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March 8, 2005

Rosenman and Colin, LLP
Attn: Karen Artz Ash
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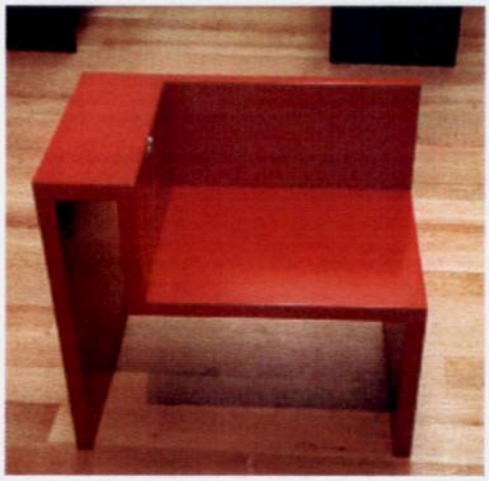
RE: CLOISTER SEAT
Control No. 60-906-1846(R)

Dear Ms. Ash:

On behalf of the Copyright Office Board of Appeals [now, Review Board], I am responding to your January 15, 2002, letter requesting a second review of our refusal to register a work entitled CLOISTER SEAT. This one copyright claim had been among eleven furniture designs previously submitted to this Office. Your letter requesting reconsideration argues that the copyright standards relating to useful articles should not be applied to this work since its primary function is not to serve as a chair, but instead to serve as a visual decoration. It is the Review Board's conclusion that the copyrightability standards relating to useful articles are applicable to the work at issue here. Applying these standards, the Board now affirms the Examining Division's refusal to register.

I. DESCRIPTION OF THE WORK

CLOISTER SEAT is a modernistic chair consisting of several [the deposit photographs appear to show six] rectangular panels which are solid red in color.



II. ADMINISTRATIVE RECORD

Initial submission:

The Copyright Office received 11 forms VA, deposits in the form of identifying material (photographs), and fees, covering copyright claims in eleven furniture designs on June 28, 2001. By letter dated October 1, 2001, Visual Arts Examiner John Martin refused registration on the ground that the designs were useful articles without any separable sculptural or artistic authorship. He elaborated that the various benches, seats, and stools did not display any sculptural or artistic features that could be identified separately from the works' intrinsically utilitarian form; nor did the works display the minimum creativity required for protection as an original work of authorship under the copyright law. Letter from Martin to Ash of 10/1/01 at 1.

First Request for Reconsideration:

In a letter dated November 15, 2001, you requested reconsideration of the Office's refusal to register the eleven furniture designs. You argued that while the letter refusing registration referred to your client's works as useful articles, you regarded the works as sculptural works entitled to registration. Letter from Ash to Martin of 11/15/01 at 1. After quoting the definition of "pictorial, graphic, and sculptural works" in section 101 of the copyright law, you asserted that artistic authorship was embodied in the unique, distinctive configuration of the works, independent of the utilitarian aspects of the articles. *Id.* at 1. As supporting authority, you cited the Supreme Court case of Mazer v. Stein, 347 U.S. 201 (1954), upholding copyright in works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned. You further cited a statement from the Nimmer treatise,1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, 2.08[B](1998) [hereinafter *Nimmer*], suggesting that the Mazer decision can be read to mean that aesthetically pleasing useful articles are subject to copyright protection. Letter from Ash of 11/15/01 at 2.

For guidance as to the meaning of conceptual separability, you quoted from Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987), in which the court ruled that a work was conceptually separable "where design elements can be identified as reflecting the designer's artistic judgement exercised independently of functional issues." Letter from Ash of 11/15/01 at 2. Applying that test, you asserted that artistic judgements, rather than functional issues, influenced your client's decisions as to the configuration of the furniture.

As further support, you cited the case of Kieselstein-Cord v. Accessories By Pearl, Inc., 632 F.2d 989 (2d Cir. 1980) upholding copyright in belt buckles containing

decorative features that serve both an aesthetic and utilitarian purpose. Again you cited *Nimmer,* 2.08[B][3], stating 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 Ash to Martin of 11/15/02 at 2. Applying the above authorities, you asserted that conceptual separability existed in the works in issue because the furniture designs were displayed as part of the Chinese Contemporary Art Exhibition presented by Goedhuis Contemporary at Sotheby's New York. You contended that such recognition was similar to the belt buckles found copyrightable in Kieselstein. Id. at 2-3.

Examining Division Attorney Adviser Virginia Giroux responded by maintaining the refusal to register on the grounds that the furniture designs were useful articles lacking separable copyrightable authorship. Ms. Giroux stated that the fact that the furniture designs had been displayed as part of the Chinese Contemporary Art Exhibition held at Sotheby's did not take the designs out of the useful article category. Letter from Giroux to Ash of 12/4/01 at 1. Under the definition of "useful article" in section 101 of the copyright law, she elaborated, as long as a work had at least one utilitarian function, it was considered a useful article. Id.

She pointed out that for useful articles, the definition of "pictorial, graphic, or sculptural work" in section 101 provided that the design of a useful article "shall be considered a pictorial, graphic, or sculptural work only if ... 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 with destroying its basic shape." Id. at 1. Legislative history, she stated, confirmed that separability may be physical or conceptual, citing H.R. Rep. No. 94-1476, 55 (1976). Letter from Giroux to Ash at 1-2.

Ms. Giroux stated that the Copyright Office applied a different test for conceptual separability from the one advanced in Brandir International v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987). Letter from Giroux of 12/4/01 at 2.[1] The test applied by the Copyright Office is enunciated in the Compendium of Copyright Office Practices, Compendium II, section 503.03 (1984), providing that, with respect to a useful article, conceptual separability occurs when a pictorial, graphic, or sculptural work can be visualized on paper, or as a free-standing sculpture, independent of the shape of the article and without destroying the shape of the article. Examples included the carving on the back of a chair, or pictorial matter on a glass vase. Id. at 2. Cases supporting the Copyright Office's interpretation of the separability requirement include Esquire v. Ringer, 591 F.2d

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[1] Ms. Giroux also pointed out that the court in that case ultimately found the work in issue, a bicycle rack, to be uncopyrightable because the design was adapted to accommodate a utilitarian purpose.

796 (D.C. Cir. 1978), *cert denied* 440 U.S. 908 (1979), regarding refusal to register an outdoor lighting fixture, and Norris Industries, Inc. v. International Telephone & Telegraph Corp., 696 F.2d 918 (11th Cir. 1983), *cert denied* 464 U.S. 818 (1983), holding that a wire-spoked wheel cover was not copyrightable. Letter from Giroux of 12/4/01 at 2 - 3. Turning to the works at issue, Ms. Giroux concluded that all were furniture designs in which no physically or conceptually separable design elements, separate and apart from the overall configuration of the furniture itself, could be identified under the Compendium II test without destroying the basic shape of the furniture pieces. She further stated that the fact that a work contained a unique or distinctive shape for purposes of aesthetic appeal did not mean that the features, as a whole, constituted a separable copyrightable work. Id. at 3.

Finally, she concluded that neither Mazer v. Stein, 347 U.S. 201 (1954), nor Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980) supported registration of the eleven furniture designs. The Mazer holding that a work of art did not lose copyrightability because of its intended use as part of a useful article did not apply to the works at issue here because the works are useful article amenable to the separability test and, after analysis, lack the necessary separable artistic authorship. In Kieselstein-Cord, the belt buckles at issue there were held by the court to contain separately identifiable sculptural shapes constituting separable authorship. Ms. Giroux did not find any comparable authorship in the furniture pieces at issue here. Id. at 3.

Second Request for Reconsideration:

In a letter dated January 15, 2002, a second request for reconsideration was filed for just one of the furniture designs; this work is entitled CLOISTER SEAT. You request that your client's work not be treated as a useful article, but instead as a sculptural work. Letter from Ash to Board of Appeals of 1/15/02 at 1. As authority for taking such an approach, you cite at length the costume case of National Theme Productions, Inc. v. Jerry B. Beck, Inc., 696 F.Supp. 1348 (S.D. Cal. 1988). You argue that in that case the court looked at the overall shape of a costume depicting a rabbit coming out of a hat. The court held that the overall shape of the costume constituted the artist's communication of aesthetic judgments exercised independently of functional considerations. Letter from Ash of 1/15/02 at 2.

You further argue that CLOISTER SEAT reflects the designer's artistic judgment exercised independently of functional issues. Your position is that the work in question, CLOISTER SEAT, was not designed primarily to serve as a functional chair. In fact, you claim the design was intended to explore the concept of modern space, a unique configuration reflective of the artist's conceptions of the interplay between light and space. Id. at 2. After pointing out several design aspects of CLOISTER SEAT that you describe

as not being particularly conducive to comfortable seating, you conclude that the design of the work as a functional chair is "secondary to its unique configuration, a refection of the artist's distinct interpretation of light and space" and, thus, should be registered. Id.

III. DECISION

Because the argumentation in your second request for reconsideration relies heavily on the reasoning in National Theme Productions, Inc. v. Jerry B. Beck, Inc., 696 F. Supp. 1348 (S.D. Cal. 1988), the Board has reviewed this case which you cite as supporting registration of CLOISTER SEAT. We have concluded that nothing in the opinion supports your contention that the copyright standards relating to useful articles should not be applied to a work such as CLOISTER SEAT. National Theme expressly held that costumes are useful articles, and as such, "are copyrightable, if at all, to the extent that they have features which can be identified separately and are capable of existing independently as a work of art." 696 F. Supp. at 1352. The costumes in that case represented, among others, a rabbit coming out of a hat and a dragon; the costumes had been registered by the Copyright Office. Prefacing its discussion of separability, the court referred to the House Report accompanying the 1976 Act and to the fact that the "objective behind the conceptual separability test is to distinguish copyrightable applied art from uncopyrightable industrial design" Id. at 1353. The National Theme court qualifiedly accepted the Second Circuit's adoption of the Denicola test for separability [*see* Brandir International, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1141 (2d Cir. 1987)] in so far as that test requires "one to look to an artist or designer's creative process, and the decisions going into that process, in creating a useful article." 696 F. Supp. at 1353. Applying this test, the National Theme court found separability in the costumes at issue. Id. at 1353-1354. The holding in National Theme does not, however, support copyright registration of CLOISTER SEAT: the Denicola test for separability is one of several which the Copyright Office does not follow. The following sets out the Office's long-standing tests for determining separability of artistic features in useful articles.

A. Separability

The purpose of the Office's separability analysis is to ensure that utilitarian aspects of useful articles are not registered since they are not subject to copyright. Written guidelines for the separability analysis are found in section 505 of Compendium II. 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.)

These 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. 94-1476 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. No. 94-1476 at 55 (1976).

B. CLOISTER SEAT must be treated as a useful article under the copyright law

You have asserted that the useful article standards should not apply to CLOISTER SEAT because the design of the chair's artistic features do not advance its utilitarian purpose. In fact, you argue that your client's work serves poorly as a chair, observing: "The CLOISTER SEAT has a flat bottom perpendicular to a flat back portion. These two features are not designed to advance its utilitarian purpose as furniture. If these features were designed to advance its utilitarian purpose as furniture, they would be curved to the contours of a human being's back and lower body..." Letter from Ash of 1/15/02 at 2.

We point out that whether the aesthetic or artistic design or configuration of a particular article furthers the accomplishment of a utilitarian purpose for that article is not a relevant consideration in applying the useful article standard of the copyright law. As we have explained above, the House Report to the 1976 Act, H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 (1976), which accompanied the massively revised copyright law of 1976, makes it clear that "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." The legislative history is useful in explaining that Congress meant no protection for articles of industrial or utilitarian design and, thus, the statute defines a "pictorial, graphic and sculptural" work as one which does not include mechanical or utilitarian aspects; further, the statute provides that a useful article is protected only to the extent that the design of the article incorporates 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. Compendium II states that the Office "may take administrative notice of matters of general knowledge. It may use such knowledge as the basis for questioning applications that appear to contain or be based upon inaccurate or erroneous information." Compendium II, section 108.05[b]. Although you have argued that the design of CLOISTER SEAT "was not intended to serve as furniture per se" [Letter from Ash of 1/15/02 at 2], the Board cannot ignore the photographs of the identifying materials as well as the title given to the work, CLOISTER SEAT, both of which point unequivocally to the fact that the work at issue here is a useful article, no matter how uniquely or fancifully it may be structured or configured.

We further take the liberty of citing a 2004 case, Pivot Point International, Inc. v. Charlene Products, Inc., 372 F.3d 913 (7th Cir. 2004), in which the Seventh Circuit held that the facial features of a head mannequin used to teach the application of makeup were

conceptually separable under the Denicola test as that test was applied by the Second Circuit in Brandir, 834 F.2d at 1145. As we have stated, *above at 5*, the Copyright Office applies the Compendium test to determine separability; the Office does not accept any of the several tests proffered by commentators and scholars to determine whether the design of a useful article "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, definition of "pictorial, graphic and sculptural works." We point out that it is also instructive to refer to the statutory definition of "useful article": it is an "article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." Id. A useful article, then, has at least one– "an"– intrinsic utilitarian function. Thus, an object having both a useful function as well as an aesthetic purpose may be classified as a useful article and fall under the statutory necessity of evidencing design features which must be separable as the statute describes that necessity in order to enjoy copyright protection. CLOISTER SEAT, explicitly described on the registration application form as "furniture design," is undoubtedly a type of seating utility, or bench, and that fact is confirmed by looking at the photographic deposit submitted for registration. The arguably artistic design of the work cannot sufficiently overcome the one intrinsic function of the same work to remove CLOISTER SEAT from the "useful article" class of works.

We have cited Pivot Point which provides a scholarly review of the topic of conceptual separability. And, although Pivot Point accepts a test for separability that the Office does not, we nevertheless point to Pivot Point's quoting from Judge Newman's dissenting opinion in Carol Barnhart, Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985). The quote concerns Judge Newman's proposed test that an ordinary observer may recognize in a particular object two different concepts in his mind– one utilitarian and the other non-utilitarian– and may displace the utilitarian concept of the object with one which is not. Judge Newman saw such displacement in the observer's mind to be a basis for determining that the necessary statutory separability may exist in a given useful object. Judge Newman uses the example of an "artistically designed chair displayed in a museum." Under his test, if the observer can displace the concept of the utility of the chair by some other [non-utility] concept, conceptual separability may exist. He further opines, as an example, that "[T]hat does not occur, at least for the ordinary observer, when viewing even the most artistically designed chair." Pivot Point, 372 F.3d at 926, citing Carol Barnhart, 773 F.2d at 422. We use this example to state again that the Office takes administrative notice of the facts provided by your client in the application form and notice of the deposit materials submitted; having taken such notice, we determine that a beautifully, or skillfully, or artistically-design chair is still a chair and, thus, amenable to the useful article separability requirement. As a useful article, CLOISTER SEAT must meet the statutory requirement of separability as applied in the Office's separability test for registration purposes.

The Office's understanding of separability as reflected in Compendium II's test, and as confirmed by the District of Columbia Circuit, *above at 7*,was confirmed again in Norris Industries v. International Telephone & Telegraph Corp., 696 F.2d 918 (11th Cir. 1983). In that case, the owner of a wire-spoked wheel cover argued that the useful article standard should not be applied because the wheel covers in question were purely ornamental. The 11th Circuit rejected this assertion, explaining its reasoning as follows:

> In response Norris pointed out that the design of its wheel cover allowed passage of road debris through it to the wheel of the automobile, and on appeal Norris states that one of its designs lacks the protective backplate. As the Register observes, however, the efficiency of a utilitarian article is irrelevant for copyright purposes.

Id. at 922, footnote 8.

Although a case decided under the 1909 statute, a similar result was reached by the district court in Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co., 155 F.Supp. 932 (S.D.N.Y. 1957), *aff'd in part, reversed on other grounds,* 260 F.2d 637 (2d Cir. 1958). This decision affirmed a decision of the Copyright Office that an artistically-designed watch face was not copyrightable. The District court rejected the argument that the watch face was a poor work of utility in the following language:

> In order to support its claim that the watch is a work of art, plaintiff has gone so far as to cite testimony that it is hard to tell time by its watch. That plea that it is not a work of utility because it is not a very good work of utility, however, seems to me as ineffective as the oft proffered plea that something is not a work of art because it is not a very good work of art. 155 F.Supp. at 934-935.

Again, Compendium II, section 505.03 states that the shape of a useful article is not protectible on the "mere fact that certain features are nonfunctional or could have been designed differently [because such a fact] is irrelevant under the statutory definition."

Concerning your assertion that CLOISTER SEAT should be regarded as "a reflection of the artist's distinct interpretation of light and space," [Letter from Ash of 1/15/02 at 2], aesthetic considerations concerning the shape of a useful article cannot transform that article into a copyrightable work of art. In Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985), the Second Circuit held that mannequins of partial human torsos used to display articles of clothing were utilitarian articles which did not possess artistic or aesthetic features that were physically or conceptually separable

from their utilitarian dimension. The court rejected the plaintiff's appeal to aesthetic considerations in the following language:

> Applying these principles, we are persuaded that since the aesthetic and artistic features of the Barnhart forms are inseparable from the forms' use as utilitarian articles, the forms are not copyrightable. Appellant emphasizes that clay sculpting, often used in traditional sculpture, was used in making the molds for the forms. It also stresses that the forms have been responded to as sculptural forms, and have been used for purposes other than modeling clothes, e.g. as decorating props and signs without any clothing or accessories. While this may indicate that the forms are "aesthetically satisfying and valuable," it is insufficient to show that the forms possess aesthetic or artistic features that are physically or conceptually separable from the forms' use as utilitarian objects to display clothes. On the contrary, to the extent the forms possess aesthetically pleasing features, even when these features are considered in the aggregate, they cannot be conceptualized as existing independently of their utilitarian function.

Id. at 418.
Such an assessment finds consistency with congressional intent that an aesthetically satisfying shape cannot, in itself, bring a useful article into conformance with the statutory separability requirements for protection of a useful article. Your appeal arguments identify no physically or conceptually separable features from the overall configuration of CLOISTER SEAT; and, the Board's close inspection of the identifying materials submitted for registration of the work confirms the lack of such separable features.

In conclusion, because CLOISTER SEAT is a useful article which does not possess separably identifiable artistic features, we must affirm the Examining Division's decision to refuse registration.

The Board's decision constitutes final agency action in this matter.

Sincerely,

/s/

Nanette Petruzzelli
Special Legal Advisor for Reengineering
for the Review Board
United States Copyright Office