The Register of Copyrights of the United States of America
United States Copyright Office · 101 Independence Avenue SE · Washington, DC 20559-6000 · (202) 707-8350

April 7, 2004

Neil S. Goldstein, Esq.
Gursky & Ederer, LLP
1350 Broadway, 11th Floor
New York, NY 10018

Re: DECORATIVE PICTURE/PLATE STAND
DECORATIVE PLANT HANGER
DECORATIVE BASKET
DECORATIVE URN-SHAPED BASKET
Control No. 61-205-4565(G)

Dear Mr. Goldstein:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated March 27, 2003, requesting reconsideration of a refusal to register the works entitled "DECORATIVE PICTURE/PLATE STAND," "DECORATIVE PLANT HANGER," "DECORATIVE BASKET," and "DECORATIVE URN-SHAPED BASKET" (hereinafter referred to collectively as "the DECORATIVE works") on behalf of your client, Rodney Loomis d/b/a Loomco. The Board has carefully examined the applications, the deposits and all correspondence in this case concerning these applications and affirms the denial of registration of these works.

ADMINISTRATIVE RECORD

Initial Submission and Office Refusal to Register:

On March 19, 2002, an attorney with your firm, Mary Grieco, submitted applications for registration together with photographs of "the Decorative works" on behalf of Rodney Loomis d/b/a/ Loomco. By letter dated May 8, 2002, Visual Arts Examiner, Wilbur King advised Ms. Grieco that the claims could not be registered because all of the works were "useful articles" which did not contain any separable authorship needed to sustain a claim to copyright.

Mr. King explained that a useful article is considered a pictorial, graphic or sculptural work only if it incorporates such design features as can be identified separately from and are capable of existing independently of the utilitarian aspects of the article, citing the definition of useful article in the copyright law. 17 U.S.C. § 101. He went on to relate that separability may be either physical or conceptual. H. R. Rep. No. 94-1476, at 55 (1976). Mr. King further explained that physical separability means separability by

ordinary physical means, giving examples of a lamp base of a Balinese dancer, and a pencil sharpener shaped like an antique car. Conceptual separability, he stated, involved authorship that was clearly recognizable as a sculptural work which can be visualized as free-standing sculpture, independent of the shape of the article, without destroying the article's basic shape. Letter from King to Grieco of 5/8/2002, at 1.

Mr. King continued that none of the artistic features can be perceived as having separate independent existence from the utilitarian aspects of the articles, there is no physically or conceptually separable authorship. *Id.* at 2. Further, he explained that even though certain non-functional features could have been designed differently, if those features are a part of the overall shape or contour of the useful article, no registration is possible.

First Request for Reconsideration:

In a letter to the Examining Division of September 5, 2002, an attorney from your office, Louis S. Ederer, requested reconsideration of the Copyright Office's refusal to register the DECORATIVE works. While conceding that the works were useful articles, he argued that the rejection of the copyright claims for the DECORATIVE works was in error. Letter from Ederer to King of 9/5/2002, at 2.

Mr. Ederer pointed out that the requisite level of creativity is extremely low. *Id.*, *citing*, Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991). He also stated that a sculptural work is entitled to protection if it incorporates "features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.*, *citing*, 17 U.S.C. § 101. He stated that separability may be either physical or conceptual and correctly cited the relevant tests: physical separability means that a "pictorial, graphic or sculptural feature incorporated into the design of a useful article ... can be physically separated from the article without impairing the article's utility and if, once separated, it can stand alone as a work of art traditionally conceived. *Id.* at 2, *citing*, Leicester v. Warner Brothers, 232 F.3d 1212, 1219, n.3 (9th Cir. 2000). Mr. Ederer also correctly stated that conceptual separability "means that the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work 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 of 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. *Id.* at 2-3, *citing*, The Compendium of Copyright Office Practices: Compendium II (1984) (hereinafter, "Compendium II").

Mr. Lederer states that the DECORATIVE PICTURE/PLATE STAND consists of an inverted "V" having a pair of horizontal legs from which spiral extensions protrude

from the end of the legs farthest from the "V." He states that although the "spiral extensions" are not physically separable, they are "clearly recognizable as a sculptural work independent of the shape of the stand. Letter from Ederer to King of 9/5/2002, at 3. He states that the spiral extensions can be imagined separately and independently, without destroying the basic shape of the stand and without affecting the utilitarian function of the stand. He continues that the extensions have "absolutely no relationship to the stand's ability to function as a stand" and "exist merely to make the stand more attractive." *Id.* at 3-4.

Mr. Ederer explains that the DECORATIVE PLANT HANGER consists of an inverted "J" with an upturned lip attached to the curved portion of the "J" to which a plant can be suspended. A pine cone shaped structure is interposed in the straight portion of the "J." *Id.* at 4. Mr. Ederer states that since the cone structure is a portion of the stand, it is not physically separable by ordinary means, but is clearly recognizable as a sculptural work independent of the shape of the hanger. He continues that the cone structure does not serve any utilitarian function and exists only for aesthetic effect. *Id., citing,* Brandir International, Inc., v. Cascade Pacific Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987).

He states that the DECORATIVE BASKET consists of a shopping bag-type structure, including handles. The front and back sections of the larger panels of the bag are formed by a circular structure centrally positioned having "S" shaped spokes extending form the center circle to the outer edges of the front and back sections. Mr. Ederer admits that the spokes are "integral to the shopping bag," but argues that the front, rear, and side "spokes" and the circular structure on front are imaginable as sculptural works. He argues that these elements exist merely for aesthetic purposes and that if the spokes were removed, the shape of the bag would not be destroyed. Letter from Ederer to King of 9/5/2002, at 5.

Lastly, Mr. Ederer explains that "it is difficult to separate the artistic and utilitarian aspects of Loomco's DECORATIVE URN-SHAPED BASKET, either physically or conceptually," but that the work is entitled to registration nonetheless. He argues that "conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities." Letter from Ederer to King of 9/5/2002, at 5-6, *citing* Nimmer on Copyright, § 2.08[B][3] at 2-101. He states that while intended for use as a basket, the work has "an independent aesthetic existence." He also states that "it is not hard to imagine the basket's marketability for strictly aesthetic purposes" and that the wire framework is such that the basket is not really useful, i.e., items would "simply spill or pour out." *Id.* at 6.

Thus, Mr. Ederer concludes that all of the Decorative works should be registered by the Copyright Office.

Examining Division Response to First Request for Reconsideration:

In a letter dated July 24, 2002, Examining Division Attorney Advisor, Virginia Giroux responded to the your first request for reconsideration and explained that the Examining Division fully reviewed the points raised in your letter. After explaining that the Examining Division carefully reviewed the works in light of the points raised in Mr. Ederer's letter, Ms. Giroux stated that the works must still be rejected because they are useful articles, functional in nature, and do not contain any separable authorship that is copyrightable. Letter from Giroux to Ederer of 11/27/2002, at 1.

Ms. Giroux explained that the copyright law defines a "useful article" as an "article having an intrinsic function that is not merely to portray the appearance of an article or to convey information. An article that is part of a useful article is considered a useful article." 17 U.S.C. 101. She also states that you do not dispute that the DECORATIVE works are useful articles, but rather argue that the works contain non-functional elements based on the designer's artistic judgment rather than utilitarian concerns, and as such, contain separable authorship that is copyrightable. *Id.* at 1.

Ms. Giroux points out that the Copyright Office examines a useful article to determine if it contains physically or conceptually separable elements that can be regarded as a "work of art" apart from the shape of the article in order to support a copyright registration. She also states that examiners do not make aesthetic judgments; nor are they influenced in any way by the attractiveness of a design, its visual effect and appearance, its uniqueness, the time and effort it took to create, or its commercial success in the marketplace during the examining process. *See*, Compendium II at § 505.03 (1984).

Ms. Giroux notes that the Copyright Office follows the test for conceptual separability which is enunciated in Compendium II, § 505.03, which follows generally the separability principles set forth in Esquire v. Ringer, 591 F.2d 706 (D.C. Cir. 1978). Compendium II states that conceptual separability occurs when the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper or as a free-standing sculpture, for example, independent of the shape of the article, without destroying its basic shape. Examples include the carving on the back of a chair or pictorial matter engraved on a glass vase. Letter from Giroux to Ederer of 11/27/2002, at 2.

Ms. Giroux explains that the Examining Division does not believe that any of the design elements or features to which Mr. Ederer referred can be perceived as conceptually or physically separable from the works themselves, without destroying their basic shape. In the Examining Division's view, "the inverted "V" shape and spiral extensions in DECORATIVE PICTURE/PLATE STAND, the inverted "J" shape with the upturned lip as well as the pine cone shape in DECORATIVE PLANT HANGER, the spokes with

spiral ends as well as the circular shape from which the spokes radiate in DECORATIVE BASKET, and the wire framework with interposed spokes in DECORATIVE URN-SHAPED BASKET [are] all part of the overall shape, contour, and configuration of the useful articles themselves, not physically or conceptually separable from the utilitarian function without destroying the basic shape of the article, and as such, not copyrightable." *Id.* at 2-3. She continues that "even if some of the elements were conceptually separable from the basic shape of the works, and we do **not** believe that they are, they consist of common geometric shapes or designs, or minor variations thereof, in the public domain, and, therefore, not copyrightable. This is explained in Sec. 202.1 of the Copyright Office Regulations. 37 C.F.R. 202.1. Even the combination and arrangement of the few sculptural elements, if they were separable, would not support separate registrations as copyrightable "works of art." *See*, Compendium II, Copyright Office Practices, Sec. 503.02(b)." *Id.* at 3.

Ms. Giroux also adds that although the Copyright Office agrees that the level of creative authorship necessary to support a claim of copyright is low, in applying this standard to a useful article, there must first be separable authorship. *Id.* at 3. She concludes that all of the elements or features of each work are either related to the utilitarian aspects or function, or are subsumed within the overall shape, contour, or configuration of the work such that the DECORATIVE works contain no separable authorship. *Id.* at 4. Thus, the Examining Division refused registration of the four works.

Second Request for Reconsideration:

In a letter dated March 27, 2003, you sent a second request for reconsideration to the Copyright Office's Board of Appeals. This letter is virtually identical to the first request for reconsideration and adds no new arguments nor any new authority in support of your position. Letter from King to the Board of Appeals of 3/27/2003. It is therefore unnecessary to repeat the arguments advanced, because they were summarized above in the first request for reconsideration.

DECISION

Description of Work:

- The DECORATIVE PICTURE/PLATE STAND consists of a metallic substance formed into an inverted "V" having a pair of horizontal legs from which spiral extensions protrude from the end of the legs farthest from the "V."

- The DECORATIVE PLANT HANGER consists of a metallic bar shaped into an inverted "J" with an upturned lip in the shape of a "U" attached to the curved portion of the "J" to which a plant can be suspended. A pine cone-shaped

structure is interposed in the straight portion of the "J." At the base of the hanger is a vise-like mechanism to affix the hanger to a surface.

- The DECORATIVE BASKET consists of a shopping bag-type structure, with inverted "U" handles. The front and back sections of the larger panels of the bag are formed by a design in the form of a circle with nine identical and symmetrically-placed, radiating shapes similar to a "9" affixed to the corner rail sections. The narrower side panels have "S" shaped designs affixed at an angle to the outer edges of the corner rail sections.

- The DECORATIVE URN-SHAPED BASKET is a metallic urn-like container consisting of a horizontal wire framework with interposed upright spokes.

DISCUSSION

The Board recognizes the applicability of Feist when examining and judging the authorship of a sculptural work or any other work. Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991). The Board further recognizes that the threshold for copyrightability of a work is low. Nevertheless, a threshold does exist, as indicated by the facts and holding of the Feist decision itself. 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," *Id.* 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.

Nevertheless, before considering the sufficiency of the creative authorship in a pictorial, graphic, or sculptural work that falls within the definition of a "useful article," there must exist separable authorship. 17 U.S.C. § 101. Since there is no dispute that all of the DECORATIVE works are useful articles within the statutory definition, the fundamental question is whether the DECORATIVE works contain physically or conceptually separable authorship.

Congress drew a clear line between copyrightable works of applied art and works of industrial design which are not subject to copyright protection. It did so by withholding protection from the shape of an industrial product - even though it might be aesthetically satisfying and valuable - unless the shape contains some elements that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article. Specifically, the House Report accompanying the current copyright law states that:

> In adopting this amendatory language, the Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted

> works of industrial design . . . . [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 is determined by aesthetic (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. No. 1476, at 55 (1976).

Physical separability exists when artistic or sculptural features can be physically separated from the utilitarian portion of the work. The landmark case of Mazer v. Stein, 347 U.S. 201 (1954), involved an easily recognizable separable work of sculpture of a Balinese dancing figure. And since Mazer, numerous cases have clarified that aesthetically pleasing and popular industrial designs which lack separable artistic authorship cannot support a copyright claim.

Conceptual separability exists when artistic "or sculptural features, ... can be visualized ... as free-standing sculpture ... 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 (1984). If the artistic features can be imagined separately and independently from the useful articles without destroying its basic shape, those features may be conceptually separable. Compendium II provides a useful example: "Thus, carving on the back of a chair, or pictorial matter engraved on a glass vase, could be considered for registration." *Id.* at § 505.03. Each of the DECORATIVE works have been examined by the Board under these tests for physical and conceptual separability and the Board agrees with the Examiner and the Examining Division that there is no separable authorship.

The DECORATIVE PICTURE/PLATE STAND contains only two identical elements alleged to be separable – the spiral shapes connected to the legs of the stand. Despite your contention that the spirals contain "absolutely no relationship to the stand's ability to function as a stand," the Board finds that these spirals do in fact serve a function. Letter from Goldstein to the Board of Appeals of 3/27/2003, at 3. Were a picture or a

plate placed into the stand with these spirals removed, these items could slide down from the stand. The spirals function as a brace which holds the picture or plate securely in place. Since picture or plate stands typically contain such an end piece to prevent the item from falling, the mere fact that this end piece is decorative does not alter the utilitarian function of the element. The fact that this end piece could have been designed differently makes no difference to the analysis. *See*, Compendium II, § 505.03. Since these spirals are integral to the function of the useful article, they can not be considered either physically or conceptually separable.

The DECORATIVE PLANT HANGER contains only one element alleged to be conceptually separable – the pine cone-shaped design. Were this shape affixed to the stand, it might be considered separable, but instead the shape was incorporated into the overall configuration of the hanger. While the purpose was to add aesthetic interest to the stand, it was made part of the useful article. Under the Office's tests for determining separability in useful articles, this artistic feature cannot be imagined separately and independently from the useful article without destroying the basic shape of the useful article.

The DECORATIVE BASKET is alleged to contain separable designs on the sides or "walls" of the bag-like article. While these designs are ornamental, they provide an intrinsic utilitarian function: they hold contents within the basket. Were these designs to be conceptually separated from the basket, the utilitarian function of the basket would be destroyed. *See*, Compendium II, § 505.03.

The DECORATIVE URN-SHAPED BASKET is not alleged to fit within either test for conceptual separability. Although you argue that a different test should be applied, i.e., Professor Nimmer's test, as Ms. Giroux correctly pointed out in the first request for reconsideration, this is not the test for conceptual separability followed by the Copyright Office. The test suggested by Professor Nimmer was his attempt to reconcile the decisions of two court cases, namely, 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. 1987). While the Kieselstein-Cord decision accepted that conceptual separability may be established even where no actual separability is possible, the Copyright Office's longstanding test for conceptual separability requires that the aesthetic features and the functional features must be simultaneously conceivable as complete works – that in the mind of the observer, a separation of the aesthetic work can be conceived without destroying the conceptual integrity of the utilitarian object.

Conceptual separability exists when artistic or "sculptural features, ... can be visualized, ... as free-standing sculpture, ... 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(1984). If the artistic features can be imagined separately and independently from the useful articles without destroying its basic shape, those features may be conceptually

separable. Examples given include the "carving on the back of a chair, or pictorial matter engraved on a glass vase . . . ." *Id.* Thus, a pictorial engraving on this basket could be considered for registration, while the basket itself may not, despite its aesthetic qualities.

The market-based test proposed by Professor Nimmer is not reconcilable with the Copyright Office's test - a test judicially endorsed in the Esquire case - or with the statute itself. *See*, 17 U.S.C. § 101, definition of "pictorial, graphic, and sculptural works." The test suggested - "that conceptual separability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities," Nimmer on Copyright, § 2.08[B][3] at 2-101 - would be impossible for the Copyright Office to apply without making subjective assumptions or objective factual surveys, because it looks to considerations external to the work itself, namely, the consumer's ultimate motivation for purchasing the work and the degree to which this aesthetic motivation is "significant" in the marketplace. Such extrinsic considerations are not relevant to the registrability of a work and are without basis in the statutory definitions of "useful article" and "pictorial, graphic, and sculptural works." 17. U.S.C. § 101. In addition, the subjectiveness of the suggested test would place Copyright Office examiners in the position of becoming arbiters of aesthetic merit in the marketplace. As Justice Holmes stated long ago: "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside the narrowest and most obvious limits." Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251 (1903).

In essence, the suggested test does away with the requirement of separability altogether, considering instead whether the entire work is capable of being marketed as a useful article and as an aesthetic work of art in the marketplace. Aside from the factual investigation necessary to make such a determination, the other significant problem is that such a test is capable of providing copyright protection to all useful articles under the proper circumstances without any showing of physical or conceptual separability. Such a result can not be reconciled with the statute and is contrary to the clear intent of Congress as expressed in the legislative history. H.R. Rep. No. 1476, at 55 (1976), *quoted, supra* at 6-7.

If the work was not found to be a useful article, but rather was only a depiction of a useful article, it would be protectable. For example, works of jewelry or a model car, neither of which serve a utilitarian function, are registrable as "works" rather than as "useful articles," because the intrinsic purpose of those works is aesthetic - merely to portray the appearance of the article. *See*, 17 U.S.C. § 101 definition of "useful article." Such an aesthetic work may be incorporated "in or on any kind of article, whether useful or otherwise." 17 U.S.C. § 113(a). But an article that does not merely portray a useful article, but rather is a useful article is not protectable without either physical or conceptual

separability. The DECORATIVE URN-SHAPED BASKET is a useful article that is neither physically or conceptually separable. It is, as the name implies, an aesthetically pleasing useful article. There is no aesthetic element of the basket that is physically or conceptually separable – a statutorily mandated condition for protection. *See*, 17 U.S.C. § 101, definition of "pictorial, graphic, and sculptural works."

In response to your argument that the basket is not useful for holding many types of materials, the Board nevertheless finds that it is a basket capable of holding material; it has an opening at the top, sides, and a base. "The shape of the alleged "artistic features" and the useful article are one and the same . . . ." Compendium II, § 505.03. The DECORATIVE URN-SHAPED BASKET is the overall configuration of a useful article and its mere attractiveness or the fact that alternative variations were possible is not relevant to the separability analysis. Compendium II, § 505.05.

The Board additionally notes that it agrees with the Examining Division that even were any of the alleged elements in the works to be considered separable, none of these elements rise to the level of sufficient creative authorship to sustain a claim to copyright. Therefore, the Board's firm conclusion that none of the works contain separable authorship results in essentially the same outcome which would be the case if the Board were to concede separability. The supposedly separable elements are merely *de minimis* variations on common geometric shapes which individually or in their selection and arrangement within each work are insufficient to sustain a claim of copyright. Thus, under either analysis – no separability or separable features which, nevertheless, are *de minimis* in their expression – these works were properly denied registration.

CONCLUSION

For the reasons stated in this letter, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register the "DECORATIVE PICTURE/PLATE STAND," "DECORATIVE PLANT HANGER," "DECORATIVE BASKET," and "DECORATIVE URN-SHAPED BASKET." This decision constitutes final agency action in this matter.

Sincerely,

/s/

Marybeth Peters
Register of Copyrights
for the Appeals Board
United States Copyright Office