United States Copyright Office
Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

August 22, 2007

Mark J. Diliberti, Esq.
Foley & Lardner, LLP
777 East Wisconsin Avenue
Milwaukee, WI 53202-5306

RE: SWIRLED GLOW BULB
Control No. 61-309-7472(F)

Dear Mr. Diliberti:

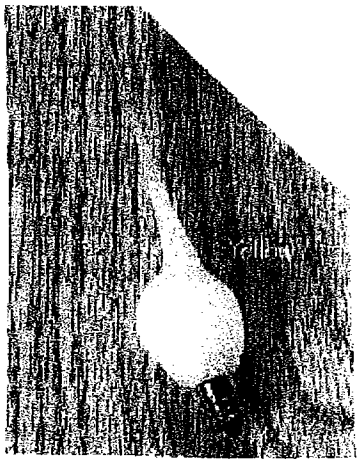
The Copyright Office Review Board has reviewed your request to reconsider the Examining Division's denial of a claim to register the SWIRLED GLOW BULB ("the bulb") on behalf of its author and copyright owner, Vicki Jean's Creations, Inc. After considering the materials submitted in support of the claim, the Board has determined that the work is a useful article that does contain conceptually separable features, but that the bulb cannot be registered because those conceptually separable aspects are not sufficiently creative to constitute copyrightable authorship.

ADMINISTRATIVE RECORD

On January 26, 2004, the Copyright Office received your client's application for registration of the SWIRLED GLOW BULB, submitted by Mr. James L. Vana, of your firm. By letter dated February 25, 2004, Examiner Kathryn Sukites advised Mr. Vana that the claim could not be registered because the work is a useful article without any separable features that are copyrightable.

The Examiner explained that a useful article cannot be copyrighted unless (1) it has pictorial, graphic, or sculptural authorship that is physically or conceptually separable from the article's useful function, and (2) the separable authorship is copyrightable. She explained that the SWIRLED GLOW BULB did not have any physically or conceptually separable authorship. Further, even if some feature[s] of the work were deemed to be separable, such features were not sufficiently original to support copyright registration. (Letter from Sukites to Vana of 2/25/2004, at 2.)

Image of SWIRLED GLOW BULB, reproduction of deposit material



In a letter dated June 24, 2004, you requested reconsideration of that decision. The appeal focused on how separability of an artistic feature should be determined, citing *Brandir International v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987). You argued that the three-dimensional, swirled finial of SWIRLED GLOW BULB was conceptually separable and did not "further the utilitarian application of the work." Letter from Diliberti of 6/24/2004, at 2. You also argued that the swirled finial had the requisite degree of creativity: "[g]iven the impact that the artistic feature has on the overall work, it cannot be said to be *de minimus* [sic], but rather presents the observer with a creative expression." *Id.* at 3.

The Examining Division, in a letter dated August 19, 2004 from Attorney-Advisor Virginia Giroux, advised you that there could be no registration for SWIRLED GLOW BULB because it did not possess any elements that are physically or conceptually separable from the intrinsic shape of the light bulb which is, in itself, a useful article. She began her analysis by defining a useful article and separable authorship. After noting that there was no dispute that SWIRLED GLOW BULB is a useful article, she rejected your argument that nonfunctional design elements, based on the designer's aesthetic judgments rather than on utilitarian concerns, constituted conceptually separable, copyrightable authorship.

Ms. Giroux explained that the Copyright Office follows a different test for conceptual separability than the one cited in your June 24 letter and set forth in *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987), and *National Theme Prods. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348 (S.D. Cal. 1988). Instead,

> . . . 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.

(Letter from Giroux to Diliberti of 8/19/2004, at 2 (citing *Compendium of Copyright Office Practices, Compendium II*, § 505.03 (1984) and *Esquire v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978)). Ms. Giroux explained that the Office test requires more than merely drawing analogies from the general shape of the article to works of modern sculpture. Letter from Giroux of 8/19/2004, at 2, 3. Instead, the nonutilitarian features of the article must be separable and also copyrightable as a work of art.

Ms. Giroux stated that the swirled finial was not physically or conceptually separable from the light bulb. Thus, it was part of the overall shape, contour and configuration of the light bulb itself, and as such, not copyrightable. *Id.* at 3-4. The fact that some other shape, size, or configuration could have been chosen instead of the swirled finial does not make the work copyrightable. Because all elements of the SWIRLED GLOW BULB were either related to its useful aspects or function, or were subsumed within the overall shape, contour, or configuration, there was no separable authorship that could be registered. Letter from Giroux of 8/19/2004, at 2; 4. Attorney Giroux did not reach the question of whether, assuming the swirled finial were conceptually separable, it was sufficiently original to support copyright registration.

In a letter dated November 11, 2004, you appealed to this Board. Your second appeal contends that "analysis of the proper features of the Work (its swirled appearance and finial apex) under the proper standard (conceptual separability) entitles [the] Work to copyright registration." Letter from Diliberti of 11/11/2004, at 1. In particular, you assert that the "swirled appearance...does not constitute the basic shape of the article." *Id.* at 2. You also asserted that because the "swirled sculptural elements" are "anti-functional," in that they reduce the illumination provided by the bulb, that fact demonstrates that the design elements were added as a reflection of artistic judgment independent of functional influences, citing *Brandir*. *Id.* at 3. Finally, you contend that the swirled elements are sufficiently creative to support registration. *Id.* at 4-5.

In a letter dated July 10, 2006, you provided the Board with two actual SWIRLED GLOW BULBS. In that letter, you indicated that, "Applicant has been able to train one employee to follow this manual process in a manner that faithfully reproduces the claimed features." Letter from Diliberti of 7/10/06, at 1.

DISCUSSION

The SWIRLED GLOW BULB is a light bulb. Thus it has a predominantly utilitarian function. An artistic work that is also a useful article may, in some cases, be registered, but its utilitarian aspects cannot form the basis of the authorship registered. Design elements of pictorial, graphic, or sculptural works can be considered for copyright registration only to the extent that they can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article. 17 U.S.C. § 101.

1. The "Swirled" Surface Appearance and Finial Apex Are Separable from the Bulb.

Because the light bulb is a useful article, the Board's analysis must begin by determining whether there are any elements that are physically or conceptually separable from the utilitarian function of the article. Your letter contends that copyright protection is being sought for "discrete design features," namely, "a sculpted swirled appearance which peaks into a finial apex that resembles a horn or spire." Letter from Diliberti of 11/11/2004, at 2.

You do not assert, and it does not appear, that the swirled elements are physically separable from the bulb. The test which the Office follows for conceptual separability is set forth in the *Compendium of Copyright Office Practices, Compendium II, 505.03 (1984):*the features said to be conceptually separable must be clearly recognizable as a pictorial, graphic, or sculptural work which can be visualized on paper, for example, or as a free-standing sculpture, 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. Thus, we must determine whether the "swirled" appearance and finial apex fit this category of works just described.

You have cited the Denicola test as it was utilized in Brandir and as it was cited in several other cases: if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. *Brandir*, 834 F.2d at 1145. We do not reach the question whether the Denicola test is an appropriate test to apply or whether, under that test, the "swirled" appearance and finial features would constitute separable authorship, because we conclude below that under the test set forth in *Compendium II*, there is separable authorship in the work at issue.

The question under *Compendium II's* test is whether the "swirled" appearance feature as well as the finial, spire-like ending to the bulb can be separated from the bulb without destroying the bulb's basic shape. *See above.* The Review Board agrees that the swirled coating and the finial elements of SWIRLED GLOW BULB can be visualized independently of the bulb itself. The swirled element sits atop a common useful article– a light bulb. The swirl feature, as you have explained, is "a silicone appendage" that wraps around the bulb. Letter from Diliberti of 11/11/2004, at 3. We note that, although the silicone wraps around the

underlying bulb, it does not exactly, and faithfully, mimic the shape of the bulb but, rather, assumes a swirled, layer-like circling, beginning with larger circles, descending to smaller circles and, finally ending in a finial point. As a wrap, it can reasonably be said to be a surface adornment to the bulb. The basic shape of the bulb is essentially unchanged: one can visualize the bulb, alone and unadorned, juxtaposed next to the swirled/tapered feature but the image of the bulb remains conceptually intact. Thus, the work meets the *Compendium* test for conceptual separability.

2. The Separable Elements Do Not Possess Sufficient Creativity to Constitute a Registrable Work of Art.

While the Board agrees that the swirled surface feature and the finial, spire-like ending of the work in question are separable elements, it, nevertheless, concludes that, taken together or separately, these elements do not constitute more than a *de minimis* amount of authorship. The mere fact that an artistic feature may be considered physically or conceptually separable from a utilitarian object in which it is embodied does not mean that it will necessarily represent copyrightable authorship sufficient to sustain registration. All works of authorship for which registration is sought, be they sculptures, drawings, or otherwise, must 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 Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 345 (1991). First, the work must have been independently created by the author, *i.e.*, not copied from another work. The Office assumes for the purpose of this portion of the analysis that your client did independently create the work. Second, the work must possess sufficient creativity. In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Copyright Office adheres to the standard set forth in *Feist* where the Supreme Court held that only a modicum of creativity is necessary.

Although *Feist* stated that the "requisite level of creativity is extremely low; even a slight amount will suffice," *id.*, 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," *id.* at 363, and that there can be no copyright in work in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359. *See also*, 37 C.F.R. 202.10(a) (2003) ("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 on Copyright § 2.01(b)(2006)("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.").

Even prior to *Feist*, 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*, § 202.02(a). With respect to pictorial, graphic, and sculptural works, *Compendium II* further 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). The Review Board finds that the required amount of creativity has not been met by the content of the work at issue here, SWIRLED GLOW BULB.

We also note that the application for this work, at space 6, indicates that this is a derivative work: space 6a- preexisting material= candle glow bulb; space 6b- material added to this work= swirled appearance of exterior of candle glow bulb. When a work is derivative, the copyrightable content of the work must be considered based not on the preexisting material, but only on the material added to the work; it is this additional material that is subject to consideration as a new work. The statute explicitly states that "copyright in a compilation or derivative work extends only to the material employed in the work, and does not imply any exclusive right in the preexisting material." 17 U.S.C. § 103(b). Further, the authorship which forms the basis of a claim in a derivative work must be protectible in itself, *i.e.*, must possess the Feist-required "minimal degree of creativity" [*Feist*, 499 U.S., at 345], just as must all authorship for which registration is sought. *See also L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir.), cert. denied, 429 U.S. 857 (1976) ; *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 909 (2d Cir. 1980) ("to support a copyright the original aspects of a derivative work must be more than trivial."

Your description of the claim, both in the application filed and your discussion of the scope of the claim confirms that the work you are attempting to register is that which has been added to the bulb. That added material is a silicone surface coating on the light bulb which surrounds it, assumes a descending swirl of uneven circles down the surface of the light bulb, and ends in a point. This amount of new authorship, or material added to the preexisting light bulb, is insufficient to be entitled to registration as either a derivative work as applied for, or as a new work.

The quantum requirements for sculptural authorship are expressed in the *Compendium,* section 503.02(b), and are directly on point. Copyrightability is based upon the creative expression of the author, that is, the manner or way in which the material is formed or fashioned. Thus registration cannot be based upon standard designs which lack originality, such as common architecture moldings, or the volute used to decorate the capitals of Ionic and Corinthian columns. Similarly, it is not possible to copyright common geometric figures or shapes in three-dimensional form such as the cone, cube, or sphere. *Compendium II, § 503.02(b).*

You admit that the tip of the swirled glow bulb constitutes a spire. Like a cone, cube or sphere, this finial is a common geometric figure– a very narrow, cone-like or spire-like shape, ending in a simple point. Further, the swirled effect may also be fairly said to result in a common shape– essentially a series of circles made by the wrapping around of the constituent

material. The same section of the *Compendium* cautions that "*the 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.*" *Id.* (emphasis added) The Board also notes that the actual samples of the bulbs submitted are not completely identical. There are variations in the swirled pattern as well as the height of the finial. That the bulbs were produced from the same manual process you described in your letter dated July 10, 2006 suggests that it may be that underlying process for which copyright protection is sought. However, section 102(b) of the Copyright Act is clear that no copyright protection exists for a "procedure, process, system, method of operation...." Thus, this process, no matter how much skill is required, cannot serve as the basis of copyrightability.

We also note your statement [Letter from Diliberti of 11/11/2004, at 5] that "courts have routinely held that the creation of a three-dimensional sculpture exhibits more than the requisite level of creativity" and you *cite W. Goebel Porzellanfabrik v. Action Industries, Inc.*, 589 F. Supp. 763 (S.D.N.Y. 1984). The *Goebel* case involved the well-known Hummel figurines which are marketed throughout the world. Essentially a case in which antitrust issues played a central role, the court, however, in addressing a charge of fraud on the Copyright Office, noted that artists who were employed by Goebel to "translate[d] the sketches into three-dimensional arts works have added sufficient creative effort to make the Hummel figures protectible under the copyright laws." *Goebel*, 589 F. Supp. at 767. The Board does not find the Hummel sculptures at issue in *Goebel* comparable in their configurations to the simple sculptural elements incorporated into SWIRLED GLOW BULB. Further, we do not read *Goebel* to mean that any three-dimensional sculpture is, per se, copyrightable: there are clearly sculptural works which do not meet the level of creativity required by *Feist* and SWIRLED GLOW BULB falls into the category of three-dimensional works possessing very simple, minor variations on very few common shapes.

In response to your appeal to consider the artistic content of the individual elements or design features of the SWIRLED GLOW BULB, we point out that these elements– the swirled, circular surround which ends in a simple, pointed cone-like appendage– taken either individually as design elements or together as an ensemble of sculptural elements, do not rise to the level of copyrightable authorship. The Office's registration practices incorporate the principle that the use of public domain elements, of commonly known and/or geometric shapes, and of familiar symbols, may yet result in a copyrightable work as long as the overall resulting design, taken in its entirety, constitutes more than a trivial variation of the constitutive elements. *Compendium II*, § 503.02(b). In *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995), the court, although considering the appropriate infringement test for a design on clothing, articulated a copyrightability analysis in terms of the overall pattern that was infringed in that case, pointing out that "[W]hat is protectible then is 'the author's original contributions,' (citing *Feist* at 350)-- the original way in which the author has 'selected, coordinated and arranged' (citing *Feist* at 358) the elements of his or her work." 71 F.3d at 1004. Again, using *Feist's* standard, the Board does not see individual aspects or an overall arrangement of shapes which rises above the commonplace and simple; SWIRLED GLOW BULB contains design features

which represent an overall authorship too minimal to sustain registration. *See also Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003)(concerning a glass-in-glass jellyfish sculpture, a combination of several commonplace elements, where the court observed that "it is not true that any combination of unprotectable elements automatically qualifies for copyright protection. ... a combination of unprotectable 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.") Applying the above principles to the two elements in this work– a swirl with minor variations from the smooth surface of the underlying light bulb, devolving to a simple point– we determine that such design constitutes *de minimis* authorship under *Feist*, *Compendium II*, and prevailing case law.

CONCLUSION

For the reasons stated above, the Copyright Office Review Board concludes that SWIRLED GLOW BULB cannot be registered. This decision constitutes final agency action in this matter.

Sincerely,

N. Petruzzelli

Nanette Petruzzelli
Associate Register for
Registration and Recordation
for the Review Board
United States Copyright Office