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March 31, 2005

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RE: Gerard Console with Stone Top Lombard Chest
Control Number: 61-207-7196(B)

Dear Mr. Crosby:

I am writing on behalf of the Copyright Office Board of Review in response to your second request for reconsideration, dated July 28, 2003. After reviewing the application from C & C Imports, Inc. D/B/A Nancy Corzine and the arguments you presented on the company's behalf, the Board affirms the Examining Division's refusal to register Nancy Corzine's copyright claims for decorative elements in furniture identified as Lombard Chest and Gerard Console with Stone Top.

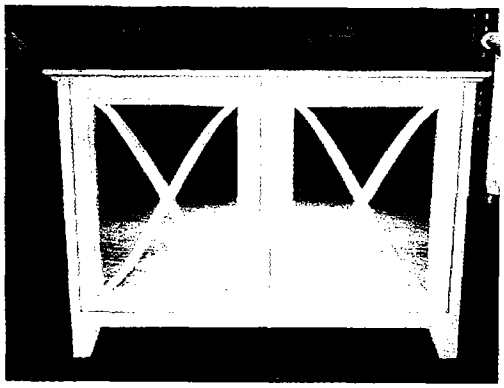
ADMINISTRATIVE RECORD

Applicant, C & C Imports, Inc. D/B/A Nancy Corzine, submitted many applications, each to register decorative elements on different pieces of furniture and each received by the Office on January 3, 2003. Since a second request for reconsideration has been submitted for only two of the applications, this administrative record is limited to those two, which are the Gerard Console with Stone Top, hereinafter, "console," and the Lombard Chest, hereinafter, "chest." On August 6, 2002, Examiner, Kathryn Sukites, refused examination for the console and chest because she found them to be useful articles with no physical or conceptually separable elements that are copyrightable.

On December 2, 2002, you submitted a request for reconsideration for the console and chest on behalf of your client. You argued that Ms. Sukites had not applied the rules for physical and conceptual separability in a consistent manner. Specifically, with regard to the console and chest, you said:

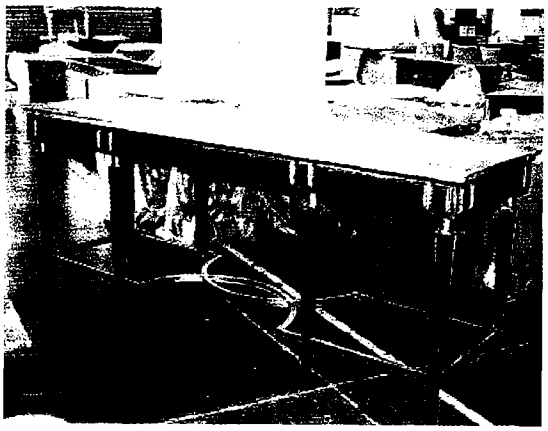
> The Lombard Chest has curved X-shaped artwork on its front face with a mirror backing. This ornamental artwork can be physically separated without destroying the overall three-dimensional,

rectangular shape of the chest. Further, it can be conceptually separated and visualized as free-standing artwork.



The Gerard Console with Stone Top has horizontal embellishments and carving on the vertical panels and console legs. The embellishments and the carving can be physically separated without destroying the overall table-like shape of the console. Further, they can be conceptually separated and visualized as free-standing artwork.

Letter from Crosby to Sukites of 12/4/02, at 2.



On March 28, 2003, Attorney Advisor, Virginia Giroux, determined that the decorative elements in the chest and console are conceptually separable, but upheld the refusal to register them on the basis that they did not have sufficient originality to be copyrightable.

On July 28, 2003, you requested that the Copyright Office Appeals Board, renamed the Review Board[1], again reconsider the refusal to register the console and chest, arguing that their decorative elements are physically and conceptually separable and that they have sufficient originality to be copyrightable. You rejected Ms. Giroux's argument that the law, as reflected in 37 C.F.R. 202.1, prohibits copyright protection for the decorative shapes because they are common and familiar shapes or designs in the public domain. Your further assert that "[w]here design elements reflect designer's artistic judgement exercised in independently of functional influences, conceptual separability exists, and the work is copyrightable." Letter from Crosby to Chair of the Board of appeals of 7/28/03, at 2, citing Brandir Int'l Inc., v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987).

DECISION

I. Useful articles

The Board of Appeals has determined that the console and chest are useful articles. As their names indicate, these works are furniture. The Board recognizes these works to be useful articles under authority set out in Compendium II, Compendium of Copyright Office Practices (1984). Section 108.05[b] of Compendium II states that the Office may take administrative notice of matters of general knowledge and may use such knowledge as the basis for questioning applications. The Board's classification of applicant's furniture as useful articles is strongly bolstered by the statutory definition of useful article 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. Also, any article that is "normally a part of a useful article is considered a 'useful article.' " Id. Finally, you acknowledged the works are useful articles by framing your arguments for registration based on the works having separable authorship--the statutory requirement for a useful article's enjoyment of any copyright protection. 17 U.S.C. 101 defines a pictorial, graphic and sculptural work; limits its protection to exclude any mechanical or utilitarian aspects of such a work; and indicates the need for separable features in the design of a useful article. Thus, as useful articles, the console and chest are subject to the separability analysis that copyright law requires for 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 copyrightable. Written guidelines for the separability analysis are found in section 505 of Compendium II. Section 505.02 states that:

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[1] On January 27, 2005, the body which considers an applicant's second request for reconsideration of a refusal to register a work became known as the Review Board. See 69 Fed. Reg. 77636 (December 28, 2004).

> 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, that is discussed above, is a valid interpretation of copyright law because it 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).

When the Board determines that there is either a physically or conceptually separable aspect of a useful article, the next step in its review is to analyze the separable element to determine whether it satisfies the originality requirements that are necessary for copyrightability. The Board's analysis of those two factors, separability and originality, as applied to the console and chest is set forth below.

B. Physical separability

As quoted earlier, the definition of a useful article is that it has an "intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. The statute also provides that registration is possible only if, and to the extent that, a work contains pictorial, graphic or sculptural features that are separable from the useful article. 17 U.S.C. § 101 (definition of "pictorial, graphic and sculptural works") and § 102(b). Based on these statutory provisions and legislative history, the Copyright Office applies a physical separability test that is contained in § 505 of Compendium II. As quoted above, § 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.

As quoted above, "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 functional aspects of the useful article are copyrightable. H.R. Rep. No. 94-1476, at 55 (1976). Only elements that are independent of utilitarian functions are copyrightable.

Therefore, the Board found no features of either work *physically* separable. The X designs serve as doors for the chest. The horizontal lattice work around the bottom of the legs of the console functions as part of the base that supports the table top. However, the Board does agree that these features are conceptually separable.

C. 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 of Compendium II also 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.

The Board agrees that the horizontal lattice work around the console's table legs and the X designs on the doors of the chest can be imagined separately from the overall design and function of the works. However, the Board would like to clarify a point you made in your second request for reconsideration, in which you cited Brandir Int'l , Inc. v. Cascade Pacific Lumber Co. for the proposition that, where conceptual separability exists, a work is copyrightable. Letter from Crosby to Chair of the Board of Appeals of 7/28/03, at 2. That characterization is somewhat inaccurate. As explained, supra, when a work has conceptually separable elements, those elements may be copyrightable if they have a sufficient level of creativity. Conceptual separability alone is not sufficient for elements of a useful article to be copyrightable. Therefore, although the Board agrees that the decorative elements of the works are conceptually separable, registration must still be denied because the level of creativity in those elements is *de minimis*.

D. Originality

As explained above, after finding that an element of a useful article is separable, the Board then evaluates whether it 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 Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340, 346. *See also* Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102 (2d 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, courts interpreted "original" as requiring a low level of creativity. Any "distinguishable variation" of a work constitute sufficient originality as long as it is the product of an author's independent efforts, and is "more than a 'merely trivial' variation." Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250 (1903): "... a very modest grade of art has in it something irreducible, which is one man's alone."

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. 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 have always 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 [visual arts] works, 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 registration procedures, also reflects 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.

Section 503.02(a) reflects the policy that is also the basis for 37 C.F. R. § 202.1, a provision that you reject as a basis for rejecting Applicant's copyright claim. However, the policy reflected in these provisions represents one of the most fundamental principles of copyright law, which is that common ordinary shapes and designs, and minor variations of those, may not be copyrighted because that could limit their availability to the general populace. Basic, common and ordinary shapes, designs and symbols are in the public domain for use by all since they form the building blocks for creative works.

Also, 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* quantum of authorship and such authorship may consist of a

selection, coordination and arrangement of preexisting elements or features. Works based on public domain elements may be copyrightable if there is some distinguishable element in their selection, arrangement or modification that reflects choice and authorial discretion and 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. *See also* 17 U.S.C. 101– definitions of "compilation" and "derivative work." Although the individual components of a given work may not be copyrightable, the Copyright Office follows the principle that works should be judged in their entirety and not judged in terms of the protectibility of individual elements within the work. Atari Games Corp. v. Oman, 979 F.2d 242, 244-245 (D.C. Cir. 1992).

The analysis followed in the Office's examining procedure for determining whether there is sufficient creativity for copyright protection does not involve comparing works. Compendium II, section 108.03. Rather, each work is examined for registrability based on its own merits, without comparison to prior art or to other existing / registered works.

The X design on the chest and the horizontal lattice work around the legs of the console have only a *de minimis* amount of creativity. There is substantial support in case law for the Board's conclusions that Applicant's works are not copyrightability: in Homer Laughlin China Co. v. Oman, 22 U.S.P.Q.2d 1074 (D. D.C. 1991) (upholding refusal to register chinaware design pattern composed of simple variations or combinations of geometric designs due to insufficient creative authorship to merit copyright protection); in Jon Woods Fashions, Inc. v. Curran, 8 U.S.P.Q.2d 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).

The Board finds that the decorative elements in Lombard Chest and Gerard Console consist of uncopyrightable variations on simple shapes--too simple to result in an overall work that rises to the level of copyrightable authorship. Like the alphabetical arrangement in Feist, the horizontal lattice work and X shaped designs fall within the category of simple, less than minimal authorship which Feist referred to as "entirely typical"or "garden variety" authorship. While a

"simple arrangement" may contain enough authorship to meet the creativity standard, as Feist holds, some selections and arrangements fall short of the mark. There is no authorship, considered individually or as a whole, that is more than merely trivial in the decorative elements that are part of Applicant's works.

For the reasons stated in this letter, the Board of Review affirms the Examining Division's refusal to register Lombard Chest and Gerard Console. This decision constitutes final agency action in this matter.

Sincerely yours,

/s/

Marilyn J. Kretsinger
Associate General Counsel
For the Review Board
United States Copyright Office