that the wiring and other components may be effectively employed within the article in question. Detachment of the relevant casing would result in something other than the WORM LIGHT article; the casing itself may remain intact, as you have indicated [Beuerle 1/3/01 letter at 4] but the casing is not the equivalent of WORM LIGHT-- rather, it is merely part of the entire WORM LIGHT article.[1]

Further, the plastic casing of WORM LIGHT, including the elliptical head, are part of the overall shape of the article and, under the House Report's explanatory guidance [above at 2,3], this overall shape, although it may be termed aesthetically pleasing, is not the subject of copyright protection. Finally, we cite the concurring opinion in Esquire v. Ringer. In his concurrence, Judge Leventhal stated that the "overall legislative policy against monopoly for industrial design sustains the Copyright Office in its efforts to distinguish between the instances where the aesthetic element is conceptually severable and the instances where the aesthetic element is inextricably interwoven with the utilitarian aspect of the article." 591 F.2d at 807. Although the reference in this passage from Esquire's concurring opinion is to conceptual separability, we consider the statement equally applicable to physical separability in emphasizing the underlying congressional philosophy with respect to the extent of copyright protection for useful articles under the 1976 Act. We consider the casing, or sheathing, of WORM LIGHT– which casing follows the path of the operating parts of WORM LIGHT as they are connected and which casing provides protection to those operating parts as WORM LIGHT is used by the consumer– to be inextricably interwoven with the utilitarian aspects of the article. Thus, we see no physically separable features capable of sustaining registration.

2. Conceptual separability

You have also argued that WORM LIGHT contains features which are conceptually separable from its utilitarian aspects in accord with Compendium II's articulation of the principle. You specifically enumerate the conceptually separable elements to be : 1. the spiral, worm-like body; 2. the elliptical, UFO-shaped head with visible angled ridges or ribs; 3. the overall shape, i.e., the combination of [1] and [2]. [Beuerle 1/3/01 letter at 5]. You then again specifically identify the features which you consider to be conceptually separable as the "spiral, worm-like body and the elliptical, generally UFO-shaped head with visible angled ridges or

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[1] We also take this opportunity to note that the issue in Mazer was not separability but, rather, whether copyright protection already secured for a pictorial, graphic or sculptural work would end once that work was incorporated into a useful article. Mazer decided that such copyright protection continues. 347 U.S. at 214.

ribs" *as well as* the "overall shape or configuration of WORM LIGHT." Id., at 6. You also cite Professor Denicola's proferred test for separability and the Second Circuit's approval of that test in Brandir International, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987). [Beurele 1/3/01 letter at 7] Your argument that Professor Denicola's test should apply in judging WORM LIGHT's separability is based on the reasoning that the elements which you have enumerated "reflect the designer's artistic judgment exercised independently of functional influences." [Id., at 7].

We consider WORM LIGHT to be a useful article subject to the need for separability in order to enjoy any copyright protection. You have stated that you "do not dispute that the WORM LIGHT is a useful article." [Beuerle 1/3/01 letter at 1]. Considering Professor Denicola's test, the Brandir Court adopted that test for determining conceptual separability. That test considers whether or not a given feature or aspect of a useful article "reflects a merger of aesthetic and functional considerations;" if so, the artistic features of the useful article cannot be said to be conceptually separable; if not, conceptual separability may exist. 834 F.2d at 1145. Professor Denicola's test encompasses a consideration of the design process involved in the useful article in question as well as the artistic choices of the creator of the article and whether the artistic aspects of the article were significantly influenced by the functionality requirements. 67 Minn. L. Rev. 707 (1983). We point out that the Office does not follow the Denicola test; nor does it follow any of the other separability tests proferred by other scholars and commentators.[2] Because of the possible problems which the Denicola and other tests might engender, premised as they are, at least partly, on subjective perception and because such tests might result in registration of works in conflict with the expressed Congressional intent to deny copyright protection to the design of useful articles which happen to be aesthetically pleasing [above at 2,3], the Copyright Office has also not adopted these particular alternative separability tests.

We also take this opportunity to state that the fact that aspects of a useful article could have been designed differently is not relevant with respect to the test of conceptual separability that is used by the Copyright Office, a test frequently upheld by the courts [above at 4] and one not permitting protection for artistic or aesthetically influenced aspects or features of a work that constitute the shape, or part of the shape, of the useful article. "The mere fact that certain features... could have been designed differently is irrelevant to the statutory definition of pictorial, graphic and sculptural works." Compendium II, section 505.03. You have cited Severin Montres, Ltd. v. Yidah Watch Co., 997 F. Supp. 1262 (C.D. Cal. 1997), aff'd 165 F.3d 917 (9th Cir. 1998) in its use of the Denicola separability test. [Buerele 1/3/01 letter at 7, fn.

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[2] The Copyright Office also does not follow the alternative separability test proferred by Judge Newman in his dissent in Carol Barnhart. Carol Barnhart, Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985). Judge Newman's test, sometimes referred to as a "temporal displacement" test, would take into consideration whether the observer of the useful article in question would be able to arrive at a "separate, non-utilitarian concept that can displace, at least temporarily, the utilitarian concept." 773 F.2d at 423.

5]. Again, the Office has not implemented the Denicola test. And, concerning the particular watch at issue in Severin, the Copyright Office canceled the registration because the separately identifiable matter was not copyrightable. The only separable aspect of that watch design was a single letter of the alphabet, the letter "G." Lettering and typographic ornamentation are not copyrightable. 37 C.F.R. 202.1(a),(e).

Although the casing and elliptical head elements of WORM LIGHT may have been chosen for their artistic or aesthetic qualities, these elements nevertheless are integral parts of the overall shape or configuration of the useful article in question here. They cannot, therefore, be considered separable under the Office's Compendium II test because they, in the words of section 505.04, cannot "be imagined separately and independently from the useful article without destroying the basic shape of the useful article." The useful article which has been submitted for registration *is* WORM LIGHT and WORM LIGHT consists of the totality of its casing, head, and internal operating elements.[3] The casing of WORM LIGHT, including the head, constitute the shape of the useful article and, under the principles and reasoning set out in the 1976 Act's House Report, cannot form a basis for registration.

The Board of Appeals, however, has identified one feature of WORM LIGHT's design which it considers separable. That feature is the design of the ridged lines which are a conceptually separable aspect of the WORM LIGHT head. We consider these ridges, or lines, separable because one could, in the terms of Compendium, 505.03, imagine the design of the ridges, or lines, "separately and independently from the useful article without destroying the basic shape of the useful article." We now analyze the copyrightability of this design.

D. The conceptually separable design on the WORM LIGHT head is not copyrightable

As you know, the rule that originality is the fundamental requirement for copyright protection is found explicitly in Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340 (1991). Feist, while straightforwardly articulating that originality in a work of authorship means that the work was independently authored and that the work possesses at

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[3] Your request for reconsideration also references and discusses a preliminary injunction granted to Nyko Technologies, Inc., on trade dress grounds by the District Court for the Central District of California. [Beuerle 1/3/02 letter at 8; copy of 4/10/00 preliminary injunction grant, attached as Exhibit F]. We appreciate your reference to this trade dress litigation but point out that an analysis of non-functionality in terms of the law of trade dress does not automatically render an article, i.e., its design features, non-functional for purposes of a separability analysis under copyright law. The fanciful design of a given useful article or product, although considered as meeting non-functionality requirements of trade dress law, does not necessarily meet the requirements of conceptual separability as those requirements are stated under the judicially confirmed Copyright Office analysis of the meaning of the statute's definition of separability and the Office's test for such separability.

least some minimal degree of creativity [Id. at 345], also recognized that there exists a narrow category of works in which the necessary quantum of creativity is missing. Id. at 359. The 2-dimensional design formed by the ridges, or lines, on the surface of the head of WORM LIGHT is insufficient to sustain a copyright registration. The design can be described as slightly curved lines which are drawn across the elliptical head of WORM LIGHT. The last of the lines which appears at the end of the elliptical head where the head meets the coil wire is a more curved line whose shaped is parabola-like. All the ridges, or lines, are evenly spaced, parallel and of equal width.

The design consisting of these parallel, slightly curved lines is *de minimis* in its composition. This simple design falls into the narrow category of works, recognized by Feist, in which creativity is lacking and the creative spark is insufficient to support a copyright. In support of your position that this separable 2-dimensional design is copyrightable, you cite CDN, Inc. v. Kapes, 197 F.3d 1256 (9th Cir., 1999) and Rogers v. Koons, 960 F.2d 301 (2d Cir. 1992). Although it is now axiomatic under the Feist principle that only a modicum of creativity is necessary in a work of authorship in order to sustain copyright, we do not consider the works at issue in Kapes [coin price guides] and in Koons [photographs] to be similar in their authorship composition to the separable, 2-dimensional line design in question here. We also do not consider the ridges / lines design at issue here to be comparable authorship to the audiovisual game in Atari Games Corp. v. Oman, 888 F.2d 878 (D.C. Cir. 1989). There the Office, after initial refusals to register, did register the work in recognition of the overall audiovisual authorship, composed of several individual elements– a series of related images with sound– which, taken together, were sufficient under Feist. The simple design appearing on the surface of the elliptical WORM LIGHT head is insufficient in its configuration to sustain a claim to copyright.

Even prior to Feist, Copyright Office registration practices following settled precedent recognized that some works exhibit only a *de minimis* quantum of authorship and, thus, are not copyrightable. This principle is stated in Compendium II, section 202.02(a). We also specifically cite Compendium II, section 503.02(b):

> ... [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.

The WORM LIGHT separable, 2-dimensional design of ridges / lines consists solely of slightly curved parallel lines following each other by equal distance across the surface of the elliptical head with the only variation of a final line more curved, in the shape of a parabola, as the end-line. This simple, one element design does not meet the admittedly low threshold of creativity required under Feist. Even some pre-Feist case law indicated that not all works of the visual arts meet the low threshold for copyrightability. *See, e.g.,* John Muller & Co. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986); Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q.2d

1870 (S.D.N.Y. 1988); Magic Marketing, Inc. v. Mailing Services of Pittsburgh, Inc., 634 F. Supp. 769 (W.D. Pa. 1986).

For the reasons stated in this letter, the Copyright Office Board of Appeals concludes that WORM LIGHT contains no separable features which are also copyrightable. This decision constitutes final agency action on this matter.

Sincerely,

Nanette Petruzzelli

Nanette Petruzzelli
Chief, Examining Division
for the Board of Appeals
United States Copyright Office