United States Copyright Office
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July 25, 2008

Arthur S. Rose, Esq.
Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

RE: TIME TANK
Copyright Office Control Number: 61-418-1439(R)
Your Reference Number: OAKLY1.295CR

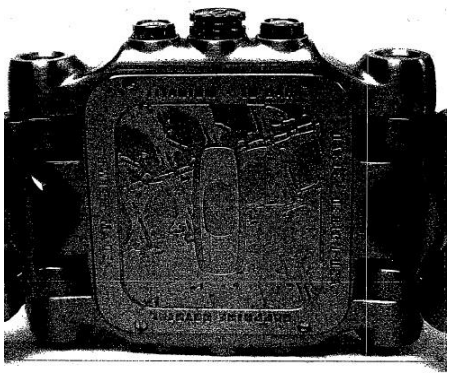
Dear Mr. Rose:

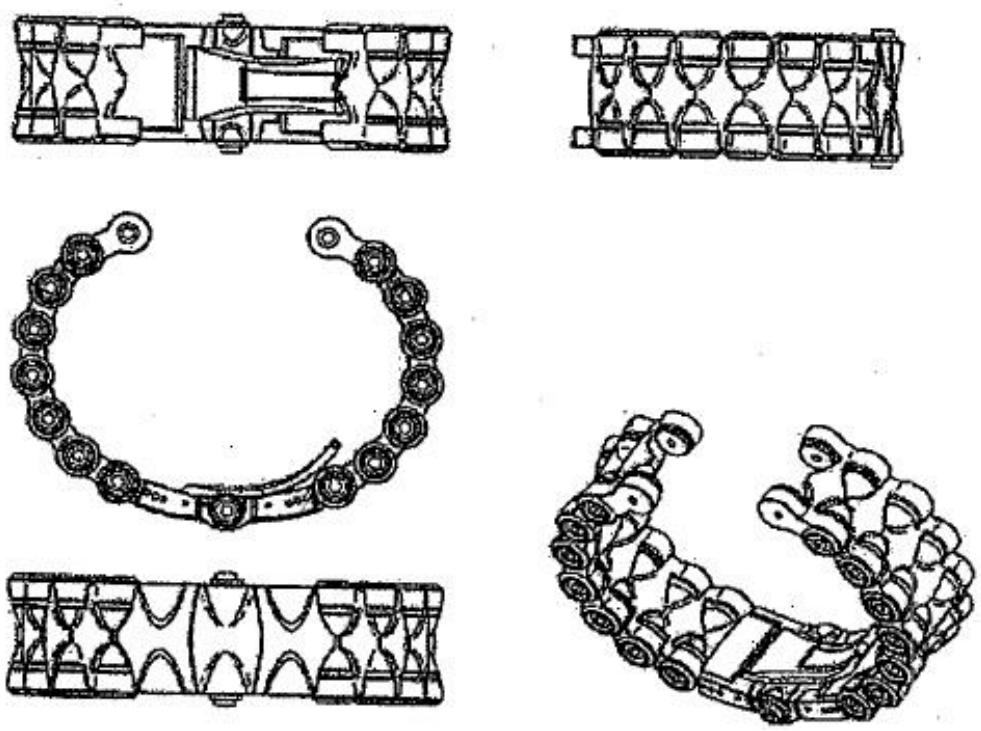
I write on behalf of the Copyright Office Review Board the ("Board") in response to your letter dated January 23, 2008, in which you requested the Copyright Office (the "Office") to reconsider for a second time its refusal to register the work entitled "Time Tank" (the "Work").

The Board has carefully examined the application, the deposit and all correspondence concerning this application, and must affirm denial of registration because the Work, as submitted for consideration, is a useful article with insufficient separable and original authorship.

I. DESCRIPTION OF WORK

The subject work, "Time Tank" is a wristwatch. As is typical for a wristwatch, it is comprised of a watch face, the timepiece itself, which is housed in a casing, and a wristband, used to hold the timepiece around the user's wrist. The back side of the watch face's casing includes a relief design. The links on the wristband consist of cylinders on both outer edges of the band that taper toward rounded conical points directed inward toward one another. The exact shape of each portion of the wrist watch is best communicated by the visual representation set forth below.





II. ADMINISTRATIVE RECORD

A. Initial application and Office's response

On July 17, 2006, the Office received a Form VA application from you on behalf of your client, Oakley, Inc., to register "Time Tank" as "jewelry." In a letter dated September 14, 2006, Visual Arts Section Examiner Rebecca Barker delayed registration for "Time Tank" in order to clarify the authorship covered by the application. *Letter from Barker to Rose of 09/14/06.* On January 11, 2007, the applicant responded to Ms. Barker's request, attempting to clarify the physically and conceptually separable features of the Work. *Letter from Rose to Barker* of 01/11/07. On February 28, 2007, Ms. Barker sent a letter to you refusing registration of the Work. She stated that, apart from the relief design on the back of the timepiece casing, the Work was a useful article that did not contain separable creative authorship sufficient to warrant registration. *Letter from Barker to Rose of 02/28/07.*

B. First request for reconsideration and Office's response

On May 23, 2007, you filed a request for reconsideration. Citing case law and pointing toward examples of watches and bracelets that have been registered by the Office, you asserted that the Work contained copyrightable aspects in addition to the relief design on the back of the timepiece casing. *Letter from Rose to Office of 05/23/07.*

On October 24, 2007, Attorney Advisor Virginia Giroux-Rollow sent you a letter upholding the Office's refusal to register the Work. Ms. Giroux-Rollow noted that the Work is a

watch, which is a useful article. She pointed out that section 101 of title 17 establishes the definition of a useful article as an "article 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'" *Letter from Giroux-Rollow to Rose* of 10/24/07, at 1, citing 17 U.S.C. § 101.

Ms. Giroux-Rollow disputed your assertion that the Work contains non-functional design elements based on the designer's aesthetic judgments rather than on utilitarian concerns and therefore contains conceptually separable authorship. She pointed out that the Office does not follow the Denicola separability test set forth in *Brandir Int'l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) and later reiterated in *National Theme Productions v. Jerry Beck Inc.* 696 F. Supp. 1348 (S.D. Ca. 1988). Instead, she noted, the Office uses the separability test enunciated in *Compendium of Copyright Office Practices II,* § 505.03 (1984) ("*Compendium II*"), which also contains the separability principles generally stated in *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979). Ms. Giroux-Rollow added that under the *Compendium II* test, conceptual separability occurs when the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are 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, without destroying its basic shape. *Letter from Giroux-Rollow to Rose of 10/24/07,* at 2.

Applying this test, Ms. Giroux-Rollow concluded that, other than the aforementioned relief design on the back of the watch casing, there are no separable elements on the wristband that are copyrightable. She stated that the Office views the contours, curvatures, and tread-styling as part of the overall shape, styling and contour, and configuration of the wristwatch itself, and as such, not copyrightable. She added that the facts that a design is aesthetically pleasing or could have been designed differently are not relevant considerations in determining copyrightability. *Id.,* at 3.

Ms. Giroux-Rollow then distinguished the instant work from the subject of the court's analysis in *Mazer v. Stein,* 347 U.S. 201 (1945). She pointed out that in *Mazer*, the copyrighted statuette of a Balinese dancer did not lose its copyrightability because of its intended use as part of a useful article. However, the bracelet portion of the Work which is used as a wristband was not a copyrighted work of art prior to being incorporated into the useful article. Additionally, Ms. Giroux-Rollow noted that the Office would not knowingly register a claim in a work such as the one cited in *Severin Montres Ltd. v. Yidah Watch Co.*, 997 F. Supp. 1262 (C.D. Ca. 1997). *Letter from Giroux-Rollow of 10/24/07,* at 3.[1] In summarizing the Office's refusal, Ms. Giroux-Rollow cited the House Report on the current copyright law, H.R. Rep. No. 94-1476, at 55 (1976), stating Congress' intent with regard to the need for separable authorship to stand on its own. *Letter from Giroux-Rollow to Rose of 10/24/07,* at 4. Finally, Ms. Giroux-Rollow reiterated the previous finding that the relief on the back of the watch casing is eligible for

[1] The Office notes that the registration of the watch in issue in *Severin Montres* was cancelled by the Copyright Office after a finding that the separately identifiable matter was not copyrightable.

copyright registration. She stated the options for pursuing registration by a new application or through amending the current application. *Id.,* at 5.

C. Second request for reconsideration

In a letter dated January 23, 2008, you requested that the Office reconsider for a second time its refusal to register the Work. You acknowledged that the work is a useful article. However, you argued that aspects of the Work are both physically and conceptually separable from the functions of indicating time and holding the timepiece on the wrist of the user. These aspects, you asserted, are works of authorship deserving of copyright protection. Having accepted the Office's separability test expressed in Esquire, as the appropriate inquiry, you maintained that under *Esquire* and the precedent established in *Mazer* the Work contains separable authorship. *Letter from Rose to Office of 01/23/08*, at 1-2.

Under your argument, not only is the relief on the back of the watch eligible for copyright registration, so, too, is the so-called bracelet portion of the Work (*i.e.*, the wristband). You asserted that the wristband, considered without the relief or the watch case, is physically and conceptually separable from the functional timepiece. You argued that the wristband is jewelry that serves an expressive non-utilitarian purpose and pointed toward examples of watches and bracelets that have been registered by the Office. You alleged that the Office had agreed that the wristband is a separable work that can be a registered, copyrighted work independent of its use with a useful article. You then added the alternative analysis that, similar to the statuette in *Mazer v. Stein*, the wristband connected to the relief is an independent element from the utilitarian aspects of the timepiece. *Letter from Rose to Office of 01/23/08,* at 2-4.

Citing *Mazer v. Stein*, you went on to argue that the intended use of the wristband with a useful article, a watch, cannot bar registration for the wristband. You pointed toward a partial quote from the Office's response to your first request for reconsideration as support for the position that the wristband is an independent element from the useful article. You cited another partial quote from the same letter in an attempt to assert that the Office erroneously concluded that an applicant must first obtain registration for a work before incorporating the same work into a useful article. *Letter from Rose to Office of 01/23/08,* at 4.

Having made your argument that the wristband is physically and conceptually separable, you went on to assert that "the Time Tank bracelet" (the wristband) is a sculptural work of art that merits copyright protection. You then argued that the wristband is original, citing *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991). You maintained that it was not copied from any other design and was independently created by the author. You further asserted that the wristband is of a caliber of jewelry that is displayed in fine jewelry stores and that its aesthetic design incorporates graphical and sculptural features that people view as art.

You argued that the links and connective hardware are highly distinctive and that features such as "'O' loop side profile" and the "tank tread like manner" of linkage express aesthetics of toughness, strength and power, which is "consistent with the Oakley image." You went on to note the appearance of several additional "O" loop images which can be perceived in the design as being evocative of the Oakley logo. Finally, you noted that you are not seeking a copyright

registration on the idea, method, system, device or concept of a bracelet but rather for the allegedly original expression embodied in the Work. *Letter from Rose to Office of 01/23/08,* at 5.

III. DECISION

After reviewing the application and deposit submitted for registration as well as the arguments you have presented, the Copyright Office Review Board affirms the Examining Division's refusal to register the wristwatch entitled "Time Tank".

The Board agrees that the relief design on the back of the watch casing can be viewed as conceptually separable. If the relief design on the back of the watch casing is original and independently created by the author and has never been published or registered, the work is eligible for registration as 2-d artwork. However, that is not the nature of the copyright claim set forth in the application.

The Board also agrees with your acknowledgment that the timepiece portion of the Work is a useful article. However, the Board does not agree that the wristband, or bracelet, portion of the work is conceptually and physically separable from the timepiece. Rather, the wristband serves the utilitarian function of securing the watch to the user's wrist, and therefore is also not considered separable under the statutory definition.

A. Analysis of Time Tank

1. Useful articles and separability

You correctly quote *Mazer* for the position that there is "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." 347 U.S. at 218. However, an article must still be independently eligible for copyright protection. Such protection is not available to useful articles.

Copyright does not extend to a useful article, which is defined as "article 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 (emphasis added). 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.,* at § 101. The design of a 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 aesthetic (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. (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. *Compendium II,* § 505.04. 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*, § 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.

We point out, however, that 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. Further, features which serve a function or usefulness within the article in question are, of course, not considered separable under the statutory definition.

The following two cases confirm the Office's understanding of, and position on, the congressionally-mandated prohibition of protecting any functional or utilitarian features of, as well as the overall shapes and configurations connected with, useful articles. *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), held that copyright

protection is not available for the "overall shape or configuration of a utilitarian article, no matter how aesthetically pleasing that shape may be." 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 and Telegraph Corp.*, 696 F.2d 918, 924 (11th Cir. 1983), the court held that a wire-spoked wheel cover, although aesthetically designed, was not entitled to copyright protection because it was a useful article used to protect lugnuts, brakes, wheels, and axles from damage and corrosion.

After examining the subject watch and its component parts in light of the above-described legal framework, the Board has determined that the Work, as submitted, is an intrinsically useful article.

As the wristwatch at issue is used by being affixed to the user's wrist and telling time, it "ha[s] an intrinsic utilitarian function that is not merely to portray the appearance of an article or to convey information," and is therefore a useful article according to 17 U.S.C. § 101. We stress the phrase "'an' intrinsic function." Even if a watch also has a decorative function, its intrinsic function is still enough to make it a useful article. *See also Severin Montres, Ltd. v. Yidah Watch Co.*, 997 F. Supp. 1262, 1265 (C.D. Cal. 1997) ("Plaintiffs concede, as they must, that a watch is a useful article with an intrinsic utilitarian function. Therefore, to be the proper subject matter of a copyright, the design of the watch must be separable from the utilitarian aspects of the watch.")

Even if the Copyright Office considers the watch as a piece of jewelry, the test the Office would apply as to whether there is sufficient separable authorship in the wristwatch to sustain copyrightability would not change. No matter the label assigned to the wristwatch, it has undeniable intrinsic utilitarian functions – affixing to the user's wrist in order to hold there the portion of the Work which tells time – functions which gives rise to the statutory need to separate aspects of function from aspects of decorativeness.

In your requests for reconsideration, you appear to be suggesting that classifying this work as a bracelet would grant the Work more generous scrutiny in determining whether it qualifies for copyright protection even if it is also utilitarian. *Letter from Rose to Office of 05/23/07*, at 3 -4. This argument is invalid. Pieces of jewelry that happen to be useful are judged by the same standard as other articles that are useful. *Cf., Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985) (holding that argument that mannequin forms designed for displaying clothing are actually sculpture and therefore did not need to undergo any separability test was without merit). You also cite a number of watches and bracelets that have been issued copyright registration, claiming that these registrations compel a registration for the subject Work. *Letter from Rose to Office of 05/23/07*, at 3 - 4. However, the Office does not compare works under consideration with works that have already been registered or refused for registration. Furthermore, all of the works you cite appear to have been issued registration based on a determination of the presence of sufficient separable authorship; physically or conceptually separable authorship remains the required factor.

Under the above-stated *Compendium II* test, the wristband is not conceptually separable as it contributes to its utilitarian function of affixing the watch to the user's wrist; removal of that feature

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[2] Although *Esquire* was decided under the 1909 version of the Copyright Act, its reasoning is still 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 803. Since pre-1976 case law in part formed the basis for the 1976 Act, the reasoning of these earlier cases remains relevant to cases arising under the later Act.

would destroy the watch's ability to perform this function. Although not shown in any of your requests for reconsideration, the wristband may, indeed, be physically separated from the remainder of the wristwatch by ordinary means. However, even if physically separable by ordinary means, the remaining objects would consist of a band which feasibly could sit on the arm and a watch face; in other words, the *wristwatch as an entirety* would be destroyed by the physical removal of the band and/or the physical removal of the time face. You have stated that "bracelet connected to the relief, like the statuette in the Mazer lamp is a completely independent element from the utilitarian aspects of indicating time." *Letter from Rose to Office of 01/23/08*, at 4. The wristband serves to keep the timepiece on the wrist of the wearer, preventing the timepiece from being misplaced or lost or inadvertently put in an inconvenient place away from the wearer; thus, the wristband is not a "completely independent element" from the utilitarian aspects of keeping time. The wristband becomes the means by which a person keeps the timepiece close to him–indeed, on his person–carrying the time with him, no matter where he goes or when.[3]

The band serves the function, or usefulness, within the wristwatch as a whole of holding the timepiece on the user's wrist; the wristband falls within the statutory definition of a useful article itself. This remains true whether the wristband is considered as connected or disconnected to the watchface or the relief casing. Similarly the features you have identified on the wristband (the tank tread-like links, the "O" shaped appearance on the side profile of the link hinges and on the clasp) also provide function or usefulness in themselves, *i.e.*, they offer flexibility and closing to fit the wristwatch on the wearer's wrist and they are the very parts of the wristband that allow it to be worn. The fact that these constitutive elements may have been designed differently does not alter their functional nature. In the words of *Compendium II*, § 505.03: "the mere fact that certain features are nonfunctional or could have been designed differently is irrelevant" under the statute. *See Letter from Giroux-Rollow to Rose of 10/24/07*, at 2. If the links of this wristwatch were designed as thin, dainty, or wisp-like links, they would still be considered functional elements of a part of a useful article.

2. Alternative separability tests

Having analyzed the Work "Time Tank" under the provisions of *Compendium II's* test for separability and having found that the wristband is not a separable feature, we now turn to the alternative separability test under which you previously argued the Work would be registrable because separability would be apparent. In your first request for reconsideration you cited to Professor Denicola's test as adopted by the *Brandir* court. *Brandir International, Inc. v. Cascade Pacific Lumber Co.,* 834 F.2d 1142 (2d Cir. 1987). 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

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[3] We also take the opportunity here to comment on *Mazer v. Stein*, 347 U.S. 201 (1954), which you have cited in both requests for reconsideration [*Letters from Rose to Office of 05/23/07 and 01/23/08*]. You have stated that the bracelet, or wristband, feature of "Time Tank" is physically and conceptualy separable from the rest of the article "Time Tank," or, in your words, "from the watch itself." *Letter from Rose to office of 01/23/08*, at 4. The Board does not find this to be the case. We point out, first, that the wristband or bracelet portion of "Time Tank" cannot be either physically or conceptually separated from the timepiece portion without destroying the article. The timepiece without its corresponding wristband is just that– a small, isolated clock; thus, the useful article is both physically and conceptually destroyed because the overall shape and configuration of "Time Track" is destroyed. *See Compendium II* reference, above at 7. We also point out that, 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), *Mazer* did not explicitly address the separability issue and, thus, provides no detailed analysis or framework that can be used in support of your position concerning the separability of any feature within "Time Tank."

independently of functional influences," *Brandir*, 834 F.2d at 1145, 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. *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, above at 7*, 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 to provide additional analysis of the work "Time Tank" under the alternative test you raise in order to determine as objectively as possible whether the Work does, indeed, possess any separable features which might be subject to copyright registration.

You have argued that the wristwatch's design elements can be identified as reflecting the designer's aesthetic judgement exercised independently of functional considerations. We recognize that the wristwatch contains features that are arranged so that the watch may not only be useful but also be attractive to those who may wish to purchase it. However, in order to be a wristwatch, it must function as one and the creator has achieved this goal. It is immaterial that the configuration of the watch or the wristband could have been aligned or set differently or that the configuration or makeup could have reflected a different style or approach. See our comment on differing styles, above at 9.

Although your client has created a wristwatch with a stylized band, the band's features are nevertheless aspects of something that has utilitarian purpose. Under the Denicola test, "copyrightability ultimately should depend on the extent to which the work reflects artistic expression *uninhibited* by functional considerations." Robert C. Denicola, "Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles," 67 *Minn. L. Rev.* 707, 741 (1983) (emphasis added). Under this guideline, the Work is, in its entirety, a timepiece to be affixed to the user's wrist. Thus, the Work fails the Denicola test: in *Brandir's* words, "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." 834 F.2d at 1145. Such is the case with the Work "Time Tank" which is sought by users because it is responsive to their utilitarian demands. While it may be novel and aesthetically pleasing, it is nevertheless created in a way that allows the device to work as a wristwatch; "Time Tank" meets the utilitarian and functional demands of a wristwatch. "Time Tank" fails the Denicola test because its form does not, in Professor Denicola's words, "reflect purely aesthetic visions." Denicola, *id*., at 743.

3. The Originality Threshold

As previously stated, the Office has concluded that the relief design on the back of the watch casing is conceptually separable from the work's useful features and possesses at least a minimal degree of creativity required under the *Feist* standard. Therefore, it is eligible for copyright registration provided it is independently created by the author and appears as published for the first time in the March 26, 2006 publication in Switzerland of "Time Tank."

In order to secure registration if the relief design meets these requirements, you should submit a revised application Form VA, limiting the claim to "2-d artwork" at space 2 and describe the nature of the work at space 1 as "artwork on the back of watch casing."

IV. CONCLUSION

For the reasons stated above, the Copyright Office Review Board concludes that, as submitted, "TIME TANK" cannot be registered for copyright. 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