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January 24, 2008

Michael M. Ballard, Esq.
Workman Nydegger
1000 Eagle Gate Tower
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Re: Avila 7 Bit
Copyright Office Control Number: 61-316-1935(W)
Your Reference Number: 15920.2

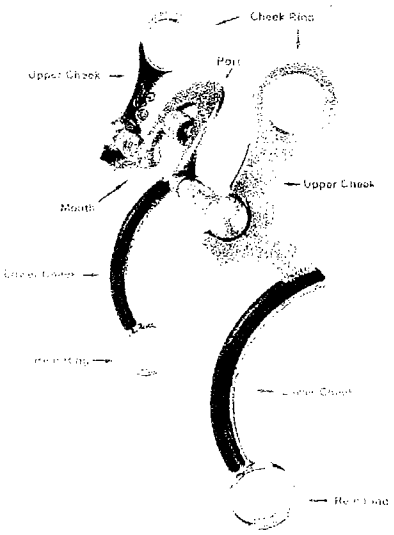
Dear Mr. Ballard:

I write on behalf of the Copyright Office Review Board [hereinafter Board] in response to your letter dated November 17, 2005, in which you requested the Copyright Office to reconsider for a second time its refusal to register the work entitled *Avila 7 Bit*. We apologize for the delay in getting this decision to you.

The Board has carefully examined the application, the deposit and all correspondence concerning this application, and must affirm denial of registration because of the bit's lack of sufficiently creative and separable authorship.

I. DESCRIPTION OF WORK

The subject work is a curb bit for a horse. As is typical for a curb bit, it is comprised of two identical sides featuring cheek rings and rein rings with vertical components in between and a horizontal portion that connects the two sides and fits into a horse's mouth. This particular bit uses stainless steel, deep brown and copper coloring to accent certain portions of the bit. The exact shape of each portion of the bit is best communicated by the visual representation set forth in this paragraph.



II. ADMINISTRATIVE RECORD

A. Initial application and Office's refusal to register

On October 6, 2004, the Office received a Form VA application from John C. Stringham of your firm on behalf of your client, Tom Lee Balding, to register a "bit for horses." In a letter dated December 3, 2004, Visual Arts Section Examiner Sandra D. Ware refused registration of this work because she determined that it is a useful article that does not contain any separable authorship as needed to sustain a claim to copyright. Letter from Ware to Stringham of 12/03/04, at 1.

B. First request for reconsideration

In a letter dated April 1, 2005, you and John Stringham of your law firm requested reconsideration of the Office's refusal to register the *Avila 7 Bit*. Letter from Stringham and Ballard to Chief, Receiving and Processing Division of 04/01/05, at 1. You argued that the *Avila 7 Bit* has "features of sculptural authorship that are **at least conceptually separable** from the utilitarian aspect of the article." *Id.* You cited the following elements as being conceptually separable: the arches of the various components; the contrasting coloration of the metal pieces on the Lower Cheek portion of the bit and the copper coloring on the mouthpiece; the stacked fashion of the cylindrical metal pieces on the Lower Cheek portion; the contrast of flat pieces of metal having sharp, bold corners and varying widths along a jagged edge with pieces of smooth cylindrical metal; the blended transition from the Upper Cheek portion of the bit to the Lower Cheek portion; the spherical shaped pieces at either end of the mouth piece; the shape of the lateral pieces of the mouthpiece signifying courage and strength; and the uniform rib design on the cylindrical part of the mouthpiece near the Port. *Id.* at 2. You also argued that the spherical shapes at each end of the mouthpiece "are conceptually, and arguably physically separable" because they "do not serve a functional purpose." *Id.*

C. Examining Division's response

In response to your request and in light of the points raised in your letter of April 1, 2005, Attorney Advisor Virginia Giroux of the Examining Division reexamined the application, and she, too, determined that the *Avila 7 Bit* is a useful article that does not contain any authorship that is both separable and copyrightable. Letter from Giroux to Ballard of 08/25/05, at 1. She noted that you did not dispute the fact that this horse bit is a useful article, but rejected your argument that it contains physically and conceptually separable design elements, mainly because the elements are part of the overall shape and contour of a useful article and are thus not copyrightable. *Id.* at 2. Finally, she noted that neither the material of which a work is made, nor its aesthetics, uniqueness, or visual effect, determine the copyrightability of a work. *Id.* at 1, 3.

D. Second request for reconsideration

In a letter dated November 17, 2005, you requested that the Office reconsider for a second time its refusal to register the copyright claim in the *Avila 7 Bit*. Letter from Ballard to Board of 11/17/05, at 1. You argue, and submit a supporting declaration by the author, that numerous elements of the bit are not required for its functionality, that they reflect the author's artistic judgment, and that the author's primary consideration in creating and designing bits is the aesthetic, or decorative, appearance rather than functional considerations. *Id.* at 1-2. Specifically, you cite the same elements that you cited in your first request for reconsideration as being conceptually separable and thus copyrightable. *Id.* at 3. You argue that the design elements present in the *Avila 7 Bit* warrant copyright protection as much as the ornamentation on picture frames in *Stanislawski v. Jordan*, 337 F.Supp.2d 1103 (E.D. Wis. 2003) and belt buckles in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980). *Id.* at 4-5.

III. DECISION

A. Legal framework

1. Useful articles and separability

As a general proposition, copyright protection does not extend to a useful article, defined as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. However, works of artistic craftsmanship, which may be useful articles themselves or incorporated into a useful article, can receive protection as pictorial, graphic or sculptural works pursuant to 17 U.S.C. § 102(a)(5). This protection is limited, though, in that it extends only "insofar as their form but not their mechanical or utilitarian aspects are concerned." *Id.* § 101. As you correctly note in your second request for reconsideration, the design of the useful article will be protected "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id*; Letter from Ballard of 11/17/05, at 2. This separability can be physical or conceptual. Congress has explained that:

> [A]lthough the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an . . . industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from "the utilitarian aspects of the article" does not depend upon the nature of the design – that is, even if the appearance of an article is

> determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element and would not cover the over-all configuration of the utilitarian article as such.

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

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 of Copyright Office Practices II,* § 505.03 - 505.04 (1984) [hereinafter *Compendium II*].

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.

As explained in *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979), 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.*[1] 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

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[1] 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.

corrosion, and it did not contain any sculptural design features that could be identified apart from the wheel cover itself. You argue, however, that conceptual separability exists whenever a useful article evidences the author's artistic judgment and you cite *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) in support. Letter from Ballard of 11/17/2005, at 2-3. Although the Board disagrees with your separability analysis, we will, nevertheless, analyze the work at issue here under both *Esquire* and *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 *Avila 7 Bit* does not exhibit separable features.

As we have just stated, the Copyright Office follows the articulation of conceptual separability set forth in *Esquire* and as it is explained in *Compendium II*, § 505.03. The Office's test was again 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 available from legal scholars and from case law is the correct one, including whether the "duality" test proffered by Professor Shira Perlmutter should be accepted as the correct test as put forward by Custom Chrome.[2] 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," 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. While an author's artistic judgment may, indeed, influence design elements, those elements must themselves also meet the requirements of separability and originality.

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[2] Professor Perlmutter's test focuses on the ordinary observer's capacity to see the object in question as a work of art but does not require that the ordinary observer's seeing of the object, *i.e.*, his perception of it, completely displace the observer's seeing the object as useful. *Custom Chrome*, at *14, 15, citing Professor Perlmutter's article *Conceptual Separability and Copyright Design of Useful Articles*, 37 J. Copr. Soc'y 399, 377-379 (1990).

B. Separable features are not present under any of the separability tests

1. *Compendium II*

As your client's application for copyright registration states at the "Nature of this Work" line on the registration application, the *Avila 7 Bit* is a "bit for horses" and, as such, qualifies as a useful article. While the Office recognizes that a useful article may also incorporate artistic features, the intrinsic purpose of a horse bit is to permit the rider to control and guide the horse by the use of reins. An industrial product qualifies as a "useful article" as long as it has "an intrinsic utilitarian function." 17 U.S.C. § 101 (definitions). In both your first and second requests for reconsideration, you acknowledge that the *Avila 7 Bit* has "utilitarian aspects." Letter from Ballard to Chief, Receiving and Processing Division of 04/01/05, at 1; Letter from Ballard to Board of 11/17/05, at 1. You specifically describe this work as a highly stylized curb bit, "a device mounted on a horse's head that is used for controlling the horse's movement." Letter from Ballard of 04/01/05, at 1; Letter from Ballard of 11/17/05, at 3. By the Board's assessment and your own acknowledgment, the *Avila 7 Bit* fits easily within the definition of a useful article.

Separable elements incorporated into a useful article can warrant copyright protection in and of themselves provided they embody a sufficient amount of creativity. Physical separability is a moot point in this instance because the solid metal bit has no design elements that could be actually separated by ordinary means. You argue that the spherical shapes at each end of the mouthpiece are physically separable because they "do not serve a functional purpose." Letter from Ballard of 04/01/05, at 2. An element's lack of functionality, though, is not sufficient in itself to qualify it as physically separable. The hallmark of a physically separable element is its ability to be separated from the utilitarian components *by ordinary means. Compendium II,* § *505*.04. Having to divide an otherwise *solid* metal medium with a specialized device such as a metal cutting 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 for which copyright registration is being sought.

Nor does the *Avila 7 Bit* contain any design elements which are conceptually separable from the utilitarian aspects of the bit itself. You explain that a curb bit "comprises two substantially similar side portions, wherein each side portion includes an upper cheek portion having a cheek ring and a lower cheek portion having a rein ring" and also has "a mouth portion connecting the two side portions together." Letter from Ballard of 04/01/05, at 2; Letter from Ballard of 11/17/05, at 3. You also describe the functionality of these particular parts, which, in itself, negates their copyrightability. Therefore, the only elements that could possibly be eligible for copyright registration would be those that adorn or embellish these functional components. Of these, we can identify only two minimal elements and we address their copyrightability in detail *below, at 12-13.*

Again, separable elements incorporated into a useful article can warrant copyright protection in and of themselves provided they embody a sufficient amount of creativity. The lateral pieces of the bit, however, are clearly functional parts of the bit which by definition cannot be separable, and any *symbolism* they might possess would not bear upon their copyrightability. *Compendium II, § 503.02(a)* ("Copyrightability depends upon the presence of creative expression in a work, and not upon . . . symbolic value."). The Office can consider only those sculptural elements actually expressed in the three-dimensional design, not the symbolic value they may have to certain viewers. Any separability analysis of the work in question here as that analysis is made under *Compendium II* necessarily arrives at the point where registration must be refused. Under the conceptual separability test, there are no portions of the object in question, the horse bit, which can be visualized separately from the overall shape of the object and simultaneously stand beside the useful article as independent works of art without conceptually destroying the basic shape of the useful article.

2. a. Denicola test as it was applied in *Brandir;*
b. Principle of *Mazer*

Having analyzed the *Avila 7 Bit* under the provisions of *Compendium II's* test for separability and found the work wanting in separable features, we now turn to the alternative separability tests under which you have argued the *Avila 7 Bit* would be registrable because separability would be apparent. One such test is 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 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 4-5*, 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 those alternative tests you have raised in order to determine as objectively as possible whether the *Avila 7 Bit* does, indeed, lack any separable features which might be subject to copyright registration.

You have argued that portions of the lower cheek of the bit, the stacked, flush, curved portions of the lower cheek, the "untraditional" manner in which the upper cheek flows into the lower cheek [making it difficult to determine the beginning and ending of the two distinct parts of the bit], the stylized shapes of both cheeks which are designed to blend together, the distinguishing of the upper cheek jagged edges from the lower cheek rounded edges, as well as

the contrasting colors within the bit [the different coloration on different parts of the *Avila 7 Bit*] all constitute conceptually separable elements or features of the bit. Letter from Ballard of 11/17/05, at 3.

You have also cited the seminal case *Mazer v. Stein,* 347 U.S. 201 (1945) for the proposition that a work of art may be intended to be made part of a useful article and still retain its copyright protection. Although 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), we nevertheless do not consider *Mazer* to be support for your separability arguments for the *Avila 7 Bit.* 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; but we point out that *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 that the features of the horse bit which you have enumerated are separable.

We comment on your reference to the Denicola separability test which was favorably discussed in *Brandir.*[3] You have asserted that the *Avila 7 Bit* exhibits "numerous design elements... [that] reflect the artistic judgment of the designer, independent of functional features, and thus are subject to copyright protection." Letter from Ballard of 11/17/05, at 2-3. As we have discussed above, our analysis of the *Avila 7 Bit* arrives at the recognition of a useful article, the Bit, with features or aspects of the bit which are conjoined and arranged so that the bit is useful as it may also be, we concede, attractive to those who may wish to purchase it. In order to be a horse bit, however, the object in question must function *as a bit* and the creator has achieved this goal– *Avila 7* functions as a "bit for horses," the description given on the application for registration of the work. It is immaterial that the configuration of *Avila 7* could have been aligned or set differently or that the configuration or makeup could have reflected a different style or approach to devices for controlling horses: *Avila 7* is, under any analysis, a useful article. Its features– "portions of the lower cheek of the bit, the stacked, flush, curved portions of the lower cheek, the "untraditional" manner in which the upper cheek flows into the lower cheek– making it difficult to determine the beginning and ending of the two distinct parts of the bit, the stylized fashion of both cheeks which are designed to blend together, the distinguishing of the upper cheek jagged edges from the lower cheek rounded edges," Letter from Ballard of 11/17/05, at 3, are all parts of a horse bit which overall, and in their individual and combined essence, serve a purpose.

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[3] We note that the bicycle rack that was the work in question in *Brandir* ultimately failed the Denicola test: "....while 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.

Although your client has created a bit which looks different and whose parts are designed differently, the parts are nevertheless aspects of something that has utilitarian purpose: the upper cheek and the lower cheek may take on a contrasting look but they have a use within the overall bit; the transition of the upper cheek to the lower cheek may be untraditional in its look, but it is nevertheless a design of part of a device that essentially serves a 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.* 741 (1983). Under this guideline, the *Avila 7 Bit* is, in its entirety, a device for controlling the movement of a horse and the aesthetic characteristics of the device do not negate its usefulness and facility to control a horse. Thus, *Avila 7* fails the Denicola test because, in Professor Denicola's words, the horse bit is not comparable to the statuettes used in the lamps in Mazer: ".... the Mazer statuettes remain copyrightable despite their use as lamp bases, because their form is not responsive to utilitarian demands." *Id.* at 742-743. *Avila 7* is a device sought by horse owners because it is, indeed, responsive to the utilitarian demands of controlling the horse; its configuration and aspects, although they may be novel and aesthetically pleasing, are nevertheless created in a way that allows the device to work– *Avila 7* apparently meets the utilitarian and functional demand of controlling the animal. Its form does not "reflect purely aesthetic visions" [*id.* at 743] because *Avila 7* possesses in its lines and structure the necessary elements to constitute a working, useful horse bit. 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 *Avila 7 Bit.*

3. Denicola and *Brandir* as analyzed in *Pivot Point*

You have raised the Seventh Circuit's decision in the long-running *Pivot Point* case which you have also cited as support for the separability of the enumerated features of the *Avila 7 Bit*. *Pivot Point International, Inc. v. Charlene Products, Inc.*, 372 F.3d 913 (7th Cir. 2004). 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.[4] The *Pivot Point* litigation, however, focused on the usefulness of the

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[4] 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

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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 / aspects 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.

Under an analysis following the reasoning of *Pivot Point* [which, in turn, takes its lead from *Brandir*], the *Avila 7 Bit*, however, 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 horse bit; the features you have enumerated [with two exceptions– we speak to those, *below*] cannot be regarded as purely aesthetic: the features are present within the horse bit because they are needed to make the bit operative and functional. 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 the useful device of the horse bit. As such, they fail to meet the Denicola test as it has been set out in both *Brandir* and *Pivot Point*. *Avila 7 Bit* is a device, a horse bit, which may be aesthetically pleasing but it is, from any perspective, a horse bit: 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;" the "artistic aspects of the object [in this case, the lines, curves, proportions, and configuration of the horse bit] cannot be separated from its utilitarian aspects [in this case, the lines, curves, proportions, and configuration that make the horse bit useful and functional] for purposes of copyright protection." *Brandir*, 834 F.2d at 1147.

You have also cited *Stanislawski v. Jordan*, 337 F. Supp. 2d 1103 (E.D. Wis. 2003) for the proposition that color is a "clear component of protectable work." Letter from Ballard of 11/17/05, at 3. We now proceed with the following comment on the *Stanislawski* case and the two features of the *Avila 7 Bit* which we consider conceptually separable but not copyrightable.

C. Requirements for originality

1. *Feist*

An artistic feature which may be separable from a utilitarian object does not necessarily mean that it will merit copyright protection. All copyrightable works, be they sculptures, engravings or otherwise, must also qualify as "original works of authorship." 17 U.S.C.

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[4](...continued)
analyzed within the body of registration practices and reasonable on their face, no further examiner inquiry is undertaken.

§ 102(a).

In the copyright realm, the term "original" consists of two components: independent creation and sufficient creativity. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 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 impliedly accepts that your client, Tom Lee Balding, independently created the *Avila 7 Bit*. Therefore, the first required component of the term "original" is not at issue here. The second required component for a work of authorship to be original and therefore protected by copyright is that the work must possess sufficient creativity. In determining whether a work embodies a sufficient amount of creativity to sustain a copyright claim, the Board adheres to the standard set forth in *Feist*, where the Supreme Court held that only a modicum of creativity is necessary. The Court stated that the requisite level of creativity is "extremely low"; "even a slight amount will suffice." *Feist*, 499 U.S. at 345.

However, the Court also ruled that some works (such as the white-pages telephone book 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 a work in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359; *see also* 37 CFR § 202.10(a) ("In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form."); 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.01(B) (2002) ("[T]here remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support a copyright.")

Even prior to *Feist*, Copyright Office practices 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* states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Id.* § 503.02(a). In implementing this threshold, the Office, as well as courts, have consistently found that standard designs and geometric shapes are not sufficiently creative in themselves to support a copyright claim. *Id.* § 503.02(a)("[R]egistration cannot be based upon the simplicity of standard ornamentation....").[5]

Of course, some combinations of common or standard design elements contain sufficient creativity with respect to how they are combined or arranged to support a copyright. *See Feist*,

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[5] *See also, id.* § 202.02(j) ("Familiar symbols or designs . . . or coloring, are not copyrightable."); *id.* § 503.03(b) ("No registration is possible where the work consists solely of elements which are incapable of supporting a copyright claim."); 37 CFR § 202.1(a) ("[F]amiliar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained.").

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

2. a. Any conceptually separable elements in the *Avila 7 Bit* do not embody sufficient creativity
b. Neither *Stanislawski* nor *Kieselstein* advances the copyrightability [or the separability] argument for the *Avila 7 Bit*

Having just analyzed the *Avila 7 Bit* for separability, *above, at 6-10*, we conclude that the only design elements of the Bit that are conceptually separable are the uniform rib design on the mouthpiece and the coloring– two different colors on two separate portions of the Bit. However, separability alone is not sufficient to garner copyright protection. Ultimately, any separable design elements under *consideration* must embody a sufficient amount of creativity, and these two features do not.

The rib design consists simply of several parallel lines which indent the cylindrical portion of the mouthpiece. Parallel lines possess only *de minimis* creativity and are not copyrightable in themselves. The Board does agree with your assertion that color can be a component of a protectible work. Letter from Ballard of 11/17/05, at 3. In this particular instance, however, where the bit contains no other separable design elements which could possibly be considered for copyright protection, the coloration alone– two areas of color without variation or shading within the areas– is an insufficient basis for copyright protection. *Compendium II,* § 503.02(a) ("[M]ere coloration cannot support a copyright even though it may enhance the aesthetic appeal or commercial value of a work."). And, although the Board disagrees with your assertion that the spheres at each end of the mouthpiece are conceptually separable, assuming for the sake of argument that they were, they would still not be entitled to copyright protection because spheres are simply common geometric shapes.

You cite *Stanislawski*, in which the court found, in part, that particular picture frames featuring certain simple engravings of images and words were copyrightable [337 F. Supp. 2d at

1116-1117], as support that the *Avila 7 Bit* is copyrightable. Letter from Ballard of 11/17/05, at 4. The *Stanislawski* court, though, did not hold that any design incorporated into a useful article warrants copyright protection. In fact, it noted that the Copyright Office had registered the copyrights in three of the groups of frames that featured engraved or laser cut ornamentation, but refused registration for a fourth group of frames which simply featured engravings of people's names, presumably of the person identified in the picture to be inserted into the frame. 337 F. Supp. 2d at 1107. This case does not advance your argument, but does buttress the Office's position; the Office will register a design incorporated into a useful article when the design itself embodies sufficient creativity, but not all ornamentation of a useful article is sufficiently creative to warrant copyright protection. The *Stanislawski* court commented: "Certain original and individual elements of the frames are protectable as are the original arrangements of common elements within them." *Id.* at 1117. The elements of two colors plus the parallel lines of the rib elements of the mouthpiece plus the cyclindrical ends of the mouthpiece– which we do not consider separable under any test but which we will include for the sake of argument– do not in themselves or taken together in ensemble represent a sufficient quantum of authorship necessary to sustain a claim in sculptural or two-dimensional authorship in the device at issue before the Board. The *Avila 7 Bit,* with the great portion of the device not evidencing separable features and with only a very few features classified as separable, does not fit into the category of works described in *Stanislawski*: "where a work is comprised of several, individually common elements, the arrangement of those elements may itself be an element of the work warranting protection." 337 F. Supp. 2d at 1113.

We also comment on the case of *Kieselstein-Cord. Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980). The belt buckles at issue there do not provide your client a foundation for registration as you have argued. Letter from Ballard of 11/17/05, at 5. *Kieselstein* involved two sculptured belt buckles which the court described as being "on a razor's edge of copyright law." *Id.* at 990. The Copyright Office had registered the two belt buckles on the basis that their sculptural features constituted separable artistic authorship. While the court did analogize the belt buckles to jewelry, as you have cited [Letter from Ballard of 11/17/05, at 5], the court also 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.[6] While the *Avila 7 Bit* may be an aesthetically pleasing horse bit, it is still a functional bit, and all of the purported design elements to which you cite are inextricable parts of the overall shape and contour of the functional bit itself. We do not, moreover, consider *Kieselstein* precedent for the Board's categorizing the *Avila 7 Bit* as jewelry for horses or as decorative art suitable for use in house and "other locations." Letter from Ballard of 11/17/05, at

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[6] 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.

other form of intellectual property protection has no bearing on the determination of a work's copyrightability. The copyright law and complementary case law are the determiners of a work's copyright status. The Office's reference in previous correspondence to you about the possibility of protection under patent law was simply meant to provide you with an additional avenue to consider, not to imply that copyright and patent protection were mutually exclusive.

For the reasons stated above, the Copyright Office Review Board affirms the refusal to register the *Avila 7 Bit*. This decision constitutes final agency action in this matter.

Sincerely,

/S/

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