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RE: Control No. 60-716-0417(F)
ConQuest Injection Blow-Molded Tumblers/
With Cut Glass Design and With Fluted Design

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Dear Mr. Ferrell:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter, dated July 19, 2001. I apologize for the long delay in getting back to you. You had asked the Copyright Office to reconsider two refusals to register two designs that are blow-molded into plastic drinking cups / tumblers. The designs are entitled "ConQuest Injection Blow-Molded Tumbler With Cut Glass Design" and "ConQuest Injection Blow-Molded Tumbler With Fluted Design." The Board of Appeals has carefully examined the applications, all deposit materials and all correspondence in this case and now affirms the Examining Division's refusal to register these works.

Washington
D.C.
20559-6000

Administrative record

On February 22, 2000, the Office received two submissions from your client, Fort James Corporation, for the registration of three-dimensional sculpture in the works, ConQuest Injection Blow-Molded Tumbler With Cut Glass Design and ConQuest Injection Blow-Molded Tumbler With Fluted Design. The nature of these two works is listed on the application forms as "disposable tumbler design." The designs are blow-molded into the basic structures of plastic tumblers that are used as drinking cups. In a letter dated October 10, 2000, Visual Arts Section Examiner Ivan Proctor refused to register both of these designs on the basis that they are useful articles that do not have any separable authorship that is copyrightable. He stated that "all of the elements of the works...are either related to the utilitarian aspects or function, or are subsumed within the overall shape, contour, or configuration of the articles." Letter from Proctor to Peter Ferrell of 10/10/00 at 2.

First request for reconsideration [first appeal]

In a letter dated February 5, 2001, you submitted a first request for reconsideration [first appeal] to the Copyright Office. You characterized both works as having unique molded-in designs that convey the visual appearance of "more substantial permanent glassware." Letter from Michael Ferrell to Visual Arts Section, Examining Division, of 2/5/01 at 2 and 3. In support of that argument, you described the cut glass design as:

> ...a relatively low-taper article having a diameter at its base of slightly more than two inches (2"), a height of about six inches (6") and an upper diameter of slightly less than three inches (3") such that the taper is about three degrees (3°).
>
> The tumbler is provided with a "cut glass" molded-in design defining a series of triangular ridges which are deeper in dimension than the wall thickness or caliper, but have the same thickness as the rest of the sidewall. The molded-in pattern extends from the base of the tumbler over about forty percent (40%) of the height of the glass." Id. at 2.

In describing the fluted design, you stated that it:

> ...has a higher taper, about seven degrees (7°) and a different molded-in design.
>
> The fluted design has a plurality of substantially flat, rectangular shapes each extending over about thirty degrees (30%) of the periphery of the tumbler which has an upper diameter of slightly over three and one-quarter inches (3 1/4"), a lower diameter of about (2") and a height of about four and three-quarter inches (4 3/4"). Id. at 3.

You cited Mazer v. Stein, 347 U.S. 201 (1954) for the proposition that articles of manufacture, although having a utilitarian purpose, are nevertheless copyrightable if the articles incorporate artistic expression. You also extensively cited that case in support of the principle that a work may be subject to both copyright and patent protection. Letter from M. Ferrell of 2/5/01 at 3 - 5. Finally, you cited Severin Montres, Ltd. v. Yidah Watch Co., 997 F.Supp. 1262 (C.D. Cal. 1997), to support the argument that features unrelated to a useful article's function may be entitled to copyright protection. Letter from M. Ferrell of 2/5/01 at 5. In closing, you argued that aspects of the tumbler designs, described above, give an impression of depth and appearance that is not related to the function of a cup used for drinking. You also stated that there are infinite possible designs for tumblers other than those tumbler designs at issue here. Id. at 5 - 6.

Examining Division response

In a letter dated March 22, 2001, Virginia, Giroux, Attorney Advisor, Examining Division, again refused to register the two blow-molded tumbler designs on the basis that the works are useful articles that have no conceptual or physically separable authorship that is copyrightable. Letter from Giroux to M. Ferrell of 3/22/01. Citing Compendium II of Copyright Office Practices, section 505.05 (1984), Ms. Giroux stated that neither the uniqueness, nor the visual effect on a viewer, nor the amount of time and effort to create a work, nor its commercial success are relevant factors in determining whether a work is copyrightable. Letter from Giroux of 3/22/01 at 2. Ms. Giroux explained that the fact that a work could have been designed differently is also not a relevant consideration; if the design features are an integral part of the overall shape or contour of the useful article, they cannot be said to be conceptually separable. Id. She explained the Office's test for conceptual separability and pointed out that the test is not met by merely analogizing the general shape of a useful article to a work of modern sculpture; in such a case, the shape of the article cannot be conceptualized as standing separate and apart from the overall shape of the supposed work of art. Id. Ms. Giroux concluded that the Office considered the two designs at issue here to be part of the shape and configuration of the tumblers– useful articles– and, as such, not copyrightable.

Ms. Giroux explained further that, even assuming separability, the designs at issue here were common, geometric shapes or minor variations of such shapes. And, even given the modest requirement of creativity pronounced by Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991), the elements, alone or in their simple arrangement or combination, were insufficient to serve as a basis for registration. Further, Ms. Giroux disagreed with your application of Mazer v. Stein to this case. She stated that the Supreme Court ruled in that case that a work of art did not lose its copyrightability because of its use or incorporation in a useful article. She distinguished the tumbler designs at issue here as being non-registrable, not because of their intended use as useful articles, but because the useful articles did not contain any separable features. Letter from Giroux of 3/22/01 at 3. She also pointed out that, in Severin Montres, the Copyright Office cancelled the registration for the watch at issue there, notwithstanding the court's decision, because the Office would not knowingly register a claim in a letter design– the letter "G"-- which was the separable authorship in the watch design in that case. Ms. Giroux concluded her letter with an extensive reference to the House Report accompanying the 1976 Act and its explanation of denying protection to the shape of industrial products. Letter from Giroux of 3/22/01 at 4.

Second request for reconsideration [second appeal]

In a letter dated July 19, 2001, you submitted a second request for reconsideration. You opposed the Office's refusal to register the two tumbler designs in question. You stated that "both tumblers possess design elements which are readily identified as separable from the overall shape of the tumbler and such elements can be physically separated, for example, simply by drawing them..." Letter from M. Ferrell to Board of Appeals of 7/19/01 at 1. To illustrate the physical separability of those elements, you also attached drawings to your appeal letter and further explained the details of the drawings. Id. at 2 - 4. You also stated that the design elements present in the tumblers were copyrightable in themselves, citing Feist as the authority for the minimal quantum of creativity needed to sustain copyright. Letter from M. Ferrell of 7/19/01 at 2.

Concerning the issue of whether the tumblers contain separable authorship, you explained that the top and bottom views in the drawings submitted show that the designs are not coextensive with the overall shapes of the tumblers and that the "overall shape is readily separated from the utilitarian cylindrical shape... ." Id. at 3 - 4. You stated that the drawings show that the designs exist separately from the tumblers: "the molded-in design is readily illustrated separately from the cylindrical or frustoconical structure of the disposable drinking vessel," Id. at 4, and you cited the statute's definitional guidance for the principle that the law requires only that the design for which copyright is sought in connection with a useful article is capable of being identified separately from, and existing independently of, the utilitarian aspects of the article. Id. at 6.

With respect to the design features which you assert are separable, you cited Feist in support of the argument that copyright protection extends to arrangements of geometric shapes such as those in the tumbler designs. You also cited Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc., 490 F.2d 1092 (2d Cir. 1974) and Atari Games v. Oman, 888 F.2d 878 (D.C. Cir. 1989) (Atari I) as cases in support of the argument that the level of originality required for geometric designs is not high and that a work must be considered as a whole. Letter from M. Ferrell of 7/19/01 at 7 - 8. Stating that the design in each of the tumblers at issue here includes shapes arranged in a unique pattern "to give visual perception of permanent glassware," you concluded that these patterns "are readily identifiable, capable of independent existence, and are believed to more than satisfy originality requirements of the Copyright Act." Id. at 8.

Decision

After reviewing the applications and arguments you have presented, the Board of Appeals now affirms the Examining Division's refusal to register Fort James Corporation's applications for registration of the two blow-molded tumbler designs. To briefly state its analysis, the Board has determined that, although the designs are not physically separable, the designs are conceptually separable. However, the conceptually separable cut glass and fluted designs appearing in / on these tumblers are not copyrightable because there is insufficient originality in their authorship. Our reasoning follows.

A. Description of works

The two works which Fort James Corporation has submitted for copyright registration are disposable plastic tumblers meant for drinking purposes. The tumbler with fluted design is approximately 4 3/4 inches in height; is composed of clear plastic; has a base which is slightly smaller than the top opening of the tumbler; and has a surface with is divided in identical panels, each panel being a slight variation of an elongated rectangle with the top of each panel ending in an arching scallop. The very top, or opening of the tumbler, is a smooth circular opening. The tumbler with the cut glass design is approximately 5 3/4 inches in height; is composed of clear plastic; has a base which is slightly smaller than the top, or drinking, opening of the tumbler; and has a surface which is decorated with tall, thin, triangles, arranged in a saw-tooth pattern, spanning the base to approximately half way up the total surface of the tumbler. The very top, or drinking opening of the tumbler, is smooth and circular.

B. Useful articles

Based on the statutory definition of a useful article, the Appeals Board initially determined that the tumblers, as drinking cups, are useful articles. According to both requests for reconsideration, the designs at issue here are blow-molded into plastic that is fabricated as tumblers. Letters from M. Ferrell of 2/5/01 and 7/19/01. For copyright purposes, 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 (definition of "useful article"). Also, any article that is "normally a part of a useful article is considered a 'useful article.' " Id. Because you have acknowledged in both your requests for reconsideration that the tumblers are useful articles, that issue is not in dispute.

Because the tumblers are useful articles, they are subject to the separability analysis that copyright law requires for useful articles. Such works may be the subject of copyright "insofar as their form but not their mechanical or utilitarian aspects are concerned; 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. Thus, for useful articles, any copyright protection inheres only in the features of the article which can be said to be separable. Written guidelines for the separability analysis are found in section 505 of Compendium II of Copyright Office Practices (1984). 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. (Emphasis added.)

In the case of physical separability, Compendium II, section 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.

In the case of conceptual separability, Compendium II, section 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 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. (Emphasis added.)

The Copyright Office's guidelines are based on the legislative history of the Copyright Act of 1976, noted below, in which Congress clarified that utilitarian aspects of useful articles are not copyrightable. Only elements that are physically or conceptually separable features of a useful article may be copyrighted.

> [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. (Emphasis added.)

H.R. Rep. No. 1476, 94th Cong., 2d Sess. at 55 (1976).

Section 505 of Compendium II is a direct successor to the Copyright Office regulation that was affirmed in Esquire, Inc. v. Ringer, 591 F.2d. 796 (D.C. Cir. 1978). Esquire enunciated the rule that is the basis for the Office's analysis of whether a pictorial, graphic or sculptural work may be considered separable from the utilitarian object in which it is incorporated. Relying on explicit statements in legislative history, the Esquire court found that the Office's regulation was an authoritative construction of the copyright law. Id. at 802-803. Esquire and later cases held that, despite an aesthetically pleasing, novel or unique shape, the overall design or configuration of a utilitarian object may not be copyrighted if it is not "capable of existing as a work of art independent of the utilitarian article into which [it is] incorporated." Id. at 803-804. In Esquire, the court held that the Copyright Office properly refused registration for a useful article, in that case a light fixture, notwithstanding how aesthetically pleasing the useful article's shape or configuration may have been. Id. at 800. As noted above, the legislative history states that:

> The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design--that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable.

H.R. Rep. at 55.

C. Physical separability

You have argued in your July 19, 2001, request for reconsideration that the design elements, described above, are "separable from the overall shape of the tumbler and such elements can be physically separated, for example, simply by drawing them as shown on Exhibits 1 and 2..." Letter from M. Ferrell of 7/19/01 at 1. The Office's physical separability test incorporates the principle that a work of art, protectible as such, may be incorporated into a useful article. The Board has examined the identifying materials submitted for the two tumblers, both the photographs and the drawings, and has determined that there is no design feature in either of the tumblers which can be physically separated, by ordinary means, from the useful article itself, for the purpose of analysis, and still have the article– i.e., the tumbler– remain intact and whole. The physical removal of the rectangular panels or of the triangular peaks would, in essence, destroy the tumbler, i.e., the article itself. The decorative designs are incorporated into the utilitarian function that the overall shape of the tumblers serve-- the sides, or walls, of the tumblers are an integral part of the containers. If the designs were physically separated from the tumblers, again, the shape as well as the functionality of the tumblers as drinking cups would be destroyed.

We make reference to a useful case from the Northern District of Illinois. The Office had registered a mannequin head and the plaintiff-copyright owner had sued for infringement. The district court analyzed the mannequin head as a useful article used to teach make-up artistry and, after analysis, found it to be uncopyrightable because it did not evidence physical or conceptual separability. Pivot Point International v. Charlene Products, Inc., 170 F. Supp. 2d 828 (N.D. Ill. 2001). Although we make no assertion concerning the reference to Professor Goldstein's tests for separability which the court cited with approval, we do cite a statement by Judge Easterbrook of the Seventh Circuit [sitting by designation] concerning the issue of separability: "Conceptual separability differs from physical separability by asking not whether the features to be copyrighted could be sliced off for separate display, but whether one can conceive of this process." 170 F. Supp. 2d at 833. Again, although we have cited the Office's tests for separability [above at 5-6] and although the Office has not adopted any alternative tests proffered by copyright scholars or commentators [including Professor Goldstein], we nevertheless find Judge Easterbrook's comment consistent with Compendium II's tests for both physical and conceptual separability as well as with the House Report's explanation that the overall shape of a useful article is not to be afforded copyright protection. The Board finds no physical separability with respect to the two tumblers at issue here and so we turn to whether, under Compendium II's test, conceptual separability exists.

D. 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. As an example, section 505.03 also states, "Thus, carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for registration."
You have argued in your first request for reconsideration that "both tumblers... have unique and readily identifiable design elements conceptually separable from the overall cylindrical shape of the tumbler." Letter from M. Ferrell of 2/5/01 at 2. In support of this position you have cited Mazer v. Stein and Severin Montres Ltd. v. Yidah Watch Company. Id. at 3 - 5. The Board is persuaded that a valid argument exists that the designs are conceptually separable since the designs in question can be imagined separately and independently from the tumblers without destroying the basic shapes of the tumblers. Further, the designs in question may also be described as having been added to, and thus are non-essential to, the basic utilitarian function of the tumblers. Thus, the cut glass and fluted designs are conceptually separable under Compendium II's test, section 505.03: "... carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for registration."

We take this opportunity to comment on the two cases which you have cited. We agree with you that Mazer v. Stein, 347 U.S. 201 (1954), stands for the proposition that a work of art does not lose its copyright protection if it is subsequently incorporated into a useful article or an article of manufacture. We point out, however, that Mazer did not provide further instruction concerning the distinction between a work of industrial design and a work of art that might be part of that industrial work. Nor does the Office interpret Mazer as unqualifiedly stating that any article of manufacture having artistic or aesthetic qualities or features automatically qualifies for copyright protection. The House Report to the 1976 Act [above at 6], referred to the need for finding separable features in utilitarian objects and, in so doing, noted that the statutory requirement "is an adaptation of language added to the Copyright Office Regulations in the mid-1950's in an effort to implement the Supreme Court's decision in the *Mazer* case." H.R. Rep. at 55. The Board has found conceptually separable features in the two tumbler designs within the guidelines of Compendium II and not because of an interpretation of Mazer's holding that the presence per se of aesthetic or artistic qualities in a useful article ushers the work into protection.

We also take this opportunity to comment on Severin Montres v. Yidah Watch Co., 997 F. Supp. 1262 (C.D. Cal. 1997). In that case, the district court held the plaintiff's watch design, with a focus on the defining feature as being the letter "G" framed around the rectangular face of the watch and appearing as a "thick, three-dimensional block letter" [along with a featureless face, metal bracelet and clasp], was a design in which separable features were present. 997 F. Supp. at 1265. Further, the court held that the "G" design, in

particular, was copyrightable, given the Feist standard for creativity, Id., citing Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991). We must point out that the Office, even given the court's ruling on protection for the watch design, cancelled the registration made for the separable "G" lettering feature because it had determined that an examiner error had been made. The Office, as Ms. Giroux noted in her March 22, 2001 letter, would not knowingly register a claim in what is essentially the authorship of an alphabet letter configuration. Thus, although we would agree with you that the letter "G" surrounding the watch face at issue in Severin Montres is separable from the overall shape as well as the function of the watch as a useful article, we ultimately cancelled that registration because, even under Feist, the Office does not consider the basic shape of alphabet letters to be copyrightable. 37 C.F.R. 202.1[a]. We continue our discussion of the level of creativity in the tumbler designs at issue.

II. Originality: Feist's principle and Office practices

After finding that an element of a useful article is separable, the Board must then determine whether that element has sufficient originality to be copyrightable. Copyright protection is only available for "original works of authorship." 17 U.S.C. 102(a). The Supreme Court has stated that originality consists of two elements, "independent creation plus a modicum of creativity." Feist, 499 U.S. at 346. *See also* Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102 (2nd Cir. 1951) ("'Original' in reference to a copyrighted work means that the particular work 'owes its origin' to the 'author.' No large measure of novelty is necessary."); Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884) (The court defined "author" to mean the originator or original maker and described copyright as being limited to the creative or "intellectual conceptions of the author.").

Even prior to Feist, which was decided in 1991, courts interpreted "original" as requiring a low level of creativity. Any "distinguishable variation" of a work constituted sufficient originality as long as it was the product of an author's independent efforts, and was "more than a 'merely trivial' variation." Catalda at 102-103; *see also* Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903). Moreover, the Catalda court stated that originality for copyright purposes amounts to "little more than a prohibition of actual copying." 191 F.2d at 103.

However, at the same time that the Supreme Court reaffirmed in Feist the established precedent that only a modicum of originality is required for a work to be copyrightable, it also emphasized that there are works in which the "creative spark is utterly lacking or so trivial as to be virtually nonexistent." Feist at 359. The Court held that such works are incapable of sustaining copyright protection, Id., citing Nimmer on Copyright, 2.01[B]. The Court observed that "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity," Feist at 363, and that there can be no copyright in works in which "the creative spark is utterly lacking or

so trivial as to be virtually nonexistent." Id. at 359. A work that reflects an obvious arrangement fails to meet the low standard of minimum creativity required for copyrightability. Id. at 362-363. An example would be alphabetical listings in white pages of telephone directories, the type of work at issue in Feist, which the Supreme Court characterized as "garden variety...devoid of even the slightest trace of creativity." Id. at 362.

Copyright Office registration practices, even prior to Feist, recognized that some works of authorship have a *de minimis* amount of authorship and, thus, are not copyrightable. *See* Compendium II, 202.02(a). With respect to pictorial, graphic and sculptural works, which are Class VA works, the class to which the cut glass and fluted designs belong, section 503.02(a) of Compendium II states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." Further, there is no protection for familiar symbols, designs or shapes such as standard geometric shapes. 37 C.F.R. 202.1. In addition to stating that prohibition, Compendium II, which provides detailed instructions for Copyright Office procedures, is also based on the principle that creative expression is the basis for determining whether a work is copyrightable, not an assessment of aesthetic merit. Section 503.02(a) of Compendium II states that:

> Copyrightability depends upon the presence of creative expression in a work, and not upon aesthetic merit, commercial appeal or symbolic value. Thus, registration cannot be based upon the simplicity of standard ornamentation such as chevron stripes, the attractiveness of a conventional fleur-de-lys design, or the religious significance of a plain, ordinary cross. Similarly, it is not possible to copyright common geometric figures or shapes such as the hexagon or the ellipse, a standard symbol such as an arrow or a five-pointed star. 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.

The Office does not evaluate the aesthetic qualities of works. A work may be highly valued for its aesthetic appeal and, yet, not be copyrightable. Rather, copyright law requires evidence of more than a *de minimis* level of authorship in selection, coordination and arrangement. Works based on public domain elements may be copyrightable if there is some distinguishable element in their selection or arrangement that reflects choice and authorship that is not so obvious or so minor that the "creative spark is utterly lacking or so trivial as to be nonexistent." Feist at 359.

Based on the above considerations, the Appeals Board has found that, although the cut glass and fluted designs of the two tumblers at issue here are conceptually separable, registration must still be denied because the designs are comprised of simple geometric shapes that have been arranged in a simple, even obvious, way. The Board disagrees with your analysis that the designs have sufficient creativity to be copyrightable. You have stated that the "shapes are arranged in unique patterns to give visual perceptions of permanent glassware." Letter from M. Ferrell of 7/19/01 at 8. We point out that the "unique patterns" to which you refer are composed of [1] vertical lines separating equal-width long rectangular panels, and, [2] elongated triangles surrounding the lower half of the tumbler in a minor variation of a saw-tooth pattern. The level of creativity for these two patterns is *de minimis*. Essentially, in each design, a single geometric shape is repeated around the circumference of the tumbler to create a simple pattern. A slight modification in diameter occurs at the base of each tumbler creating a minor sculptural effect.

You have cited Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc., 490 F.2d 1092 (2d Cir. 1974) and Atari Game Corp. v. Oman, 888 F.2d 878 (D.C. Cir. 1989) (Atari I) as cases in which courts have ruled that the level of originality required for geometric designs is not high and that a work must be considered as a whole. Letter from M. Ferrell of 7/19/01 at 7. The Board of Appeals agrees that some geometric designs may be copyrightable because they possess the requisite quantum of creative authorship required by Feist. Also, the Board agrees with the principle that individual elements of which a work is composed must be considered as a whole, i.e., a work must be viewed as an entirety when one determines its copyrightability. When viewed as a whole, the selection and arrangement of public domain elements in the tumbler designs, that is, the repetition of a simple geometric shape and the slight increase in diameter, are not sufficiently creative to warrant registration.

In Soptra Fabrics and Atari I, we point out that the courts found the works at issue in those case to reflect sufficient authorship to meet the admittedly low level of creativity needed for copyright. In Atari I, the court remanded the case with the instruction that the Register again consider the audiovisual work at issue there, taking into account the court's opinion. The Atari I court emphasized that the individual screen displays must be taken together as a whole, "i.e., the total sequence of images displayed as the game is played." 888 F.2d at 883. The pre-Feist Atari I opinion was confirmed in its principles that a work must be viewed as an entirety and that the standard of originality for copyrightability is low [having been described as slight, minimal and modest] in the post-Feist Atari Games Corp. v. Oman, 979 F.2d 242 (D.C. Cir. 1992) (Atari II). In the latter opinion, the court again emphasized the need to view a work as a whole and to consider a work's "choice and ordering of elements that, in themselves, may not qualify for copyright protection" but where the author's "selection and arrangement" of elements, however, may constitute the creativity needed under Feist. 979 F.2d at 245. Again, in Soptra Fabrics, the Second Circuit, citing Catalda for the principle that modest authorship was sufficient for copyrightability, stated that in the textile fabric field, "a minimal quantum of originality... not very high" may

constitute copyrightability." The court held the "embellishment or expansion of the original design 'in repeat' so as to broaden the design and thereby cover a bolt of cloth, together with beginning the pattern in a particular way so as to avoid showing an unsightly joint when the pattern is printed on textiles on a continual basis," coupled with the fact that the "design printed is itself unmistakably original...," was sufficient for the pattern to be judged copyrightable. 490 F.2d at 1094. The design itself contained "a strip of crescents, scalloping or ribbons between that strip and then rows of semicircles." Id. at 1093.

The Board has not found in the two tumbler designs at issue here any authorship comparable to that in the Atari cases or in Soptra. Each of the tumbler designs is a simple arrangement based on a single geometric shape. Again, the cut glass design repeats a simple triangular pattern, with the elongated triangles set in a rather standard, saw-tooth pattern; and, the fluted design repeats a very simple vertical pattern with straight lines running down the surface of the tumbler, thus dividing the tumbler's surface into long rectangular spaces. Each design is arranged in an obvious manner around the tumbler's surface and following the tumbler's circular shape. Like the alphabetical arrangement in Feist, the repetition of simple geometric shapes around the circumferences of the tumblers falls within the category of authorship that is referred to in Feist as "garden variety" and "devoid of even the slightest trace of creativity." 499 U.S. at 362. The sculptural effect that is created by changing the diameter close to the base of the tumblers is a minor modification which, when taken as a whole along with the basic elements of the patterns on the tumblers, does not raise the level of authorship in each tumbler beyond *de minimis*.

There is substantial support in case law for the Board's conclusion concerning the non-copyrightability of the separable designs for these two tumblers: in Homer Laughlin China Co. v. Oman, 22 USPQ2d 1074 (D. D.C. 1991) (upholding refusal to register chinaware design pattern composed of simple variations or combinations of geometric designs due to insufficient creative authorship to merit copyright protection); in Jon Woods Fashions, Inc. v. Curran, 8 USPQ2d 1870 (S.D.N.Y. 1988) (upholding refusal to register fabric design consisting of striped cloth with small grid squares superimposed on the stripes where Register concluded design did not meet minimal level of creative authorship necessary for copyright); in John Muller & Co., Inc. v. N.Y. Arrows Soccer Team, 802 F.2d 989 (8th Cir. 1986) (upholding a refusal to register a logo consisting of four angled lines forming an arrow, with the word "arrows" in cursive script below, noting that the design lacked the minimal creativity necessary to support a copyright and that a "work of art" or a "pictorial, graphic or sculptural work ... must embody some creative authorship in its delineation of form.") *See also*, Magic Marketing, Inc. v. Mailing Services of Pittsburgh, Inc., 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 copyright protection); 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); and Forstmann Woolen Co. v. J.W. Mays, Inc., 89 F.Supp. 964 (E.D. N.Y. 1950) (label with words "Forstmann 100% Virgin Wool" interwoven with three *fleur-de-lis* held not copyrightable).

A simple arrangement may contain enough authorship to meet the creativity standard, yet, some selections and arrangements fall short of the mark. The Board is unable to discern in the tumbler designs any authorship, considered individually or as a whole, that is more than merely trivial. Again, each design is comprised of a single public domain shape, a triangular shape in the cut glass design and a rectangular one in the fluted design, repeated in a pattern or arrangement that reflects very few simple, and even obvious, choices. Each design has the simple addition of a slight modification in diameter near the base of the tumbler, creating a minor sculptural effect. In the words of Atari I, "simple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and in court." 888 F.2d at 883. The two tumbler designs at issue here are not manifestations of such copyrightable combinations of shapes.

For the reasons stated in this letter, the Board of Appeals affirms the Examining Division's refusal to register the two blow-molded tumbler designs. This decision constitutes final agency action in this matter. Again, we apologize for the long delay in getting this decision to you.

Sincerely,

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