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May 6, 2004

Laurie Haynie
Welsh and Katz
120 S. Riverside Plaza, 22nd Floor
Chicago, IL 60606

RE: SAPPHIRE
Control No. 60-906-285.(L)

Dear Ms. Haynie:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated November 15, 2002, on behalf of your client, Armament Systems and Procedures, Inc., requesting reconsideration of the refusal to register a work entitled "Sapphire." The Board has carefully examined the application, the deposit, and all correspondence in this case concerning this application and affirms the denial of registration of the three-dimensional sculpture.

ADMINISTRATIVE RECORD

Initial Submission

On July 30, 2001, the Copyright Office received a Form VA application from Applicant, Armament Systems and Procedures, Inc., to register a three-dimensional sculpture. Peter J. Shakula also requested special handling of the application. In a letter dated August 8, 2001, Visual Arts Section Supervisory Examiner John H. Ashley refused registration of this work because it was a useful article that did not contain any separable authorship necessary to support a copyright claim.

Mr. Ashley explained that the design of a useful article is considered to be a pictorial, graphic or sculptural work only if and to the extent that the design incorporates pictorial, graphic, or sculptural features that are either physically or conceptually separable from the utilitarian aspects of the useful article. He then set forth the tests for physical and conceptual separability used by the Office as stated in the Compendium II of Copyright Office Practices, Chapter 5 (1984). He also noted no registration is possible where certain features of the work are non-functional or could have been designed differently, if those features are an integral part of the overall shape or contour of the useful article.

Mr. Ashley determined that since all of the elements of Sapphire are "either related to the utilitarian aspects or function, or are subsumed within the overall shape, contour, or configuration of the article, there is no physically or conceptually 'separable' authorship

as such. Consequently, we cannot register this claim." Letter from Ashley to Shakula of 8/8/01, at 2. Mr. Ashley noted, however, that the design might be entitled to protection under federal patent law.

First Request for Reconsideration

On May 10, 2002, your firm filed with the Office "Applicant's First Appeal Brief" as well as "Applicant's Supplemental First Appeal Brief"[1] seeking reconsideration of the initial rejection of the application. In the First Appeal Brief, Mr. Brezina asserted that the work at issue is "a novel, original, asymmetrical and angularly offset sculpted shape formed as a housing for a flashlight" that is copyrightable because unlike typical flashlights, "the shape [here] provides aesthetic, . . . content over that typically shown in flashlights." Letter from Brezina to Ashley of 5/10/02, at 1. He concluded that the "sculptured light design is copyrightable because its form departs from, and is therefore physically and conceptually separate from, its flashlight function, and thus is appropriate material for copyright registration." *Id.* at 2.

In support of his assertion, Mr. Brezina described the work in detail. He noted that rejection did not rest on the "'simple geometric shape' argument." *Id.* at 3. For convenience (but without admission), he referred to the "overall shape of the frame as a 'generally parallelogram' shape, the body as a 'generally trapezoid' shape and the three-sided portion as a 'generally triangular' shape" but pointed out that "the work is not a simple geometric shape or combination of geometric shapes." *Id.* Rather, he argued that the "[a]uthorship lies in the combination of shapes, textures, colors and arrangement of elements that give rise to the symmetric sculptural flashlight." *Id.* at 3-4.

Mr. Brezina attached as exhibits to the brief several patented flashlight designs of a "non-authorship nature," as they illustrate the three general configurations of the typical or traditional flashlight and related lantern or lighting device design. He then contrasts the work at issue with the patented designs and concludes that unlike the typical flashlight, the work here is asymmetric and hangs at one angle and is aimed at another. He states that the work here "combines numerous hybrid shapes, panels, radii, edges, openings, colors and textures, the features that typically make up sculptures, into a whole that is original compared to any flashlights, while flashlights typically add features solely based on utility." *Id.* at 5.

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[1] According to the accompanying cover letter, David C. Brezina, a member of Mr. Shakula's firm, originally sent the First Appeal Brief to the Office on November 19, 2001, but that brief was never received. Subsequently, your firm became the new counsel for Armament Systems & Procedures, Inc. After receiving approval from the Office, you filed a Supplemental First Appeal Brief in conjunction with resubmitting the First Appeal Brief.

Mr. Brezina then stated, "where form differs from or is inconsistent with prevailing indicators of function, there is a copyrightable work of authorship, not merely a utilitarian item. Form that departs from function, . . . provides an objective standard far more useful and consistent with the Copyright Act of 1976 than the examples cited from the Compendium." *Id.* at 6. He then cited cases to illustrate his point. Dan Kasoff, Inc. v. Gresco Jewelry Co., 204 F. Supp. 694 (S.D.N.Y.), aff'd, 308 F.2d 806 (2d Cir. 1962)(ring box); S-K Potteries & Mold Co. v. Sipes, 192 U.S.P.Q. 537 (N.D. Inc. 1976) (pottery molds); Ted Arnold Ltd. v. Silvercraft Co., 259 F. Supp. 733 (S.D.N.Y. 1966) (pencil sharpener having case shaped like an antique telephone). In addition, he claims that like the pencil sharpener in Arnold, the flashlight here is a "decorative conversation piece," which makes it copyrightable. Letter from Brezina to Ashley of 5/10/02, at 7, citing Arnold, 259 F. Supp. at 736.

Next, he discusses the cases Esquire v. Ringer, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), and Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980). He stated that the shape of the lamp at issue in Esquire "had nothing to depart from its function" and therefore was not copyrightable. Letter from Brezina to Ashley of 5/10/02, at 8. He clarified that no claim was being made for the LED that protrudes from the case or for the latching tip of the locking gate in the triangle portion. Conversely, he pointed out that the court in Kieselstein-Cord found conceptually separable elements in the two belt buckles at issue there and asserted that "the valid inquiry is to consider the question of whether the aesthetic appearance is either enhancing or departs from to (sic) the function." *Id.* at 10. Mr. Brezina stated that the court gave "weight to the premium that attaches to the pleasing appearance. The issue is whether the shape is dictated by function or reflects the aesthetic judgments of the creator." *Id.* He argued that the asymmetrical and angular offset of the flashlight here, "when compared to the typical flashlight, are key in providing aesthetic, hence copyrightable, content over that typically shown in flashlights." *Id.*

In the Supplement First Appeal Brief, Mr. Wood of your firm notes that Sapphire is not only a flashlight but a key chain as well. He then describes in detail the process of creating the Sapphire design and provides the Declaration of Dr. Kevin Parsons, the designer and creator of the design. He then asserts that "the Sapphire sculpture is both physically and conceptually separable from the utilitarian aspects of the sculpture (the flashlight). Letter from Wood to Ashley of 5/10/02, at 4.

He contends that the Sapphire sculpture is physically separable from its utilitarian use as a flashlight. As support, he states that the "only part of the sculpture that directly relates to the flashlight function is the LED that protrudes from one corner." *Id.* at 5 (emphasis in original). He argues that removal of the flashlight components would leave the artistic features of the sculpture intact, thus satisfying the test for physical separability articulated by David Nimmer, and making the work copyrightable. *Id.*

Mr. Wood also relies on the Arnold case in regard to physical separability. *Id.* at 6. He contends that the flashlight here is similar to the antique telephone casing which housed the pencil sharpener in Arnold. He states that like the work at issue in Arnold the flashlight here is a copyrightable "decorative conversation piece" that looks nothing like a flashlight. *Id.*

Next, Mr. Wood asserts that the sculpture is conceptually separable from the flashlight, employing the test articulated by the Second Circuit in Brandir Intern. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987). The Brandir test finds conceptual separability where "design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences." Letter from Wood to Ashley of 5/10/02, at 7, citing Brandir, 834 F.2d at 1145. Using this test, he asserts that the goal in designing the Sapphire sculpture was to "create a product that would be attractive and appealing to potential customers, with a modern stylized appearance. As a result, the design elements reflect the designer's artistic judgment exercised independently of functional influences." Letter from Wood to Ashley of 5/10/02, at 7-8. Consequently, he asserts that the Sapphire sculpture is copyrightable.

He notes that a "number of courts" have adopted the Brandir test and then discusses two cases--National Theme Productions, Inc. v. Jerry R. Beck, Inc., 696 F. Supp. 1348 (S.D. Cal. 1988), and Severin Montres, Ltd. v. Yidah Watch Co., 997 F. Supp. 1262 (C.D. Cal. 1997)--to further support the contention that the Sapphire sculpture satisfies the Brandir test for conceptual separability and therefore is copyrightable. Next, he discusses briefly Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980), to further support his assertion that the sculptural aspects of the flashlight are conceptually separable from its functional aspects.

Finally, he discusses Masquerade Novelty v. Unique Indus., 912 F.2d 663 (3d Cir. 1990), where the court "explained the policy behind Congress' (sic) reluctance to register industrial designs." Letter from Wood to Ashley of 5/10/02, at 11. He asserts that because "there is nothing about the design of the Sapphire sculpture that makes it function better as a flashlight . . . the policy underlying Sections 101 and 102(a)(5) is not violated by granting copyright registration in this case." *Id.* at 12.

In a letter dated July 22, 2002, Attorney Advisor Virginia Giroux of the Examining Division replied that she had reviewed your client's work in light of the points raised in the briefs submitted on May 10, 2002, and determined that the Sapphire sculpture was a "flashlight, [that] is a useful article, functional in nature, that does not contain any authorship that is both separable and copyrightable." Letter from Giroux to Haynie of 7/22/02, at 1.

She noted the copies of the patented flashlight designs attached to Mr. Brezina's brief and explained that there are differences in the standards for patent protection and copyright protection; the fact that a work is afforded patent protection does not mean that the same work is eligible for copyright protection. For example, uniqueness is applicable to patent protection but not to copyright; thus, the fact that the flashlight here is unique and atypical in shape to other flashlights does not make this flashlight copyrightable. She pointed out that the work here falls within the industrial design category and explained that "the only possibility of copyright protection for this work, like any other useful article, would be whatever separable features one might identify apart from the shape and function of the work." *Id.* In addition, she noted that Congress has considered and refused to enact design copyright protection for such works.

Ms. Giroux then set forth the definition of a useful article under the Copyright Act and the extent to which such a work is copyrightable. She explained that the Office examines useful articles first to determine whether the work contains any pictorial, graphic, or sculptural authorship that is physically or conceptually separable from the work's utilitarian aspects. She noted that examiners do not make aesthetic judgments and do not consider the design's attractiveness, uniqueness or its look or feel, and the like.

She explained that the work here does not satisfy the test of physical separability set forth in section 505.04 of the Compendium of Copyright Office Practices, Compendium II (1984), because the "outer frame or body portion provides an enclosure for the functional aspects of the flashlight. An enclosure is not considered to be physically separable authorship." *Id.* at 2.

Next, she noted that the Office does not follow the test for conceptual separability set forth in Brandir and explained that the Office follows the principles set forth in Esquire v. Ringer, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), as set out in section 505.03 of Compendium II. She explained that the test could not be met where, as here, "certain features are non-functional or could have been designed differently, if the features are an integral part of the overall shape or contour of the useful article." *See* Esquire v. Ringer, 591 F.2d 796 (D.C. Cir. 1978) *cert. denied*, 440 U.S. 908 (1979), (upholding refusal to register an outdoor lighting fixture); *see also* Norris Industries, Inc. v. International Tel. & Tel. Corp., 696 F.2d 918 (11th Cir.), *cert. denied*, 464 U.S. 818 (1983)(wire-spoked wheel cover non-copyrightable useful article not containing any separable sculptural design). Here, the parallel, circular, triangular, and trapezoidal sculptural features or elements are "part of the overall shape, contour, and configuration of the useful article itself, not physically or conceptually separable from its utilitarian function without destroying its basic shape." Letter from Giroux to Haynie of 7/22/02, at 3. She then noted that even if there were separable elements to this work, such elements are not copyrightable because they "consist of common geometric shapes and designs, or minor variations thereof, in the public domain." *Id.*

Ms. Giroux then moved on to distinguish the cases cited in the briefs because the work here is not a copyrightable work of art, such as the works in Mazer v. Stein, 347 U.S. 201 (1954), Kieselstein-Cord, Royalty Designs, Inc. v. Thriftcheck Services Corp., 204 F. Supp. 702 (S.D.N.Y. 1962), and Arnold. She pointed out that the Office could not follow the decision in Severin Montres and had cancelled the registration of the watch design in that case. Lastly, while some of the sculptural elements here were not inextricably interwoven with utilitarian aspect of the work, as was the case in Carol Barnhardt Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985), such elements "are part of the shape, contour, and configuration of the useful article, itself, not conceptually separable without destroying its basic shape." Letter from Giroux to Haynie of 7/22/02, at 5.

Finally, Ms. Giroux cited from the portion of the legislative history of the 1976 Copyright Act which clearly stated Congress's intent in crafting the existing law, and its emphasis on the need for separable authorship to stand on its own and that a useful article's design not be protected.

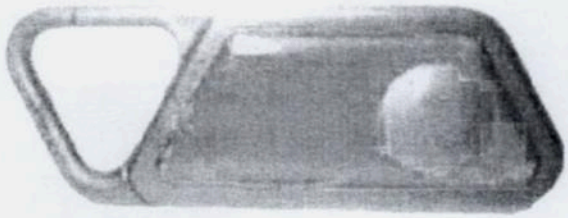
Second Request for Reconsideration

On November 15, 2002, you filed a second brief seeking reconsideration of the Office's refusal to register the Sapphire sculpture which reiterates the arguments made in your first request for reconsideration regarding physical and conceptual separability. In addition, you assert that the Office "relies on conflicting authority from the D.C. Circuit to support its position that no separability exists. It should be noted at the outset that the authority cited by the Copyright Office has been criticized by legal scholars" while the authorities you relied on "have articulated a standard that more closely follows the policies inherent in the Copyright Act." Letter from Haynie to Board of Appeals of 11/15/02, at 5. Specifically, you take issue with the Office's reliance on Esquire because you assert that "the D.C. Circuit flatly rejected the possibility of conceptual separability, and dismissed the House's Report mention of conceptual separability as an 'isolated reference'" and the decision has been criticized for this reason. *Id.* at 15-16. You go on to assert that Esquire and Compendium II, §§ 505.03, 505.05, are "overly restrictive" and "do not legitimately allow for conceptual separability"; as such, you go on to assert that the Office's reliance "on such authorities to justify its refusal to register the Sapphire design was an abuse of discretion." *Id.* at 16. You assert that in light of the conflicting authority, the Office should register the work under the rule of doubt set forth in section 108.07 of Compendium II. *Id.* at 17.

Next, you assert that the separable elements of the work here possess the requisite level of creativity to support a copyright registration. *Id.* at 18. You state that "the unique arrangement and combination of elements in the Sapphire sculpture" satisfy the low level of creativity required under Feist Publications, Inc. v. Rural Telephone Service Company,

Inc., 499 U.S. 340 (1991), and its progeny. *Id.* at 20-21. In support of this assertion, you cite the following cases: Atari Games Corp. v. Oman, 888 F.2d 878 (D.C. Cir. 1989); Atari Games Corp. v. Oman, 979 F.2d 242 (D.C. Cir. 1992); Tennessee Fabricating Co. v. Moultrie Mfg. Co., 421 F.2d 279 (5th Cir.), *cert. denied*, 398 U.S. 928 (1970); Concord Fabrics, Inc. v. Marcus Bros. Textile Corp., 409 F.2d 1315 (2d Cir. 1969); In Design v. Lynch Knitting Mills, Inc., 689 F. Supp. 176 (2d Cir. 1988); and Runstadler Studios, Inc. v. MCM Limited Partnership, 768 F. Supp. 1292 (N.D. Ill. 1991).

DECISION



After reviewing the applications and the arguments you presented, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register Sapphire as a three-dimensional sculpture because it is a useful article, a flashlight, with no separable sculptural aspects.

While you do not contest that the work at issue here is a useful article, you argue that the Sapphire sculpture is both physically and conceptually separable from the utilitarian aspects of the sculpture. In addition, you take issue with the tests for separability utilized by the Copyright Office, asserting that the Office "relies on conflicting authority from the D.C. Circuit to support its position that no separability exists. It should be noted at the outset that the authority cited by the Copyright Office has been criticized by legal scholars . . .." Letter from Haynie to Board of Appeals of 11/15/02, at 5.

As you acknowledge, determining whether a useful article contains physically or conceptually separable features is not always an easy task; as you point out, "different courts have announced varying standards for ascertaining whether this separability exists, particularly with respect to conceptual separability." *Id.* Therefore, it is not surprising that there are some who disagree with the Office's separability tests. However, as will be discussed below, the tests for separability used by the Office are consistent with the Copyright Act and its legislative history and have been upheld by the courts.

Useful Articles and Separability

A useful article may be entitled to copyright protection 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).

The legislative history of the Copyright Act of 1976 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. 94-1476, at 55 (1976). The House Report 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.

Id. (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.

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).

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 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 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.), *cert. denied*, 464 U.S. 818 (1983); Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979); 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) *cert. denied*, 440 U.S. 908 (1979). 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 in which the Court noted Congress's 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, 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).[2]

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[2] You argue that the Office's reliance on Esquire and Compendium II amounts to an abuse of discretion because they are "overly restrictive and do not legitimately allow for conceptual separability." Letter from Haynie to Board of Appeals of 11/15/02, at 16. The court in Custom Chrome stated "the Copyright Office's 'conceptual separability' test is consistent with the holding in Esquire, later cases decided under the present law, and the legislative history." 35 U.S.P.Q.2d at 1718. Therefore, this argument has no merit.

Physical Separability

At the outset, you argue that section 505.04 of Compendium II "is at odds with the Supreme Court's decision dealing with physical separability" in Mazer. Letter from Haynie to Board of Appeals of 11/15/02, at 6. Accordingly, you urge the Board to abandon its physical separability test in favor of the physical separability test articulated by Professor Nimmer, which states that such separability exists when the artistic features of a work remain intact after removal of the features necessary for the utilitarian function of the article. *Id.* at 8. This the Board cannot do, as the Office's physical separability test is not "at odds" with Mazer. First, we 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. The Office's test for physical separability is consistent with Mazer as it is "derived from the principle that a copyrightable work of sculpture which is later incorporated into a useful article retains its copyright protection." Compendium II, § 505.04. Mazer, however, did not address the question of "whether the overall shape of a utilitarian object is 'an article eligible for copyright.'" Esquire, 591 F.2d at 804. Congress has been clear that the overall shape of a useful article even if it is determined by aesthetic as well as functional considerations is not entitled to copyright protection. H.R. Rep. No. 94-1476, at 55; *see also* Esquire, 591 F.2d at 804. The Office's test for physical separability is faithful to this congressional intent and has been upheld by the courts. *See* Esquire, 591 F.2d at 804; Norris, 696 F.2d at 922; Custom Chrome, 35 U.S.P.Q.2d at 1718. Therefore, we do not follow the test proffered by Professor Nimmer.

You state that the flashlight components, which are "largely housed inside the sculpture," can be physically separated from the sculpture without disturbing its artistic features. *Id.* In support of this assertion, you liken Sapphire to the works in Ted Arnold Ltd. v. Silvercraft Co., 259 F. Supp. 733 (S.D.N.Y. 1966), and Royalty Designs, Inc. v. Thriftcheck Services Corp., 204 F. Supp. 702 (S.D.N.Y. 1962).

As discussed above, Compendium II, § 505.04, states explicitly that the fact that the 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. 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 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. Similarly, the works at issue in Royalty Designs, toy banks in the shape of dogs, were found to be separable works of art incorporated into a useful article. 204 F. Supp. at 704.

We do not find a parallel between the Arnold telephone sculpture or the dog-shaped toy banks in Royalty Designs and the casing which surrounds the wiring and other flashlight components of Sapphire. It is a given that some kind of covering is necessary for the wiring and other flashlight components 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 refer again to 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 even necessary, for electrical and electronic articles to contain casing surrounding wiring, transistors, connectors, etc., in order that the wiring and other components may be employed effectively within the article in question. Detachment of the casing here would result in something other than the Sapphire article; the casing itself may remain intact, as you have indicated, but the casing is not the equivalent of Sapphire–rather, it is merely part of the entire work.

Further, the casing of Sapphire is part of the overall shape of the article; and under the House Report's explanatory guidance, this overall shape, although it may be termed aesthetically pleasing, is not the subject of copyright protection. We consider the casing of Sapphire--which provides protection to those operating parts as Sapphire 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.

Finally, you assert that physical separability exists because Sapphire is "not used only as a flashlight, but also as a decorative key chain," again relying on Arnold. Letter from Haynie to Board of Appeals of 11/15/02, at 9. In Arnold, the court referred to the antique telephone casing as a "decorative conversation piece" for which consumers were willing to pay a relatively significant amount of money. 259 F. Supp. at 736. You argue that consumers are willing to pay "significantly higher amount[s]" for Sapphire, "not because it shines a light 'uncommonly well, but because it is also a decorative conversation piece.'" Letter from Haynie to Board of Appeals of 11/15/02, at 9. However, the amount of money a consumer is willing to pay for Sapphire is irrelevant to the Office's physical separability analysis. *See* Homer Laughlin China v. Oman, 22 U.S.P.Q.2d 1074, 1076 (D.D.C. 1991) (commercial success not a consideration in determining copyrightability); Compendium II, § 505.05. Also whether consumers would buy Sapphire even if it did not function as a flashlight is a theoretical question that is not before the Board.

Conceptual Separability

You have also argued that the artistic features of Sapphire are conceptually separable from its utilitarian aspects. You assert that the following design elements are conceptually separable: "the overall parallelogram shape combined with the slim profile, and colored trapezoidal side panels with rounded edges that would fit within a contrasting

black plastic frame, leaving a triangular opening at one end, with all of the edges and corners, both interior and exterior, being rounded as well, and a black circle on one of the side panels." Letter from Haynie to Board of Appeals of 11/15/02, at 12. In support of this argument, you cite Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980). *Id.* at 10-11. 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), and later reiterated in Nat'l Theme Productions v. Jerry B. Beck, Inc., 696 F. Supp. 1348 (S.D.Cal. 1988). *Id.* at 12-13. Your argument that Professor Denicola's test should apply in judging Sapphire's separability is based on the reasoning that the design elements specified above "reflect the designer's artistic judgment exercised independently of functional influences." *Id.* at 12.

Since Sapphire is a useful article that does not have any physically separable features, there must be conceptual separability in order for it to enjoy any copyright protection. 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. 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, 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 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, § 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. Letter from Haynie to Board of Appeals of 11/15/02, at 13. Again, the Office has not implemented the Denicola test. Additionally, 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 elements comprising the casing here 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 therefore cannot be considered separable under the Office's Compendium II test because they 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* Sapphire and Sapphire consists of the totality of its casing and internal operating elements.[3] The casing of Sapphire constitutes the shape of the useful article and thus cannot form a basis for registration.

For this reason, Kieselstein-Cord is not persuasive. There the court upheld the Office's registration of the belt buckles at issue there because the sculptural aspects did not constitute the shape of the belt buckles but rather were fanciful shapes separably identifiable from the overall functional design of the belt buckles. 632 F.2d at 989.

De Minimis Authorship

In determining whether a useful article is entitled to registration, the Examining Division follows a two-part analysis. First, a determination is made whether or not there are any design elements that are separable from the function of the useful article. If there is any separable work, then a determination is made as to whether such work rises to the level of authorship required by law. 17 U.S.C. § 102(a). We have found no design elements separable from Sapphire's function as a flashlight; however, because Ms. Giroux addressed the issue of copyrightable authorship in her July 22, 2002, letter and you address it in your second request for reconsideration, the Board has examined Sapphire to determine whether, regardless of the issue of separability, there is copyrightable authorship. We conclude that there is not a sufficient amount of original authorship necessary to support a copyright registration.

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[3] You also make brief reference to Act Young Imports, Inc. v. B&E Sales Co., 667 F. Supp. 85 (S.D.N.Y. 1986)(artistic aspect of animal-shaped backpacks–animal image–separable from utilitarian function); Animal Fair, Inc. v. AMFESCO Industries, Inc., 620 F. Supp. 175 (D.Minn. 1985)(fanciful artistic rendition of bear's paw conceptually separable from utilitarian aspects of slipper); and Sunset Lamp Corp. v. Alsy Corp., 698 F. Supp. 1146 (S.D.N.Y. 1988)(design of banana leaf lamp base conceptually separable from utilitarian function of lamp). These cases are not persuasive because, unlike the works in the cited cases, the casing here constitutes the shape of the useful article and cannot be separated.

In determining whether a work has a sufficient amount of original artistic authorship necessary to sustain a copyright claim, the Board adheres to the standard set forth in Feist Publications v. Rural Telephone Service Co., 499 U.S. 340, 345 (1991), where the Supreme Court held that only a modicum of creativity is necessary to support a copyright. However, the Court also ruled that some works (such as the work at issue in Feist) fail to meet the standard. The Court observed that "as a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity," 499 U.S. at 363, and that there can be no copyright in work in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359.

The Board also applies the principles of Compendium II that are relevant to the particular work being examined. Even prior to the Court's decision, as noted in Compendium II, the Office stated "[w]orks that lack even a certain minimum amount of original authorship are not copyrightable." Compendium II, § 202.02(a)(1984). With respect to pictorial, graphic, and sculptural works, the class within which Sapphire falls, *see* 17 U.S.C. § 102(a)(5), Compendium II states 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(a)(1984). Compendium II recognizes that it is not the aesthetic merit or commercial appeal of a work, but the presence of creative expression that determines the copyrightability of a work, and that

> registration cannot be based upon the simplicity of standard ornamentation . . . Similarly, it is not possible to copyright common geometric figures or shapes . . . Likewise, mere coloration cannot support a copyright even though it may enhance the aesthetic appeal or commercial value of a work. . . . The same is true of a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations.

Id. *See also* 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); Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958) (cardboard star with two folding flaps allowing star to stand for retail display not copyrightable work of art); Magic Marketing, Inc. v. Mailing Services of Pittsburgh, 634 F. Supp. 769 (W.D. Pa. 1986) (envelopes with black lines and words "gift check" or "priority message" did not contain minimal degree of creativity necessary for protection); and Homer Laughlin China Co. v. Oman, 22 U.S.P.Q.2d 1074 (D.D.C.

1991) (upholding refusal to register chinaware design pattern composed of simple variations of geometric designs due to insufficient creative authorship to support copyright registration).

While use of public domain elements and/or commonly known shapes can result in a copyrightable work, such use must constitute more than a trivial variation of such elements. Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 103 (1951); *see* Compendium II, § 503.02(a). The Board applies this standard by examining a work to determine whether it contains elements, either alone or in combination, on which a copyright can be based.

You state in your second request for reconsideration that the sculpture here is comprised of elements--namely simple geometric shapes such as a parallelogram, trapezoid, triangle, and circle--that are not copyrightable when viewed individually but argue that "the unique arrangement and combination of elements" of the sculpture "easily satisfies the creativity threshold" set forth in Feist. Letter from Haynie to Board of Appeals of 11/15/02, at 19, 21. The Board finds that the sculpture here consists of a combination of common and familiar geometric shapes in the public domain which do not exhibit original artistic authorship when examined individually. The Board agrees that the question to be decided is whether the combination of these familiar geometric shapes exhibits original artistic authorship.

You cite Atari Games Corp. v. Oman, 888 F.2d 878 (D.C. Cir. 1989) ("Atari I") and Atari Games Corp. v. Oman, 979 F.2d 242 (D.C. Cir. 1992) ("Atari II"), to support your argument that the combination of the common geometric shapes satisfies the creativity threshold of Feist. The Board disagrees. In Atari II, the court found several aspects of the BREAKOUT game--such as the motion created by the selection and arrangement of the graphic elements and the subsequent selection and arrangement of the sequence of the screens, the use of a square ball, a rectangular shrinking paddle, the placement and design of the scores, and the use of sounds--as beyond mechanical, typical or garden variety. Atari II, 979 F.2d at 246, 247. Likewise, in Runstadler Studios Inc. v. MCM Limited Partnership, 768 F. Supp. 1292 (N.D. Ill. 1991), the court observed that the artist's "choice of location, orientation and dimensions of the glass panes, and the degree of arc of the spiral, show far more than a trivial amount of intellectual labor and artistic expression on plaintiff's part." 768 F. Supp. at 1295-96.

No such selection and arrangement is present in Sapphire. When viewed as a whole, the selection and arrangement of the parallelogram, circle, triangle, and trapezoid--common geometric shapes--are not sufficiently creative to warrant registration. Rather, the selection and arrangement here is no more than the mere bringing together of a few standard forms or shapes with minor linear or spatial variations. Accordingly, there is not sufficient creativity to support a registration. Compendium II, § 503.02(b).

The sculpture here consists of simple variations of standard shapes and simple arrangements, which while aesthetically pleasing and commercially successful, do not contain the minimal amount of original artistic authorship to support a copyright registration; and the courts have consistently upheld the Office's refusal to register such works. John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986)(logo consisting of four angled lines forming an arrow, with the word "Arrows" in cursive script below, found not copyrightable); Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q.2d 1879 (S.D.N.Y. 1988)(upholding Copyright Office's refusal to register design consisting of striped cloth over which was superimposed a grid of 3/16" squares).

The other cases you cited--Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc., 490 F2d 1092, 1094 (2d Cir. 1973); Tennessee Fabricating Co. v. Moultrie Mfg. Co., 421 F.2d 279 (5th Cir. 1970); Concord Fabrics, Inc. v. Marcus Bros. Textile Corp., 409 F.2d 1315 (2d Cir. 1969); and In Design v. Lynch Knitting Mills, Inc., 689 F. Supp. 176 (S.D.N.Y. 1988)--each involves works more complex than Sapphire.

Finally, you request that the Office register Sapphire under its rule of doubt, Compendium II, § 108.07, "in view of the conflicting authority" on separability. The short answer is that there is no doubt as to the copyrightability of the work: it is not copyrightable. Therefore, we have no alternative but to refuse registration.

For the reasons stated herein, the Copyright Office Board of Appeals affirms the refusal to register Sapphire as a three-dimensional sculpture. This decision constitutes final agency action on this matter.

Sincerely,

/S/

Marilyn J. Kretsinger
Associate General Counsel
for the Appeals Board
United States Copyright Office