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

May 20, 2004

Roberta S. Bren, Esq.
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

Re: MASTER-CARRE PATTERNED GLASS DESIGN
Control No. 61-204-8824(O)

Dear Ms. Bren:

I am writing on behalf of the Copyright Office Board of Appeals in response to your letter dated December 10, 2002, on behalf of your client, Saint-Gobain Glass France, requesting reconsideration of a refusal to register a work entitled "Master-Carre Patterned Glass Design." 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 this work.

ADMINISTRATIVE RECORD

Initial Submission

On February 6, 2002, the Copyright Office received a Form VA application from you on behalf of your client, Saint-Gobain Glass France, to register a patterned glass design as three-dimensional sculpture. In a letter dated March 7, 2002, Visual Arts Section Examiner Kathryn Sukites refused registration of this work because she determined that it lacked the artistic or sculptural authorship necessary to support a copyright claim. Ms. Sukites noted that a copyrightable sculpture must contain at least a minimum amount of original artistic material; she also stated that the ideas or concepts embodied in such a work are not protected by copyright. Lastly, she noted that copyright does not protect familiar symbols and designs, minor variations of basic geometric shapes, lettering and typography, or simple combinations of these elements.

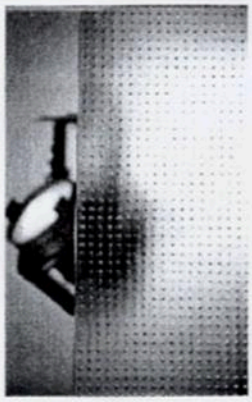
First Request for Reconsideration

On July 3, 2002, you requested that the Office reconsider its refusal to register the glass design. In support of your request, you assert that the work satisfies the two elements of an original work as set forth by the Supreme Court: "'independent creation' plus 'a modicum of originality.'" Letter from Bren to Examining Division of 7/3/02, at 2, citing Feist Publications Inc. v. Rural Telephone Service Co., 499 U.S. 340, 360 (1991).

To illustrate that the design was independently created, you provide the declarations of 1) Isabelle Bernheim, the person responsible for overseeing the creation of the design; 2) Russell H. Miles, "an engineer with over thirty years of experience in the rolled and patterned glass industry,"

who states that "he has never seen a glass design like the Master-Carre Design"; and 3) Steve Paetz, Director of Sales and Marketing for your client, who states "based on his experience, that the Master-Carre Design contains original creative expression that did not exist elsewhere prior to its creation, and therefore could not have been copied from another source." Letter to Bren to Examining Division of 7/3/02, at 5, citing respective declarations.

You assert that the design also contains the requisite modicum of creativity. In support of this assertion, you describe the glass design process and state that the design here consists of more than "glossy shapes [created] to a particular dimension with raised, finished, soft-rounded edges. The background is created by etching hexagonal cells, each with an open center, into a tightly interwoven mesh." Id. at 6.



You then cite several cases and pertinent sections of the Compendium II of Copyright Office Practices, (1984), for the proposition that the presence of simple shapes does not preclude copyright protection as long as they are combined in a distinctive manner. Id. at 7. You also state that if there is still doubt surrounding the copyrightability of the work here in light of the case law, the work should be registered under the Office's "rule of doubt." Compendium II, § 108.07.

Finally, you state that the design at issue here is conceptually separable from the useful article into which it is incorporated because it can be "visualized on paper as evidenced by the schematic drawing submitted to the Copyright Office" as part of the application and is not "dictated by functional considerations." Letter from Bren to Examining Division of 7/3/02, at 10-11.

In a letter dated August 12, 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 your request for reconsideration submitted on July 3, 2002, and determined that no copyright registration could be made for "the artistic or graphic contents on the surface of this work, a useful article, because, although conceptually separable from the utilitarian aspects or function of the work, they do not

contain a sufficient amount of original and creative authorship to support a copyright registration." Letter from Giroux to Bren of 8/12/02, at 1.

She noted that the Copyright Act does not extend protection to an idea, procedure or process, system, method of operation, concept, principle, or discovery. 17 U.S.C. § 102(b). She explained that as such "it is not the manufacturing process or technique used in applying or impressing the design onto the glass that is subject to copyright protection but rather the actual resulting expression or product." Letter from Giroux to Bren of 8/12/02, at 1.

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 did not dispute that the design here was conceived by Mr. Guillaume Saalburg. She agreed that there were elements on the surface of the work that were conceptually separable; but she found that these elements examined individually and as a whole were not copyrightable. She described the surface design as being repetitive in nature consisting of a series of raised square-like shapes with rounded corners on a background consisting of etched hexagonal cells with an open center. As such, she noted that the squares and hexagons are familiar geometric shapes in the public domain that are not copyrightable; likewise, she found that the combination and arrangement of these shapes did not rise to the level of copyrightable authorship needed to support a copyright registration. She then cited cases to support her determination.

She then distinguished the cases you cited as involving works that are more complex and containing more authorship than the work at issue here. She then refused to register the works under the "rule of doubt" because she found that the work clearly fell into the category of noncopyrightable works. 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 no protection will be accorded a useful article's design.

Second Request for Reconsideration

On December 10, 2002, you again requested reconsideration of the Office's refusal to register the glass design. To assist the Board in its examination, you provided: 1) a three-dimensional sample of the Master-Carre design; 2) an artistic rendering of the design prepared by a trained draftsman; and 3) the declaration of Ralph Oman, former Register of Copyrights.

You assert that several of the cases cited by Ms. Giroux were not on point as they were decided under a different legal standard and involved challenges to the Register's decision to refuse copyright registration. You state "[t]he present inquiry is one of registrability in the first instance. The presumption of validity afforded the Register's original decision to deny registration does not apply." Letter from Bren to Board of Appeals of 12/10/02, at 4.

You then took issue with Ms. Giroux's quotation of the legislative history of the Copyright Act discussing copyright protection for functional design in refusing registration. Id. at 5 (emphasis omitted). You urge that protection is not being sought for the shape of an industrial product but rather for the three-dimensional surface decoration.

Next, you recount that the design was independently created by Mr. Saalburg, thereby satisfying the first prong of originality. In addition, you assert that close inspection of the three-dimensional sample and the artist's rendition of the work reveals "numerous artistic and sculptural elements . . ., all of which are combined in a subtle, yet complex manner" which "cannot be characterized as mere 'minor variation' of a few public domain elements." Id. at 7. In support of this assertion, you state that there are three-dimensional pockets which are depressed in the glass and arranged in an offset design with the pockets in diagonal, rather than vertical or horizontal, lines. You further describe the pockets as having soft finished edges which "render them not quite squares and not quite rectangles," and their surfaces are polished to a shine "which allows light to pass through the glass to the rear surface and provides contrast against a matte background." Id. You state if you view the pockets from the rear of the glass, they create a "raised, rib-like pattern." Id. at 7-8.

Next, you describe the background design as consisting of minute hexagonal etchings which vary "ever slightly in depth and curvilinear modulation to enhance the play of light from the surface." Id. at 8. You further state that "the rows of hexagons bend or scallop subtly around the indented features to create a slight wave-like effect." Id. You assert that "[t]he design serves a decorative purpose, very similar to wallpaper or other wall covering" and "the reflective properties are the result of design choices, in depth and angle of cut, that are intrinsic to the design and are fixed in the tangible medium of the glass." Id. at 9. You argue that the design possesses the requisite level of creativity to support a copyright registration

DECISION

After reviewing the applications, the three dimensional sample, and the arguments you presented, the Copyright Office Board of Appeals affirms the Examining Division's refusal to register the Master-Carre Design because although conceptually separable from the utilitarian aspects or function of the work, the glass design does not contain a sufficient amount of original and creative authorship to support a copyright registration.

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 Office uses a separability test, set forth in section 505.02 of the Compendium of Copyright Office Practices, Compendium II, (1984) ("Compendium II"), which 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.

You do not dispute that the glass design is part of a useful article, and the Board acknowledges that protection is being sought only for the conceptually separable glass design and not for the overall shape of the useful article itself. Therefore, the Board must determine whether any pictorial, graphic or sculptural features of the glass are either physically or conceptually separable from the work's utilitarian function.

Physical Separability. The test for physical separability is as follows: "The physical separability test derives from the principle that a copyrightable work of sculpture which is later incorporated into a useful article retains its copyright protection." Compendium II, § 505.04 (1984). You do not contend that there are any physically separable pictorial, graphic or sculptural features in the glass design. The Board agrees that there are no physically separable elements; therefore, the Board must determine whether there are any pictorial, graphic or sculptural elements that are conceptually separable.

Conceptual Separability. Conceptual separability exists when pictorial, graphic, or sculptural features are "independent of the shape of the useful article, i.e., the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article." Compendium II, § 505.03. Section 505.03 provides a useful example: "Thus, the carving on the back of a chair, or pictorial matter engraved on a glass vase, would be considered for registration."

The Board concurs that the glass design is conceptually separable, as it can be visualized on paper and is independent of the shape of the useful article; thus, removal of the glass design will not

destroy the basic shape of the useful article. See Compendium II, § 505.03 (1984). The Board will now consider the copyrightability of the glass design.

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). As discussed above, the Board concludes that the glass design is conceptually separable. However, the Board concludes that the glass design does not constitute more than de minimis authorship and therefore is not copyrightable.

As you acknowledge, and the courts have held, originality has two components: 1) independent creation by the author and 2) a modicum of creativity. Feist Publications v. Rural Telephone Service Co., 499 U.S. 340, 345 (1991). The Board does not dispute that the overall design, i.e., the Master-Carre Design work in its entirety, although consisting of some elements which may fall within the public domain, was independently authored by Mr. Saalburg on behalf of your client, Saint-Gobain Glass France; thus, the sole issue left for the Board to decide is whether the glass design contains a modicum of creativity.

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, where the Supreme Court held that only a modicum of creativity is necessary to support a copyright. 499 U.S. at 345. 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. While "the standard of originality is low, . . . it does exist." Id. at 362.

The Compendium of Copyright Office Practices, Compendium II (1984) ("Compendium II") has long recognized this principle: "[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 the Master-Carre Design 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 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 . . . a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations [also cannot support a copyright].

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)(label with words "Forstmann 100% Virgin Wool interwoven with 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); Tompkins Graphics, Inc. v. Zipatone, Inc., 222 U.S.P.Q. 49 (E.D. Pa. 1983) (collection of various geometric shapes not copyrightable).

Despite the considerable case law sustaining Copyright Office decisions of refusal to register simple designs, the Office nevertheless recognizes that the use of public domain elements and/or commonly known shapes can result in a copyrightable work as long as the overall resulting design or overall pattern, taken in its entirety, constitutes 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 taken as a whole, on which a copyright can be based.

At the outset, the Board does not dispute that a tremendous amount of time and effort went into creating the Master-Carre Design or that the design is the "expression of eighteen months of [Mr. Saalburg's] intellectual labor." Letter from Bren to Board of Appeals of 12/10/02 at 6. However, as you know, Feist struck down the "sweat of the brow" doctrine. 499 U.S. at 353-354. Therefore, factors such as the Master-Carre Design's commercial success, the expense of creating it, the human effort expended in creating it, the professional skills and expertise of the designer or artistic recognition of the design are not relevant to the Board's determination of the Master-Carre Design's copyrightability. See, Homer Laughlin China Co. v. Oman, 22 U.S.P.Q.2d 1074, 1076 (D.D.C. 1991).

You describe the Master-Carre Design as having three-dimensional pockets which "are depressed in the glass, . . . and are arranged in a diagonal format." Letter from Bren to Board of Appeals of 12/10/02, at 7. The pockets have "soft finished edges that render them not quite squares and not quite rectangles" and their polished surfaces "allow[] light to pass through the glass to the

rear surface and provide[] contrast against a matte background. Viewing them from the rear of the glass, the pockets create a raised, rib-like pattern." Id. Further, the background consists of "minute hexagonal etchings" that "vary ever slightly in depth and curvilinear modulation," id., and "bend or scallop subtly around the indented features to create a slight wave-like effect," id. at 8, resulting in a "unique creation, heretofore not seen in the glass industry, or elsewhere." Id. at 6.

The Board finds that the Master-Carre Design consists of common and familiar geometric shapes: a minor variation on a square and a hexagon. The variation on the square consists of essentially rounding the corners of the square. These square-like shapes are placed on a background comprised of the etched hexagonal cells with an open center. Thus, even if the square-like shapes are "not quite squares and not quite rectangles," they are merely a minor variation on a square which itself is a common geometric shape. Similarly, the open centers on the hexagonal cells are minor variations on the common geometric shape of the hexagon. Neither the slightly varied square nor the open-faced hexagon exhibits sufficient authorship when examined individually. The Board agrees that the question to be decided is whether the combination or arrangement of these common geometric shapes exhibits sufficient original authorship.

The Board concurs with Ms. Giroux that the Master-Carre Design is repetitive in nature and consists of raised square-like shapes with rounded corners on a background consisting of etched hexagonal cells with open centers. The hexagonal cells are arranged in rows of straight lines horizontally and diagonal rows vertically. The square-like shapes are arranged at equidistant intervals, also resulting in rows of straight lines horizontally and diagonal rows vertically. This overall pattern is a symmetrical one and results from a mere bringing together of two standard shapes with minor variations thereof; such a combination fails to rise to the level of creativity required to support a copyright registration. As stated in Compendium II, § 503.02(a): "It is not possible to copyright . . . a simple combination of a few standard symbols such as a circle, a star, and a triangle with minor linear or spatial variations."

As such, the Master-Carre Design 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. Courts have consistently upheld the Office's refusal to register such works. Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q.2d 1879 (S.D.N.Y. 1988)(action brought under the Administrative Procedure Act upholding Copyright Office's refusal to register design consisting of striped cloth over which was superimposed a grid of 3/16" squares); Homer Laughlin China Co. v. Oman, 22 U.S.P.Q.2d 1074 (D.D.C. 1991)(action brought under the Administrative Procedure Act upholding Copyright Office's refusal to register chinaware design pattern); see also 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).

You take issue with the applicability of such cases to your request for reconsideration on the ground that these cases "involve court challenges to the Register's decision to refuse copyright registration, not registrability in the first instance. The presumption of validity afforded the Register's original decision to deny registration does not apply." Letter from Bren to Board of Appeals of 12/10/02, at 4. The Board disagrees. While you are correct that cases such as Jon Woods and Homer Laughlin, which were actions brought under the Administrative Procedure Act, were decided under an "abuse of discretion" standard, they are apposite nonetheless. In each case, the principles and case law discussed herein were applied to the works at issue to determine whether these works contained the requisite amount of authorship to warrant copyright registration. In each instance, the Office determined that registration was not warranted and that decision was upheld by the court. Because the Board concludes that the Master-Carre Design falls into the same category as these works--namely, works comprised of simple arrangements and simple variations of standard designs--such cases are particularly relevant to your request for reconsideration.

You are correct that the "mere incorporation of geometric shapes in the design does not itself prohibit copyright protection." Letter from Bren to Board of Appeals of 12/10/02, at 9, citing Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc., 490 F.2d 1092 (2d Cir. 1973). For instance, even though the dress design in Soptra was comprised in part of crescents and semi-circles--familiar and standard shapes--the court found "modest but sufficient originality so as to support the copyright." 490 F.2d at 1094. Specifically, the court found "modest but sufficient originality" in the "embellishment or expansion" of the "unmistakenly original" underlying design there "'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." Id.

There is no such originality and creativity in the arrangement of the Master-Carre Design. Again, the design is comprised of two basic elements–squares and hexagons–both common geometric shapes or minor variations thereof. Arranging the rounded squares and hexagonal cells into a symmetrical pattern comprised of horizontal and diagonal rows is a simple and standard arrangement which does not possess the requisite modicum of creativity. As such, the Master-Carre Design falls within the "narrow category of works" that do not satisfy the admittedly low threshold of creativity. Feist, 340 U.S. at 359.

Next, you list eight design features which you argue "required the considered judgment of the artist": 1) the recessed contours of the oblong figures; 2) the smooth shiny surface of the figures; 3) the soft and variable muted edges of the surface figures; 4) the framing around the oblong figures; 5) the etched hexagonal background figures; 6) the visual and tactile texture that constitute the background; 7) the depth and angle of the facets used to form the various sculptural elements; and 8) the subtle combination and interplay of the various artistic and sculptural elements. Letter from Bren to Board of Appeals of 12/10/02, at 10.

The Board does not dispute the fact that the creator of the Master Carre Pattern Glass design made a number of choices when creating this work; however, the Board finds these choices– to the extent that they represent individually identifiable features-- to represent largely utilitarian decisions or aesthetic choices which, with respect to each chosen feature itself and also with respect to the features considered in their totality, do not support a copyright. The Board notes that in theory an author creating any work has an unlimited choice of alternatives. However, it is not the possibility of choices that determines copyrightability, but whether the resulting expression contains copyrightable authorship. See, Florabelle Flowers, Inc. v. Joseph Markovits, Inc., 296 F. Supp. 304, 307 (S.D.N.Y. 1968) (an "aggregation of well known components [that] comprise an unoriginal whole" cannot support a claim to copyright). The Board concludes that the glass design here, upon examination of the design elementally and as a whole, does not contain a sufficient amount of original and creative authorship to sustain a copyright claim.

Finally, you argue that the Master-Carre Design contains sufficient creativity to support a copyright registration because the design has "heretofore not [been] seen in the glass industry, or elsewhere." Id. at 6. However, such comparison with other existing glass pattern designs is not determinative of a work's copyrightability. The Office does not judge, as part of its examining procedures, the commercial, artistic or aesthetic worth of a given work. As stated in Compendium II § 503.02(b): "The requisite minimal amount of original sculptural authorship necessary for registration in Class VA does not depend on the aesthetic merit, commercial appeal or symbolic value of a work." Thus, nothing can be concluded about the protectability of the Master-Carre Design as it compares to other glass designs. Again, focusing solely on the authorship in the Master-Carre Design in both its individual elements as well as its overall composition when it is regarded in its entirety, the Board has concluded that the design at issue here does not reflect design elements that are protectable in themselves nor does the Master-Carre Design reflect a creative manner of arrangement sufficient to justify registration.

For the reasons stated herein, the Copyright Office Board of Appeals affirms the refusal to register the Master-Carre Design. This decision constitutes final agency action in this matter.

Sincerely,

/S/

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