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June 5, 2008

Christensen O'Connor Johnson Kindness PLLC
Attn: Jerald E. Nagae
1420 Fifth Ave., Ste. 2800
Seattle, WA 98101

RE: NUNCHUK
Copyright Office Control Number: 61-414-3939(C)
Your Reference Number: NOAM-4-6509

Dear Mr. Nagae:

I am writing to you on behalf of the Copyright Office Review Board [hereinafter Board] in response to your letter dated October 15, 2007, in which you requested the Copyright Office to reconsider, for a second time, its refusal to register the work entitled Nunchuk. The Board has carefully examined the application, the deposit and all correspondence concerning this application, and hereby affirms the denial of registration.

I. DESCRIPTION OF WORK

The subject work is a video game control unit. The housing of the work is described as "a sleek, smooth profile and a body shaped by flowing curves which converge into opposing parabolic taperings at either end." Letter from Jerald E. Nagae to Chief, Receiving and Processing Division of 10/15/2007, at 2. The control unit also has a joystick and two buttons which enable its function of "transmitting information from a [the] controller to an in-home video game console." Letter from Sarah E. Nagae to Chief, Receiving and Processing Division of 3/13/2007, at 3. The exact shape and configuration of Nunchuk is best communicated by the visual representation shown below.

II. ADMINISTRATIVE RECORD

A. Initial application and Office's refusal to register

On October 6, 2006, the Office received a Form VA application from you on behalf of your client, Nintendo of America, Inc., to register a "3-Dimensional sculpture" entitled Nunchuk. In a letter dated November 16, 2006, Visual Arts Section Examiner Bill Shuttleworth refused registration of this work because he determined that it was a useful article that did not contain any separable authorship needed to sustain a claim to copyright. Letter from Bill Shuttleworth to Jerald E. Nagae of 11/16/2006, at 1.

B. First request for reconsideration

In a letter dated March 13, 2007, Sarah E. Nagae of your firm requested reconsideration of the Office's refusal to register the Nunchuk. Letter from Nagae of 3/13/2007, at 1. She argued that the Nunchuk contains the requisite degree of separable authorship to support a copyright claim. *Id*. at 2. She described the work as "a molded plastic outline of a shape having particular curvatures and promontories" with "artistic qualities" such as "a sleek, smooth profile and a body shaped by flowing curves which converge into opposing parabolic taperings at either end." *Id.* She argued that "the sculptural features of the applicant's work are conceptually separable from the object's most common utilitarian function of transmitting information from a video game controller to an in-home video game console," and cited in support *Pivot Point Int'l, Inc. v. Charlene Prods*, 372 F.3d 913 (7th Cir. 2004) (quoting *Brandir Int'l v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987)) which held that copyright protection depends on whether the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences. *Id.* at 3. She stated that the structure of the work is a "largely arbitrary shape not necessary for an information-transmission function," *id*. at 3, and noted that utility patent protection for the Nunchuk design has neither been sought from, nor granted by, the United States Patent and Trademark Office. *Id*. at 4-5.

C. Examining Division's response

In response to your request and in light of the points raised in Ms. Nagae's letter of March 13, 2007, Attorney Advisor Virginia Giroux-Rollow of the Examining Division [now part of the Copyright Office's Registration and Recordation Program] reviewed the application, and she, too, determined that Nunchuk was a useful article that did not contain any authorship that is both separable and copyrightable. Letter from Virginia Giroux-Rollow to Sarah E. Nagae of 7/16/2007, at 1. She noted that you did not deny that this work was a useful article. *Id.* at 2. She stated that, instead of the *Brandir* test you cited, the Copyright Office uses the test for conceptual separability articulated in *Compendium of Copyright Office Practices II*, Ch. 500, § 505.03 (1984) [hereinafter *Compendium II*], which generally follows the separability principle set forth in *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C.Cir. 1978). *Id.*

Ms. Giroux-Rollow noted that the *Compendium* 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 that can be visualized on paper – independent of the shape of the article – without destroying its basic shape. *Id.* She noted that where certain features are an integral part of the overall shape or contour of a useful article, no registration is possible. *Id*. at 2, citing *Esquire*.

Ms. Giroux-Rollow then stated that the physical separability test is derived from the principle that a copyrightable work of art which is later incorporated into a useful article retains its copyright protection. *Id.* at 3. However, she noted that 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 other component of a work is detachable from the working parts of the article. *Id.* Thus, she determined that the design elements you described in the Nunchuk could not be physically or conceptually perceived as separable without destroying the work's basic shape, and that the design elements you described in your first request for reconsideration were all "part of the overall shape, contour, and configuration of the useful article itself and, as such, not copyrightable." *Id*.

Ms. Giroux-Rollow noted that all works involve choices, and the fact that other shapes, sizes, and configurations could have been chosen or selected for this work does not mean that the work is copyrightable. *Id.* at 4. Finally, she summarized her reasons for again refusing registration of Nunchuk by emphasizing Congress's intent that the overall design of a utilitarian article not be granted copyright protection. *Id*. (citing H.R. Rep. No. 94-1476, at 55). She 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 itself, **or are subsumed** within the overall shape, contour, and configuration of the work itself, there is no physically or conceptually separable authorship" that could warrant registration of the claim. *Id*. (emphasis in original)

D. Second request for reconsideration

In a letter dated October 15, 2007, you requested that the Office reconsider, for a second time, its refusal to register the copyright claim in the work Nunchuk. Letter from Jerald E. Nagae of 10/15/2007, at 1. You argue that the work's "sculptural design may be visualized independently of any utilitarian features of the work" and that its shape "has artistic merit and qualities divorced from any function." *Id.* at 2. In support of this proposition, you submit and refer to exhibits showing (1) the work's sculptural design, *id.* at Exhibit 2; (2) a representation of the utilitarian features of the work, *id.* at Exhibit 3; and photographs of other controllers that you argue, in contrast to Nunchuk, have functional shapes. *Id*. at Exhibits 4-7. [Your 10/15/2007 letter refers to exhibits 7 and 8; the deposit materials which we have received end the exhibits at exhibit # 7.]

You then argue that, applying the conceptual separability test articulated in *Compendium II* and followed by the Copyright Office, the sculptural work can be visualized on paper or as a free-standing sculpture, and can be "conceptually separated from the utilitarian elements of the article without destroying the basic shape of the utilitarian elements." *Id.* at 3. Therefore, you argue, "the design features of Applicant's article can be said to not be an integral part of the overall shape, styling, and contour of the useful article." *Id.* You state that the design of the Nunchuk incorporates sculptural features that can be identified separately from, and are capable of existing independenly of, the utilitarian aspects of the article. *Id.* at 4. You then argue that, assuming the doctrine of physical separability applies, the sculptural features of the work are physically separable elements that can be regarded as a "work of art" apart from the shape of the original article. *Id.* You analogize the work Nunchuk to useful articles in several other cases which held that those articles contained physically or conceptually separable sculptural authorship. *Id*. at 4-6.

III. DECISION

After reviewing the application and arguments in favor of registering Applicant's work, the Review Board upholds the Examining Division's decision to refuse registration of Nunchuk. The Board determines that the work has no elements separable from their utilitarian function and that Nunchuk is a useful article.

A. Useful articles and separability

A useful article is defined as having "an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." An article that is normally a part of a useful article is considered a "useful article." 17 U.S.C. § 101. Copyright protection can be extended to the design of a useful article "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*. (definition of "pictorial, graphic, and sculptural works").[1] You do not dispute that the work Nunchuk, as a video game control unit, is a useful article. As a useful article, the work is subject to the separability analysis that copyright law requires.

The purpose of the separability analysis is to ensure that utilitarian aspects of useful articles are not registered since they are not subject to copyright protection. Written guidelines for separability analysis are found in § 505.02 of *Compendium II*, which states that:

> Registration of claims to copyright in three-dimensional useful articles can be considered only on the basis of separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence apart from the shape of the useful article. Determination of separability may be made on either a conceptual or physical basis.

These guidelines are based on the legislative history of the Copyright Act of 1976, quoted below, in which Congress clarified that utilitarian aspects of useful articles are not copyrightable. Only elements or features that are physically or conceptually separable from the utilitarian purpose of a useful article may be copyrighted.

> [A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it

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[1] In your second request for reconsideration, you seek a clarification of applicable law, noting that Ms. Giroux-Rollow in her 7/16/2007 letter incorrectly ended the statutory definition of "pictorial, graphic, and sculptural works" with the phrase "without destroying its basic shape." As explained below, while this phrase does not appear in the statutory definition, the legislative history, *Compendium II*, and subsequent case law all establish that this phrase is an accurate description of the separability test under which the Copyright Office can and does perform its separability analysis. We do apologize, however, for the error in our July 16 letter which misleadingly used the phrase to make it appear as part of the statute.

> copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from the "utilitarian aspects of the article" does not depend upon the nature of the design– that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and *would not cover the over-all configuration of the utilitarian article as such*.

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

Physical separability means that the subject pictorial, graphic, or sculptural features must be able to be separated from the useful article by ordinary means:

> 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.

Compendium II, at § 505.04

In the case of conceptual separability, *Compendium II,* at § 505.03, states:

> Conceptual separability means that 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 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. Thus, carving on the back of a chair, or

> pictorial matter engraved on a glass vase, could be considered for registration. The test of conceptual separability, however, is not met by merely analogizing the general shape of a useful article to works of modern sculpture, since the alleged "artistic features" and the useful article cannot be perceived as having separate, independent existences. The shape of the alleged "artistic features" and of the useful article are one and the same, or differ in minor ways; any differences are de minimis. *The mere fact that certain features are nonfunctional or could have been designed differently is irrelevant under the statutory definition of pictorial, graphic, and sculptural works*. (emphasis added)

1. Separability tests

Section 505 of *Compendium II*, as quoted above, 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), *cert. denied,* 440 U.S. 908 (1979). The Office relies on the authority of *Esquire* for the analysis it follows to determine whether pictorial, graphic or sculptural works are separable from the utilitarian objects in which they are incorporated. As *Esquire* explains, copyright protection is not available for the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be." *Id. at 800*. In that case, the Office had refused to register an outdoor lighting fixture which arguably contained non-functional, purely aesthetic features. The court upheld the Office's refusal, noting that "Congress has repeatedly rejected proposed legislation that would make copyright protection available for consumer or industrial products." *Id.*[2] Similarly in *Norris Industries, Inc. v. International Telephone & Telegraph Corp.*, 696 F.2d 918, 924 (11th Cir. 1983), *cert. denied*, 464 U.S. 818 (1983), the court held that a wire-spoked wheel cover was not entitled to copyright protection because it was a useful article used to protect lugnuts, brakes, wheels and axles from damage and corrosion, and it did not contain any sculptural design features that could be identified apart from the wheel cover itself.

In your first appeal of the Office's refusal to register Nunchuk, you argue that conceptual separability exists whenever a useful article evidences the author's artistic judgment exercised independently of functional influences. Letter from Nagae of 3/13/2007, at 3, citing the separability test found in *Brandir Int'l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) and *Pivot Point Int'l, Inc. v. Charlene Prods*., 372 F.3d 913 (7th Cir. 2004). Although you did not raise this particular separability test in your second appeal, and although the Board disagrees with its separability analysis, we will, nevertheless, analyze the work at issue here under both *Esquire* and

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[2] Although *Esquire* was decided under the 1909 version of the Copyright Act, its reasoning is, nevertheless, applicable to cases arising under the 1976 Act. "[T]he 1976 Act and its legislative history can be taken as an expression of congressional understanding of the scope of protection for utilitarian articles under the old regulations." 591 F.2d at 803.

Compendium II's test as well as under the alternative test proffered by *Brandir* and accepted by *Pivot Point*. Under any of these tests, the work Nunchuk does not exhibit separable features.

2. Custom Chrome

The Office's *Compendium II* test was confirmed in an action against the Copyright Office in *Custom Chrome, Inc. v. Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. 1995). *Custom Chrome* was an action brought under the Administrative Procedure Act [APA], 5 U.S.C. §§ 701-706, based on an assertion that the Copyright Office's action refusing registration for twenty-three motorcycle parts was arbitrary and not in accord with the law. *Custom Chrome*, at *1. The District Court for the District of Columbia held that the Office's determination, under the Office's *Compendium II* separability test, (that the motorcycle parts did not contain separable features) was reasonable and consistent with the copyright statute and with "declared legislative intent." *Custom Chrome*, at *12.

Because *Custom Chrome* was an APA action, the Court did not determine which of the several separability tests proffered by legal scholars or derived from case law was the correct one. The Court simply stated that "so long as the Copyright Office has offered a reasonable construction of the copyright statute, its judgment must be affirmed even if this Court were to accept Custom Chrome's assertions that the duality test would support its copyright claims." *Custom Chrome*, at *15. We point out *Custom Chrome* to emphasize that *Compendium II's* separability test, centering on the general shape of the useful article, is consistent with "later cases decided under the present law and the legislative history," *id.* at *16, in denying protection to the shape of an industrial product even though it may be aesthetically pleasing. Further, *Compendium II* states that the shape or configuration of supposedly artistic features cannot be considered to provide the requisite separability merely because the features are nonfunctional. *Id.* at § 505.03.

B. Compendium test applied to Nunchuk

1. The useful article at issue

You have put forth an argument that the work Nunchuk may be registered because the "sculptural design may be visualized independently of any utilitarian features of the work." Letter of 10/15/2007, at 2. You describe the housing of Nunchuk as the "sculptural design," and the "buttons and their internal interrelation parts" as the "utilitarian features" of the work; you submitted exhibits showing how they may be separated, physically or conceptually, from each other. *Id.* at Exhibits 2-3. You conclude that the work Nunchuk "can primarily be viewed as a sculptural work, into which buttons have been inserted so the sculpture may additionally serve a function." *Id.* at 3. The Board disagrees with this analysis for two reasons.

First, the Board considers both the external housing and the "buttons and their internal interrelation parts" to be two parts of the same useful article. Again, the statutory definition of a useful article states that "an article that is normally a part of a useful article" is considered a useful article. 17 U.S.C. § 101. The materials you have submitted in support of registration for the work

show that they are marketed as one unit. The work Nunchuk is not simply the buttons and their internal interrelation parts; rather, the work consists of the buttons, the internal features, and the housing. As such, the housing is an integral part of the useful article.

Second, the Board finds that the external housing is itself a functional feature of Nunchuk. As a video game control unit, the apparent function of the article is not simply to "transmit[] information from a video game controller to an in-home video game console," Letter of 3/13/2007, at 3, but to do so in a way that permits an individual using the controller to input such information. This would require that the user be able to wield or handle the control unit, a function that the housing – the outer shell – of Nunchuk fulfills. In this way, the housing performs the same function as the housings of the controllers submitted in your Letter of 10/15/2007, at Exhibits 4-7. The fact that Nunchuk's housing is designed differently from these other controllers does not negate its function as a means by which the control unit can be wielded or handled. On the contrary, the ergonomic design of the housing allows a user to comfortably hold it in one hand, further illustrating its useful, functional characteristics. Nunchuk's housing may be more aesthetically pleasing than that of the other controllers, but this does not automatically grant it copyright protection. *See Esquire*, 591 F.2d at 800 (upholding refusal to register "aesthetically pleasing" lamp design).

For these reasons, the Board must consider the work Nunchuk as a whole, including the housing, buttons, and interrelational parts, in determining whether there exists physical or conceptual separability necessary to support a registration.

2. Nunchuk fails Compendium II's test for conceptual separability

The Board concludes that Nunchuk's design features, which you describe as "a sleek, smooth profile and a body shaped by flowing curves which converge into opposing parabolic taperings at either end" [Letter of 10/15/2007, at 2] are not separable under the Office's *Compendium II* test because these features are part of the overall shape of the article itself. The artistic features of the design cannot be "imagined separately and independently from the useful article without destroying the basic shape of the useful article" as required by *Compendium II*, at § 505.03.

You argue, however, that the sculptural design of Nunchuk "can be conceptually separated from the utilitarian elements of the article without destroying the basic shape of the utilitarian elements." Letter 10/15/2007, at 3. However, for the reasons stated above, the Board considers the useful article as a whole in order to determine conceptual separability. While one could conceptually separate the design of the housing without changing the basic shape of the buttons and internal interrelation parts, the same cannot be said about the entire video game control unit, the basic shape of which would certainly be destroyed if the housing were imagined separately and independently.

In support of your argument that the sculptural design of Nunchuk is conceptually separable, you cite *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980). *Id.* at 5. *Kieselstein* involved two belt buckles, registered by the Copyright Office, which consisted of solid

sculptured designs with rounded corners and appearing within several surface levels. 632 F.2d at 990. You argue that "Applicant's sculptural design, like the belt buckles, is not representational … and does consist of a fanciful shape separately identifiable from the overall functional design of the useful article." Letter of 10/15/2007, at 5. We point out that the belt buckles at issue in *Kieselstein* reflected sculpted, contoured lines which could not fairly be said to be co-extensive with the entire shape of the buckles. The Second Circuit explicitly stated that, in considering the sculptural features of the *Kieselstein* belt buckles conceptually separable, it came to a conclusion of conceptual separability which "is not at variance with the expressed congressional intent to distinguish copyrightable applied art and uncopyrightable industrial design." 632 F.2d at 993. It is the overall shape of the useful article that Congress has determined cannot be protected by copyright.

With respect to the work Nunchuk, the sculptural "outer" design features you describe in your letter, however, do, indeed, form the overall shape or configuration of the useful article *as that article is used* to transmit information from a video game controller to an in-home video game console. With respect to the *Kieselstein* belt buckles, the Second Circuit explicitly applied the separability test for useful articles. In upholding the Copyright Office's registration of the two belt buckles, the court concluded: "[w]e see in appellant's belt buckles conceptually separable sculptural elements..." *Id*. at 993. The belt buckles contained conceptually separable ornamentation that was not part of the general contours of the buckle itself.[3] While Nunchuk's shape may be aesthetically pleasing, that shape is nevertheless still functional because it is just that – the overall shape or form which the user grasps in order to put Nunchuk to its intended use; the design elements – a sleek profile of the body of the object characterized by "flowing curves which converge into opposing parabolic taperings at either end" [Letter of 3/13/2007, at 2] to which you cite are inextricable parts/aspects of the overall shape and contour of the Nunchuk object itself.

Similarly, the works at issue in *Royalty Designs, Inc. v. Thrifticheck Service Corp.*, 204 F. Supp. 702 (S.D.N.Y. 1962), and *Animal Fair, Inc. v. Amfesco Industries Inc.*, 620 F. Supp. 175, 187-88 (D. Minn. 1985), which you cite in support of registration, contained artistic features that could not fairly be said to be co-extensive with the entire shape of the useful articles in those cases and thus could be conceptually separated from those articles. Such features included, in *Royalty Designs*, the facial features of a dog, *see* 204 F. Supp. at 703, and in *Animal Fair*, the graphic artwork, choice of colors and other features resembling a bear's paw, *see* 620 F. Supp. at 187-88. Unlike these works, the Board finds that the Nunchuk design features you describe are part and parcel of the overall shape or configuration of the useful article itself and are therefore not conceptually separable.

Likewise, the work at issue in *Spectrum Creations, Inc. v. Catalina Lighting, Inc.*, 2001 U.S. Dist. LEXIS 11861 (W.D. Tex. 2001), to which you also cite, was the graphic, stained-glass design embodied in plaintiff's lampshade, rather than the overall shape of the lamp itself. On this basis,

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[3] Please note that although the Office determined that the belt buckles embodied sufficient creativity in order to sustain registrations, the court expressly declined to address the issue of originality in its opinion. *Kieselstein-Cord*, 632 F.2d at 991.

the district court distinguished the lamp at issue in *Spectrum Creations* from that at issue in *Esquire*, and held that such graphic design was copyrightable. *Id.* at *38. In the case at hand, the sculptural design of the work Nunchuk is comparable to the lamp design rejected in *Esquire,* i.e., the designs of the articles are co-extensive with, and constitute, the shape of the useful articles. This was not the case in *Spectrum Creations*, distinguishable because the protected aspect of the lamp there was the graphic design or artwork on the shade.

Your citation to *Trans-World Manufacturing Corp. v. Al Nyman & Sons, Inc*., 95 F.R.D. 95, 218 USPQ 208 (D. Del. 1982), is also inapt. In *Trans-World*, the defendant moved for summary judgment, arguing that the plaintiff's eyeglass display cases were not copyrightable. The court denied the motion, holding that the affidavit of plaintiff's creative director, averring that the display cases had "artistic merit," raised a genuine issue of material fact as to whether the display cases exhibited conceptually separable authorship. *Id.* at 99. The *Trans-World* court neither deemed the display cases registrable nor took issue with the *Compendium II* test for conceptual separability. Rather, the court based its holding on *Kieselstein*, which in turn simply held that conceptual separability is adequate to support copyright, a holding that in its view contradicted *Esquire*.[4] 95 F.R.D. at 98. The *Compendium II* test allows conceptual separability to be a basis for registration, and does not involve judgments of "artistic merit:" the registrability of a work does not depend upon artistic merit or aesthetic value. *Id*. at §503.01. Rather, the test merely centers on whether there are graphic or sculptural features that can be conceptually separated from the useful article without destroying the article's basic shape. *Id*. at §505.03. The Board determines that Nunchuk fails this test, again, because its sleek shape, curves, and parabolic tapering at the end points of the object cannot be conceptually separated from the overall shape or configuration of the object as the object exists in its useful functioning.

3. Nunchuk fails Compendium II's test for physical separability

To the extent that physical separability is an issue in this case, the Board determines that the Nunchuk's housing is not physically separable from the useful article. Physical separability would appear to be a moot point in this instance because Nunchuk's solid housing has no design elements that could be actually separated by ordinary means, the hallmark of a physically separable element. *Compendium II*, § 505.04. Having to divide an otherwise solid plastic medium with a specialized device, such as a bandsaw, would not be within the scope of separation by ordinary means – either under *Compendium II's* test or under any other test – because doing so would essentially destroy the specific work – Nunchuk as it exists as an entity for its purpose of information transmission – for which copyright registration is being sought. In addition, since the overall shape of a useful article is not copyrightable, this test cannot be met by the mere fact that the housing of a useful article is detachable from the working parts of the article, even by ordinary means. *Id*. Therefore, your Exhibits purporting to show the housing physically separated from the buttons and internal

[4] The Board disagrees with the *Trans-World* court's reading of *Esquire*. *Esquire* did not decide that conceptually separable authorship could not sustain a copyright, but rather, that the design features at issue formed the basic shape of the useful article and were therefore not conceptually separable in the first place.

interrelated parts, Letter of 10/15/2007, at Exhibits 2-3, do not support the proposition that Nunchuk exhibits any physically separable features.

You have also cited *Mazer v. Stein*, 347 U.S. 201 (1954) and *Ted Arnold Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966) for the proposition that Nunchuk's sculptural features are physically separable from the rest of the article. The Board does not find that these cases support your separability arguments for Nunchuk. Although *Mazer* is an important case which teaches that works of art may be used in commercial or industrial products and still retain copyright ("We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration. We do not read such a limitation into the copyright law." 347 U.S. at 218), it did not explicitly address the separability issue and, thus, provides no detailed analysis or framework that can be used in support of your position.

Likewise, though the *Ted Arnold* court states that "[t]he telephone casing could be separated physically from the pencil sharpener," 259 F. Supp. at 735, the decision did not rest solely on physical separability. Rather, the court took issue with the defendant's assertion, much like the assertion of the defendant in *Mazer*, that "the copyrighted article is not a work of art because it is utilitarian." *Id*. at 734. Following *Mazer's* principle, the *Ted Arnold* court focused on the *categorization* of the pencil sharpener encased in the small sculpture of an antique telephone and concluded that what the plaintiff was seeking protection for was not a pencil sharpener but, rather, a work of art , consisting of an "imaginative conjunction of two objects, one of which disguises the other." *Id.* at 736. Nunchuk cannot fairly be similarly categorized: Nunchuk consists of a shaping or configuration which itself is a useful object, i.e., it allows the hand to hold the controller and to press the button for video game movements. The antique telephone sculpture in *Ted Arnold* was not useful in itself. The Office admits the possibility that a useful article may contain separable features, *i.e*., features which may, in themselves, be works of art protectible by copyright; however, in determining whether such an article contains separable features, the Office applies the *Compendium II* tests for physical or conceptual separability and, again, Nunchuk meets neither.

C. Nunchuk also fails the Denicola/Brandir/Pivot Point test for separability

Having analyzed the work at issue here, Nunchuk, under the provisions of *Compendium II's* tests for separability and found the work wanting in separable [as well as physical] features, we now turn to the alternative separability test articulated in *Brandir Int'l. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1145, accepted in *Pivot Point Int'l, Inc. v. Charlene Prods.*, 372 F.3d 913, 931 (7th Cir. 2004), and put forth in your first appeal of the Office's decision to refuse registration for Nunchuk. Letter of 3/13/2007, at 3. The *Brandir/Pivot Point* test requires copyright protection in a useful article to depend on "whether the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences." *Brandir*, 834 F.2d at 1145.

Judging a creator's intent, given the factual circumstances of creation, and determining whether design elements in a particular work reflect "the designer's artistic judgment exercised

independently of functional influences," *id.*, is not the type of judgment the Office normally undertakes in its examining process. Such judgments would necessarily rely on interpreting the specific actions surrounding the creation of a work; these actions occur outside the registration process. Any investigation and questioning of the method and circumstances of creation lie beyond the administrative capability of the Office.[5] *See, e.g., Compendium II*, §108.05. Thus, the Office uses as its tests for separability those adopted in *Esquire* and found in *Compendium II*, in carrying out its mandate at 17 U.S.C. § 410(a) to examine works submitted for registration under the copyright law. However, judicial acceptance of separability tests other than those found in *Compendium II* leads us, as we have mentioned, to analyze the work in question here under the alternative test you have raised in order to determine as objectively as possible whether the work at issue here, Nunchuk, does, indeed, lack any separable features which might be subject to copyright registration.

You have raised the Seventh Circuit's decision in the influential *Pivot Point* case which you have also cited as support for the separability of the enumerated features of Nunchuk. *Pivot Point* adopted the test articulated in *Brandir*, which in turn was derived from that proffered by Professor Robert C. Denicola in an influential law review article.[6] *See* Robert C. Denicola, "Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles," 67 *Minn. L. Rev*. 707, 741 (1983). Under the Denicola test, "copyrightability ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations." *Id.* at 741. In the words of the *Pivot Point* court, "If the elements do reflect the independent, artistic judgment of the designer, conceptual separability exists. Conversely, when the design of a useful article is 'as much the result of utilitarian pressures as aesthetic choices,' the useful and aesthetic elements are not conceptually separable." 372 F.3d at 931 (quoting *Brandir*, 834 F.2d at 1147); *see also Brandir*, 834 F.2d at 1145 ("[I]f 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.").

You have asserted that the work Nunchuk's "sleek, smooth profile and [its] body shaped by flowing curves which converge into opposing parabolic taperings at either end" are separable from the "utilitarian features" of the article (*i.e.*, the "buttons and their internal interrelation parts") and are thus subject to copyright protection. Letter of 10/15/2007, at 2. You have also stated that "the structure of applicant's work is a largely arbitrary shape not necessary for an

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[5] We note that you have offered to supplement your material with a statement from *Nunchuk*'s designer discussing the design process and the factors that influenced the design. Letter of 10/15/2007, at 2, n.2. Because the Office's determination of registrability does not evaluate circumstances outside the registration process and its application of the statute, any statement explaining the process by which a work is created would be inapplicable to the *Compendium II* tests for separability.

[6] We note that the bicycle rack that was the work in question in *Brandir* ultimately failed the Denicola test: "[W]hile the rack may have been derived in part from one or more 'works of art,' it is in its final form essentially a product of industrial design." 834 F.2d at 1147.

information-transmission function." Letter of 3/13/2007, at 3. As we have discussed above, however, our analysis of Nunchuk does not stop at the article's information-transmission function. The housing itself is functional, in that it allows an individual to use the article – to grasp it, to hold it, to wield it – for game playing functions, functions which are fulfilled by Nunchuk's [ergonomic] design itself.[7]

Viewed in this light, the work Nunchuk is, in its entirety, a useful article; all of its features, including its housing, form part of this single unit and serve a purpose. The aesthetic characteristics of the device do not negate its usefulness and facility to function as such. Though the article's design may be novel and aesthetically pleasing, and though it could have been designed differently, it is nevertheless created in a way that allows the device to work – Nunchuk apparently meets the utilitarian and functional demand of allowing its user to hold it in order to perform its "information-transmission" function. Thus, Nunchuk fails the Denicola test because its form does not, in Professor Denicola's words, "reflect purely aesthetic visions," Denicola, supra, at 743. At best, the artistic aspects of Nunchuk's design "reflect a merger of aesthetic and functional considerations," and thus "cannot be said to be conceptually separable from the utilitarian elements." *Brandi*r*,* 834 F.2d at 1145.

The work at issue in *Pivot Point*, a mannequin of a female face and head entitled MARA, was registered by the Copyright Office as a sculpture; the issue of MARA's also serving as a mannequin to teach the proper application of makeup and hair arrangement did not arise during the registration process.[8] The *Pivot Point* litigation, however, focused on the usefulness of the bareheaded, makeup-less mannequin and, in a scholarly opinion, the Seventh Circuit surveyed the multiple separability tests and explained its acceptance of the Denicola test as that test was articulated in *Brandir*. In *Pivot Point,* the application of *Brandir's* reasoning resulted in the Seventh Circuit's finding the features of the mannequin head at issue to "meet the requirements for conceptual separability:" the MARA mannequin head was the "product of a creative process unfettered by functional concerns, its sculptural features 'can be identified separately from, and are capable of existing independently of,' its utilitarian aspects." 372 F.3d at 932.

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[7] *See* What is Wii?: Controllers, at http://www.nintendo.com/wii/what/controllers (last visited Mar. 25, 2008) ("You'll find a Nunchuk fits in your hand like an old friend. It hooks up to the Wii Remote via the external extension connector to give you even more flexibility.").

[8] The Office does not normally investigate the facts surrounding the creation of a work which has been submitted for registration. *Compendium II*, § 108.05*:* "In connection with its examining and related activities, the Copyright Office does not ordinarily make findings of fact with respect to publication or any other thing done outside the Copyright Office." If the information provided in a submission for registration appears consistent and reasonable on its face, the Office accepts the submission without further inquiry. We do wish to add, however, that *Compendium II*, § 108.05[b], also states that the Office may take administrative notice of "matters of general knowledge"and that it may use such knowledge as the basis for questioning applications that "appear to contain or be based upon inaccurate or erroneous information." If all aspects of a registration submission appear acceptable as analyzed within the body of registration practices and reasonable on their face, no further examiner inquiry is undertaken.

Under an analysis following the reasoning of *Pivot Point* (which, in turn, takes its lead from *Brandir*), the work at issue here, Nunchuk, cannot be said to exhibit features which are, in *Pivot Point's* words, "unfettered by functional concerns." All of the features you have enumerated as separable are part of the overall configuration and structure of the video game control unit. As discussed above, those features you have enumerated cannot be regarded as purely aesthetic; the features are present within the controller because they are needed to make it operative and functional and render it amenable to being held by an operator of the game. There may be other ways in which some of the features may be configured but they are, nevertheless, features meant to operate as parts of a useful device. As such, they fail to meet the Denicola test as it has been set out in both *Brandir* and *Pivot Point*.

Where a useful object takes a particular form which is as much the result of utilitarian pressures as aesthetic choices, form and function are inextricably intertwined. *Brandir*, 834 F.2d at 1147. The artistic aspects of the work at issue (the profile, curves, and taperings of the controller's housing) cannot be separated from its utilitarian aspects, (the profile, curves, and taperings that form the apparatus that the controller's user must wield) for purposes of copyright protection. *Pivot Point*, 372 F.3d at 931.

For the reasons stated above, the Copyright Office Review Board affirms the refusal to register the work *Nunchuk*. This decision constitutes final agency action in this matter.

Sincerely,

/s/

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