United States Copyright Office
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February 8, 2006

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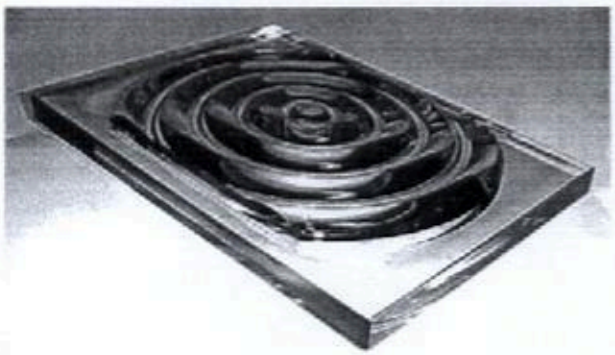
Re: DOOR LIGHT WITH TRUNCATED DESIGN
Copyright Office Control No. 61-315-4769(W)
Your File No. G0718.80000US00

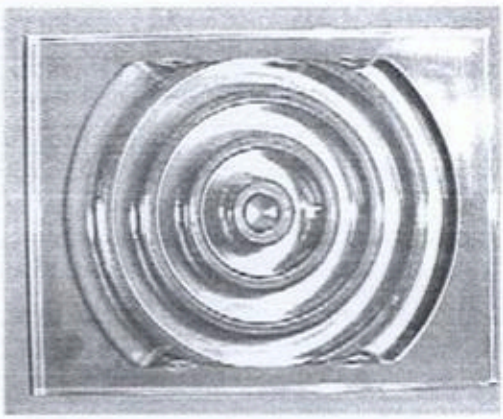
Dear Mr. Green:

I write on behalf of the Copyright Office Review Board ("Board") in response to your letter dated May 24, 2005, in which you requested the U.S. Copyright Office ("Office") to reconsider for a second time its refusal to register a glass panel entitled "Door Light with Truncated Design." The Board has carefully examined the application, the deposit and all correspondence concerning this application and affirms denial of registration due to the design's lack of sufficient copyrightable authorship.

I. DESCRIPTION OF WORK

The subject work is a clear, rectangular, relatively thick glass panel designed to be installed into a door or wall to enable the passage of light from one side to the other. Molded into the center of the panel are several three-dimensional, concentric circles comprised of ridges and depressions. Invisible parallel lines, equidistant from each edge of the length of the glass rectangle, "cut off" or truncate the outermost concentric circles thereby creating arcs that flank the circles. The resulting design is a"bull's-eye" positioned in the center of the glass panel.





II. ADMINISTRATIVE RECORD

A. Initial Application and Office's Refusal to Register

On April 26, 2004, the Office received a Form VA application signed by Kristin D. Wheeler on behalf of the author and your client, Philip Zocco, to register a three-dimensional glass panel with sculptural elements. In a letter dated June 30, 2004, Visual Arts Section Examiner Sandra D. Ware refused registration of this work because she determined that it is a useful article that does not contain any separable authorship needed to sustain a claim to copyright. Letter from Ware to Green of 06/30/04, at 1.

Ms. Ware explained that while copyright protects works of artistic craftsmanship with respect to their form, it does not protect their mechanical or utilitarian aspects. The design of a useful article will be subject to protection only if it can be identified separately from and is capable of existing independently of the utilitarian aspects of the article. She explained that such separability can be physical or conceptual. *Id.* (*citing* 17 U.S.C. § 101 (2004) and H.R. Rep. No. 94-1476 (1976)). Physical separability exists where design features can be physically separated from the utilitarian item by ordinary means. Conceptual separability exists where the design feature is 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. *Id.* (*citing Compendium of Copyright Office Practices II,* Ch. 5 (1984)) [hereinafter *Compendium II*]. Ms. Ware provided examples of each type of separability. She cautioned, though, that the test of conceptual separability is not met by merely analogizing the general shape of a useful article to a work of modern sculpture, since, in such a case, the alleged "artistic features" cannot be perceived as having a separate, independent existence from the useful article. She also noted that regardless of whether certain design features are non-functional or could have been designed differently, no registration is possible if such features are an integral part of the overall shape or contour of the useful article. *Id.* at 2.

Ms. Ware concluded that because "all of the sculptural elements of the work you deposited are either related to the utilitarian aspects or function, or are subsumed within the overall shape, contour, or configuration of the article, there is no physically or conceptually 'separable' authorship as such" and that the Office could not register this claim. *Id.*

B. First Request for Reconsideration

In a letter dated October 27, 2004, Cheryl A. Clarkin of your firm requested reconsideration of the Office's refusal to register this work. After summarizing Examiner Ware's statement of the law pertaining to the copyrightability of useful articles, Ms. Clarkin concluded that the three-dimensional sculptural design elements on the door light are "unrelated" and have "no necessary connection" to the form, function or utilitarian aspects of the door light, but that they can be imagined existing separately from the door light without destroying the door light's basic shape. Letter from Clarkin to Chief, Receiving and Processing Division of 10/27/04, at 1-2. Ms. Clarkin also noted that the applicant does not seek to protect the rectangular shape of its door light, but rather the three-

dimensional design adorning it. *Id.* at 4. Ms. Clarkin cited several federal cases as support for her position that the sculptural elements of the work are plainly conceptually separable. *Id.* at 3 - 5 (*citing Brandir Int'l Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987), *Mazer v. Stein*, 347 U.S. 201 (1954), *Kieselstein-Cord v. Accessories By Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980), *Animal Fair, Inc. v. Amfesco Indus., Inc.*, 620 F. Supp. 175, 187 (D. Minn. 1985), *aff'd* 794 F.2d 678 (8th Cir. 1986), *Act Young Imports, Inc. v. B&E Sales Co.*, 673 F. Supp. 672 (S.D.N.Y. 1987)). Finally, Ms. Clarkin argued that the door light is copyrightable because it is "made to be looked at." *Id.* at 5 (*citing Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320 (2d Cir. 1996) and *Masquerade Novelty v. Unique Indus., Inc.*, 912 F.2d 663 (3d Cir. 1990)).

C. Examining Division's Response to First Request for Reconsideration

In response to the first request and in light of the points raised in Ms. Clarkin's letter of October 24, 2004, Attorney Advisor Virginia Giroux of the Examining Division reexamined the application and determined that the glass door panel is a useful article which does not contain any authorship that is both separable and copyrightable. Letter from Giroux to Clarkin of 01/24/05, at 1.

Ms. Giroux explained in a letter dated January 24, 2005, that because the door light is a useful article, which by definition has an intrinsic utilitarian function that is not merely to portray the appearance of the article and can include an article that is a part of a useful article, the design is copyrightable:

> 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 destroying its basic shape.

Id. (citing 17 U.S.C. § 101). She noted that this separability could exist either physically or conceptually. Ms. Giroux explained that the Office follows the conceptual separability test set forth in *Esquire v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978), *Compendium II, supra,* § 505.03 and *Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. 1995), not the "Denicola test" followed by *Brandir Int'l* and referenced in the first request for reconsideration. *Id.* at 2-3. Thus, conceptual separability occurs when the pictorial, graphic or sculptural features of the work can, for example, be visualized on paper or as a free-standing sculpture, independent of the shape of the utilitarian article, without destroying the basic shape of the article, such as with respect to a carving on the back of a chair or pictorial matter engraved on a glass vase. *Id.* at 2.

She explained, however, that conceptual separability and copyrightability do not automatically exist simply because an element within a useful article is not dictated by utilitarian concerns. Even if certain features are non-functional or could be designed differently, Ms. Giroux noted that no copyright registration is possible where such features are an integral part of the overall shape or contour of the useful article. *Id.* She then recounted the holding in *Esquire* wherein the

court upheld the Office's refusal to register the shape of a utilitarian outdoor lighting fixture, even though it did contain some aesthetically pleasing features. In further support of the limits imposed on the copyrightability of useful articles, she also cited *Norris Indus., Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir. 1983), *cert. denied*, 464 U.S. 818 (1983) (holding a wire-spoke wheel cover was not copyrightable because it did not contain any separable sculptural design). She also quoted the House Report regarding the copyrightability of elements in an industrial design or product. *Id.* at 4-5 (*citing* H.R. Rep. 94-1476, at 55). Ms. Giroux cautioned that the test for conceptual separability cannot be met merely by analogizing the general shape of a useful article to a work of modern sculpture, since the artistic or decorative features would not be perceived as having a separate existence. *Id.* at 2. Finally, Ms. Giroux also noted that examiners do not evaluate a work's aesthetics, attractiveness, uniqueness, visual effect, commercial success in the marketplace, the fact that the work could have been designed differently, nor the time and effort expended to create the work in examining the work for copyrightability. *Id.* at 1, 4.

Evaluating the work at issue, Ms. Giroux concluded that the glass panel door light is a useful article that does not contain any sculptural elements that could be physically or conceptually separated from the glass panel without destroying its basic shape. Specifically, she found that "the grooves, ridges, and indentations on the surface of this work all [are] part of the overall shape, contour, and configuration of the useful article itself not physically or conceptually separable from the utilitarian function without destroying its basic shape and, as such, not copyrightable." *Id.* at 2. She stated that even if some portion of this design was conceptually separable, such elements consisted of common and familiar geometric shapes, in the public domain, not sufficiently original in and of themselves or in combination to meet the requisite level of creativity set forth in *Feist Pubs. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). *Id.* at 3 (*citing* 37 C.F.R. § 202.1 (2004) and *Compendium II, supra*, §§ 503.02(a) and (b)).

Ms. Giroux addressed each of the cases Ms. Clarkin cited, but found that the works at issue in those cases were not comparable to the subject glass door panel. Therefore, their determinations of copyrightability were inapplicable. *Id.* at 3-4.

Ms. Giroux concluded that "[b]ecause all of the elements or features of this work are either related to the utilitarian aspects or function of the work, or if separable, do not contain a sufficient amount of original and creative sculptural authorship, or as we believe, are subsumed within the overall shape, contour, or configuration of the work, there is no separable authorship as such." *Id.* at 5. Ms. Giroux consequently refused copyright registration for this work.

D. Second Request for Reconsideration

In a letter dated May 24, 2005, you request the Office to reconsider for a second time its refusal to register the copyright claim in the glass panel door light. Letter from Green to Board of 05/24/05, at 1. You describe the subject sculptural design as three-dimensional concentric circles surrounded by truncated arches, each in an alternating crest and trough pattern, that exist within a transparent or translucent rectangular tile which may be inserted into a door or wall to allow the passage of light through the tile. *Id.* at 4. You recount the procedural background, the prior findings

made by the Copyright Office, the arguments made by Ms. Clarkin in the first request for reconsideration and the legal principles of separability and originality that are relevant to the copyrightability of elements incorporated into a useful article. *Id.* at 1-3.

With respect to separability, you argue that the concentric circle design is conceptually separable under the test set forth in *Compendium II* because it "may be exhibited on paper (as either a three-dimensional representation with the crest and trough patterns or in a two-dimensional representation without them), or as a free standing sculpture, independent of the shape of the useful object, which in this case is the rectangle defining the tile to be inserted in a wall or a door to allow the passage of light. . . . [A]ny patterns or images (whether etched on or sculpted into the object) incorporated into the door light are conceptually separable from the subject work itself." *Id.* at 6. You note that a plain, flat, unadorned rectangular door tile would retain its basic shape and function to allow the passage of light. *Id.* at 7. The circular design, you argue, can be seen as a combination of a carving and pictorial matter engraved on glass. *Id.* at 7-8. You refer the Board to the cases regarding separability cited in the first request for reconsideration. *Id.* at 8.

With respect to the originality required to support a copyright registration, you argue in essence that geometric shapes are not barred from copyright protection. You claim that Ms. Giroux's citation to 37 C.F.R. § 202.1 does not support the position that geometric shapes are not copyrightable. *Id.* at 4. You state that "most works of art can be broken down in to some arrangement of commonly known geometric shapes which, existing separately, may be considered to be in the public domain, but taken together are a copyrightable piece of artwork." *Id.* at 5. Moreover, you argue that the subject work is not simply a common geometric shape, but rather "a creative three-dimensional sculpture incorporating several shapes and design themes into a comprehensive work. There is no commonly-known word, phrase, or name, *e.g.* 'star,' 'circle,' etc., that describes or names this design." *Id.* at 5. You argue that this combination of shapes is sufficiently creative to meet the "extremely low" creativity threshold set forth in *Feist*. *Id.*

III. DECISION

A. Useful Articles and Separability

1. The Legal Framework

As a general proposition, copyright protection presumptively does not extend to a useful article, defined as "an article 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. However, works of artistic craftsmanship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic or sculptural works pursuant to 17 U.S.C. § 102(a)(5). This protection is limited, though, in that it extends only "insofar as their form but not their mechanical or utilitarian aspects are concerned." *Id.* § 101. The design of the useful article will be protected "only if, and only 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." *Id.* This separability can be physical or conceptual. Congress has explained 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] 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.

H.R. Rep. No. 94-1476, at 55.

Physical separability means that the subject pictorial, graphic or sculptural features must be able to be separated from the useful article by ordinary means. For example, a statuette that also serves as a lamp base can be ordinarily separated from the functional portion of the lamp by unscrewing the bulb and shade. Thus, the statuette can qualify as physically separable. *See, Mazer.*

Conceptual separability means that the subject features are "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 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." *Compendium II, supra,* § 505.03. For example, while a carving on the back of a chair cannot readily be physically separated from the chair, it can easily be conceptually separated because one could imagine the carving existing as a drawing. The chair, meanwhile, would still remain a useful article having retained its basic shape, even absent the carving. The carving would therefore qualify as conceptually separable.

However, just because a feature is not necessary to or dictated by the utilitarian concerns of an article does not mean that the feature is automatically conceptually separable. If removing such

features would destroy the useful article's basic shape, namely because the features are an integral part of the overall shape or contour of the useful article, then the features would not qualify as conceptually separable.

2. The Door Light Is A Useful Article

The Board agrees with Examiner Ware's and Attorney-Advisor Giroux's determinations that the glass panel door light qualifies as a useful article. Its intrinsic purpose is to permit light to emanate from one side of a door or wall to the other. Appropriately, in the second request for reconsideration, you do not contest the characterization of the panel as a useful article. On the contrary, you specify the item's purpose, "namely allowing light to pass from one side of a door or wall to the other." Letter from Green to Board of 05/24/05, at 6.

Although Ms. Clarkin also concedes the utilitarian function of the glass panel and describes it as "for placement within a door or wall for the admission of light," letter from Clarkin to Chief, Receiving and Processing Division of 10/27/04, at 3, she later seems to argue that the panel is not a useful article within the meaning of the copyright law because it "has as its very purpose to be looked at." *Id.* at 5. In her later argument, she analogizes the panel to a taxidermy mannequin of a fish and a novelty animal nose mask, both of which courts have held in particular cases to be copyrightable. The Board finds Ms. Clarkin's initial description of the glass panel door light as a useful article to be more on point. An industrial product qualifies as a "useful article" as long as it has "*an* intrinsic utilitarian function," not *solely* an intrinsic function. 17 U.S.C. § 101. Not only has the Copyright Office consistently found the glass panel door light to have a utilitarian function in allowing the passage of light through an otherwise opaque barrier, but both you and Ms. Clarkin have also identified this same function. Therefore, that the door light additionally is intended to be looked at is immaterial to the determination of whether the door light qualifies as a useful article for copyright registration purposes.

3. Separability

As you correctly note, separable elements embodied within a useful article can warrant copyright protection in and of themselves provided that they meet certain criteria, the first of which is the ability to exist independently of the useful article without destroying the basic shape of that article. With respect to this work, physical separability is a moot point because the solid, glass panel door light has no design elements that could be separated by ordinary means. The Board notes that neither request for reconsideration suggests that physical separability applies. Based on its review of the two-dimensional photographs of the work deposited in connection with the application for copyright protection, the Board finds it difficult to determine whether the three-dimensional work actually contains conceptually separable matter. However, it is not necessary for the Board to resolve this issue in order to render a decision on this request for reconsideration because the Board finds that even if the concentric circle design were conceptually separable from the glass panel, it does not embody a sufficient amount of creativity to warrant copyright registration, as will be explained in detail below.

One point of clarification is also warranted. In the first request for reconsideration, Ms. Clarkin argued that "functional items" and "utilitarian objects . . . became copyrightable if they were designed to have some particular, artistically-selected form not dictated by the functionality of the item." *Id.* at 3-4. A functional item or utilitarian object itself will never be protected by copyright, even if that object happens to contain physically or conceptually separable matter. It is only the separable matter that may be subject to copyright protection provided that such matter also embodies the requisite amount of originality.

B. Original Works of Authorship

1. The Legal Threshold

The separability of a design feature from a utilitarian object does not mean that the feature will necessarily merit copyright protection. All copyrightable works, be they sculptures, engravings or otherwise, must also qualify as "original works of authorship." 17 U.S.C. § 102(a).

The term "original" consists of two components: independent creation and sufficient creativity. *Feist*, 499 U.S. at 345. First, the work must have been independently created by the author, *i.e.*, not copied from another work. The Copyright Office accepts at face value the assertion on the subject application for registration that your client Philip Zocco authored and claims any copyrights in and to this work. Therefore, the first component of the term "original" is not at issue in the analysis set forth herein. Second, the work must possess sufficient creativity. In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the standard set forth in *Feist, id.*, where the Supreme Court held that only a modicum of creativity is necessary.

As you properly note in your second request for reconsideration, the requisite level of creativity is extremely low; even a slight amount will suffice. *Id.* Letter from Green to Board of 05/24/05, at 5. However, the Court also ruled that some works (such as the work at issue in that case) fail to meet the standard. 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,* 499 U.S. at 363, and that there can be no copyright in a work in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359; *see also*, 37 C.F.R. § 202.10(a). "In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form."; 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.01(b) (2002). "[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright."

Even prior to the *Feist* Court's decision, the Office recognized the modest, but existent, requisite level of creativity necessary to sustain a copyright claim. *Compendium II* states, "Works that lack even a certain minimum amount of original authorship are not copyrightable." *Compendium II, supra*, § 202.02(a). With respect to pictorial, graphic and sculptural works, *Compendium II* states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Id.* § 503.02(a).

In implementing this standard, the Office and courts have consistently found that standard designs, figures and geometric shapes are not sufficiently creative to support a copyright claim. *Id.* § 503.02(a). "[R]egistration cannot be based upon the simplicity of standard ornamentation . . . . Similarly, it is not possible to copyright common geometric figures or shapes . . . .". Moreover, making minor alterations to these otherwise standard elements will not inject the requisite level of creativity. *Id.* § 503.02(a). "[Registration cannot be based upon] a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations." Attorney-Advisor Giroux's citation to 37 C.F.R. § 202.1 and its prohibition against the registration of "familiar symbols or designs" is consistent with the *Compendium II*'s specific prohibition on the registration of a common geometric figure in and of itself.

Of course, some combinations of common or standard design elements may contain sufficient creativity with respect to how they are combined or arranged to support a copyright. *See Feist*, 499 U.S. at 358 (the Copyright Act "implies that some 'ways' [of compiling or arranging uncopyrightable material] will trigger copyright, but that others will not"; determination of copyright rests on creativity of coordination or arrangement). However, merely combining non-protectible elements does not automatically establish creativity where the combination or arrangement itself is simplistic. For example, the Eighth Circuit upheld the Register's refusal to register a simple logo consisting of four angled lines which formed an arrow and the word "Arrows" in cursive script below the arrow. *John Muller & Co. v. New York Arrows Soccer Team*, 802 F.2d 989 (8th Cir. 1986). *See also Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) ("It is true, of course, that a *combination* of unprotectible elements may qualify for copyright protection. (citations omitted.) But it is not true that *any* combination of unprotectible elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectible elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.") (emphasis in original).

2. The Circular Design Does Not Embody Sufficient Creativity

Even assuming the concentric circle design is conceptually separable from the glass panel, it is not sufficiently creative to support a copyright claim. The requisite level of creativity for copyright protection is admittedly low, but it is not non-existent.

Ms. Clarkin noted in her first request for reconsideration that the applicant does not seek to protect the rectangular shape of the glass panel. Letter from Clarkin to Chief, Receiving and Processing Division of 10/27/04, at 4. Therefore, the only other remaining elements to evaluate are the concentric and truncated circles created by ridges and troughs.

In this work, the design consists of circular indentations and ridges. A circle, even with variations in its width, simply is unable to embody a sufficient level of creativity to sustain a copyright registration within the meaning of *Feist*. Here, it is a three-dimensional representation of a common geometric shape, and is therefore not subject to copyright protection. Similarly, the truncated outermost circles are simply arcs, another standard geometric shape within the public domain and ineligible for copyright protection in and of themselves.

You argue that "commonly known geometric shapes which, existing separately, may be considered in the public domain, [can be] taken together [as] a copyrightable piece of artwork." Letter from Green to Board of 05/24/05, at 5. While creative combinations and arrangements of otherwise unprotectible design elements can in certain situations merit copyright protection, this situation is not one of them. The indentations and ridges create equidistant, concentric circles positioned in the middle of the medium. The arcs symmetrically flank the sides of the circles. Such a simplistic "combination and arrangement" of non-protectible elements cannot rise to the requisite level of creativity. *See Compendium II, supra,* § 503.02 (b) "[T]he creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations." You also argue that there "is no commonly-known word, phrase or name, *e.g.* 'star,' 'circle,' etc., that describes or names this design." Letter from Green to Board of 05/24/05, at 5. Although this design could easily be described as "three-dimensional concentric circles" or a "bull's-eye," in any event whether or not a design has a specific name is immaterial to the determination of its copyrightability.

IV. CONCLUSION

For the reasons stated herein, the Copyright Office Review Board affirms the refusal to register the work entitled "Door Light with Truncated Design." This decision constitutes final agency action on this matter.

Sincerely,

/s/

David O. Carson,
General Counsel
for the Review Board
United States Copyright Office