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

August 3, 2009

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RE: PIEZOELECTRIC LIGHTER
Correspondence ID: 1-2RAJDF

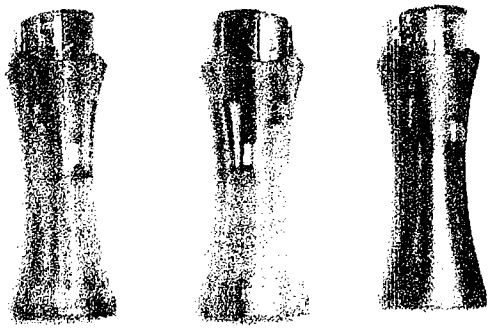
Dear Mr. Mariam:

I am writing on behalf of the Copyright Office Review Board ("Board") in response to your letter dated March 20, 2009, in which you requested the Copyright Office (the "Office") to reconsider its refusal to register the work entitled "Piezoelectric Lighter" (the "Work").

After reviewing the application from your client, Big J & J Int'l Corp., and the arguments you have presented on the Applicant's behalf, the Board affirms 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, the "Piezoelectric Lighter" is a lighter. As is typical for a lighter, it is comprised of a flame-emitting aperture, vent holes, and a flame-activating push-button, all of which are located at the lighter's head. The lighter also features such internal structures and mechanisms that release fuel from a fuel storage vessel. For this particular lighter, the typical functional features mentioned above are contained within and/or attached to an hourglass-shaped structure forming the base portion of the lighter. The exact shape of each portion of the lighter is best communicated by the visual representation set forth below.



II. ADMINISTRATIVE RECORD

A. Initial Application and Office's Refusal to Register

On December 16, 2008, the Office received an online application from you to register "Piezoelectric Lighter." In a letter dated March 4, 2009, the Office refused registration of this work because it determined that it is a "useful article" that lacks sufficient physically or conceptually "separable" authorship required to support a copyright registration. Letter from Office to Mariam of 03/04/2009, at 1. The Office also stated that even if the Work contains features which *might* be considered separable from the utilitarian aspects, they would still not sustain a claim to copyright, as the features represent an insufficient amount of original authorship. *Id.* at 2.

B. Request for Reconsideration

In a letter dated March 20, 2009, you filed a request for reconsideration. Letter from Mariam of 03/20/2009, at 1. You argued that the "Piezoelectric Lighter" "incorporates 'sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.'" *Id.* You contended that the hourglass-shaped base portion of the lighter is "an original, creative and artistic sculpture" that is completely physically separable from the utilitarian features of the lighter. You asserted that these features are neither part of the base nor do they influence the hourglass shape of the base and that they do not form any portion of the sculptural shape. *Id.*, at 2. You also argued that the Work's hourglass-shaped base warrants copyright protection as much as the sculptural statuettes that served as lamp bases in *Mazer v. Stein*, 347 U.S. 201 (1954). *Id.*, at 3. You claimed that the base portion of the Work, like the lamp statuettes in *Mazer*, can be conceived as an artistic and aesthetic feature that has been added to, or superimposed upon, an otherwise utilitarian article. *Id.* You argued that since this choice to add or superimpose an hourglass-shaped base to the utilitarian portions of the lighter reflects artistic judgment exercised independently of functional influences, conceptual separability also exists. *Id.*, at 4. You further contended that the Work meets the minimum threshold of creativity required for copyrightability and dispute the Office's finding of an insufficient amount of original authorship by citing the following elements as contributing to the Work's creative features: the selection of the overall shape, the relative proportions of the waist of the base to its upper and lower ends, the horizontal cross-sectional shape of the base, and the relative proportions of its height, width and depth. *Id.*, at 4-5.

C. Direct Referral to Review Board in Light of Pending Litigation

In light of the fact that your request for reconsideration was made in the context of pending litigation, the Office proposed to refer your request for reconsideration, and any amendments to the request that you may wish to offer, directly to the Review Board per 37 C.F.R. 202.5. Letter from Ruwe to Mariam of 05/29/2009. In a letter dated June 3, 2009, you accepted this proposal and indicated that you did not have any further amendments to your request for reconsideration. Letter from Mariam to Ruwe of 06/03/2009.

III. DECISION

After reviewing the application and your arguments in favor of the Applicant's work, the Copyright Office Review Board affirms the Office's refusal to register the work entitled "Piezoelectric Lighter."

IV. ANALYSIS

In determining whether a work submitted for copyright registration is copyrightable, a threshold determination is made about whether a work is a useful article or not. If it is not a useful article, the analysis proceeds immediately to the question of whether the work is sufficiently original to be copyrightable. However, if it is a useful article, the next step is to determine whether it has any elements that are separable from its utilitarian function. Congress has decreed that there is no copyright protection for any element associated with the configuration of a useful article that is not a separable element. If there are no separable elements, that ends the analysis and the work is not copyrightable. If there are separable elements, however, the Office examines them to determine whether they have sufficient originality (which requires both independent creation and sufficient creativity) to be copyrightable. The separability analysis is independent of, and precedes, the creativity analysis.

A. Legal Standards for 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 request for reconsideration, the design of a useful article will be protected "if it incorporates 'sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.' " *Id.*, Letter from Mariam of 03/20/2009, at 1. 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 (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) ["*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 freestanding 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 nonfunctional, 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 corrosion, and it did not contain any sculptural design features that could be identified apart from the wheel cover itself.

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[1] 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.

In your request for reconsideration, you argued that conceptual separability exists whenever a useful article evidences the author's artistic judgment and you cited *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 Mariam of 03/20/2009, at 4. As indicated above, the Office applies the test of separability 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. Although the Board disagrees with your separability analysis, judicial acceptance of separability tests other than those found in *Compendium II* leads us to provide analysis of the work under the alternative test you raised in order to determine as objectively as possible whether the Work does, indeed, possess any separable features which might be subject to copyright registration. Under any of these tests, the Work does not exhibit separable features.

B. Separable Features are not Present under any of the Separability Tests

1. Physical separability

Your client's application for copyright registration describes the nature of the Work at the "Author Created" line as a "sculpture/3-D artwork." The Work possesses a stylized hourglass-shaped structure. However, as is clearly evident by the deposited image and the chosen title, "Piezoelectric Lighter," the Work is a lighter that has an inherently utilitarian purpose and thus qualifies as a useful article. While the Office recognizes that a useful article may also incorporate artistic features, the intrinsic purpose of a lighter is to serve as a portable mechanical device that produces a flame. An industrial product qualifies as a "useful article" as long as it has "an intrinsic utilitarian function." 17 U.S.C. § 101 (definitions). In your request for reconsideration, you acknowledge that the Work has "utilitarian features" and offer the following description: "Some of the utilitarian features are located above the base in the head portion of the lighter, and include the flame emitting aperture, the vent holes, and the push-button for activating the flame. Other utilitarian features...include the spring-loaded piezoelectric sparking mechanism, the valve for releasing fuel into the spark, the fuel itself, and mounting structures on the internal walls of the base..." Letter from Mariam of 03/20/2009, at 2. All of these collective features indicate the lighter's utilitarian purpose. By the Board's assessment and your own acknowledgement, the "Piezoelectric Lighter" 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. You offer an argument for physical separability which mixes the elements of physical and conceptual separability, arguing that the sculptural features are not mandated by any utilitarian features of the lighter. Regardless of your misconception of the elements of physical separability, you acknowledge that the lighter's "utilitarian features are inside of and/or attached to the hourglass-shaped base. *Id.* You further acknowledge that the lighter incorporates "mounting structures on the internal walls of the base which are not externally visible." *Id.* By your own description, the fuel vessel is mounted to the "sculptural base." However, you offer no explanation as to how the mounting of these two elements can be separated by *ordinary means*. Furthermore, the utilitarian components at the lighter's head appear to be firmly adhered to its base. By all appearances any division of the base from the head portion of the lighter, or disassembly of the mounting structures to separate the head and base

portions of the lighter, would not be within the scope of separation by ordinary means.

2. Compendium II test for conceptual separability

Your argument for conceptual separability fails to meet the test set forth for conceptual separability in *Compendium II*. Removal of the hourglass-shaped base would destroy the overall shape and configuration of the Work. Furthermore, the hourglass-shaped base is not conceptually separable as it contributes to the lighter's utilitarian function. The hourglass-shaped base contains the fuel that facilitates the lighter's flame output. It provides a protective exterior for the vessel storing fuel so that a user can safely operate the lighter. And, its contoured shape enables the user to easily hold and operate the lighter. Despite your assertion that "the hourglass shape of the base is 'not in any respect required by [its function],' the design of the lighter's base portion certainly accommodates the functional considerations mentioned above. The fact that the base may have been designed differently does not alter its 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.

3. Denicola test for conceptual separability

Having analyzed the Work under the provisions of *Compendium II's* test for separability and having found that the hourglass-shaped base portion 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 request for reconsideration, you cited to Professor Denicola's test as adopted by the *Brandir* and *Pivot Point* courts. *Brandir Int'l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987); *Pivot Point Int'l Inc. v. Charlene Products Inc.*, 372 F. 3d 913, 71 USPQ2d 1225 (7th Cir. 2004); Letter from Mariam of 03/20/2009, at 4. 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* 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 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 argue that the Work's design elements can be identified as reflecting the designer's aesthetic judgment exercised independently of functional considerations. Letter from Mariam of 03/20/2009, at 4. We recognize that the lighter contains features that are arranged so that it serves its functional purpose and also appears attractive to potential purchasers. However, these features are nevertheless aspects of an article that has a 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). Additionally, 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 hourglass-shaped base portion of the lighter because it is responsive to users' utilitarian demands. While the Work may be novel and aesthetically pleasing, it is nevertheless created in a way that allows the device to work as a lighter. As indicated previously, "Piezoelectric Lighter" meets the utilitarian and functional demands of a lighter. The Work thus fails the Denicola test because its form does not, in Professor Denicola's words, "reflect purely aesthetic visions." 67 *Minn. L. Rev.* at 743.

You have also cited the seminal case *Mazer v. Stein,* 347 U.S. 201 (1945) for the proposition that the Work includes conceptually separable features. 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 "Piezoelectric Lighter." In *Mazer*, the balinese dancer sculpture was a preexisting copyrightable work of art that was incorporated into a lamp. The court found that this incorporation did not bar copyright protection. While the Office admits the possibility that a useful article may contain separable features, *i.e.*, features which may, in themselves, be works of art protectable by copyright; 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 lighter which you have enumerated are conceptually separable.

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. § 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, Big J & J Int'l Corp., independently created the *Piezoelectric Lighter*, as acknowledged in your request for reconsideration. Letter from Mariam of 03/20/2009, at 5. 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, has 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....").[2]

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*, 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 nonprotectible 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 (8 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

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[2] *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.").

and arrangement original enough that their combination constitutes an original work of authorship.") (emphasis in original).

2. Any conceptually separable elements under consideration in the *Piezoelectric Lighter* do not embody sufficient creativity

Having analyzed the "Piezoelectric Lighter" for separability, we conclude that the Work lacks the physically or conceptually separable authorship required to support a copyright. Yet, even if the Work were to incorporate separable artistic features, separability alone is not sufficient to garner copyright protection. Ultimately, any separable design elements under *consideration* must embody a sufficient amount of creativity, and the hourglass-shaped base portion of the Work – the element which you claim is the separable artistic feature of the Work – does not.

In your request for reconsideration, you describe the base portion of the lighter as "hourglass-shaped." Letter from Mariam of 03/20/2009, at 4. You further detail the base portion's "sculptural features" and conclude that "[t]he design of the base of the lighter is thus the result of Applicant's selection and combination of several artistic sculptural features." *Id.* at 2. Yet, your description still indicates that the overall shape of the lighter's base can be summed up and readily identified in terms of one common geometric shape in three-dimensional form. As *Compendium II* states, "[I]t is not possible to copyright common geometric figures or shapes in three-dimensional form, such as the cone, cube, or sphere. The mere fact that a work of sculpture embodies uncopyrightable elements, such as standard forms of ornamentation or embellishment will not prevent registration. However, the creative expression capable of supporting copyright must consist of something more than the mere bringing together of two or three standard forms or shapes with minor linear or spatial variations." *Compendium II*, § 503.02(b). Because the form of the lighter's base consists simply of a standard hourglass shape with nearly no – or at most, just minor – linear or spatial variations, the Work does not rise to the level of creative expression that would entitle it to copyright protection.

3. Other considerations

You also state that the ornamental design of the Work is protected by a United States Design Patent and further mention that "[t]he Copyright Office recognizes that an ornamental design protected by a design patent is also eligible for copyright protection." Letter from Mariam of 03/20/2009, at 5. However, please note that the availability of any other form of intellectual property protection has no bearing on the determination of a work's copyrightability. The copyright law and relevant case law are the determiners of a work's copyright status. Thus, securing design patent protection for a work does not necessarily guarantee copyright protection for the work as well.

V. CONCLUSION

For the reasons stated in this letter, the Copyright Office Review Board affirms the refusal to register the "Piezoelectric Lighter." This decision constitutes final agency action in this matter.

Sincerely,

/s/

Tanya M. Sandros
Deputy General Counsel,
for the Review Board
United States Copyright Office