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February 23, 2005

Matthew R. Jenkins, Esq.
Jacox Meckstroth and Jenkins
2310 Far Hills Bldg.
Dayton, OH 45419-1575

Re: Gun Cover and Design
Control No. 61-216-9920(J)

Dear Mr. Jenkins:

I am writing on behalf of the Copyright Office Board of Appeals [now, Review Board] in response to your letter dated March 2, 2004, requesting a second appeal of the Copyright Office's refusal to register a work entitled "GUN COVER AND DESIGN" on behalf of your client, Shoot-A-Way, Inc. The Review Board has carefully examined the application, the deposit, and all correspondence in the case concerning this application and affirms the denial of registration because the work is a useful article that does not contain sufficient separable authorship to support a claim to copyright.

I. DESCRIPTION OF THE WORK

The representative photograph of the work submitted for deposit depicts a four-sided cover intended to be placed over a basketball return device. It has three, inwardly-sloping sides that meet a rounded top of the cover. At the front of the cover is an oval opening for expulsion of a basketball and at the top, there is a funnel-like attachment to catch the basketballs as they descend from the hoop. The deposit depicts this cover on a rectangular base with wheels on each corner.

In addition to the sculptural features of the work, there are pictorial and graphic elements located on the sides of the cover. There is a pictorial depiction of a basketball with three lines (of varying thicknesses) angling diagonally downward from the ball. There are also lines on the bottom. There are also two horizontal lines (again, of different thicknesses) on the bottom of the cover's sides. In a region between the diagonal and horizontal lines, there is a graphic arrangement of the words "THE GUN" with a basketball depicted as shooting out of the top of the top of the "G". Reproductions of representative deposit photographs are presented below and your "Exhibit A", referenced in this letter, is appended at the end of this letter.







II. ADMINISTRATIVE RECORD

A. Initial submission and Office refusal to register

The initial application for registration, received on June 9, 2003, sought registration for the work entitled GUN COVER AND DESIGN as a three-dimensional sculpture. In a letter dated June 11, 2003, Visual Arts Examiner Joy Fisher Burns rejected the application because the work is a useful article that, although containing separable elements, contains insufficient separable authorship to warrant copyright protection. Ms. Burns also noted that copyright does not protect familiar shapes, symbols and designs or simple variations or combinations of basic geometric designs. (Letter from Burns to Jenkins of 6/11/03.)

B. First request for reconsideration

In a letter dated July 30, 2003, you requested reconsideration of the Examiner's denial of registration. You stated that the "purpose" of the design was to aesthetically enhance the appearance of a basketball practice machine. (Letter from Jenkins to the Chief of the Receiving and Processing Division of 7/30/03 at 2.) In support of this view, you referenced John G. Joseph's declaration of 7/24/03, which generally confirm that the cover was created in such a way as to enhance the aesthetic appeal of the cover. (Letter from Jenkins to the Chief of the Receiving and Processing Division of 7/30/03 at 3-4 and Declaration of John G. Joseph of 7/24/03 at 1-2.)

You cited the low threshold for originality articulated in Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 345 (1991) and in Nimmer on Copyright, 1 Nimmer on Copyright § 2.01[A] at 2-9 (2003) to support the truism that originality does not require novelty. Similarly, the requisite level of creativity does not demand an inventive leap, or a new idea, but simply "a spark of distinctiveness in expression." (Letter from Jenkins to the Chief of the Receiving and Processing Division of 7/30/2003 at 4.) You also correctly state that separability may be either physical or conceptual and cite the Copyright Office's test for conceptual separability in the Compendium II, Copyright Office Practices, § 505.03. Id.

To refute the refusal of registration, you argue that the Examiner erred on three points: independent creation, creativity, and separability. Id., at 5. You point to Mr. Joseph's declaration to show that the work was not copied and was therefore independently created, i.e., original. Id.

You argue that the work is creative for the following reasons. First, you note that the purpose of the sculptural features and the graphic design was "to enhance the aesthetic appeal of the device" and to make it attractive and aesthetically pleasing. Id. Second, you maintain that the graphic design comprised of "a series basketball-themed graphics, lines and color blocks" arranged and organized in their particular manner create a "high performance, athletic appearance." Id. Third, you state that the sculptural cover's angled lines and contours were selected to give the device a "modern and aesthetically pleasing appearance." Id. Fourth, you argue that "the combination of the sculptural cover and the graphic design" reaches a level of creativity that "exceeds the "extremely low" requirement set by Feist...." Id., at 6. Fifth, aside from the "combination" of sculptural and graphic elements, you maintain that separately, both the sculpture and design are original and sufficiently creative.

In regard to separability, you agree with the Examiner's determination that the design graphics are conceptually separable and recognizable as pictorial or graphic works that have little or no relation to the function or idea of the machine to which they are attached, citing Kieselstein-Cord v. Accessories By Pearl, Inc., 632 F.2d 989 (2d Cir. 1980). (Letter from Jenkins to the Chief of the Receiving and Processing Division of 7/30/03 at 6.) Furthermore, you assert that the sculptural work "is conceptually independent of the function or idea of the cover, ***which is to shield the working parts of the machine to which it is attached.***" Id. (emphasis added). You continue that the "artistic sculptural features [labeled as features G-K in your Exhibit A] are also separable from this idea," and that "an ordinary observer would not think of the idea of shielding mechanical parts of a machine when looking at the sculptural features of Mr. Joseph's cover and graphics. Again, the author's unique design of the cover(including its shape and angled walls) and exterior graphics sets it apart from the cover's utilitarian purpose." Id. Thus, you conclude that the "unique arrangement and combination of the aforementioned sculptural and design features is original to Mr. Joseph and ***have little*** or no relation to the function of the machine." Id. (emphasis added).

C. Examining Division response to first request for reconsideration

By letter from Attorney Advisor Virginia Giroux dated November 5, 2003, the Examining Division again refused registration because the work is a cover or housing for a useful article, a basketball practicing machine, which is also considered to be a useful element for copyright purposes and, as such, does not contain any authorship that is both separable and copyrightable.

Ms. Giroux explained that section 101 of the Copyright Act defines a "useful article" as an "article having an intrinsic utilitarian function that is not merely to portray the appearance of an article or to convey information. An article that is normally part of a useful article is considered a useful article." 17 U.S.C. 101. She further explained that the statute provides that the "design of a useful article shall be considered a pictorial, graphic, or sculptural work only if and to the extent that such design incorporates pictorial, graphic, or sculptural features that can be identified separately from and are capable of existing independently of the utilitarian aspects of the article without losing its basic shape." (Letter from Giroux to Jenkins of 11/5/2003 at 1.)

She continued, "[i]n examining a work within the useful article category, the Copyright Office must first determine whether the work has any pictorial, graphic, or sculptural authorship that is either physically or conceptually separable from the utilitarian aspects of the article. In applying this standard, the Copyright Office examines such a work 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. Examiners do not make aesthetic judgments; nor are they influenced in any way by the attractiveness of the design, its uniqueness, its visual effect and appearance, the time and effort it took to create, or its commercial success in the marketplace during the examining process." Id., at 1-2.

Ms. Giroux pointed out that your letter does not dispute the fact that the work, a cover or housing, is a useful article, but that you argue in favor of registration because this work contains non-functional design elements based on the designer's aesthetic judgment rather than utilitarian concerns and as such, contains physically or conceptually separable authorship that is copyrightable. Ms. Giroux stated that the Examining Division does not agree with your conclusion. Id., at 2.

The test for physical separability derives from the principle that a copyrightable work of art which is later incorporated into a useful article retains its copyright protection. Examples of works meeting the physical separability test include a sculptural lamp base of a Balinese dancer, or a pencil sharpener shaped like an antique car. 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 or cover or other component of a useful article is detachable from the working parts of the article. *See,* Compendium II, § 505.04. She stated that the Examining Division does not believe that any of the components or elements embodied in this work meet the test for physical separability. (Letter from Giroux to Jenkins of 11/5/2003 at 1.)

Ms. Giroux explained that the Copyright Office's test for conceptual separability is articulated in Compendium II, § 505.03, which follows generally the separability principle set forth in Esquire v. Ringer, 591 F. 2d 796 (D.C. Cir. 1978). The 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, for example, or as a free-standing sculpture, as another 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. Id., at 2.

She clarified, however, that the test for conceptual separability is not met by merely analogizing the general shape of an article to works of modern sculpture since in this case, the alleged "artistic or decorative" features and the useful article cannot be perceived as having separate existences. Further, where certain features are non-functional or could have been designed differently, if the features are an integral part of the overall shape or contour of the useful article, no registration is possible. *See,* Esquire v. Ringer, supra, in which the court of appeals upheld the Copyright Office's refusal to register an outdoor lighting fixture on the grounds that copyright protection was not possible based on the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape or configuration might be." The copyright law that took effect in 1978 codifies this practice of precluding registration of claims to copyright in the overall shape or form of articles that have a utilitarian function. The only possible basis for a registration of a useful article are those features of the useful article that can be viewed as separable and that is also copyrightable as a "work of art". Id., at 2-3.

Ms. Giroux stated that the Copyright Office concedes that the pictorial or graphical elements on the cover are conceptually separable from the utilitarian aspects, but nevertheless finds these separable elements to lack the minimal level of creativity necessary to maintain a registration. In addition, while she stated that the Copyright Office accepts that the work was not copied from another, i.e., independently created and original, to be regarded as copyrightable, a work must not only be original, but it must also "possess more than a de minimis quantum of creativity." Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991). In the case of a design, a certain minimum amount of pictorial, graphic, or sculptural material in the work must have originated with the author. In the instant work, Ms. Giroux explains that the Examining Division does not find more than a trivial variation of public domain elements. Id., at 3. Specifically, she explains:

> The basketball shapes, as well as the angular and straight parallel lines, or any minor variation thereof, are common and familiar shapes, in the public domain, and are, therefore, not copyrightable. This is explained in Sec. 202.1 of the Copyright Office

> Regulations. 37 C.F.R. 201.1. Names, titles, words, and short phrases as well as coloring are also not copyrightable as stated in the same regulation. The artistic or graphic authorship on the surface of this work does not, in our view, reflect sufficient originality and creativity to support a separate registration as a copyrightable "work of art". As a graphic design, even the combination and arrangement of the surface elements do not rise to the level of copyrightable authorship [necessary] to sustain a copyright registration. The resulting design is de minimis involving mostly public domain elements arranged in a rather simple configuration. *See*, Compendium II, Copyright Office Practices, §§ 503.02 (a) &(b).
>
> The Compendium II principle, referred to above, is confirmed by several judicial decisions. In John Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986) the court upheld 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 "pictorial, graphic, or sculptural work must embody some creative authorship in its delineation of form." *See*, Forstmann Woolen 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. *See*, The Homer Laughlin China co. v. Oman, 22 U.S.P.Q. 1074 (D.D.C. 1991) upholding refusal to register chinaware "gothic" pattern composed of simple variations or combinations of geometric designs due to insufficient creative authorship to merit copyright protection. *See*, John 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 that design did not meet minimal level of creative authorship necessary for copyright.

Id., at 3-4.

Accepting that post-Feist cases have found that even a slight amount of creativity will suffice to obtain copyright protection and that the vast majority of works make the grade easily, Ms. Giroux points out that the leading treatise on copyright law states that "there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a claim to copyright." We believe that the graphic elements on the surface of this work, as a whole, fall within this narrow area. Id., at 4, *quoting*, Nimmer On Copyright, in § 2.01(b).

The sculptural features, including the oval opening, the rounded upper side, and the angling of the sides creating a triangular configuration, cannot be perceived as physically or conceptually separable from the shell or cover itself, without destroying its basic shape. Ms. Giroux therefore states that the Examining Division views all of these sculptural features as part of the overall shape, contour, and configuration of the useful article itself and, as such, not copyrightable. Id., at 4.

Ms. Giroux further explains that the fact that a work consists of a unique or distinctive shape for purposes of aesthetic appeal does not mean that the work constitutes a copyrightable "work of art". As stated in Compendium II, § 505.05, the aesthetics of a design or the fact that the design could have been designed differently are not relevant considerations in determining copyrightability. Id.

Ms. Giroux distinguished this case from that of Kieselstein-Cord v. Accessories By Pearl, Inc., 632 F.2d 989 (2d Cir. 1980), on which you relied. She noted that the court likened the belt buckles at issue to jewelry, but that such a dual-purpose use was not present in this case. As Ms. Giroux stated, all works involve choices, but the fact that other shapes, styling, and configurations could have been selected for this work does not mean that the chosen expression is copyrightable. In the case of a useful article, unless the resulting expression or product contains separable authorship that is also copyrightable, no registration is possible. The elements on the surface of this work, individually, and in their particular arrangement, simply do not contain a sufficient amount of original and creative authorship to support a copyright registration. Id., at 4-5.

Ms. Giroux discussed your argument that elements of a work may convey, for example, motion, but that such an impression actually takes place in the mind of the viewer rather than revealing creativity in the composition of the work itself. Therefore, the fact that the 3- pronged comet-like tail gives the impression of the basketball being shot towards the goal does not evidence creative authorship.

Furthermore, despite Justice Holmes admonition in Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903), against any attempt to judge the worth of pictorial illustrations, outside of the narrowest and most obvious limits, Ms. Giroux points out that those limits do exist. One of those limits include familiar symbols and designs, which are in the public domain and are, therefore, not copyrightable. The Copyright Office does not judge the worth of pictorial works, but must, pursuant to 17 U.S.C. 410(a), determine whether the material deposited constitutes copyrightable subject matter and whether the other legal and formal requirements of the law have been met. Id., at 5.

Finally, Ms. Giroux quotes from the House Report explaining the legislative emphasis on the need for separable authorship to stand on its own:

> In adopting this amendatory language, the committee is seeking to draw as clear a line as possible between copyrightable works of art and uncopyrightable works of industrial design. A two-dimensional painting,, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statute or carving is used to embellish an industrial design or as in the Mazer case, is incorporated into the product, without losing its ability to exist independently as a work of art. **On the other hand, although 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.** 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 aesthetic (as opposed to functional) consideration, only elements, if any, which can be identified as separable from the useful article as such, are copyrightable. And even if the three-dimensional design contains some elements (for example, the carving on the back of a chair or a floral design on silverware) **copyright protection would extend only to that element and would not cover the overall configuration of the utilitarian article as such.**

H.R. Rep. 94-1476, at 55. (emphasis added).

Since the elements of this work are either related to the utilitarian aspects or function of the work, or if separable, lack a sufficient amount of original and creative authorship, or are subsumed within the overall shape, contour, and configuration of the work, the Examining Division found that the GUN COVER AND DESIGN contains no authorship that is both separable and copyrightable. Id., at 6.

D. Second request for reconsideration

By letter dated March 2, 2004, you submitted a second request for reconsideration of the refusal of registration for GUN COVER AND DESIGN. Your letter restates the argument that the author designed and created the cover "for the purpose of aesthetically enhancing a basketball practice machine." (Letter from Jenkins to the Board of Appeals of March 2, 2004 at 2.) The letter supports this aesthetic purpose by quoting from the author's declaration and the author's view that the sculptural features of the cover and the graphical design enhance the aesthetic appeal of the device. Id., at 2-3.

In discussing the administrative record, you claim that the Copyright Office rejected the claim "on the basis that the work did not constitute an original piece of art." Id., at 3. You then claim that in the "Second Letter of Refusal," the Attorney Advisor "withdrew the prior rejections and conceded the work was original, and thereafter gave new grounds for rejection," namely, that the work is a useful article that does not contain any authorship that is both separable and copyrightable. Id., at 3-4.

In your letter, you cite 37 C.F.R. § 202.10(c) and 17 U.S.C. § 101 for the proposition that the shape of a utilitarian article that incorporates features, which can be identified separately and are capable of existing independently as a work of art, are registrable. Id., at 5. You point out that Copyright Office practices confirm that artistic features need not be physically separable, but may alternatively be conceptually separable.

You also restate that in order to be copyrightable, a work requires a minimum level of creativity. Citing Feist, you point out that the requisite level is extremely low and that even a slight amount will suffice. Id., at 6. You also point to Bleistein and Alfred Bell to support the proposition that the "worth" of a work should not be judged "outside of the narrowest and most obvious limits" and that originality amounts to little more than a prohibition of actual copying." Id.

In argument, you state your disagreement with Ms. Giroux's view that the sculptural features of the cover are not conceptually separable. You cite Mazer v. Stein, 347 U.S. 201 (1954) to support your position. You argue that Mazer, which featured an artistic statuette to cover the stem and wiring of the lamp, a useful article, is similar to the artistically designed basketball machine cover. " The creative elements of the three dimensional [sic] design, just like the statuettes in *Mazer*, serve no purpose other than to give expression to the artistic ideas of Mr. Joseph and to enhance the attractiveness of the machine." Id., at 6. You also point out that although the cover may contain patentable subject matter, this does not affect the copyrightability of the work. Id., at 7.

You also provide a list features of the work that you claim are physically and conceptually separable components of the work, combining the sculptural and graphic components into the list:

- a trailing, three-pronged comet-like tail (labeled B in Exhibit A);
- lines of varying thicknesses (labeled C in Exhibit A);
- a basketball being shot towards a basketball goal (labeled A in Exhibit A);
- angled lines (labeled D in Exhibit A);
- color blocks used to accentuate the funnel;
- a defining line (labeled E in Exhibit A);
- a plurality of horizontal base lines (labeled F in Exhibit A);
- four sides (labeled G, H and I) angled inward in a triangular configuration that tangentially meet at the rounded upper side J of the cover;
- the rear sides (labeled H and I) extend upward at an angle greater than the front;
- a large, distinct oval opening (labeled K in Exhibit A) located at the top of the front side of the cover; and
- the comet tail lines being substantially 90° and angled upwardly.

You state that these features are conceptually independent of and separate from the function or idea of the cover, which is to shield the working parts of the machine to which it is attached. You also state that the "unique arrangement and combination of the sculptural features, when taken alone or in combination with the design features, have little or no relation to the function of the machine." Id., at 7.

You distinguish this work from the outdoor lamps at issue in Esquire because here the applicant is not seeking to register the "entire" shape of the cover, but only the artistic and separable sculptural and graphic features of the cover. Id., at 8. You argue that although these features, alone or in combination, may be crude, humble or obvious, under both Bleistein and Feist, they are nevertheless copyrightable because they are creative and original to the author. Id., at 8-10.

Finally, in support of the your argument of the copyrightability of the graphic designs, you cite two court decisions that upheld the protectability simple designs, namely Fabrex Corp. v. Scarves by Vera, Inc., 129 U.S.P.Q. 392 (S.D.N.Y. 1961) and Scarves by Vera, Inc. v. Fabrex Corp., 129 U.S.P.Q. 295 (S.D.N.Y. 1961) without discussing the applicability of these cases. You also conclude by suggesting that the Attorney Advisor appeared to rely on personal experience in support of the rejection of the designs in this case, because she did not support her conclusion with facts. Should the registration again be refused, you request specific findings for each of the identified sculptural features and graphics (when viewed alone or in combination) and the factual or legal basis for denying protection for such features and graphics. Id., at 10-11.

III. DECISION

The Review Board has reviewed the application as well as all material submitted in support of the registration at both the first and second levels of reconsideration and has determined that GUN COVER AND DESIGN is a useful article that does not contain any separable elements, either alone or in combination, that meet the minimal level of creative authorship necessary to sustain a copyright registration.

Before proceeding with the legal and factual bases for the Review Board's refusal of registration, the Board would like to address assertions made in you second request regarding the bases for prior refusals to register this work. In particular, you stated that the Examiner rejected the claim "on the basis that the work did not constitute an original piece of art." Id., at 3. You then claim that in the "Second Letter of Refusal," the Attorney Advisor "withdrew the prior rejections and conceded the work was original, and thereafter gave new grounds for rejection," namely, that the work is a useful article that does not contain any authorship that is both separable and copyrightable. Id., at 3-4.

Your assertion about the initial basis for rejection is incorrect, as indicated by the discussion of the administrative record above which states in relevant part:

> Visual Arts Examiner Joy Fisher Burns rejected the application because the work is a useful article that, although containing separable elements, contains insufficient separable authorship to warrant copyright protection. Ms. Burns also noted that copyright does not protect familiar shapes, symbols and designs or simple variations or combinations of basic geometric designs.

(Letter from Burns to Jenkins of 6/11/03.) Similarly, your assertion that Attorney Advisor Virginia Giroux "withdrew prior rejections" is also inaccurate. While it is true that she stated that "[w]e do not refute your assertion that the work is original and was not copied from another work," there is nothing in Ms. Burns initial rejection that refutes this assertion. Both Ms. Burns and Ms. Giroux were consistent in the basis for their refusal to register the work, namely, that the work is a useful article that does not contain any separable features that are [also] copyrightable. Your perceived withdrawal of prior objections was actually nothing more than a clarification; in regards to rejection for lack of sufficient original authorship, copying was not alleged, but rather the requisite level of creative authorship found wanting in any separable elements. Therefore, the Review Board finds that the basis for the rejection was and is now consistent throughout the administrative review process.

A. Useful Article

The Review Board has determined that GUN COVER AND DESIGN is a "useful article" within the definition of that term in the Copyright Act. 17 U.S.C. §101. Section 101 states that "[a] 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." The cover for a basketball machine meets the general definition of a useful article even if the cover has other, non-functional purposes. We point out that the statutory definition indicates "*an* intrinsic utilitarian function"– one functional use is sufficient to render a work utilitarian under the statutory definition and the fact that a work may serve other, non-useful purposes does not negate its

usefulness.[1] The fact that the work was created to aesthetically enhance the appearance of the basketball machine does not alter the nature of the work for copyright registration purposes. The work as depicted in the deposit copy materials submitted for this claim and as described in the arguments submitted on reconsideration is a stylized cover for a mechanical basketball device. You state that the purpose of the cover "is to shield the working parts of the machine to which it is attached." (Letter from Jenkins to the Chief of the Receiving and Processing Division of 7/30/03 at 6.) Despite aesthetic design considerations and expression of those considerations, the intrinsic functionality of the cover meets the statutory definition of a useful article.

B. Separability

Since the Review Board unanimously finds the work to be a useful article, the question is whether there are any design elements that are separable from the overall shape and function of the useful article. The design of a useful article may be registered for copyright only if and to the extent that it contains elements that can exist and be identified independently from the useful article. 17 U.S.C. § 101 definitions of "pictorial, graphic, and sculptural works" and "useful article" and Compendium II, § 505 (1984). As you have noted, separability may be physical or conceptual. Id., at § 505.02. Once separability has been established, separable elements must be independently copyrightable in order for that aspect of the useful object to obtain copyright protection.

Congress clarified its intent with respect to the shape of useful articles in the legislative history of the Copyright Act of 1976. Specifically, the House Report accompanying the Act states that:

> [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 aesthetic (as opposed to functional) considerations, only

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[1] The statutory definition's reference to *an* intrinsic utilitarian function was a legislative change in 1976 from the Copyright Office's previous regulatory provision regarding the extent of copyright protection for a useful article. The Office's previous regulations at 37 C.F.R. 10[c] (1959), (revoked 1978), determined a work to be a useful article, and thus requiring separately identifiable artistic features, if its "*sole* intrinsic function" was its utility. (emphasis added). The ultimate 1976 statutory revision was the result of the decision in Mazer v. Stein, 347 U.S. 201 (1954), that works of art incorporated into utilitarian objects did not lose their copyright protection. *See also* Fabrica, Inc. v. Ed Dorado Corp., 697 F.2d 890, 893 (9th Cir. 1983): "The significant change from the prior law is that courts need no longer determine whether an article's function is *solely* utilitarian. Now, if an article has *any* intrinsic utilitarian function, it can be denied copyright protection except to the extent that its artistic features can be identified separately and are capable of existing independently as a work of art." (emphasis in original); and, *see also* Carol Barnhart, Inc. v. Economy Cover Corp., 773 F.2d 411 (2nd Cir. 1985), for a review of the history of copyright protection for useful articles.

> elements, if any, which can be identified separately from the useful article as such are copyrightable. (emphasis added).

H.R. Rep. No. 94-1476 at 55 (1976).

The Office's implementation of the 1976 Act, including the Act's legislative history, on this issue is reflected in Compendium II, §§ 505.02, 505.03, and 505.04 (1984). These sections of Compendium II state that claims in three-dimensional useful articles may be registered if the works in question exhibit separately identifiable– either physically or conceptually– pictorial, graphic, or sculptural features capable of independent existence apart from the shape of the useful article.

In the case of physical separability, Compendium II, § 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, § 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).

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

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

H.R. Rep. at 55.

1. *Physical Separability.* You do not argue that the works are physically separable. Nevertheless, the Board explicitly finds that the sculptural features of the work are not physically separable. As stated above, 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. It appears clear that whatever aesthetic design considerations were present, they were made in relation to enhancing the appearance of a cover for the machine. Unlike the Mazer statuettes, this cover did not have a preexisting or independent existence as a work of art. As the Compendium II states, 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. Compendium II at § 505.04. Even though the cover may be physically removed from the mechanical parts of the device, it nevertheless remains a part of the useful article. It is not, therefore, physically separable.

2. *Conceptual Separability.* You do maintain that sculptural elements of the cover are conceptually separable. The Review Board does not agree. The cover is an intrinsic part of the useful article. Removal of the cover does not change the nature of the cover – it remains a part of a useful article. The sculptural features of the cover cannot be imagined separately and independently from the useful article without destroying the basic shape of the useful article. Without the sides ["four sides (labeled G, H and I) angled inward in a triangular configuration that tangentially meet at the rounded upper side J of the cover"], the basic shape of the cover would be destroyed. Similarly, without "the rear sides (labeled H and I) extend upward at an angle greater than the front," the basic shape of the cover would be destroyed. Without the oval opening ["a large, distinct oval opening (labeled K in Exhibit A) located at the top of the front side of the cover"], the device could not eject the basketball. While all of these features could have been designed differently, individually or in combination, all of the individual parts are components of the overall useful article.

As you state, the purpose of the cover "is to shield the working parts of the machine to which it is attached." (Letter from Jenkins to the Chief of the Receiving and Processing Division of 7/30/03 at 6.) The cover is thus normally a part of the useful article. Despite aesthetic design considerations and expression of those considerations in the creation of the cover, the intrinsic functionality of the cover remains. The Review Board finds that none of the sculptural features that you listed (labeled H through K in your Exhibit A) are conceptually separable, because they are necessary parts of the useful article – the cover – notwithstanding the aesthetic expression of those parts, individually or in combination. Similarly, even though you are not claiming that the "entire" cover, but only those artistic and separable sculptural aspects (as you claim distinguishes this case from the facts of Esquire), since the Review Board finds that there are no conceptually separable elements, this is a distinction without significance.

The Review Board agrees that the pictorial or graphic elements on the cover, in contrast to the sculptural elements, are conceptually separable. All of the pictorial or graphic elements on the cover may

be imagined separately and independently from the useful article without destroying the basic shape of the useful article. Compendium II at § 505.03. Nevertheless, the Review Board finds that these pictorial or graphic elements, individually or in combination, do not contain sufficient creative authorship to support the registration of a claim of copyright.

C. Creative Authorship

The fact that an artistic feature is separable from the utilitarian article does not mean that this separable feature is copyrightable. In order to be copyrightable, and thus registrable, the artistic feature must qualify as an "original work of authorship." 17 U.S.C. § 102(a).

As Ms. Giroux stated, the Copyright Office does not refute that the work was independently created, i.e., not copied. Yet, the originality requirement requires more than independent creation alone. The originality requirement also requires "that [the work] display some minimal level of creativity." Feist at 358. While it is true that most works meet or surpass this requisite level quite easily, the Feist decision itself makes clear that some works do not. "There remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." Feist at 359. Similarly, Justice Holmes warning against any attempt to judge the worth of pictorial illustrations, outside of "the narrowest and most obvious limits," indicates that "narrow" and "obvious" limits do exist. Bleistein at 251. While the Copyright Office never judges the "worth" of any work, it is statutorily required to determine whether the material deposited constitutes copyrightable subject matter and whether the other legal and formal requirements of the law have been met. 17 U.S.C. § 410(a).

In examining the pictorial and graphic elements contained in the deposit for GUN COVER AND DESIGN, the Review Board does not find any individual feature or combination of features that rise to the requisite level of creative authorship.[2]

Copyright Office regulations state that "[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs, mere variations of typographic ornamentation, lettering or coloring. . . ." are not subject to copyright. 35 C.F.R. § 202.1(a). The pictorial and graphic features claimed as separable from the useful article are:

- a trailing, three-pronged comet-like tail (labeled B in Exhibit A);
- lines of varying thicknesses (labeled C in Exhibit A);

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[2] The Board notes that nowhere in any of your arguments do you claim that the "THE GUN" logo on the side of the cover is original authorship within the scope of the claim. Therefore, the Board does not specifically address this feature individually or in combination. Nevertheless, the Board notes that the analysis of this design would be consistent with the court's view in Jon Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986). Alone, the Board views this design as containing insufficient creative authorship to sustain a registration. Similarly, the centered arrangement of the design within the overall arrangement of the graphic elements on the cover would not alter the Board's conclusion regarding the insufficient quantum of creative authorship in the overall claim.

- a basketball being shot towards a basketball goal (labeled A in Exhibit A);
- angled lines (labeled D in Exhibit A);
- color blocks used to accentuate the funnel;
- a defining line (labeled E in Exhibit A);
- a plurality of horizontal base lines (labeled F in Exhibit A);
- the comet tail lines being substantially 90° and angled upwardly.

Taking each in turn, the three-pronged, comet-like tail is simply three, diagonal lines of varying or tapering thicknesses. Lines of any width, taper, or color are, in themselves, variations of a common geometric shape. Whether the lines are diagonal, horizontal, vertical, curved or some trivial directional variation, they remain common geometric shapes. As such, lines designated as B, C, D, and F each represent insufficient creative authorship. Similarly, the pictorial representation of a basketball is a common and familiar design or a trivial variation thereof that is incapable of supporting a claim of copyright. The "color blocks" are merely coloring of a functional component of the useful article (the funnel into which the basketball falls). The "defining line" (labeled E in Exhibit A) is simply an oval line around (or highlighting) the oval opening through which the ball is ejected from the device. While individually, any of these features may be conceptually imagined separately from the machine without destroying the function, each is a common or familiar geometric shape, design, or symbol. Individually, these features fall within the most obvious limits. Copyright Office regulations clearly preclude protection of such features individually. 35 C.F.R. § 202.1(a).

The Review Board also finds that all of these elements in combination, i.e., the selection, coordination and arrangement of these elements, reveal a creative spark so utterly lacking or trivial as to be virtually nonexistent. The overall design of the surface elements does not rise to the level of copyrightable authorship necessary to sustain a copyright registration. The design consists of de minimis creativity involving the selection and arrangement of familiar or public domain elements coordinated in a very simple configuration. *See*, Compendium II at §§ 503.02 (a) &(b). In addition, at least two of the individual elements do not involve creative arrangement. The defining line (labeled E in Exhibit A) is dictated by the functional placement of the oval opening. Similarly, the colored funnel's placement is dictated by the functional location of that utilitarian element. The creativity is therefore limited to the selection and placement of the lines and the representation of the basketball. The combination of these features is trivial and a finding of de minimis creative authorship is consistent with relevant case law. *See*, Jon Muller & Co. v. New York Arrows Soccer Team, Inc., 802 F.2d 989 (8th Cir. 1986) (the court upheld 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 "pictorial, graphic, or sculptural work must embody some creative authorship in its delineation of form."). *See also*, Forstmann Woolen 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 Homer Laughlin China co. v. Oman, 22 U.S.P.Q. 1074 (D.D.C. 1991) (upholding refusal to register chinaware "gothic" pattern composed of simple variations or combinations of geometric designs due to insufficient creative authorship to merit copyright protection); John Woods Fashions, Inc. v. Curran. 8

U.S.P.Q. 392 (S.D.N.Y. 1961), the work at issue was registered by the Copyright Office. The court describes the work as a "Butterfly" design consisting "of a novel execution and variation of commonplace items (butterflies and dragonflies) [that] is sufficiently original to warrant copyright protection." Id. There was no issue in the case as to the copyrightability of the design by either the Copyright Office or the Plaintiff, and the court determined that the design was sufficiently original to warrant protection. While a complete description of the work is not present in the case, the brief description of the "novel execution and variation" of items capable of more creative variation than lines, namely butterflies and dragonflies, sufficiently distinguishes this case from the present design.

Similarly, in Scarves by Vera, Inc. v. Fabrex Corp., 129 U.S.P.Q. 295 (S.D.N.Y. 1961), a companion action to the dispute above, the Plaintiff received a registration for the work entitled "Vera's Vegetable Design." Although the court did not describe the design, it noted that the Defendant did not dispute the copyrightability of the design, but did contend that the Plaintiff failed to satisfy an applicable notice requirement at the time of publication. While the court found that notice was sufficient, the critical issue for the instant matter is that the case offers no support for your position – no one, including the Copyright Office, disputed that sufficient creativity was present in the design.

The Review Board concludes that the GUN COVER AND DESIGN is a useful article that contains no creative authorship that is both separable and copyrightable.

IV. CONCLUSION

For the reasons stated herein, the Copyright Office Review Board affirms the refusal to register the GUN COVER AND DESIGN. This decision constitutes final agency action on this matter.

Sincerely,

/S/

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

Exhibit A

